

European Court of Justice, 7 July 2005, Nestlé v Mars

HAVE A BREAK ... HAVE A KIT KAT



TRADEMARK LAW

Acquired through use

The distinctive character of a mark referred to in Article 3(3) of the directive may be acquired in consequence of the use of that mark as part of or in conjunction with a registered trade mark.

In regard to acquisition of distinctive character through use, the identification, by the relevant class of persons, of the product or service as originating from a given undertaking must be as a result of the use of the mark as a trade mark (judgment in [Philips](#), paragraph 64). In order for the latter condition, which is at issue in the dispute in the main proceedings, to be satisfied, the mark in respect of which registration is sought need not necessarily have been used independently. In fact Article 3(3) of the directive contains no restriction in that regard, referring solely to the ‘use which has been made’ of the mark. The expression ‘use of the mark as a trade mark’ must therefore be understood as referring solely to use of the mark for the purposes of the identification, by the relevant class of persons, of the product or service as originating from a given undertaking. Yet, such identification, and thus acquisition of distinctive character, may be as a result both of the use, as part of a registered trade mark, of a component thereof and of the use of a separate mark in conjunction with a registered trade mark. In both cases it is sufficient that, in consequence of such use, the relevant class of persons actually perceive the product or service, designated exclusively by the mark applied for, as originating from a given undertaking. The matters capable of demonstrating that the mark has come to identify the product or service concerned must be assessed globally and, in the context of that assessment, the following items may be taken into consideration: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (judgment in [Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee \[1999\] ECR I-2779](#), paragraphs 49 and 51).

Source: curia.europa.eu

European Court of Justice, 7 July 2005

(C.W.A. Timmermans, R. Silva de Lapuerta, C. Gulmann, P. Kūris and G. Arestis)

JUDGMENT OF THE COURT (Second Chamber)

7 July 2005 (*)

(Trade marks – Directive 89/104/EEC – Absence of distinctive character – Distinctive character acquired through use – Use as part of or in conjunction with a registered trade mark)

In Case C-353/03,

REFERENCE to the Court under Article 234 EC by the Court of Appeal (England and Wales) (Civil Division) (United Kingdom), made by decision of 25 July 2003, received at the Court on 18 August 2003, in the proceedings

Société des produits Nestlé SA

v

Mars UK Ltd,

THE COURT (Second Chamber),

composed of C.W.A. Timmermans, President of the Chamber, R. Silva de Lapuerta, C. Gulmann (Rapporteur), P. Kūris and G. Arestis, Judges,

Advocate General: J. Kokott,

Registrar: L. Hewlett, Principal Administrator,

having regard to the written procedure and following the hearing on 20 January 2005,

after considering the observations submitted on behalf of:

- Société des produits Nestlé SA, by J. Mutimear, Solicitor, and H. Carr QC,
 - Mars UK Ltd, by V. Marsland, Solicitor, and M. Bloch QC,
 - the United Kingdom Government, by E. O’Neill, acting as Agent, and M. Tappin, Barrister,
 - the Irish Government, by D.J. O’Hagan, acting as Agent,
 - the Commission of the European Communities, by N.B. Rasmussen and M. Shotter, acting as Agents, after hearing the Opinion of the Advocate General at the sitting on 27 January 2005,
- gives the following

Judgment

1 This request for a preliminary ruling concerns the interpretation of Articles 3(3) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1, hereinafter ‘the directive’) and Article 7(3) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1).

2 It arises in the context of a dispute between Société des produits Nestlé SA (‘Nestlé’) and Mars UK Ltd (‘Mars’) concerning the application by Nestlé for the registration as a mark of a part of a slogan constituting a registered mark of which that company is already the owner.

Legal framework

3 Under Article 2 of the directive ‘a trade mark may consist of any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or

of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings’.

4 Article 3 of the directive entitled ‘Grounds for refusal or invalidity’ is worded as follows:

‘1. The following shall not be registered or if registered shall be liable to be declared invalid:

...

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

...’

3. A trade mark shall not be refused registration or be declared invalid in accordance with paragraph 1(b) ... if, before the date of application for registration and following the use which has been made of it, it has acquired a distinctive character. ...’

5 Article 4 and Article 7(1)(b) and (3) of the regulation are worded in terms which are essentially identical to the terms of Article 2 and Article 3(1)(b) and (3) of the directive.

