

**BL O/0638/24**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF:**

**TRADE MARK APPLICATION No. 3834357**

**IN THE NAME OF VALRHONA S.A.S.**

**DECISION**

1. On 29 September 2022, Valrhona S.A.S. applied under number 3834357 to register the following “*three-dimensional shape*” as a trade mark for use in relation to “*Chocolate and chocolate products namely chocolate beans, chocolate candies; Couverture chocolate; Baking chocolate; Chocolate preparations for making pastry and confectionery; Chocolate-based sauces*” in Class 30:



2. The evidence filed in support of the Application clearly showed that the shape for which protection was requested is “*the shape of chocolate beans sold by Valrhona*” (as expressly confirmed by Mr Andrew Gravett, who previously worked for the Applicant as a pastry chef in chocolate development and educating chefs about the company’s products and who is now Executive Pastry Chef at The Langham Hotel in London, in para. 5 of his Witness Statement dated 21 June 2023).

3. The Application was refused in its entirety under s.3(1)(b) of the Trade Marks Act 1994 for the reasons given by Ms Helen Davies in a Decision issued on behalf of the Registrar of Trade Marks under reference BL O/0260/24 on 26 March 2024.

4. The Hearing Officer determined that the shape was inherently non-distinctive:

[36] ... the mark has (a) not been shown to differ significantly from the norms and customs of the trade and (b) in light of the legal presumption that consumers are not in the habit of regarding 3D marks representing the goods as serving a trade mark function, that the trade mark is, and under the statutory test, devoid of trade mark distinctive character.

5. She came to that conclusion on the following basis (with emphasis added by me):

[31] When considering how the relevant consumer will perceive the mark **I have taken into consideration the fact that consumer perception is not necessarily the same in relation to a three-dimensional mark consisting of the appearance of the product itself as it is in relation to a word or figurative mark, and furthermore, consumers are not in the habit of making assumptions about the origin of products on the basis of their shape or the shape of their packaging in the absence of any graphic or word element** (*Henkel, Freixenet SA*). Here we have a representation of the goods, oval in shape, with a central indentation adorned with a figurative element at its centre.

[32] It is my view that the mark is a 3D representation of the goods, namely, a piece of chocolate. I would regard the sector in which these goods are offered to be the chocolate and chocolate confectionery sector. **Within that sector, the goods generally come in a range of shapes and sizes**. Some come in the form of a bar or block, while others come in individual bite size pieces of various shapes and sizes. These can be a very simple geometric shape such as a circle, oval or a square, while others are more fancy and elaborate in their design.

[33] As mentioned above, the mark is that of a three-dimensional oval shaped product with a similar oval shaped indentation. **From my**

**knowledge of chocolate products on the market, I do not regard the features of the mark to be enough to conclude that the shape of the chocolate 'in its totality' departs significantly from the norms and customs of the trade and thereby fulfils its essential function of indicating origin**. Furthermore, it should not necessitate an analytical examination of the goods by the consumer in order for them to identify features that would enable the goods to be distinguished from those of other undertakings in the market place. I

refer in this regard to C-136/02 Mag Instrument v OHIM and paragraph 32 where it reads:

*“It must always be determined whether such a mark permits the average consumer of that product, who is reasonably well informed and reasonably observant and circumspect, to distinguish the product concerned from those of other undertakings without conducting an analytical examination and without paying particular attention.”*

[34] If the relevant consumer is required to take time in analysing the goods in order to notice what are considered to be their distinguishing features, then the mark cannot be said to immediately designate single trade origin. Moreover, I am of the view that the relevant consumer would not pay too much attention to the shape of the product or the indentation and figurative element to the extent that it would lead them to conclude that the chocolate shape was a distinctive sign designating the goods of a particular undertaking. **I acknowledge the figurative element appearing on the mark but I consider this would be regarded by the relevant consumer as a non-distinctive decorative feature that does not imbue the mark with any distinctive character.**

[35] **In assessing the inherent distinctiveness of the mark I have also considered how the mark will be perceived when appearing on the packaging. In my mind, it serves only to indicate to the consumer the appearance of the chocolate they can expect to find inside the packaging and they will not perceive the sign as a trade mark.**

