

**TRADE MARKS ACT 1994
IN THE MATTER OF INTERNATIONAL REGISTRATION NUMBER
WO0000001785667
BY TRAEGER PELLET GRILLS, LLC
TO PROTECT THE FOLLOWING TRADE MARK IN CLASS 4:**

WHEN FLAVOR MATTERS

Background

1. On 18 April 2024, Traeger Pellet Grills, LLC ('the Holder') applied to designate the UK as part of an International Registration at the World Intellectual Property Organization ('WIPO') for the above mark.

2. Registration was sought in Class 4 for the following goods:

Class 4: Wood pellets for grilling and smoking food.

3. On the 7 May 2024, the Intellectual Property Office ('UKIPO') issued an examination report in response to the application. In that report, an objection was raised under Section 3(1)(b) of the Trade Marks Act 1994 ('the Act') which reads as follows:

Absolute grounds for refusal

Section 3(1)(b)

The designation is not acceptable in Class 4. There is an objection under Section 3(1)(b) of the Act as the mark is devoid of any distinctive character.

This is because the expression merely serves a promotional function e.g. wood pellets by means of grilling and smoking to flavour your food thus to enrich and enhance the taste.

It is considered that the average consumer when greeted with the sign "WHEN FLAVOR MATTERS" would not attribute any trade mark significance and would instead merely perceive the sign as a promotional intimation with the purpose of highlighting a positive attribute of the goods being offered that when taste is important and significant to you then the use of the wood pellets will create the flavour that you desire.

When a sign is purely promotional in nature it is considered that it cannot function as a badge guaranteeing the commercial origin of the goods and does not distinguish your goods from those of another undertaking.

4. On 3 July 2024, the Appointed Representative of the Holder, HGF Limited, requested a hearing in which to discuss the objection raised and make submissions supporting acceptance of the mark.

5. On 22 August 2024 the hearing was held before me, with Mr James Appleyard of HGF Limited representing the Holder. Mr Appleyard's submissions were as follows.

6. Mr Appleyard stated that he disagrees with the objection under Section 3(1)(b). In his view the mark is not merely a promotional slogan. Regardless of this, he reminded me that UKIPO guidance states that slogans are registrable, provided they are not directly descriptive of the goods and services, and that they are not devoid of any distinctive character.

7. Next, Mr Appleyard said that in his opinion the mark in question is distinctive for the goods applied for. In his view, it does not refer directly to the goods nor does it inform the consumer about the goods in any way. It features an unusual syntax and structure and is an unfinished sentence. In his view, the mark is immediately identifiable to the consumer as a badge of trade origin.

8. Mr Appleyard was of the opinion that the mark is odd for the goods specified in Class 4, i.e., *wood pellets for grilling and smoking food*. He said that if the goods were foodstuffs or spice mixes, for example, then the mark may have some meaning in relation to those goods. These goods are a means of cooking, therefore the reference to 'FLAVOR' in the mark is a step removed. The mark is not closely aligned with the goods.

9. In the UKIPO Manual of Trade Marks Practice it states that slogans are registrable and that an element of ambiguity and imagination is useful to imbue the mark with distinctive character. In Mr Appleyard's view the mark doesn't say something simplistic like 'Makes Food Taste Great' for example, the mark is more ambiguous than that and is more than the sum of its parts. It triggers off a cognitive process requiring interpretive effort on the part of the consumer.

10. In Mr Appleyard's view, flavour would not be the consumer's main concern when selecting these goods.

11. Mr Appleyard accepted there are examples of other undertakings using the format 'when...matters' in a promotional sense but these examples are not overly common and are not conclusive when assessing the perception of the consumer. Further, the consumer would not perform a search for similar slogans to determine whether the mark was a trade mark or not.

12. Finally, Mr Appleyard felt it pertinent to present to me some examples of earlier registered marks that contain the word 'flavour'. UK00004070955 Flavour Guru and UK00004042216 PASSION THROUGH FLAVOUR. While he was aware that examination is not bound by earlier acceptances Mr Appleyard felt that these marks are at least on par with, or less distinctive than, the mark in question.