Main proceedings and question referred

6 Both the slogan ‘Have a break ... Have a Kit Kat’ and the name KIT KAT are marks registered in the United Kingdom in Class 30, as defined by the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as amended and revised, that is to say for chocolate, chocolate products, confectionery, candy and biscuits.

7 On 28 March 1995 Nestlé, the proprietor of those two marks, applied for registration in the United Kingdom of the words HAVE A BREAK as a mark in respect of Class 30.

8 That application was opposed by Mars which relied in particular on Article 3(1)(b) of the directive.

9 On 31 May 2002 the opposition was upheld on the basis of that provision and the application for registration was rejected.

10 Nestlé appealed to the High Court of Justice of England and Wales, Chancery Division. The appeal was rejected by decision dated 2 December 2002.

11 Nestlé appealed against that decision to the Court of Appeal (England and Wales) (Civil Division).

12 The Court of Appeal considers, in light of the evidence in the dispute before it, that the expression ‘HAVE A BREAK’ is devoid of inherent distinctive character and that, consequently, the provisions of Article 3(1)(b) of the directive, as a matter of principle, preclude its registration as a mark.

13 It considers that registration may therefore occur only on the basis of Article 3(3) of the directive, subject to proof of distinctive character acquired through use.

14 It points out that the application for registration was rejected on the ground that the phrase ‘HAVE A BREAK’ was essentially used as part of the registered mark HAVE A BREAK ... HAVE A KIT KAT and not, genuinely, as an independent trade mark.

15 It states that, according to Nestlé, that view of the matter could have serious consequences for operators

seeking to register marks comprising shapes since such marks are seldom used by themselves.

16 It considers that a slogan-like phrase associated with a trade mark may, by repetition over time, create a separate and independent impression and thus acquire distinctive character through use.

17 Under those circumstances the Court of Appeal (England and Wales) (Civil Division) decided to stay the proceedings and refer the following question to the Court for a preliminary ruling:

‘May the distinctive character of a mark referred to in Article 3(3) of [the directive] and Article 7(3) of [the regulation] be acquired following or in consequence of the use of that mark as part of or in conjunction with another mark?’

The question referred

18 In light of the indications contained in the order for reference, the question raised must be understood as seeking only an interpretation of the directive, since the regulation is not applicable to the facts of the main dispute.

19 By its question the referring court is essentially asking whether the distinctive character of a mark referred to in Article 3(3) of the directive may be acquired in consequence of the use of that mark as part of or in conjunction with a registered trade mark.

20 Nestlé and the Irish Government consider that the distinctive character of a mark may, under Article 3(3) of the directive, be acquired following use of that mark as part of or in conjunction with another mark.

21 Mars, the United Kingdom Government and the Commission of the European Communities consider that a mark cannot acquire a distinctive character solely in consequence of use as part of a composite mark. Conversely, Mars and the Commission acknowledge that a mark may acquire a distinctive character in consequence of use in conjunction with another mark. In the United Kingdom Government’s view, distinctive character may also be acquired through use of the mark as a physical component.

22 In that regard it should be pointed out that, under Article 2 of the directive, a mark has distinctive character when it is capable of distinguishing the goods or services of one undertaking from those of other undertakings.

23 Under Article 3(1)(b) of the directive a mark devoid of any distinctive character may not be registered or, if registered, is liable to be declared invalid.

24 However, the provision mentioned in the preceding paragraph is rendered inapplicable if, before the date of application for registration and following the use which has been made of the mark, it has acquired a distinctive character.

25 Whether inherent or acquired through use, distinctive character must be assessed in relation, on the one hand, to the goods or services in respect of which registration is applied for and, on the other, to the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well-informed and reasonably observant and

circumspect (judgment in [Case C-299/99 Philips \[2002\] ECR I-5475](#), paragraphs 59 and 63).

26 In regard to acquisition of distinctive character through use, the identification, by the relevant class of persons, of the product or service as originating from a given undertaking must be as a result of the use of the mark as a trade mark (judgment in Philips, paragraph 64).

27 In order for the latter condition, which is at issue in the dispute in the main proceedings, to be satisfied, the mark in respect of which registration is sought need not necessarily have been used independently.

28 In fact Article 3(3) of the directive contains no restriction in that regard, referring solely to the 'use which has been made' of the mark.

