

OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS)

The Boards of Appeal

DECISION
of the Second Board of Appeal
of 4 August 2003

In Case R 120/2001-2

Eli Lilly and Company

Lilly Corporate Center

Indianapolis, Indiana 46285

United States of America

Appellant

represented by LOVELLS, 37, avenue Pierre 1^{er} de Serbie, F-75008 Paris, France

APPEAL relating to Community trade mark application No 1452853

THE SECOND BOARD OF APPEAL

composed of S. Mandel (Chairperson), D.T. Keeling (Rapporteur) and P. Dyrberg (Member)

Registrar: E. Gastinel

gives the following

Language of the case: English

Decision

Summary of the facts

- 1 By an application filed on 7 January 2000 the appellant seeks to register

THE TASTE OF ARTIFICIAL STRAWBERRY FLAVOUR

as a gustatory trade mark for the following goods:

Class 5– Pharmaceutical preparations.

The appellant offered a description of the mark in the following terms: ‘The mark consists of the taste of artificial strawberry flavour.’

- 2 By letter of 21 February 2000 the examiner informed the appellant that the mark was not eligible for registration because it did not comply with Article 7(1)(a) and (b) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (‘CTMR’) (OJ EC 1994 No L 11, p. 1; OJ OHIM 1/95, p. 52). The examiner argued as follows:
 - The mark is not capable of being represented graphically. The vague description ‘artificial strawberry flavour’ does not allow for comprehension of the actual taste being referred to; since a strawberry taste may be simulated in many different ways with variable results. The mark is too indefinite in nature and scope to perform the function of distinguishing the goods or services of one undertaking from those of other undertakings. It is therefore not eligible for registration under Article 7(1)(a) CTMR.
 - The mark is devoid of distinctive character because, in relation to pharmaceutical preparations, the taste of strawberry is one of many common tastes used as a flavouring to mask the otherwise unpleasant taste of the products. In relation to sanitary products which are not for buccal hygiene, the mark will be wholly overlooked because there is no reason for the consumer to taste these products. The mark is therefore not eligible for registration under Article 7(1)(b) CTMR.
- 3 By letter of 20 April 2000 the appellant disputed the examiner’s view that the trade mark was not eligible for registration. It argued as follows:
 - The purpose of the graphical representation is to allow third parties to ascertain what is being protected by the trade mark. The graphical representation of a sign must be such that third parties, when consulting the Community Trade Mark Bulletin, can understand immediately what the object of the trade mark protection is. Whether such a graphical representation consists of a device, a shape or form, a written word or words, or a verbal description is irrelevant provided that the aim is attained. In this respect, a taste is similar to a smell in

that it can be the subject of a verbal description which conveys the necessary information for the public to grasp which taste or smell is being protected.

- There are only two ways to reproduce the strawberry taste. On the one hand, there is the ‘natural’ taste, which reproduces a taste as close as possible, if not identical, to that of a fresh strawberry. On the other hand, there is the ‘artificial’ strawberry taste, which does not purport to reproduce the taste of fresh strawberries. On the contrary, it is a very sweet, purposefully artificial flavour, which, in particular, appeals strongly to children. The artificial strawberry taste is commonly used, for instance, in confectionery. It goes without saying that, most of the time, no fresh strawberry goes into the making of the product reproducing the artificial strawberry taste, which is composed of chemical flavours. The taste of artificial strawberry flavour is one which everyone immediately recognises from experience, since it is a taste which immediately brings back memories of sweets and tastes pleasantly associated with childhood. The inherent nature and purpose of the goods in question is not dependent on their taste. Such goods are not consumed for their pleasant taste, whether ‘artificial strawberry taste’ or otherwise, but because they have specific therapeutic functions.
 - The taste added to the goods is a sign, the purpose of which is to distinguish the goods of one undertaking from those of other undertakings, and clearly falls within the definition of Article 4 CTMR.
 - There may be many tastes which can be used for various purposes, for instance, to mask an otherwise unpleasant taste or to give an attractive taste to an otherwise bland product and therefore distinguish it from other goods of the same or similar nature, just as there are many different shapes of products or their packaging used for the same purpose. The range of available tastes is so broad that it cannot be said that one specific taste is necessary in relation to goods which do not, by nature, have a taste.
- 4 By letter of 27 June 2000 the examiner raised a further objection under Article 7(1)(c) CTMR. He argued as follows
- The mark would appear to be descriptive of characteristics of pharmaceutical preparations. A sign or other indication which designates characteristics of the goods is barred from registration as a Community trade mark under Article 7(1)(c). The taste of artificial strawberry flavour is obviously an ingredient widely used in the pharmaceutical and food industries. The mark consists entirely of a desirable characteristic for such goods. In particular, the mark as a whole without any distinctive alteration or addition merely indicates that pharmaceutical and dietetic substances adapted for medical use contain or have the taste of artificial strawberry flavour. Such a sign or indication is legitimately required by other traders to indicate characteristics of their competing goods.

- 5 By letter of 29 November 2000 the examiner notified the appellant of his decision (hereafter 'the contested decision') that the trade mark was not eligible for registration under Article 7(1)(b) and (c) CTMR on the grounds stated in the examiner's previous correspondence. The examiner waived the objection based on Article 7(1)(a) CTMR.
- 6 On 29 January 2001 the appellant filed a notice of appeal against the contested decision. The grounds of appeal were filed on 29 March 2001.
- 7 The appeal was submitted to the examiner for interlocutory revision, pursuant to Article 60 CTMR. It was remitted to the Boards of Appeal on 19 April 2001.

