

O/307/12

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION 2341223  
BY ICELAND FOODS LIMITED**

**TO REGISTER IN CLASSES 3, 4, 5, 6, 7, 8, 9, 11, 16, 20, 21, 29, 30, 31, 32, 33,  
34, 35, 41, 42, 43 THE SERIES OF THREE TRADE MARKS:**



**ICELAND**

**AND**

**OPPOSITIONS THERETO BY:**

- i) ICELAND SPRING IN ICELAND (No 94461)**
- ii) ICELANDIC GROUP PLC (No 94462)**
- iii) BLUE LAGOON LIMITED (BLAA IONID H.F) (No 94463)**
- iv) ICELANDAIR EHF (No 94464)**
- v) ALFESCA LTD (No 94465)**
- vi) THE MINISTRY OF FOREIGN AFFAIRS (AND OTHERS) (No 94466)**

## The background and the pleadings

1) On 20 August 2003 Iceland Foods Limited (“IFL”) filed application 2341223 for the following series of three marks for the following goods and services:



ICELAND

**Class 03:** Non-medicated toilet preparations; anti-perspirants; cosmetics; perfumes; toilet waters; soaps; toilet articles; shampoos; dentifrices; non-medicated preparations and substances, all for the treatment, conditioning and care of skin and scalp; essential oils; cleansing, polishing and scouring preparations and substances; detergents; all included in Class 3.

**Class 04:** Firelighters; candles; night lights; charcoal; coke; coal; wood for burning; briquettes.

**Class 05:** Disinfectants; food for babies; all included in Class 5.

**Class 06:** Goods of common metal; small items of metal hardware; kitchen foil; all included in Class 6.

**Class 07:** Dishwashers; washing machines; domestic machines; parts and fittings for all the aforesaid goods.

**Class 08:** Cutlery, knives, forks, spoons; all included in Class 8.

**Class 09:** Downloadable electronic publications, in particular catalogues and directories; batteries; lighters.

**Class 11:** Apparatus for heating, cooking, refrigerating, drying or ventilating; freezers, refrigerators, combined freezers and refrigerators, microwave ovens; parts and fittings for all the aforesaid goods.

**Class 16:** Paper, cardboard, paper articles, cardboard articles, wrapping and packaging materials; bags of paper or plastics, all for packaging; toilet paper, paper tissues, carrier bags, plastic bags, paper and plastic sacks; closures for bags; labels; pens and pencils; transfers; price tags and tickets and holders in the nature of envelopes; stationery.

**Class 20:** Drinking straws.

**Class 21:** Dishcloths, stockinet rolls, dusters, floor cloths, sponge cloths, household gloves; household or kitchen utensils and containers (not of precious metal or coated therewith); cookware; storage containers and container lids; jugs and measuring jugs; glassware, porcelain and earthenware not included in other classes; eating and drinking utensils; tableware; tray and tray covers; roasting dishes; oven trays, pizza pans, loaf pans and sandwich pans, all made of metal; combs and sponges; brushes (except paint brushes); electric and non-electric toothbrushes; toothpicks; articles for cleaning purposes; steel wool.

**Class 29:** Meat; fish, poultry and game, none being live; all for food for human consumption; meat extracts; fruits and vegetables, all being preserved, dried, cooked, canned or frozen; jellies and dairy products, all for food; jams, marmalade, eggs, edible oils, edible fats; food preserves; potato crisps and potato products (for food); prepared meals and constituents therefor, snack foods, all included in Class 29.

**Class 30:** Coffee, tea, sugar, rice, tapioca, sago; mixtures of coffee and chicory, coffee essences and coffee extracts; chicory and chicory mixtures, all for use as substitutes for coffee; flour, preparations made from cereals for food for human consumption, bread, biscuits (other than biscuits for animals), cakes, pastry, non-medicated confectionery; edible ices; refreshing ice; honey, treacle; yeast, baking-powder, salt (for food), mustard, vinegar, pepper, sauces, salad sauces; spices (other than poultry spice); prepared meals and constituents therefor, snack foods, all included in Class 30.

**Class 31:** Agricultural, horticultural and forestry and grain products, not included in other classes; living animals; fresh fruits and vegetables; seeds; natural plants and flowers; animal feeds, malt.