29 The expression 'use of the mark as a trade mark' must therefore be understood as referring solely to use of the mark for the purposes of the identification, by the relevant class of persons, of the product or service as originating from a given undertaking.

30 Yet, such identification, and thus acquisition of distinctive character, may be as a result both of the use, as part of a registered trade mark, of a component thereof and of the use of a separate mark in conjunction with a registered trade mark. In both cases it is sufficient that, in consequence of such use, the relevant class of persons actually perceive the product or service, designated exclusively by the mark applied for, as originating from a given undertaking.

31 The matters capable of demonstrating that the mark has come to identify the product or service concerned must be assessed globally and, in the context of that assessment, the following items may be taken into consideration: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (judgment in [Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee \[1999\] ECR I-2779](#), paragraphs 49 and 51).

32 In the final analysis, the reply to the question raised must be that the distinctive character of a mark referred to in Article 3(3) of the directive may be acquired in consequence of the use of that mark as part of or in conjunction with a registered trade mark.

Costs

33 Since these proceedings are, for the parties to the main proceedings, a step in the action pending before the national court, the decision on costs is a matter for that court. Costs incurred in submitting observations to the Court, other than the costs of those parties, are not recoverable.

On those grounds, the Court (Second Chamber) hereby rules:

The distinctive character of a mark referred to in Article 3(3) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member

States relating to trade marks may be acquired in consequence of the use of that mark as part of or in conjunction with a registered trade mark.

OPINION OF ADVOCATE GENERAL KOKOTT

delivered on 27 January 2005 (1)

Case C-353/03

Société des produits Nestlé SA

v

Mars UK Ltd

(Reference for a preliminary ruling from the Court of Appeal (England and Wales) (Civil Division))

(Trade marks – Directive 89/104/EEC – Lack of distinctive character – Acquisition of distinctive character by use)

I – Introduction

1. In the present case the Court of Justice is once again asked to express a view on the rules concerning the distinctive character of trade marks. On this occasion the dispute turns on whether the advertising slogan 'HAVE A BREAK' was able to acquire distinctive character as a result of its use as a part of the registered trade mark 'HAVE A BREAK ... HAVE A KIT KAT'. The nub of the legal dispute is the question whether this kind of use of a sign can result in distinctiveness for trade mark purposes or whether it precludes recognition as a trade mark.

II – Legal framework

2. Article 2 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (2) defines trade marks as follows:

'A trade mark may consist of any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.'

3. Grounds for refusal of registration of a trade mark are contained in Article 3. In that connection Article 3(1)(b) is of particular relevance:

The following shall not be registered or if registered shall be liable to be declared invalid:

(a)

...

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

(c) – (h) ...'

4. However, the first sentence of Article 3(3) provides for an exception to that ground of refusal in the following terms:

'A trade mark shall not be refused registration or be declared invalid in accordance with paragraph 1(b), (c) or (d) if, before the date of application for registration and following the use which has been made of it, it has acquired a distinctive character.'

5. These provisions were transposed in the United Kingdom in section 3 of the Trade Mark Act 1994.

6. Article 5 of Directive 89/104 determines the rights conferred by the trade mark:

‘(1) The registered trade mark shall confer on the proprietor exclusive rights therein. The proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade:

(a) any sign which is identical with the trade mark in relation to goods or services which are identical with those for which the trade mark is registered;

(b) any sign where, because of its identity with, or similarity to, the trade mark and the identity or similarity of the goods or services covered by the trade mark and the sign, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association between the sign and the trade mark.

2. – 5 ...’

7. Article 10(2)(a) particularises the concept of use of a trade mark in regard to use thereof for the purpose of maintaining it:

‘2. The following shall also constitute use within the meaning of paragraph 1:

(a) use of the trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered.’

8. Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (3) to a considerable extent contains analogous provisions.

III – The reference for a preliminary ruling

9. The Court of Appeal is seized of a dispute as to whether the slogan ‘HAVE A BREAK’ can be registered in the United Kingdom as a trade mark in respect of chocolate, chocolate products, confectionery, candy and biscuits. The applicant for registration is the Société des produits Nestlé SA which at the same time is proprietor of the trade marks ‘HAVE A BREAK ... HAVE A KIT KAT’ and ‘KIT KAT’ registered in respect of the same category of goods. Registration of the trade mark ‘HAVE A BREAK’ is opposed by Mars UK Ltd.