13. Mr Appleyard suggested that it may be possible to provide evidence of

acquired distinctiveness and also enquired as to whether an amendment to the goods could overcome the objection. I stated that in my view an amendment to the specification is unlikely to overcome the objection but that if he wished to submit such a request I would consider it.

14. On 29 August 2024 the hearing report was issued. In it I confirmed that the Section 3(1)(b) objection had been maintained on the basis that I did not consider the sign to possess distinctive character. The purpose of the goods applied for in Class 4 is to smoke or grill food, and in my view, the point of cooking food in this way is to introduce flavour to the food via the method of cooking. It is my view that the word 'FLAVOR' in the mark is a reference to the flavour imbued into the food by the wood pellets during smoking or grilling. The consumer, who purchases pellets with the intention of smoking or grilling food, is in my view going to have the resulting flavour of the food (e.g. a flavoured smokiness) in the forefront of their mind when making that purchase and will make an easy connection between the goods and the reference to 'FLAVOR' in the mark. As such, I disagree that the reference to 'FLAVOR' in the mark is odd or that the mark is a step removed from the goods applied for.

15. In the report I included a screenshot of the Holder's website, where the mark is clearly shown in use as a promotional slogan and under the brand name 'Traeger'. In my view the diverse range of flavoured pellets on offer on the website (such as apple, cherry, pecan etc) clearly shows that flavour is a key consideration for the consumer when purchasing the goods, i.e., flavour matters to the consumer when making their purchase.

16. In the report I disagreed with Mr Appleyard's submissions that the words in the mark require the consumer to undergo a cognitive process to arrive at its meaning. I also disagreed that the fact that the sign 'WHEN FLAVOR MATTERS' is an unfinished sentence creates an element of uncertainty or perplexing ellipsis in the mark. In the report I referred to research I had conducted prior to the hearing and showed that a Google search for the phrase "when * matters" returned examples of other undertakings using this format in a promotional way. The pattern I have noticed is that the phrases follow this format:

'when – (insert word relevant to the goods or services) – matters'.

and examples of my findings include:

When Details Matter for bathroom accessories
When Results Matter for education and training

These examples support my opinion that this format is not grammatically unusual or imaginative, and also that there is a link between the mark and the goods (see Annex for examples). When the consumer views the sign 'WHEN FLAVOR MATTERS' in the context of the goods (pellets for grilling and smoking food) it is my opinion that there is no mystery as to what it refers. Therefore, it is my opinion that the consumer would not consider it at all unusual. Instead, they would simply see it as a non-distinctive, promotional phrase indicating that that the holder's goods are the best choice when flavour matters, and would not perceive it as a trade mark.

Notwithstanding this research, it is my view that the sign ‘WHEN FLAVOR MATTERS’ falls foul of Section 3(1)(b) based upon my linguistic analysis alone. It was for these reasons that I maintained the objection, allowing Mr Appleyard a response period of two months to consider a potential limitation to the specification or to consider making a plea of acquired distinctiveness.

17. On 29 October 2024, HGF Limited responded to the hearing report. They did not make a plea of acquired distinctiveness. They requested an amendment to the specification in Class 4 as a means to overcome the objection. The suggested amendment was as follows:

Current specification:

Class 4: *Wood pellets for grilling and smoking food.*

Proposed amended specification:

Class 4: *Wood pellets for grilling food.*

The justification given for this request was that the removal of the word ‘smoking’ from the specification “should be sufficient to overcome the objection because this will render the goods sought for registration as simply a means of cooking, and not as a method of adding flavour to food in any way. Such goods cannot be seen as imbuing the food with a flavour, and will simply be seen by the relevant public as a method of cooking food.”