**Class 32:** Beers, mineral and carbonated waters and other non-alcoholic beverages; fruit drinks and fruit juices; syrups and other preparations for making beverages.

**Class 33:** Alcoholic beverages; wines, spirits and liqueurs.

**Class 34:** Smokers articles.

**Class 35:** Retail supermarket services connected with the sale of toiletries, household products including cleaners, polishers, scourers, soaps, hardware, kitchen foil, electrical goods including white goods, publications and stationery, household utensils, glassware and kitchenware, foodstuffs and drinks; shop window dressing; telesales

services; ordering services; advertising, marketing and promotion of goods and services; direct mail advertising services; distribution of samples; operation of in-store self-service schemes; cost and payment calculation, monitoring, recordal and processing; organisation, operation and supervision of sales and promotional incentive schemes to consumers and/or the wholesale trade; customer advisory and consultancy services; the provision of promotional, incentive and loyalty schemes by means of customer club membership schemes; business management advice and assistance, business appraisals; business administration services; arranging business introductions; market research; personnel management advice; provision of trade information; procurement of goods on behalf of business; business advisory services relating to franchising; information and advisory services relating to all the aforesaid.

**Class 41:** Providing online catalogues and directories.

**Class 42:** Website hosting; computer services related to computerised on-line searching for, ordering, delivery and transporting of foods, drinks and consumer goods.

**Class 43:** Cafe, cafeteria, catering and restaurant services.

The application was published in the Trade Marks Journal on 31 March 2006.

2) Six separate oppositions were filed against the registration of IFL's marks. The opponents are:

- i) Iceland Spring In Iceland (No 94461);
- ii) Icelandic Group Plc (No 94462);
- iii) Blue Lagoon Limited (Blaa Ionid H.F) (No 94463);
- iv) Icelandair Ehf (No 94464);
- v) Alfesca Ltd (No 94462);
- vi) The Ministry Of Foreign Affairs (And Others<sup>1</sup>) (No 94466).

3) Save where it is necessary to do so, I will refer to the above, collectively, as the opponents. In summary, the grounds of opposition in all of the proceedings are that, because ICELAND is the name of a European country, the trade marks:

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<sup>1</sup> The others, in this joint opposition being: Samtok Ionaoarins (The Federation of Icelandic Industries), Samtok Atvinnulífsins (SA – Confederation of Icelandic Industries), Felag íslenskra storkaupinanna (The Federation of Icelandic Trade), Landssamband íslenskrautvegsmanna (The Federation of Icelandic Fishing Vessel Owners), Samtok feroapjonustunnar (The Icelandic Travel Industry Association), Samtok fishkuvinnslustoova (The Federation of Icelandic Fish Processing Plants) and Utflutningsráð (Trade Council of Iceland).

- are not capable of distinguishing the goods or services of one undertaking from those of others (section 3(1)(a) of the Trade Marks Act 1994 —the Act”);
- are devoid of any distinctive character (section 3(1)(b) of the Act);
- describe the geographical origin of the goods and services (section 3(1)(c) of the Act);
- are generic or customary in the trade (section 3(1)(d) of the Act);
- have not acquired a distinctive character through their use (a reference to the proviso to sections 3(1)(b), (c) and (d) of the Act);
- are contrary to public policy because it would be wrong to register the name of a country to one undertaking (section 3(3)(a) of the Act);
- are deceptive as to the geographical origin in so far as goods and services not originating from Iceland are concerned (section 3(3)(b) of the Act);
- would breach The Trade Descriptions Act if the goods and services did not originate from the country of Iceland (section 3(4) of the Act is relied upon).

4) Counterstatements were filed in which the various grounds of opposition were denied. IFL and the opponents filed evidence. A hearing took place before me at which IFL were represented by Mr Roger Wyand QC, instructed by Groom, Wilkes and Wright, and the opponents were represented by Mr John Baldwin QC, instructed by Page, White & Farrer.

### **The evidence**

5) I will look at the evidence collectively, identifying the witnesses as I go along.

### **Witness statement(s) of Ms Nicola Shackleton**

6) Ms Shackleton is a trade mark attorney with Page, White & Farrer. She has provided a witness statement for each of the oppositions. They are primarily the same. The bulk of her evidence provides various facts and figures about the country of Iceland, including its:

Size: 103,000 KM<sup>2</sup>, 4970km of coastline, 105 municipalities and a rising population of 316,000 people.