10. The parties are at variance as to whether the slogan ‘HAVE A BREAK’ is inherently distinctive or has actual distinctive character on the basis of its use as an element of the trade mark ‘HAVE A BREAK ... HAVE A KIT KAT’ in the sense that a product advertised in that way would be attributed to the manufacturers of the chocolate bar Kit Kat.

11. The Hearing Officer from the United Kingdom Patent Office and a first-instance court refused registration of the trade mark since ‘HAVE A BREAK’ was neither inherently distinctive nor had acquired the requisite distinctive character by virtue of the use of ‘HAVE A BREAK ... HAVE A KIT KAT’.

12. On the basis of the Court’s case-law the Court of Appeal agrees with the competent authorities below that ‘HAVE A BREAK’ is inherently devoid of distinctive character within the meaning of Article 3(1)(b) of Directive 89/104.

13. However, the Court of Appeal does not rule out the possibility that ‘HAVE A BREAK’ has acquired

distinctive character by virtue of its use as an element of the slogan ‘HAVE A BREAK ... HAVE A KIT KAT’ which is protected as a trade mark. It is true that the lower courts refused to accept that use as a part of a trade mark provided any evidence of autonomous distinctive character but, in the Court of Appeal’s view, a part of a trade mark could also acquire its own distinctive character, for example by unavoidably referring the consumer to the protected trade mark.

14. Therefore, the Court of Appeal referred the following question to the Court for a preliminary ruling:

‘May the distinctive character of a mark referred to in Article 3(3) of Directive 89/104 and Article 7(3) of Regulation No 40/94 be acquired following or in consequence of the use of that mark as part of or in conjunction with another mark?’

IV – Assessment

A – Introduction

15. The request for a preliminary ruling concerns the question whether the word sequence ‘HAVE A BREAK’ is registrable as a trade mark. Without prejudice to certain specific cases (4) which are not relevant for present purposes, a sign, that is to say also a sequence of words, can be registered under Directive 89/104 (5) as a trade mark if it has distinctive character. That follows from the wording and scheme of the various provisions of the Directive concerning grounds for refusal and from the recitals in the preamble thereto.

(6)

16. Distinctive character means that the sign is apt to serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from goods of other undertakings. (7) The Court proceeds on the basis of a universally applicable concept of distinctive character which precludes specific criteria from being applied in the case of specific trade marks. (8)

17. The distinctive character of a mark must be assessed in relation to the goods or services in respect of which registration is applied for and in light of the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and circumspect. (9) This must form the subject of a specific assessment. (10)

18. A distinction is made between inherent and acquired distinctiveness. Inherent distinctiveness is examined in conjunction with the ground of refusal of a lack of distinctive character under Article 3(1)(b) of Directive 89/104. As a matter of principle that examination is to be conducted independently of use of the sign. It has regard only to whether the sign in itself has distinctive character.

19. In the present case the Court of Appeal has already established that the relevant consumers construe the word sequence ‘HAVE A BREAK’ as an invitation which is neutral in regard to origin and therefore devoid of inherent distinctiveness.

B – The concept of use

20. None the less, under Article 3(3) of Directive 89/104 a sign may, through use, acquire a distinctive

character which it initially lacked and thus be registered as a trade mark. It is therefore only through the use made of it that the sign acquires the distinctive character which is a prerequisite for its registration. That provision appreciably dilutes the rule laid down in Article 3(1)(b), whereby registration is to be refused in relation to trade marks which are devoid of distinctive character. (11)

21. The question referred by the Court of Appeal seeks to ascertain whether, as a result of use of the principal mark, a part of a mark can also acquire its own distinctive character under Article 3(3) independently of the distinctiveness of the principal mark. For Nestlé is endeavouring to demonstrate that, as a result of use of the principal mark 'HAVE A BREAK ... HAVE A KIT KAT', the element at issue 'HAVE A BREAK' has also acquired distinctive character. Conversely, Mars rejects any evaluation of evidence relating to use of the principal mark and would accord validity only to use of the element independently of the principal mark.