Grounds of appeal

- 8 The appellant's arguments may be summarised as follows:
 - A trade mark is not distinctive, when it is the necessary, generic or usual designation of the products or services covered by the trade mark application.
 - The manufacturer of pharmaceutical products may add a specific taste to such goods, either to mask an otherwise unpleasant taste, or to make the goods in question more attractive to consumers, and therefore incite consumers to choose this manufacturer's goods rather than his competitors' equivalent goods.
 - A taste, whichever flavour it may consist of, is neither necessary nor generic in relation to pharmaceutical products. Therefore, it cannot be said that the taste of artificial strawberry flavour is usual in relation to pharmaceutical products. It is quite uncommon for a pharmaceutical substance to have a pleasant taste and in particular the taste of artificial strawberry flavour.
 - The necessity to use a conventional trade mark to name and to prescribe the product does not prevent the manufacturer from protecting a taste mark in relation to the same product. As an example, several sound marks are used in combination with a word mark. A product or service cannot be referred to merely by a sound. Nevertheless, it is now broadly accepted that a sound can constitute a valid trade mark. The same argument applies to trade marks consisting of logos, shapes or colours. Nevertheless, all these signs can constitute valid trade marks. Thus, the fact that a pharmaceutical product needs to be referred to by a name does not alter the fact that the said product can also be known and selected for its specific and distinctive taste, which also distinguishes it from other pharmaceutical products.
 - In relation to most pharmaceutical preparations, the person who selects the goods is not the end consumer, but the doctor who writes the prescription. Therefore, it is irrelevant that the taste can only be ascertained after purchase.

The doctor who prescribes the product will prescribe a pleasant tasting product, rather than other pharmaceutical products with equivalent medical indications, because he knows that the consumer will accept it more readily due to its taste.

- The taste of a pharmaceutical preparation does not describe that kind of product. The taste of artificial strawberry flavour is not the essential characteristic and function of a pharmaceutical preparation.

Reasons

9 The appeal complies with Articles 57, 58 and 59 CTMR and Rule 48 of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark (OJ EC 1995 No L 303, p. 1; OJ OHIM 2-3/95, p. 258). It is therefore admissible.

10 Article 4 CTMR provides:

‘A Community trade mark may consist of any signs 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.’

11 Article 7 CTMR provides in material part:

‘1. The following shall not be registered:

- (a) signs which do not conform to the requirements of Article 4;
- (b) trade marks which are devoid of any distinctive character;
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service;

...

2. Paragraph 1 shall apply notwithstanding that the grounds of non-registrability obtain in only part of the Community.

...’

12 The Board notes that at the time when the examiner waived the objection under Article 7(1)(a) CTMR in conjunction with Article 4 CTMR the Court of Justice had

not yet given its judgment in Case C-273/00 *Sieckmann* (judgment of 12 December 2002, not yet published). In that judgment the Court held that in respect of an olfactory sign the requirement of graphic representability is not satisfied by a description in written words. Logically the same would appear to apply to gustatory signs.

- 13 In any event it is not necessary to rule on that issue since the objection based on Article 7(1)(b) CTMR is well founded.
- 14 The underlying purpose of Article 7(1)(b) to (e) CTMR is to prevent signs which any trader may legitimately wish to use from being reserved to the exclusive use of a single undertaking by means of registration as a trade mark: see judgment of the Court of First Instance of 2 July 2002 in Case T-323/00 *SAT.1 Satelliten Fernsehen GmbH v OHIM* ('SAT.2') [2002] ECR II-2839, at paragraph 36. That has been confirmed by the Court of Justice in its judgment of 6 May 2003 in Case C-104/01 *Libertel v Benelux-Merkenbureau* ('Orange'), at paragraphs 49 to 51. In that judgment the Court held that there is a public interest in not unduly restricting the availability of colours for other traders who offer for sale goods or services of the same type as those in respect of which registration is sought (see paragraph 55 of the judgment). The same reasoning appears to apply to tastes.
- 15 Any manufacturer of products such as pharmaceutical preparations is entitled to add the flavour of artificial strawberries to those products for the purpose of disguising any unpleasant taste that they might otherwise have or simply for the purpose of making them pleasant to taste. If the appellant were given an exclusive right to use such a 'sign' under Article 9 CTMR, that would interfere unduly with the freedom of the appellant's competitors.
- 16 Even if the anti-competitive effects of registration of the TASTE OF ARTIFICIAL STRAWBERRIES as a trade mark are disregarded, it is in any event clear that such a taste cannot distinguish the pharmaceutical preparations of one undertaking from those of another. A feature that any manufacturer of such goods is entitled to use cannot distinguish the goods of one manufacturer from those of competing undertakings. Moreover, the taste is unlikely to be perceived by consumers as a trade mark; they are far more likely to assume that it is intended to disguise the unpleasant taste of the product: see the Decision of 5 December 2001 in Case R 711/1999-3 THE SMELL OF RASPBERRIES, at paragraph 43.

Order

On those grounds,

THE BOARD

hereby:

Dismisses the appeal.

S. Mandel

D.T. Keeling

P. Dyrberg

Registrar:

E. Gastinel