Labour market (as of 2002): 3.9% agriculture, 3.4% fishing, 4.1% fish processing, 10.2% mining and manufacturing, 0.9% electric and water

supply, 7.8% construction, 13.7% wholesale/retail/repair, 3.5% hotels and restaurants, 6.2% transport and communication, 3.9% financial services, 8.5% real estate and business services, 5% public administration, 8.1% education, 13.8% health/social sector, 7.1% other.

Agricultural production: 9000 tonnes of potatoes, 800 tonnes of turnips, 3000 tonnes of cereal grain, 900 tonnes of tomatoes, 800 tonnes of cucumbers (all in 2000) and, also, over 2 million square meters of hay yield. In 2002 there were 67,000 cattle, 469,000 sheep, 71,000 horses, 4000 pigs and 160,000 hens in the country.

Meat and milk production: 8676 tonnes of mutton and lamb, 3639 tonnes of beef, 6011 tonnes of pork, 4633 tonnes of poultry, 110 million litres of milk (all in 2002).

Fish: Over 2 million tonnes of fish caught in 2002 – various types of fish caught.

Minerals: 125,000 tonnes of cement, 245,000 tonnes of aluminum, 20,000 tonnes of diatomite, 111,000 tonnes of ferro silicon (2001).

Visitors: Just under 2 million visitors via airports, many coming from Germany, UK, Sweden and Denmark. 50 liners arrive each year, 58% of whose passengers come from Germany and the UK.

GDP: 13, 251 million Euro. 4238 million Euro worth of exported goods and services. Lowest unemployment rate in the EEA with the third highest rate of car ownership.

7) Ms Shackleton states that exports are a significant part of the country's business. The largest importers of goods from the country are the UK, Germany and the Netherlands. 81% of exports are for the European market. In 2002, 1,441,292 tonnes of marine products were exported. 33% of all exports relate to manufacturing products and 64% relate to agricultural and marine products.

8) Ms Shackleton makes various submissions that will be borne in mind but not summarized here. She adds that ICELAND may be doubly descriptive for frozen goods because ICE and LAND conjoined could describe an area where there are iced goods or where goods for freezing can be purchased. This is not within the pleaded case so I will say no more about this; in any event, what Ms Shackleton states seems far-fetched.

9) In relation to the section 3(1)(c) objection, she states that Iceland's products have a good quality and it is renowned for its agriculture, fishing and manufacturing; this is simple assertion and adds nothing beyond the factual evidence provided.

10) An internet search is provided, the hits of which relate primarily to the country of Iceland. I note, though, that the search conducted was not limited to UK websites. Ms Shackleton refers to two community trade marks containing the word ICELAND that were opposed and which are now refused.

11) Ms Shackleton refers to a large number of UK companies that have the word Iceland in their name, she also provides further information about them to illustrate that the companies have some form of link to Iceland (the country) or to Icelandic goods. She states that this exemplifies why there is a need to keep the word ICELAND free for the use by other traders. The company names include:

Iceland Seafood Limited;  
Icelandic Commodities Exports Limited;  
The Icelandic Trading Company Limited;  
Path (Iceland) Limited – (a project relating to civil aviation, airline management and tourism promotion);  
Project Iceland Limited – Building Installation;  
Iceland Tours Limited;  
Essential Iceland Limited – a travel agency;  
Icelandic Group Plc – Seafood;  
Icelandic UK Ltd – Seafood;  
Icelandic Group UK Ltd – Seafood;  
Alcan Iceland Ltd – Aluminum;  
Iceland Drilling Company Ltd (and a version of the name with UK in the title).

Also exhibited are prints of websites etc with Iceland used as part of a name, including:

Iceland Holidays.Com;  
Iceland Express (an airline);  
Skyn Iceland – skincare products;  
Iceland Spring Holdings;  
Iceland Metal Recycling;  
Interseafood Iceland Hf;  
Optimar Iceland – Refrigerating (Industrial refrigeration for ships).  
Tms Sambaland of Iceland (seafood).