18. On 5 November 2024, I declined to effect the suggested amendment because in my view the message behind the sign is not changed by the removal of the word ‘smoking’ from the specification. The limitation, even if compliant with the guidance set out in *POSTKANTOOR (C-363/99)*, would not have avoided the objection.

19. On 5 December 2024, the representative filed a form TM5 requesting a statement of grounds. As such I am now asked under Section 76 of the Trade Marks Act 1994 and Rule 69 of the Trade Mark Rules 2008, to state in writing the grounds for my decision and the materials used in arriving at it. No formal evidence of use has been put before me for the purposes of demonstrating acquired distinctiveness. Therefore, in respect of the goods listed in paragraph 2 above, I only have the prima facie case to consider.

The Law

20. Section 3(1)(b) of the Act reads as follows:

3.-(1) The following shall not be registered –

(a) ...

(b) trade marks which are devoid of any distinctive character,

(c) ...

(d) ...

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

The relevant legal principles - Section 3(1)(b)

21. The Court of Justice of the European Union ('CJEU') has emphasised the need to interpret the grounds for refusal of registration listed in Article 3(1) of Directive 2008/95/EC ('the Directive', being the codified version of the original Directive 89/104/EEC) and Article 7(1) of Council Regulation (EC) No 207/2009 ('the Regulation', being the codified version of original Council Regulation 40/94), in the light of the general interest underlying each of them (Case C-37/03P, *Bio ID v OHIM*, para 59 and the case law cited there and, e.g. Case C-273/05P *Celltech R&D Ltd V OHIM*).

22. The general interest to be taken into account in each case must reflect different considerations according to the ground for refusal in question. In relation to section 3(1)(b) (and the equivalent provisions referred to above upon which section 3(1)(b) is based) the Court has held that "...the public interest... is, manifestly, indissociable from the essential function of a trade mark" (Case C-329/02P *Satelliten Fernsehen GmbH v OHIM 'SAT.1'*). The essential function thus referred to is that of guaranteeing the identity of the origin of the goods or services offered under the mark to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin (see paragraph 23 of the above mentioned judgment). Marks which are devoid of distinctive character are incapable of fulfilling that essential function. Moreover, the word 'devoid' has, in the UK at least, been paraphrased as meaning 'unpossessed of' from the perspective of the average consumer.

23. Section 3(1)(b) must include within its scope those marks which, whilst not designating a characteristic of the relevant goods and services (i.e. not being necessarily descriptive), will nonetheless fail to serve the essential function of a trade mark in that they will be incapable of designating origin. In terms of assessing distinctiveness under section 3(1)(b), the CJEU provided guidance in *Koninklijke KPN Nederland NV v Benelux Merkenbureau (Postkantoor)* C363/99) where, at paragraph 34, it stated:

*“A trade mark’s distinctiveness within the meaning of Article 3(1)(b) of the Directive must be assessed, first, by reference to those goods or services and, second, by reference to the perception of the relevant public, which consists of average consumers of the goods or services in question, who are reasonably well informed and reasonably observant and circumspect (see inter alia Joined Cases C-53/01 to C55/01 *Linde and Others* 5 [2003] ECR I-3161, para 41, and Case C104/01 *Libertel**

[2003] ECR I-3793, paras 46 and 75).”

24. So, the question of a mark being devoid of any distinctive character is assessed by reference to the goods and/or services applied for, and by reference to the perception of the average consumer for those goods and/or services. I should also add that being ‘devoid of any distinctive character’ does not represent an objective standard, but is based upon an assessment which concludes that the sign presented for registration is ‘unpossessed’ of distinctive character from the perspective of the average consumer. Since, in the relevant authorities’ assessment, the sign is unpossessed of distinctive character (this has been, in turn, paraphrased as being ‘origin-neutral’ as distinct from ‘origin-specific’), the sign is not considered capable of performing the essential function of a trade mark.