6. In paras [37] to [43] of her Decision she directed herself correctly as to the legal principles applicable to the test for determining whether a mark qualifies for registration under the proviso to s.3(1) of the 1994 Act as a result of distinctiveness acquired through use. She then assessed the evidence filed in support of the Application in the light of those principles in paras [44] to [71] of her Decision.
7. In relation to the Applicant’s evidence concerning the use of images of the shape on product packaging, she again found in para. [53] that these did not imbue the depicted shape with distinctiveness: *“the mark is not being used to indicate the goods of a single undertaking, nor will it be perceived by the consumer as such, who will instead take it as representing the goods inside the package”*.

8. In para. [59] of her Decision she considered the 6 Witness Statements which I refer to in more detail in para. [18] below and went on to find as follows:

[61] ... it has been shown in the statements of the independent witnesses that there are some consumers who recognise and associate the shape, even exclusively, with the trade mark VALRHONA, but that does not necessarily mean that the shape itself is functioning as a trade mark. It must be proven that the shape itself is recognised as denoting trade origin to a significant proportion of relevant consumers and is independently relied upon as the identifier of the commercial origin. The evidence does not in my opinion show that to be the case. The consumer may find that the shape brings to mind the goods and brand name [with] which they have become familiar (VALRHONA) but these kinds of recognition and association do not necessarily amount to distinctiveness for trade mark purposes. It does not prove that the consumer perceives the shape of the goods as a trade mark, nor is there evidence to suggest that the consumer has been educated to do so. I do not agree that the extensive use and exposure that the mark has had when appearing on the packaging constitutes educating the relevant public. I do not consider that simply displaying a representation of the goods on the packaging is educating the consumer that it is a trade mark but merely informs them of what is inside the package. Moreover, recognition by a very small number of witnesses is not sufficient to conclude that the mark has acquired distinctive character.

[62] I note too that the mark is available to the general public through various retail outlets like Waitrose, Selfridges and Wholefoods, as well as other online retailers, but it is my view that the mark is not being used for the purposes of the identification, by the relevant class of persons, of the goods as originating from a given undertaking. The evidence has not shown that the relevant consumer perceives the mark as a trade mark. I also appreciate that the goods are sold in vast quantities, but that is not enough to conclude that the mark has acquired distinctiveness through use.”

9. The importance of the role played by the word mark VALRHONA in sales and marketing of the Applicant’s chocolate beans was again emphasised in para. [66] of her Decision:

[66] The evidence showed that the products are sold by various third parties but they refer to the goods as ‘Valrhona’ products. Another seven websites were identified in the evidence (Exhibit JM3) and refer to the goods as the VALRHONA ‘fève’ and that they associate the ‘feve’ with the applicant. In my mind, this suggests that it is VALRHONA that they take to be the trade mark designating origin, and while recognising the ‘fève’ and associating it with the applicant

that is not sufficient to say that they perceive it as a trade mark. There was some use of the goods being sold in areas around the UK but the majority centred around London.

10. The Hearing Officer's overall conclusion in relation to the Applicant's claim for distinctiveness acquired through use was as follows:

[70] Having considered the evidence, it is clear that the applicant has significant presence within the high end hotel market at least and that those consumers recognise the chocolate shape as that used by the applicant. However, I am uncertain as to what extent they can speak for a significant proportion of the relevant consumer which I have concluded will also include members of the general public. It is also my view that the shape itself is not being used as an indicator of brand origin, or that the mark is being used in a manner that guarantees to the consumer that the product originates from a particular undertaking. The evidence has shown that the mark applied for has, in practice, always been used with another distinctive sign, namely, VALRHONA. Consequently, there is an additional burden on the applicant to establish that, contrary to the more obvious conclusion that it is the distinctive sign which really does the job of distinguishing, in fact the non-distinctive sign has come to be regarded as a second trade mark capable (by itself) of distinguishing the applicants' goods. It is my view that the evidence has not shown that to be the case.

[71] The evidence has not demonstrated the mark has acquired a distinctive character as a result of the use made of it.