12) Exhibit D consists of extracts from the website of the Trade Council of Iceland and which refer to Iceland as being primarily a food producing country. It appears to have strict regulations to ensure a good quality is achieved. Another page refers to the type of food produced in Iceland. Many of the items referred to earlier are mentioned. Fish is again stressed and it is stated that Icelandic fish has established a reputation. Exhibit D comes from the same website and relates to Iceland's economy. Fishing is important but there is now more diversity. Fishing represented 90% of exports in the 1970s which has now dropped to 70% with only 50% total foreign currency earnings. Further information shows that in

2002 17.5% (35,739 million Krona) of exports were to the UK. In exhibit E there are extracts from the register of Icelandic exporters. A reasonably large number of companies are identified who export and who use Iceland or Icelandic in its name. Information from the same website is provided after conducting searches on it. The first search is for the word FROZEN which revealed 29 categories of business involved in frozen goods, many, but not all, relate to fished products. Another search relates to the word FISH with 99 categories of fish business revealed. Beyond fish or entries which cannot be identified I note, Icelandic Business Information Centre, the Hand knitting Association of Iceland, Iceland Post, Iceland Music Info Centre, Icelandic Sales agency, Icelandic textiles, Icelandic Dairy Produce Marketing Association, Icelandic Building Research Institution, Icelandic Skins Ltd, Air Atlanta-Icelandic, Iceland Air Cargo, Farm Foods Iceland, Iceland Air Hotels Group, Iceland Waters Ltd, Icelandic Eiderdown, Iceland Stock Exchange, Iceland Geo Survey, the national band of Iceland, Icelandic Fur Breeders Association, Confederation of Icelandic Employers, Iceland Telecom. A list of the types of goods exported is also provided, many are fish, but, also, beef and veal, food specialties, mutton and lamb, pork, fishing boats, animal feed, buoys. There are also details of other companies who export goods such as aluminum casting, lamb, dairy products, marine oils, confectionary, textiles (Icelandic wool).

13) Reference is made to the more diverse trade between Iceland and the UK (diverse from fish). Reference is made to some awards that Icelandic companies have won. Extracts are provided from [randburg.com](http://randburg.com) which contains an Iceland Export Directory. They include companies involved in Aluminum smelting, fish, seafood, caviar, lamb, salmon, sea salt, dairy products, omega 3, confectionary, woolen goods. Reference is made to other companies who produce white goods. It is stated that the class 16 goods sold under the mark ICELAND will be perceived as having the country as its subject matter. It is stated that many books sold in Iceland will be about the country and that visitors will buy postcards and other tourist goods. In relation to the foodstuff classes, reference is made to various companies who produce fish and other food products (of the type indicated above). Reference is made to companies who also operate in high tech fields.

14) Exhibit G is a print from [www.buyicelandic.com](http://www.buyicelandic.com) which contains a sponsored link to [icelandapplicances.co.uk](http://icelandapplicances.co.uk) which is said to be a link to IFL's website. It is highlighted that the nature of the website informs the consumer that the goods obtained from the link are Icelandic and that confusion/deception could arise. The website is a portal type page.

15) Exhibit G is a news article which relates to complaints that IFL received due to Iceland's (the country) whaling activities. The CEO of IFL had to write back to the complainers explaining that they had no link with the country and that IFL opposed whaling.



16) Further export statistics and details of Icelandic companies are provided which do not really add to the whole picture. What does help is a breakdown of exports by product type. The largest is in respect of marine products (104,898k), the next largest is manufacturing goods (57,670k) then agricultural (3,081K) and then other 3,256k.

*Witness statement of Andri Por Guomundsson*

17) Mr Guomundsson is a member of the non-executive board of Iceland Spring in Iceland, one of the opponents. He explains that it has been selling spring water in the UK since 2001. Packaging for the goods is provided which uses the words —a natural product of Iceland”. Further promotional material about the product is provided. It is stated that it needs to use the word Iceland to identify where its water comes from and that; therefore, it should not be possible to register the mark for water.

*Witness statement of Finnboqi Gylfason*

18) Mr Gylfason is head of finance for Icelandic Group Plc, another of the opponents. He states that the company has been active in the UK for over 40 years, with a turnover of £270 million. He provides various advertising materials which feature the companies’ trade marks ICELANDIC FROZEN FOOD (stylized) and which also features various descriptive uses of the word ICELAND (e.g. frozen at sea from Iceland). He says that the company needs to use the mark descriptively and that a monopoly ought not be granted.