22. In that connection it must first be made clear that the Court cannot in preliminary-reference proceedings establish whether a specific sign has acquired distinctive character. The task of the Court is rather to interpret Community law in such a way that the referring court can apply it correctly in the main proceedings. Accordingly, the Court can only express a view on the interpretation of Article 3(3) of Directive 89/104 and not on the question whether 'HAVE A BREAK' has acquired distinctive character in the United Kingdom.

23. Article 3(3) of Directive 89/104 permits registration of a mark if, following the use made thereof, it has acquired distinctive character. Mars and the Commission infer from this wording that use as an element of another mark may not be invoked as evidence of distinctive character for the purposes of Article 3(3) of Directive 89/104. This view of the matter does not carry conviction since, as the Irish Government as well observes, use of a mark literally means both its independent use and its use as part of another composite mark.

24. Nor, contrary to the view of the United Kingdom Government, can any other inference be drawn from Article 10 of Directive 89/104. Article 10 et seq. concerns the loss of trade-mark protection as a result of non-use. A proprietor of a mark can, as a matter of trade mark law, reserve certain signs for his exclusive use only if he actually uses them. Structurally it would surely be wrong to recognise use for the acquisition of distinctive character but not to allow it to suffice in order to prevent the loss of trade-mark protection. Indeed, it is not precluded that use of a mark as part of another mark may also suffice in the context of Article 10. Under Article 10(2)(a) it also constitutes use if the trade mark is used in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered. Use of a sign as part of a principal mark also comes within that definition. That part would indeed be registered not only as a part of the

principal mark but also alone without the other elements of the principal mark though use of the principal mark would only differ in elements from the mark registered in respect of the part. Distinctiveness of that part would not be affected if, as a result of such use, it acquired distinctive character prior to its registration.

25. The concept of the use of a mark is employed not only in Article 3(3) and Article 10 of Directive 89/104 but also in the context of Article 5 thereof which defines the rights conferred by the mark. The proprietor of a mark is entitled to prevent third parties from using his mark or other signs where there is a likelihood of confusion. In that connection the Court has restricted the concept of use to cases in which use of the sign by a third party affects or could affect the functions of the mark and in particular its chief function which is to guarantee to consumers the origin of the goods. (12) This limitation results from the fact that the objectives of trade-mark protection do not justify the prohibition of uses and thus restrictions on the freedom of users where the use in question has no appreciable effect on the function of the mark. (13)

26. However, the concept of use in the context of Article 3(3) of Directive 89/104 is wider than it is in Article 5(1) because it has a wholly different function. In Article 3(3) that concept is not intended to define the scope of trade-mark protection but only to describe the manner in which a sign which is not inherently distinctive may acquire distinctive character, namely by use. Therefore, in the case of parts of a mark the decisive factor is also whether a use leads to the acquisition of distinctive character.

27. According to Mars the judgment in Philips is said to contradict that interpretation. (14) In that case for acquisition of distinctive character the Court expressly required 'use of a mark as a trade mark'.

28. In Philips the Court examined *inter alia* whether a sign consisting of the shape of a product could acquire distinctive character. That case involved the graphic representation of the upper surface of a three-headed rotary electric shaver, comprising three circular heads with rotating blades in the shape of an equilateral triangle. For a long time Philips had sold electric shavers in this form on an exclusive basis and took the view that the representation notified as a trade mark had acquired distinctive character by virtue of such exclusive marketing over a long period.

29. The Court proceeded on the basis that the distinctive character of a sign consisting in the shape of a product, and even the distinctive character acquired by the use made of it, must be assessed in the light of the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and circumspect. (15)

30. However, it went on to qualify that statement in the following terms:

'[T]he identification, by the relevant class of persons, of the product as originating from a given undertaking must be as a result of the use of the mark as a trade mark and thus as a result of the nature and effect of it,

which make it capable of distinguishing the product concerned from those of other undertakings.’ (16)

31. Mars infers therefrom that the use of a sign as an element of a mark cannot be relied on in order to prove the acquisition of distinctive character. However, that conclusion does not carry conviction because the judgment in Philips contains no indication that the use of a sign as a part of a mark does not constitute the use of a mark as a trade mark.

