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Press and Information

PRESS RELEASE No 65/05

7 July 2005

Judgment of the Court of Justice in Case C-353/03

Société des produits Nestlé SA v Mars UK Ltd.

**THE DISTINCTIVE CHARACTER REQUIRED FOR REGISTRATION OF A MARK
MAY BE ACQUIRED THROUGH ITS USE AS PART OF AN ALREADY
REGISTERED TRADE MARK**

In order to acquire distinctive character through use the mark must be perceived by the relevant category of persons to designate a product or service as originating from a given company

In March 1995 Nestlé, the owner of the marks ‘KIT KAT’ and ‘Have a Break – Have a Kit Kat’ applied for registration in the United Kingdom of the mark ‘Have a Break’. Mars, a competitor of Nestlé, filed an opposition to that application.

Registration of trade marks is governed by a Community Directive.¹ Under that directive, a mark devoid of distinctive character cannot be registered. None the less, a mark which is not inherently distinctive may acquire distinctive character through use.

The Court of Appeal (England and Wales) (Civil Division), before which the dispute came, considers that that the expression ‘HAVE A BREAK’ is devoid of inherent distinctive character and that, consequently, it may be registered only if it has acquired distinctive character through use. Since the phrase ‘HAVE A BREAK’ was essentially used as part of the mark ‘HAVE A BREAK ... HAVE A KIT KAT’ and not, genuinely, as an independent trade mark, the Court of Appeal asked the Court of Justice of the European Communities whether the requisite distinctive character may be acquired from use as part of or in conjunction with another mark.

¹ 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).

The Court declared that **the distinctive character required for registration of a mark may be acquired through use of that mark as part of or in conjunction with a registered trade mark.**

It points out that a mark has distinctive character when it is capable of distinguishing the goods or services of one undertaking from those of other undertakings. 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.

In order to acquire distinctive character through use, the mark must be used as a trade mark. However, that does not mean that the mark in respect of which registration is sought need necessarily have been used independently. It is merely necessary that, by consequence of 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. 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.

It is for the national court to determine whether the mark 'Have a Break' has come to identify the product or service concerned. In that context the Court points out that the relevant factors 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.

Unofficial document for media use, not binding on the Court of Justice.

Languages available: CS, DE, EN, FR, PL, SK

The full text of the judgment may be found on the Court's internet site

<http://curia.eu.int/jurisp/cgi-bin/form.pl?lang=en>

It can usually be consulted after midday (CET) on the day judgment is delivered.

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