*Witness statement of Grimur Saemundsen*

19) Mr Saemundsen is the CEO of Blue Lagoon Limited. He states that the company has been active in the UK since 1994. The company runs a geothermal spa in Iceland that has 400,000 visitors annually. He says that 34% of the UK public know of its brand (BLUE LAGOON ICELAND) according to a survey conducted in 2005 (a survey which is not supplied). He also provides various material relating to the company which uses Iceland descriptively, opining that the company needs to use the word as a description and that a monopoly ought not be granted.

*Witness statement of Andri Gretarsson*

20) Mr Gretarsson is the Senior Vice President of Finance and Resource management of Iceland Air, a company active in the UK for over 60 years with a turnover of £14 million. Like the other witness, he provides various material relating to the company which uses Iceland descriptively, opining that the company needs to use the word as a description and that a monopoly ought not be granted.

Witness statement of John Berry

21) Mr Berry is IFL's company secretary. He provides various pieces of information about IFL's business. Its first shop opened in Oswestry in 1970. He refers to a book about IFL's history. He states that the name was chosen as a play on words with ICE (frozen foods) and LAND (a place to buy it). The first shop specialised in loose frozen food such as peas, chips, sprouts etc., which have no connection with Iceland the country. The business has grown significantly over the years. I do not intend to detail all of the historical information but, by 1995, it had 752 stores. A list of stores opened by 2003 is provided, I have not counted or mapped them but the numbers are significant as is the geographical spread throughout the UK. Its turnover was £1426 million in 1996, and its recent highest was £2473 million in 2001. Its advertising and promotional spend was over 11 million in 2001. This includes press, TV and radio advertising.

22) In terms of the goods sold, this is varied and has moved on from the simple loose frozen food first sold. Not all, though, are own branded. The goods of other traders are sold in the supermarket. I have been through the various exhibits - the ICELAND branded goods include: cheese, desserts, sauces, ham, chicken, salmon, pizza, ice-cream, ready meals, burgers, frozen potatoes, orange juice, doughnuts, tuna, potatoes, prawns, veg, rice, plaice.

23) The primary signs used feature a stylized version of ICELAND, be it the one applied in this application, or an older (but similar) one. Very old brochures featured a more plain presentation.

24) Mr Berry refers to market research conducted in 1982 in which 43% of people in the north of England knew that Iceland was a place to buy frozen food. Following advertising campaigns that year, this grew to a figure of 70%. Mr Berry provides a lot more information but it need not all be detailed as what the business is, its size and what is sold is already clear.

25) He states that IFL has owned a trade mark for ICELAND UK and has never tried to stop others from using the word ICELAND in a descriptive sense when such people are simply making a connection with the country. He states that the evidence relating to whaling is not relevant because it simply reflects that some people knew that IFL had a major shareholder of Icelandic origin and that this was what led to the complaints.

Witness statement of John Groom.

26) Mr Groom is a trade mark attorney at Groom Wilkes and Wright LLP. Much of his evidence is in the form of packaging material for various products including fish demonstrating that it is common for such goods to be described as ICELANDIC FISH as opposed to ICELAND FISH. He provides other examples of Scottish, Belgian etc goods. He provides exhibits showing that fish is normally

sold on the basis of the type of fish as opposed to where it is from. He notes that in Ms Shackleton's evidence the goods are often described as Icelandic. He states that Ms Shackleton's figures on agriculture are very low. He exemplifies this by looking at the country's potato yield. From information provided in The Economic Evaluation of British Potato Council 2000, the yield is equivalent to just 8 UK potato farms.

*Witness statement of Lindsey Swan*

27) Ms Swan works for IFL as a customer insights manager. She refers to a survey conducted for the purposes of these proceedings. The questions asked were:

Do you ever buy frozen food?

Can you name any retailer of frozen foods?

Can you name any other retailers of frozen food?

28) The headline figures are that 70% of people identified ICELAND as a retailer of frozen food, be it following questions 2 or 3.