32. In addition, the passage cited above can be categorised in the overall context of the case-law on trade mark law only if use of a mark as a trade mark includes all use leading to acquisition of distinctive character. If it were otherwise signs could not be protected as marks although they have acquired distinctive character only because the use of the sign which led to that distinctiveness did not constitute ‘use as a trade mark’. For, as a matter of principle, the Court has regard solely to distinctive character and rejects specific criteria for certain types of mark. (17) Distinctive signs can only not be recognised as trade marks if one of the obstacles to registration under Article 3(1) and (3) of Directive 89/104, referred to as insuperable and in the language of the Linde case as preliminary, occurs. (18)

33. The concept of use in Article 3(3) of Directive 89/104 is therefore to be construed from the perspective of the result. Any use which confers on a sign the distinctive character necessary for registration as a mark must be deemed to be use of a mark as a trade mark and meets the requirements of Article 3(3). This interpretation is confirmed by the passage of the judgment in Philips, inasmuch as the Court also concentrates on the ‘nature and effect’ of a mark. (19) However, the nature and effect of a mark precisely constitute the distinguishing function. A use leading to acquisition of distinctiveness must therefore be considered in the context of Article 3(3).

34. In the view of the United Kingdom Government and Mars the risk of an unjustified extension of the protection of the principal mark militates in favour of the application of stricter criteria in the assessment of the distinctive character of parts of a mark. This fear is based on the consideration that parts of a mark do not acquire distinctive character of their own but derive it only from the distinctive character of the principal mark. If one were to recognise this derivative distinctive character then one would have to recognise secondary derivative marks which for their part would have acquired no distinctive character of their own but would derive such character only from primary derivative marks. This process of extension could be continued ad infinitum.

35. At first sight, it would appear that this risk is not to be dismissed lightly. On closer inspection, however, it proves to be illusory. For the possible derivation of distinctive character is dependent on the distinctive character of the relevant principal mark which is inherent in it or has been acquired by it by use. Principal marks having strong distinctive character can tend to transfer quite a lot of distinctive character to elements. At the same time in the case of such marks there are

many elements and variants of the principal mark which, on the basis of use of the principal mark, have autonomous distinctive character by drawing the attention of the relevant consumer groups to the principal mark and thus to the origin of the goods, even if those elements and variants are used as marks independently of the principal mark. Thus the distinctiveness of the principal mark conveys distinctiveness to derivative marks. Extended trade-mark protection is then a necessary consequence of the distinctiveness thus conveyed.

36. However, as a rule derivative marks cannot to the same extent convey distinctiveness to other subsidiary derivative marks. They are much less well known than the principal mark. If a primary derivative mark possesses no sufficient distinctive character of its own but acquires distinctiveness only by way of the connection with the principal mark then it is unlikely that a secondary derivative mark will be able to acquire distinctive character on the basis of its connection with the primary derivative mark. Accordingly, an extension of trade mark protection is hardly to be feared.

37. The United Kingdom Government also takes up the argument of the Hearing Officer by rejecting registration of marks which are merely similar to a registered mark and therefore could be confused with it. Registration, it says, is only possible if a sign has in fact been used and has as a result come to be perceived by the average consumer, by itself, as a badge of origin.

38. This view of the matter is correct in so far as it excludes from registration signs which neither have inherent distinctive character nor have been used themselves. Under Article 3(3) of Directive 89/104 signs without inherent distinctiveness can acquire distinctive character only through use. In that regard the need for use precludes the registration of signs as marks where their distinctiveness stems only from their similarity with a strong principal mark but where they were not used with that strong principal mark. However, that does not preclude that use of parts of a mark as an element of the principal mark can also enable those parts to acquire distinctive character.

39. Moreover, the dichotomy between distinctiveness substantiating a trade mark and likelihood of confusion justifying non-recognition is a false one. Likelihood of confusion and distinctive character are both based on the consumer obtaining an indication from the sign used as a mark that the designated product originates from the proprietor of the mark. There is therefore a point at which the number of signs which relevant consumers may confuse with a strong principal mark intersects with the number of parts of that principal mark from which those consumers obtain information of the same order concerning the origin of the marked product as from the mark itself. Notwithstanding this overlap, the fact remains that such parts are to be recognised as marks if they have acquired distinctive character.

