



To protect or not to protect: Maybe!

The High Court of England and Wales rules Nestlé's four-fingered chocolate bar is not a registrable trade mark in the UK.

In a recent judgment in the appeal between Societe Des Produits Nestlé SA vs Cadbury UK Ltd [2016] EWHC50 (Ch) the High Court of England and Wales has, after considering the answers given by the Court of Justice of the European Union in a reference, ruled that the four-fingered chocolate bar being sold by Nestlé under its various KIT KAT trade marks is not registrable *per se* as a trade mark in the UK. Though the chocolate bar has been in use for about 75 years, the Court found that the chocolate bar shape *per se* had not acquired the requisite distinctiveness through use to be granted registration as a trade mark.

We reported on the answers given by the CJEU in our earlier article [here](#). After considering the answers in the CJEU reference, the challenge to the four-fingered shape on the basis that it served only a technical function, was dropped by Cadbury. The Court was left to decide whether the shape *per se* had become distinctive enough for registration on the basis of the use that had been made of it when Nestlé filed its application for registration.

At the time that Nestlé filed its application in the UK to register the shape, there were already other similar products on the UK market for chocolates, and Nestlé was not able to provide the evidence required to show that a consumer would be able to tell its product from those of other manufacturers only on the basis of its four-fingered shape, and without any reference to any of the various KIT KAT trade marks, whether embossed on the bars, used on the wrapper or otherwise used in connection with the four fingered chocolate bars.

This case shows again that parties that wish to obtain trade mark protection for shapes that are inherently non-distinctive, or do not differ significantly from the shapes that are the norm for such products, have a high evidentiary threshold to cross to demonstrate that the consumer will regard the shape as indicating the source of the goods, and not any other trade marks affixed to the shape, or appearing in connection with the shape. Associating the shape mark with a particular manufacturer's goods is not sufficient to meet the threshold.

Parties seeking to obtain protection for otherwise weak marks must, amongst other strategies, take great care when promoting the goods and must package them suitably. Merely using stronger trade marks of the owner in connection with the goods, whose shape is sought to be registered as a trade mark is not enough. For example, though the KIT KAT trade marks are registered, the shape of Nestlé's chocolate fingers has not been visible on the packaging or through it, other than for a short while, and the shape was not featured in the promotion and advertising of Nestlé's chocolate bars. Nestlé was also not able to show that consumers use the shape of Nestlé's bar, post purchase, to confirm that they have chosen Nestlé's four-fingered chocolate bars. Had Nestlé been able to show the above, this case may have had a sweeter conclusion for Nestlé.

How can A.A. Thornton & Co. help?

If you would like any further information, please do not hesitate to contact a member of our **trade mark team**. At A.A. Thornton & Co. our trade mark attorneys are qualified to advise on all aspects of trade mark law.

The services of our trade mark attorneys include:

- Advising on your choice of trade marks and their registrability
- Trade Mark Audits and IP portfolio management
- Due diligence of trade mark rights
- Searches, investigations and advice on filing strategies
- Preparing, filing and prosecuting national, EU or international trade mark applications
- Facilitating registration of trade marks overseas
- Managing renewals of trade marks
- Trade mark watches to identify competitors' applications and registrations
- Handling oppositions, cancellations and appeals
- Negotiating amicable settlements and co-existence agreements
- Negotiating and drafting licence agreements and assignments
- Advising on infringement of trade mark registrations and attacks on validity
- Liaising with solicitors and barristers in the enforcement or defence of registered and common law rights

Contact

For more information please contact Nidhi Mukhuty via email at nxm@aathornton.com or your usual A.A Thornton & Co. advisor.

For general information please visit: www.aathornton.com

Partners

Vanessa Lawrence
vabl@aathornton.com

Ian Gill
isg@aathornton.com

Craig Turner
crt@aathornton.com

Rachel Havard
rsh@aathornton.com

Adrian Bennett
arb@aathornton.com

Mike Jennings
mjj@aathornton.com

Emily Cottrill
eehc@aathornton.com

Lawrence King
llk@aathornton.com

Associates

Nick South
ngs@aathornton.com

Heather Donald
hrd@aathornton.com

Sarah Darby
smd@aathornton.com

Nikesh Patel
npp@aathornton.com