25. In addition to considering the objection in respect of all the goods claimed I then need to assess whether promotional slogans can fulfil the function of a distinctive trade mark. Following from the CJEU guidance on cases such as *Sykes Enterprises v OHIM* (Real People Real Solutions) [2002] ECR II-5179, there had been a tendency to assume that promotional statements cannot possess the necessary distinctive character to indicate trade origin. This sort of assessment was based on the assumption that consumers are not in the habit of regarding slogans as trade marks, but instead regard them as purely promotional, non-distinctive material. Following the CJEU decision in Case C398/08P *Audi AG v OHIM* (‘Vorsprung Durch Technik’) we now know that this is only part of the consideration that must be made. In paragraph 44 of that decision, the Court stated:

“... while it is true... that a mark possesses distinctive character only in so far as it serves to identify the goods or services in respect of which registration is applied for as originating from a particular undertaking, it must be held that the mere fact that a mark is perceived by the relevant public as a promotional formula, and that, because of its laudatory nature, it could in principle be used by other undertakings, is not sufficient, in itself, to support the conclusion that the mark is devoid of distinctive character.”

26. It is also a well-established principle that the Registrar’s role in examination will involve a full and stringent examination of the facts, underlying the Registrar’s frontline role in preventing the granting of undue monopolies, see, to that effect, CJEU Case C-51/10 P, *Agencja Wydawnicza Technopol sp. z o.o. v OHIM* [2011] ECR I 1541. Whilst this case was, technically speaking, in relation only to section 3(1)(c) or its equivalent in European law, the principle about the ‘prevention of undue monopolies’ must hold good whether Section 3(1)(b) and/or (c) applies.

Application of legal principles – Section 3(1)(b)

27. In arriving at my decision, I first have to identify who the average consumer for the goods covered by the application is. The specification covers *pellets for grilling and smoking food* in Class 4. I consider it reasonable to assume

the relevant consumer to be the general public, specifically those concerned with barbecuing or grilling food. The level of consumer attention for the goods covered by the application is likely to be low to moderate, however in my opinion, the precise level of attention given to the purchase of these goods by the relevant consumer will not have a material impact on how they perceive the words of the application.

28. I now have to decide whether the sign applied for, used in relation to the goods claimed, would be seen as one which lacks any capacity prima facie to distinguish the products of one trader from those of another. I must consider the perception of the average consumer when seeing the words 'WHEN FLAVOR MATTERS' in normal and fair use in relation to the goods claimed. Taking into account the fact that the goods claimed are pellets to be used in the cooking of food, that are sold in a variety of flavours, I feel that the objection is valid in respect of those goods.

29. It is necessary to start with a linguistic analysis of the words appearing in the mark in order to assess whether or not they are capable of performing the essential function of a trade mark. Although it is essential that any assessment of distinctiveness takes into account the mark's totality, it is also necessary to take into account the meaning of the individual parts of the mark.

30. The mark applied for consists of the phrase 'WHEN FLAVOR MATTERS'. Collins dictionary defines 'FLAVOR' as '*The flavor of a food or drink is its taste; If you flavor food or drink, you add something to it to give it a particular taste*'. It defines 'MATTERS' as '*be important, make a difference, count, be relevant*'.

31. I accept that marks can be both promotional and distinctive as a trade mark at the same time. However, the case law tells us that, in the prima facie, marks must be capable of being perceived as an indication of the origin of the goods and services. In other words, the essential 'origin' function must be recognisable alongside the other function of promotion. See, to that effect, (*OHIM v Erpo Möbelwerk C-64/02* "The Principles of Comfort").

32. It is reasonable to consider fair and notional use when assessing a mark. As demonstrated on the Holder's website, the goods are sold in a variety of flavours such as apple, cherry, pecan etc, and the sign at issue is displayed alongside the display of available flavours and under the brand name 'Traeger'. In my view, this manner of use supports my view that the mark at issue is a promotional reference only to the importance of the flavour imbued into the food by the goods and as such the reference to 'FLAVOR' in the mark is in no way arbitrary or unusual when seen in this context. In my view, the Holder is not using the mark in a manner commensurate with trade mark use in the example shown. Notwithstanding this example of the manner of use, it is my view that the sign 'WHEN FLAVOR MATTERS' falls foul of Section 3(1)(b) based upon my linguistic analysis alone. See Annex for the relevant example of the way the Holder is using the mark.