11. The Applicant now appeals to an Appointed Person under s.76 of the 1994 Act. It does not contest the Hearing Officer's factual determination that the three-dimensional shape which it seeks to register as a trade mark was at the relevant date (29 September 2022) inherently devoid of distinctive character for goods of the kind specified in its application for registration. For all such goods the findings I have emphasised in the paragraphs from the Hearing Officer's Decision which I have quoted in para. [5] above are therefore the starting point for the purposes of the present Appeal.
12. Moving forward from there the Applicant contends that its application for registration should have been accepted on the basis of distinctiveness acquired through use under the proviso to s.3(1) of the 1994 Act for the restricted specification of goods it now proposes unconditionally to adopt by amendment under s.39(1) of the Act (in line with the practice referred to in CARDINAL PLACE Trade Mark BL O/339/04 (28 October

2004) at para. [10] and expanded upon in CITIBOND Trade Mark [2007] RPC 13; BL O/197/06 (7 July 2007); at paras [9] to [13], [19] to [21] and [51]).

13. The proposed amendment would delete all except '*couverture chocolate*' from the list of goods specified in Class 30. That term is to be given its ordinary and natural meaning as confirmed in the Declaration made on behalf of the Applicant in Box 13 of its Form TM3 (Application to register a trade mark) filed on 29 September 2022.
14. In the United Kingdom, use of the designation '*couverture chocolate*' has since 1977 been restricted by successive iterations of The Cocoa and Chocolate Products Regulations to products that complied with a modified definition of the reserved description '*chocolate*' which required them to contain not less than 31% cocoa butter and not less than 2.5% of dry non-fat cocoa solids. That provides a sufficient basis for treating '*couverture chocolate*' (as legislatively defined) as a species of '*chocolate*' (as legislatively defined).
15. The evidence on file indicates that the properties of '*couverture chocolate*' make it desirable for use as a base product or key ingredient by chocolatiers, confectioners, patisseries, high-end restaurants and accomplished home bakers and cooks. People wanting '*couverture chocolate*' for use in that way are a necessary reference point for the required assessment of the perceptions of the reasonably well-informed and reasonably observant and circumspect consumer of such chocolate.
16. It does not follow that the shape in question must be assessed for trade mark distinctiveness in the sector consisting only of the actual goods (in this case '*couverture chocolate*') for which registration has been requested: it is permissible when making that assessment to take account of norms and variations in the shape of goods of the same type (in this case '*chocolate*'): Case C-173/04P Deutsche SiSi-Werke GmbH & Co. Betriebs KG v EUIPO EU:C:2006:20 at paras [31] to [37].
17. Chocolate products come in a wide variety of shapes and sizes and — since it is harder to stand out in a crowd than in a small group — that makes it commensurately difficult for a chocolate product shape which is inherently devoid of distinctive character to acquire a distinctive character through use. That consideration is brought to the fore by

the Applicant's case for registration on this Appeal. Whilst not contesting the Hearing Officer's factual determination — made on the basis of the findings which I have emphasised in the paragraphs I have quoted from her Decision in para. [5] above — that its chocolate bean shape was inherently devoid of distinctive character, the Applicant challenges what was, in sum and substance, the Hearing Officer's adherence to those findings in answer to its independent witness evidence as to distinctiveness acquired through use.

18. The Applicant refers in its Skeleton Argument to the following witness statement evidence (which I have marked up for the purpose of highlighting what I consider to be a disconnect between the situation of these witnesses and the situation of the average consumer used as the model for the Hearing Officer's unchallenged factual determination that the shape was inherently devoid of distinctive character):

(1) Mr Andrew Gravett is the Executive Pastry Chef at The Langham Hotel in London. In his Witness Statement dated 21 June 2023 he said:

*5. I recognise the shape shown above, as the shape of chocolate beans sold by VALRHONA and which are used in my kitchen. I and other chefs definitely associate it with VALRHONA. **It is completely***

***different to all other brands** and the product is designed to melt more quickly and is less likely to burn.*

*6. I would rely on the shape to identify it as originating from VALRHONA, for example if I was watching a TV show and see the shape, then I know a VALRHONA product is being used as **no other brand has it.***

(2) Mr Benoit Blin is the Head Pastry Chef at Le Manoir aux Quat'Saisons at the Belmond Hotel in Oxford. In his Witness Statement dated 16 June 2023 he said:

*4. I definitely recognise the above chocolate shape which I refer to as the fève.*

*5. **To my knowledge nobody else is using the feve** and I know it is a product from VALRHONA from its shape. I do not even need the packaging: if I have it in a bowl in front of me, I would rely on the shape to know it is a product from VALRHONA. For me, it is a very well recognised shape and my mind goes straight to VALRHONA. There is no shadow of a doubt that it*

*is theirs, that is very clear to me. It is definitely well-known in the industry.*

- (3) Mr Sylvain Goujon is the Executive Pastry Chef at the Four Seasons Hotel London. In his Witness Statement dated 16 June 2023 he said in paragraph 4 "I am very familiar with the mark shown above and immediately recognise it on sight" and went on to say in paragraph 5:

*"5. I perceive the mark shown above as a brand. The shape means that I recognise it as a chocolate from VALRHONA. **To my knowledge, it is the only producer using this shape on chocolates.** Visually, by the look of the shape, this is VALRHONA chocolate."*

- (4) Mr Mourad Khiat is the Executive Pastry Chef at the Berkeley Hotel in London. In his Witness Statement dated 10 July 2023 he said at paragraph 4 "I know Valrhona very well" and in paragraph 5 said:

*"The shape of their chocolate says it all. I immediately recognise it as a good quality, top end product from VALRHONA. **Nobody else is using this shape for chocolate to my knowledge.** so I know it is a VALRHONA product for sure. I consider the shape of VALRHONA'S chocolate to be well-known in the industry."*

- (5) Mr Toby Hampton is the Managing Director of ETS Public Relations Ltd. In his Witness Statement dated 21 June 2023 he explained that he has worked with a number of chocolate companies, including for the previous 7 years Valrhona. He said "*Being in the chocolate sector means that I am used to seeing chocolate producers and their branding. I very much recognise the mark shown above*" and it was "**always synonymous with Valrhona as far as I can remember**" (paragraph 4). "*I like to think that for those who work in the industry and with that quality of chocolates, if you put a few in front of them without anything else, I would imagine that a high percentage would recognise it as originating from Valrhona*" (paragraph 5). "*I would say there is an element of relying on the shape to make any repeated purchases*" (paragraph 6). "*I would say that those in the chocolate industry, for example, a patisserie chef, top-end restaurants, would recognise the shape straight away as originating from VALRHONA*" (paragraph 7).

- (6) Mr Martin Keen is the Managing Director of Chef Publishing Ltd. based in Oxford. In his Witness Statement dated 26 June 2023 he said:

*"4. I have worked with VALRHONA for around 6 years and I am very familiar with the shape of its*

*chocolate. I immediately recognise it when I attend tasting events, even if it is not in any packaging. My company also regularly publishes books, articles and recipes that feature VALRHONA 'S chocolate.*

*5. I believe that the shape of their chocolate is well-known in the industry. To the best of my knowledge, no-one else produces anything like it*

19. These were people from the constituency of consumers referred to in para. [15] above and for them the shape of the Applicant's goods in the form of "couverture chocolate" beans was according to their evidence both unique and sufficient — in and of itself — to individualise them to a single economic undertaking i.e. Valrhona. Whereas the Hearing Officer's unchallenged factual determination to the effect that the shape was inherently devoid of distinctive character proceeded on the premise that the chocolate bean shape of the Applicant's goods did not depart significantly from the norms and customs of the trade in chocolate products. Which would have been doubtful, at least, if it had to yield to the evidence of these 6 witnesses as to the uniqueness of the product shape sought to be protected by registration as a trade mark.
20. The Hearing Officer declined to extrapolate from the evidence of these witnesses because she was "*uncertain as to what extent they can speak for a significant proportion of the relevant consumer which I have concluded will also include members of the general public. It is also my view that the shape itself is not being used as an indicator of brand origin, or that the mark is being used in a manner that guarantees to the consumer that the product originated from a particular undertaking*" (para. [70]).
21. The second part of that is vulnerable to the response that for at least those 6 witnesses 'it was, because it did'. The first part of it calls into question the probative value of their evidence as to uniqueness of the chocolate bean shape. And that necessarily returns the decision taker to the interplay between the subjective and objective aspects of distinctiveness built into the repeatedly stated requirement for a shape to depart significantly from the norms and customs of the sector and 'thereby' fulfil the essential function of indicating origin.
22. On first principles, a shape must by nature and / or nurture possess a distinctive character when applied to goods of the kind specified in the request for protection by

