

# Kluwer Trademark Blog

## TEFAL: Spot the difference? Consumers apparently can't.

Julius Stobbs, Richard Ferguson (Stobbs IP) · Friday, June 25th, 2021

### Summary

Tefal applied to register “a plain red dot affixed centrally to the bottom of a cooking receptacle (such as a pan, saucepan)” (below). The goods covered were “frying pans, saucepans, casseroles, stew-pans, cooking pots, crepe pans, grills, woks” in Class 21.



The UK IPO refused the [application](#) because Tefal had not shown that it was inherently distinctive, nor had it acquired distinctiveness through use.

### Inherent Distinctiveness

The key question was ‘what is the likely perception of the relevant consumer upon seeing the sign applied for, in normal and fair use in relation to the goods specified?’ Specifically, would the consumer see the sign as being ‘origin neutral’ or ‘origin specific’, based only on its inherent characteristics?

The sign was characterised as a simple geometrical shape in red within the centre of the inside of the pan, corresponding with the overall product shape. This combination of colour, proportion and position was insufficient to make the mark origin specific: it was a mere indicia of an everyday product that consumers would not perceive as a standalone trade mark.

This analysis raises a wider question around the value of product design and what mark is adopted in the first place and why. For example, a shape that differed from the shape of the main product, say, a purple spiral, would arguably be more arbitrary (and therefore capable of indicating origin) than a red dot.

### Acquired Distinctiveness

‘Do consumers perceive the red dot as an indicator of origin to assist them in immediately identifying the product as originating from Tefal, or do they just associate Tefal with a red dot?’ Despite Tefal’s best efforts (including a point of sale cut-out exposing the red dot) to distinguish its

red dot from the *Kit-Kat* case, they failed to show origin indication.

### Technical Function

Tefal's problem was that the red dot's appearance was intertwined with its technical function as a heat indicator for the optimal temperature to start frying or cooking. The evidence also contained multiple references to its THERMO-SPOT™ technology, moving it away from being an arbitrary red dot and contributing to association rather than recognition.

### Survey Evidence

A consumer survey was also relied upon. UK courts and tribunals are meticulous about survey evidence's admissibility and weighting.

A third of those surveyed mentioned "TEFAL" when asked what came to mind when seeing the red dot. However, this was again considered to be evidence of association, not recognition. 17% also answered that the red dot was a 'heat spot', reinforcing the red spot's technical function and lack of randomness. Tefal also came unstuck by not receiving a positive response to later brand recognition questions, which were also found to be leading (and inadmissible).

### Brand Confidence

Doubt was also cast on Tefal's promotion of the red spot as a sub-brand and an indicator of origin. Even with 'TEFAL' composite use, sub-brand confidence was not found. Marketing like 'The pan with the red spot' simply referred to a technical feature of the product. Whilst it was not within the hearing officer's remit to provide acceptable examples, ad copy such as 'IF YOU DON'T SEE THE RED SPOT, IT'S NOT A TEFAL' may have served Tefal better.

### **Conclusion**

The decision provides some take homes for future applicants of similar marks:

1. the exposure versus education dichotomy continues to inform consumer recognition versus reliance on mark to indicate origin
2. education is more difficult where multiple brand elements are included
3. evidence showing origin education cannot be obtained merely by careful curation
4. marks with a technical feature should downplay this in advertising
5. survey evidence for acquired distinctiveness should be robust
6. the interplay between IP, the creative lifecycle of a brand asset and real-world use cannot be underestimated

Tefal live to fight another day with a portfolio of red dot trade marks and designs to rely on. Whether Tefal decide to put the hearing officer's feedback into practice, though, remains to be seen; often cases involving difficult marks are doggedly appealed through the courts but not internalised into practice – which would also further the legal position in the long term. A leopard doesn't change its spots, but might Tefal?

To make sure you do not miss out on regular updates from the Kluwer Trademark Blog, please [subscribe here](#).

## Kluwer IP Law

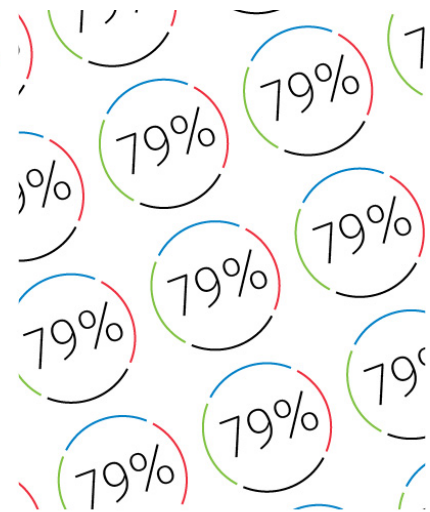
The **2022 Future Ready Lawyer survey** showed that 79% of lawyers think that the importance of legal technology will increase for next year. With Kluwer IP Law you can navigate the increasingly global practice of IP law with specialized, local and cross-border information and tools from every preferred location. Are you, as an IP professional, ready for the future?

Learn how **Kluwer IP Law** can support you.

79% of the lawyers think that the importance of legal technology will increase for next year.

**Drive change with Kluwer IP Law.**

The master resource for Intellectual Property rights and registration.



2022 SURVEY REPORT  
The Wolters Kluwer Future Ready Lawyer  
Leading change

This entry was posted on Friday, June 25th, 2021 at 1:44 pm and is filed under [Acquired Distinctiveness](#), [Case law](#)

You can follow any responses to this entry through the [Comments \(RSS\)](#) feed. You can leave a response, or [trackback](#) from your own site.