33. In *Audi v OHIM* ("Vorsprung durch Technik") C-398/08, the ECJ confirmed that literal characteristics - such as whether a mark can have a number of meanings, whether it constitutes a play on words, or whether it would be perceived as imaginative, surprising or unexpected - are likely to endow a slogan with distinctive

character. Despite Mr Appleyard's submissions that the structure of the mark is an unfinished, elliptical sentence constituting unusual wording, I am not persuaded that there is anything unusual or imaginative about the mark. As I demonstrated in the hearing report (detailed above at paragraph 16), research has shown that the structure of the mark, namely 'when [...] matters' is a known rhetorical structure used in the promotion of goods and services. This suggests to me that the relevant consumer will be accustomed to seeing a phrase of this structure used to reference and promote the important elements or outcomes of the goods and services on offer.

34. Mr Appleyard stated that the use of internet results is not conclusive when assessing the perception of the relevant consumer, but the use of internet searches to identify common usage of certain phrases or rhetorical structures has been deemed acceptable in case law (for example, in the case O-185-12 *FEEDBACKMATTERS*, at paragraphs 56, 57). The examples of other undertakings using the 'when * matters' structure support my view that the structure or wording of the sign 'WHEN FLAVOR MATTERS' is not unusual or creative. Notwithstanding this, it is my view that the sign 'WHEN FLAVOR MATTERS' falls foul of Section 3(1)(b) based upon my linguistic analysis alone. In my opinion the mark simply consists of ordinary and everyday words put together in a grammatically correct arrangement, the combined meaning of which is a phrase which is easily understood when seen in relation to the goods applied for (see to that effect O-185-12 *FEEDBACKMATTERS* paragraph 45). It is my view that the mark is unpossessed of the level of distinctive character required to make it a memorable indicator of trade origin that would enable the consumer to repeat the purchasing experience if it proves to be positive, or to avoid it, if it proves to be negative (T-79/00 *Rewe Zentral AG v OHIM*).

35. Further, the sign appears in plain word type and has no stylisation, device elements or unusual grammatical juxtaposition, in my opinion, to give it any distinctive character enabling it to be registered. It is highly unlikely that the words alone would indicate, to consumers, the trade origin of the goods.

36. Turning finally to the earlier registrations cited by Mr Appleyard, I addressed them in the hearing report, concluding that the cited registrations may feature elements that imbued those marks with the required level of distinctive character. Nevertheless, I was not party the acceptance of the marks, and as such they have not influenced my assessment of the mark at issue. I am minded of the decision of the Appointed Person BL-O-262-18 (Brexit, paragraph 11):

"..... Just because a mark is on the Register does not mean it will be held valid when challenged. Furthermore, if the touchstone for registration was to be a comparison with marks already on the register, then registration would come to depend on the lowest common denominator. In any event, it is quite clear that the application of the section 3(1)(b) ground requires an assessment not against other marks on the register, but against the standard laid down in that provision, as interpreted in the case law."

and further, the decision of the Appointed Person in O-185-12 *FEEDBACK MATTERS*, paragraph 67:

Although I agreed to review the list, the job of doing so reinforced to me the sense that there is in the general rule that each mark has to be assessed independently against the relevant legal criteria and to stand or fall on its own merits. While it is possible to reach a broad view that two marks are of a similar type and therefore should be treated similarly, that can only be so if the relevant goods and services and their respective average consumers are identical. And, of course, the marks themselves all mean different things and may or may not be the same or similar to phrases in regular use, or have particular connotations. Also, some may have been accepted as a result of evidence of acquired distinctiveness through use. So, what may appear to be dissimilar treatment may be wholly justified by these differences.