40. Hitherto, moreover, the practice of the competent Community institutions has not in principle been to refuse recognition as a mark to parts of a mark which have or are said to have acquired distinctive character

by use of the principal mark. The sign at issue in the Windsurfing Chiemsee judgment was the word Chiemsee which acquired distinctive character through use in the overall context of a figurative mark. (20) In Alcon (21) the Court of First Instance had to deal with a part of more complex word marks and in Eurocermex (22) with a figurative mark which was mostly used in common with word marks without any problem arising as to the question of common use with the principal mark. Nor in the Ringling Bros. proceedings mentioned by the parties did the Board of Appeal of OHIM take the use of a word mark as a part of a composite word and figurative mark as a pretext for precluding the possible acquisition of distinctive character. (23) Finally, the practice note of the Examination Division at OHIM of 1 March 1999 concerning evidence of use also permits evidence of use as part of a more complex sign. (24)

41. Accordingly, the use of a word sequence as part of a word mark can entail that that word sequence acquires the necessary distinctive character in order to be registered as a mark.

C – Appraisal of proof of acquired distinctiveness

42. None the less the reference for a preliminary ruling shows that the distinctive character of elements of marks in use raises particular difficulties. These are to be taken into consideration in spite of the universal applicability of the criterion of distinctive character. For the Court has held that, although the criteria for assessing distinctiveness are the same for all the various categories of marks, it may become apparent, in applying those criteria, that the relevant public's perception is not necessarily the same for each of those categories, and that therefore it may prove more difficult to establish distinctiveness for some categories of marks than for others. (25)

43. The relevant consumer groups, as the Commission rightly emphasises, as a rule perceive complex marks as a whole and do not have regard to the various details, in particular the elements of the mark. (26) For this very reason the Court has declined in assessing composite marks to appraise the parts separately. Rather the focus had to be directed to the overall impression created. (27) Therefore it is not sufficient for the purposes of demonstrating acquisition of distinctive character, as a result of use as a part of a composite mark, to provide documentary evidence of use of the overall mark. Rather it must also be demonstrated that the relevant consumer groups understand the element in question, if used separately, to designate a product as originating from a specific undertaking, thus distinguishing it from products of other undertakings.

44. Thus the acquisition of distinctive character is plain where the element in question in relation to the mark as a whole appears to be essential as for example in the case of the mark at issue in Windsurfing Chiemsee. (28) Conversely, it appears unlikely that inessential elements, used separately, will develop the requisite distinctive character. The relevant consumers will as a rule not attribute to the proprietor of the composite mark goods and services designated by an inessential part of a mark.

45. However, the present case does not concern an inessential part; it may be presumed that the slogan 'HAVE A BREAK' used on its own causes many relevant consumers to react automatically and to complete that slogan with 'HAVE A KIT KAT'. However, on its own that reflex reaction is not sufficient to prove distinctive character. Instead it must be demonstrated that a product or service designated by the mark 'HAVE A BREAK', for example on the sign of a manufacturer of chocolate or in the inscription on a biscuit tin, will in fact be attributed by the relevant consumers to the manufacturers of Kit Kat. In that connection the United Kingdom is right to submit that it is not sufficient for those consumers merely to wonder whether the product or service originates from that manufacturer. That would merely give rise to the likelihood of confusion.

V – Conclusion

46. I therefore propose that the Court should reply as follows to the question referred to it for a preliminary ruling:

The use of a word sequence as part of a word mark can, as a matter of principle, lead to that word sequence acquiring the requisite distinctive character in order to be registrable as a trade mark. In order to prove that distinctive character has been acquired through use as an element of a composite mark the relevant consumer groups must be shown to understand that the element in question, if used separately, designates a product as originating from a specific undertaking, thus distinguishing it from products of other undertakings.

1 – Original language: German.

2 – OJ 1989 L 40, p. 1, as last amended by Council Decision 92/10/EEC of 19 December 1991, OJ 1992 L 6, p. 35.

3 – OJ 1994 L 11, p. 1, most recently amended by Council Regulation (EC) No 1992/2003 of 27 October 2003 amending Regulation (EC) No 40/94 on the Community trade mark to give effect to the accession of the European Community to the Protocol relating to the Madrid Agreement concerning the international registration of marks adopted at Madrid on 27 June 1989 (OJ 2003 L 296, p. 1).

4 – Those are 'preliminary' obstacles to registration, e.g. Article 3(1)(e) of Directive 89/104. Cf. in that connection Case C-299/99 Philips [2002] ECR I-5475, paragraph 74 et seq., and Joined Cases C-53/01 to C-55/01 Linde and Others [2003] ECR I-3161, paragraph 43 et seq.