registration in order to be free of objection under s.3(1)(b) of the Act. Distinctiveness is a relative concept in the sense that it falls to be assessed with proper regard for the norms and variations of shape that are liable to be encountered in use in the market sector in which protection has been requested. It must be clear to the decision taker that the shape in question is or has become sufficiently arresting to overcome consumer inertia in the perception of shapes as indications of trade origin. And it cannot be assumed that an assessment made in the light of circumstances prevailing in the marketplace at one point in time will necessarily hold good in the light of circumstances prevailing in the marketplace at a substantially earlier or substantially later point in time.

23. All of which points to the desirability of the decision taker being provided with evidence demonstrative of the norms and variations of shape liable to be encountered in use in the relevant market sector. Nothing of substance was provided for consideration in the present case. The Applicant's General Director, Mr Jean-Luc Grisot, simply asserted in para. 32 of his Witness Statement dated 23 June 2023 that its chocolate bean shape "*is a unique shape that is only used by VALRHONA*". The Hearing Officer filled the gap by maintaining the position that "*From my own knowledge of chocolate products on the market, I do not regard the features of the mark to be enough to conclude that the shape of the chocolate 'in its totality' departs significantly from the norms and customs of the trade*" (para. [33]). The Applicant endeavoured to fill the gap with narrative statements from 6 witnesses maintaining the position that within their horizons the shape of the chocolate product was unique to Valrhona. In my view, it was open to the Hearing Officer to regard their evidence as inconclusive in the absence of cogent supporting evidence sufficient to establish as an objective fact that the Applicant's chocolate bean shape constituted a significant departure from the norms and customs of the trade in the market for chocolate products.
24. The Hearing Officer's position was central to the premise on which she made her unchallenged factual determination to the effect that the Applicant's chocolate bean shape was inherently devoid of distinctive character for '*chocolate beans*' necessarily including '*couverture chocolate*' in the form of '*chocolate beans*'. The position of the 6 witnesses was found on assessment to be insufficient to overcome or displace that unchallenged factual determination for the purposes of the Applicant's claim for

distinctiveness acquired through use. That was itself a factual assessment made from a legally correct perspective, as was the ensuing determination that the evidence filed by the Applicant had not demonstrated that its chocolate bean shape had acquired a distinctive character as a result of the use made of it for goods of the kind (pertinently including ‘*couverture chocolate*’ in the form of ‘*chocolate beans*’) covered by its application for registration.

25. I am for the reasons I have given unable to accept within the confines of the present Appeal (see paras [11] to [14] and [17] above) that the Hearing Officer’s Decision to reject the Applicant’s request for protection by registration under the proviso to s.3(1)(b) of the Act can be regarded as rationally insupportable, whether by reason of an identifiable flaw in the treatment of the question to be decided, such as a gap in logic, a lack of consistency, or a failure to take into account a material factor, which undermines the cogency of it or on any other basis. In the final analysis, the Decision under appeal proceeded without material error to give effect to the well-established proposition that: “...*use of a mark does not prove that the mark is distinctive. Increased use does not do so either. The use and the increased use must be in a distinctive sense to have any materiality.*” Bach and Bach Flower Remedies Trade Marks [2000] RPC 513 at para. [49] (per Morritt LJ with whom Thorpe and Chadwick L.JJ agreed).
26. On settled principles the Appeal must be dismissed. In line with the usual practice of this Tribunal (which is to treat appeals relating to the refusal of an application for registration as a continuation of the procedure for registration) the Appeal is dismissed with no order as to costs.

Geoffrey Hobbs KC

8 July 2024

Mr Thomas St Quintin instructed by Mewburn Ellis LLP appeared on behalf of the Applicant (Appellant) and Ms Natalie Morgan appeared on behalf of the Registrar of Trade Marks (Respondent)