37. As such it is my view that the relevant consumer would not perceive the phrase 'WHEN FLAVOR MATTERS' as being anything other than a non-distinctive promotional expression that simply indicates that the goods on offer, being pellets used for grilling and smoking food, are the best choice when flavour is important, or 'when flavor matters'.

Conclusion

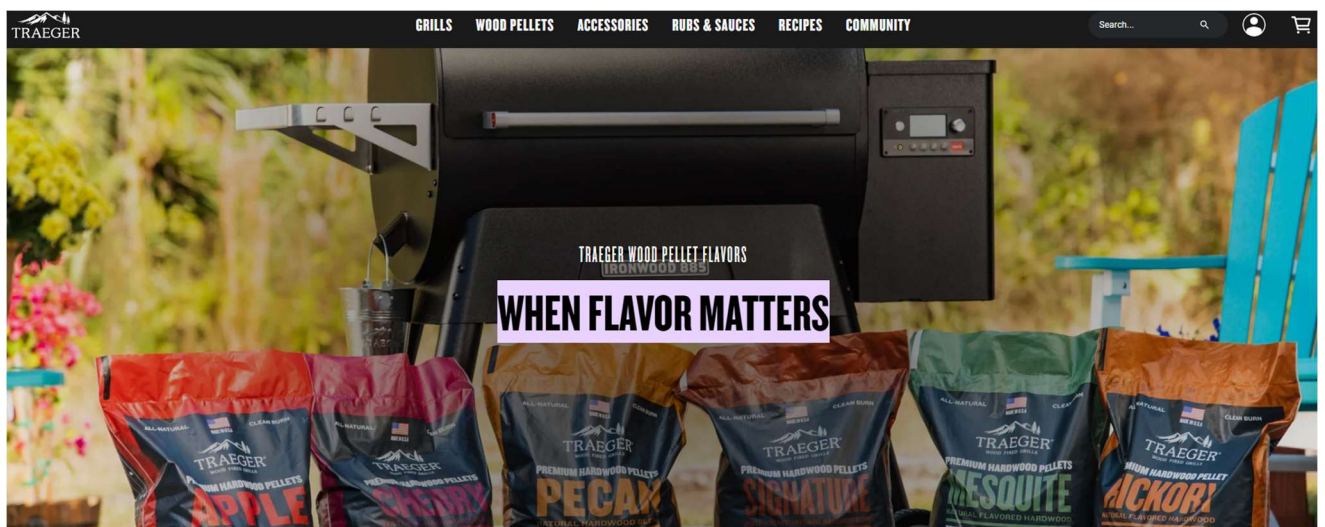
38. Having given due care and attention to all of the arguments put forward during the proceedings, the application is refused under Section 3(1)(b) for all goods in Class 4.