5 – In the present case Regulation No 40/94 is not applicable and will not therefore be further mentioned. So far as relevant, however, the case-law on the corresponding provisions and concepts of the regulation will be drawn on where appropriate.

6 – Philips (cited in footnote 4, paragraph 29 et seq.).

7 – Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee [1999] ECR I-2779, paragraph 46, Linde (cited in footnote 4, paragraphs 40 and 47) and Case C-64/02 P OHIM v Erpo Möbelwerk [2004] ECR I-0000, paragraph 33).

- 8 – .OHIM v Erpo Möbelwerk (cited in footnote 7, paragraph 36).
- 9 – .Philips (cited in footnote 4, paragraphs 59 and 63); Linde (cited in footnote 4, paragraph 41); Case C-218/01 Henkel [2004] ECR I-0000, paragraph 50; Case C-363/99 Koninklijke KPN Nederland [2004] ECR I-0000, paragraph 34; Joined Cases C-456/01 P and C-457/01 P Henkel v OHIM [2004] ECR I-0000, paragraph 35; Joined Cases C-468/01 P to C-472/01 P Procter & Gamble v OHIM [2004] ECR I-0000, paragraph 33; Joined Cases C-473/01 P and C-474/01 P Procter & Gamble v OHIM [2004] ECR I-0000, paragraph 33.
- 10 – Case C-404/02 Nichols [2004] ECR I-0000, paragraph 27.
- 11 – .Windsurfing Chiemsee (cited in footnote 7, paragraph 44 et seq.).
- 12 – Cf. Case C-2/00 Hölderhoff [2002] ECR I-4187, paragraph 16; Case C-206/01 Arsenal Football Club [2002] ECR I-10273, paragraphs 51 and 54; and Case C-245/02 Anheuser-Busch [2004] ECR I-0000, paragraph 59.
- 13 – .Arsenal (cited in footnote 12, paragraph 51 et seq.).
- 14 – Cited in footnote 4.
- 15 – .Philips (cited in footnote 4, paragraph 63).
- 16 – .Philips (cited in footnote 4, paragraph 64).
- 17 – See most recently OHIM v Erpo Möbelwerk (cited in footnote 7, paragraph 33 et seq.).
- 18 – The abovementioned statement of the Court in Philips (cited in footnote 4, paragraph 64) may be explained against the background of the preliminary obstacle to registration under Article 3(1)(e) of Directive 89/104 constituted by the shape of the product which is necessary in order to achieve a technical effect. For the potential distinctive character of the sign stemmed not from the sign or its use but presumably from the fact that the consumer attributed all appliances of the type in question to the monopoly holder and consequently also construed the representation of such appliances as a reference to that undertaking. However, it would have been sufficient if the Court had confined its considerations to this preliminary obstacle without attempting to subsume them within the interpretation of Article 3(3) of Directive 89/104.
- 19 – This reference is clearer in the French version of the Philips judgment (cited in footnote 4, paragraph 64) than in the German and English versions since in French l'usage is masculine and la marque is feminine.
- 20 – Cited in footnote 7, paragraph 10.
- 21 – Case T-237/01 Alcon v OHIM – Dr Robert Winzer Pharma (BSS) [2003] ECR II-411, paragraph 59.
- 22 – Case T-399/02 Eurocermex [2004] ECR II-0000, paragraph 50 et seq.
- 23 – Decision of the Second Board of Appeal of 23 May 2001 in Case R 111/2000-2 Ringling Bros. – Barnum & Bailey combined shows Inc. (The Greatest Show on Earth).
- 24 – [Http://www.oami.eu.int/en/mark/marque/practice_note.htm](http://www.oami.eu.int/en/mark/marque/practice_note.htm), last visited on 16 December 2004.
- 25 – .OHIM v Erpo Möbelwerk (cited in footnote 8, paragraph 34).
- 26 – Case C-251/95 SABEL [1997] ECR I-1691, paragraph 23; and Case C-342/97 Lloyd Schuhfabrik Meyer [1999] ECR I-3819, paragraph 25.
- 27 – .SABEL (cited in footnote 26, paragraph 23) and for the case of a word mark Case C-104/00 P DKV v OHIM (COMPANYLINE) [2002] ECR I-7561, paragraph 24.
- 28 – Cited in footnote 7, paragraph 10.