Dated this 9th day of October 2025

**Jayne Cocks
For the Registrar
The Comptroller-General**

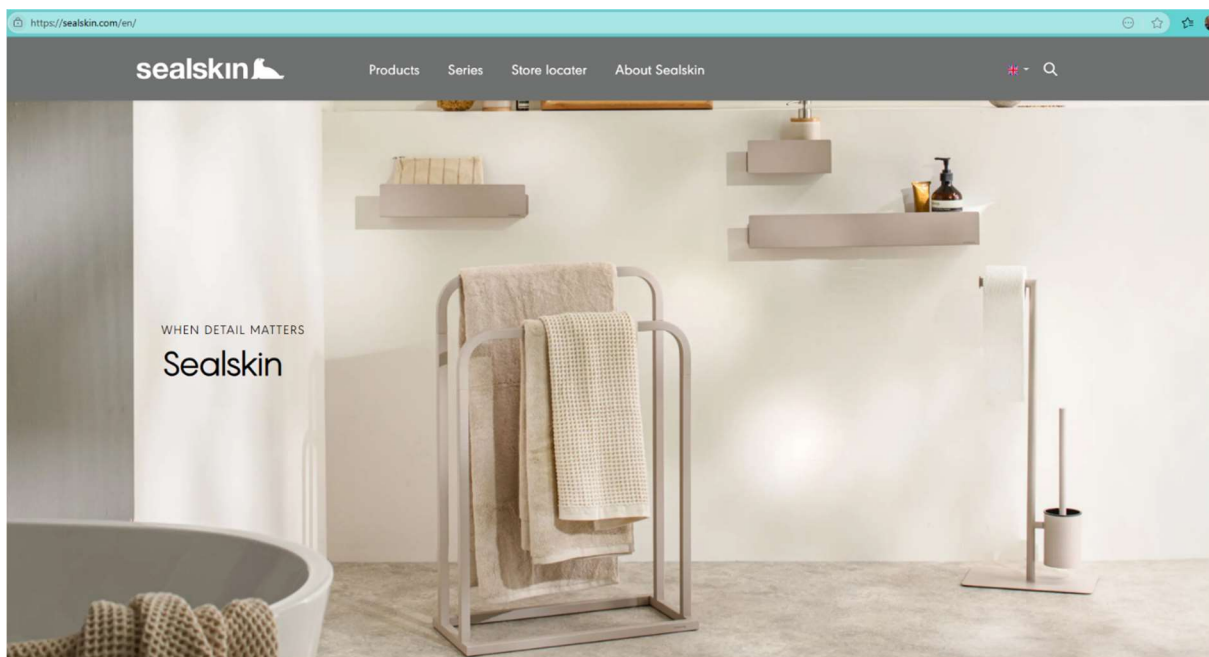
Annex

1. A screenshot of the Holder's website, detailing the variety of flavours available alongside the sign 'WHEN FLAVOR MATTERS', shown under the brand 'Traeger'.

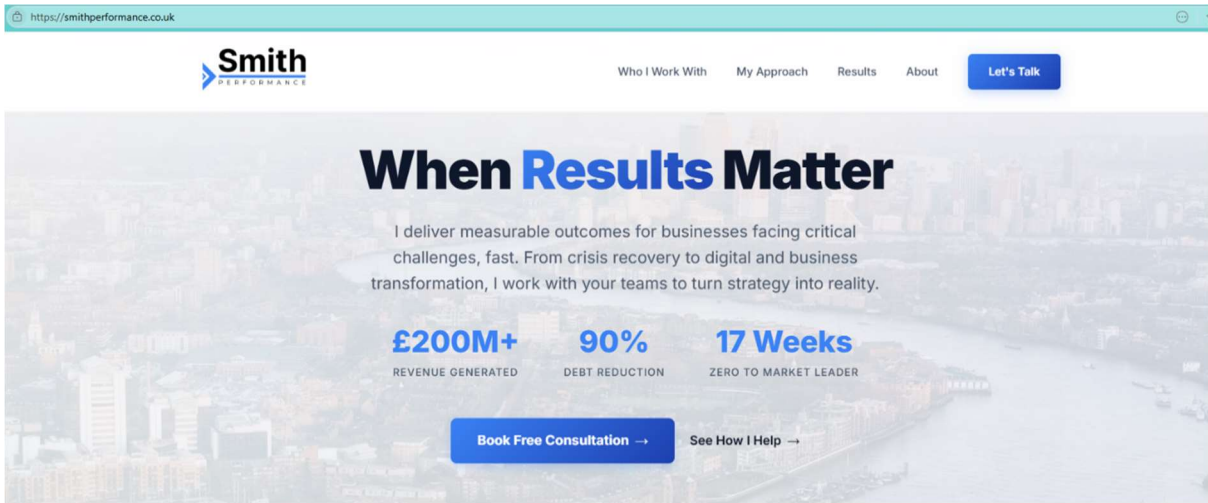


2. Examples of other undertakings using the structure 'when * matters' in a promotional context.

www.sealskin.com



www.smithperformance.co.uk



www.zeroentropynetworks.com