*Witness statement of Asdis Magnusdottir*

29) Ms Magnusdottir is a trade mark attorney at Arnason Faktor. She comments on Mr Berry's statements that IFL has not taken action against companies based in or having a connection with the country of Iceland who use the word Iceland in a way which suggests a connection with the country. She highlights that IFL have, in fact, opposed two figurative CTMs which have as a dominant element the word(s) ICELAND/ICELAND GOLD. Both marks have an Icelandic company as the applicant.

*Witness statement of Philip Malivoire*

30) Mr Malivoire is a Divisional Director of NOP, an expert in the field of surveys. He criticizes the survey on the basis of methodology, participant selection and that the survey was skewed towards specialist frozen food retailers.

### **Section 3(1)(c) of the Act**

31) The leading authority on this provision, at least in so far as the registration of geographical names is concerned, is the judgment of the Court of Justice of the European Union (CJEU) in *Windsurfing Chiemsee* (Joined cases C- 108/97 and C-109/9):

–26. As regards, more particularly, signs or indications which may serve to designate the geographical origin of the categories of goods in relation to which registration of the mark is applied for, especially geographical names, it is in the public interest that they remain available, not least because they may be an indication of the quality and other characteristics of the categories of goods concerned, and may also, in various ways, influence consumer tastes by, for instance, associating the goods with a place that may give rise to a favourable response.

.....

28. In addition, Article 6(1)(b) of the Directive, to which the national court refers in its questions, does not run counter to what has been stated as to the objective of Article 3(1)(c), nor does it have a decisive bearing on the interpretation of that provision. Indeed, Article 6(1)(b), which aims, *inter alia*, to resolve the problems posed by registration of a mark consisting wholly or partly of a geographical name, does not confer on third parties the right to use the name as a trade mark but merely guarantees their right to use it descriptively, that is to say, as an indication of geographical origin, provided that it is used in accordance with honest practices in industrial and commercial matters.

29. Article 3(1)(c) of the Directive is not confined to prohibiting the registration of geographical names as trade marks solely where they designate specified geographical locations which are already famous, or are known for the category of goods concerned, and which are therefore associated with those goods in the mind of the relevant class of persons, that is to say in the trade and amongst average consumers of that category of goods in the territory in respect of which registration is applied for.

30. Indeed, it is clear from the actual wording of Article 3(1)(c), which refers to '... indications which may serve ... to designate ... geographical origin', that geographical names which are liable to be used by undertakings must remain available to such undertakings as indications of the geographical origin of the category of goods concerned.

31. Thus, under Article 3(1)(c) of the Directive, the competent authority must assess whether a geographical name in respect of which application

for registration as a trade mark is made designates a place which is currently associated in the mind of the relevant class of persons with the category of goods concerned, or whether it is reasonable to assume that such an association may be established in the future.

32. In the latter case, when assessing whether the geographical name is capable, in the mind of the relevant class of persons, of designating the origin of the category of goods in question, regard must be had more particularly to the degree of familiarity amongst such persons with that name, with the characteristics of the place designated by the name, and with the category of goods concerned.

33. In that connection, Article 3(1)(c) of the Directive does not in principle preclude the registration of geographical names which are unknown to the relevant class of persons — or at least unknown as the designation of a geographical location — or of names in respect of which, because of the type of place they designate (say, a mountain or lake), such persons are unlikely to believe that the category of goods concerned originates there.

34. However, it cannot be ruled out that the name of a lake may serve to designate geographical origin within the meaning of Article 3(1)(c), even for goods such as those in the main proceedings, provided that the name could be understood by the relevant class of persons to include the shores of the lake or the surrounding area.

35. It follows from the foregoing that the application of Article 3(1)(c) of the Directive does not depend on there being a real, current or serious need to leave a sign or indication free ('Freihaltebedürfnis') under German case-law, as outlined in the third indent of paragraph 16 of this judgment.

36. Finally, it is important to note that, whilst an indication of the geographical origin of goods to which Article 3(1)(c) of the Directive applies usually indicates the place where the goods were or could be manufactured, the connection between a category of goods and a geographical location might depend on other ties, such as the fact that the goods were conceived and designed in the geographical location concerned.

37. In view of the foregoing, the answer to the questions on Article 3(1)(c) of the Directive must be that Article 3(1)(c) is to be interpreted as meaning that:

— it does not prohibit the registration of geographical names as trade marks solely where the names designate places which are, in the mind of the relevant class of persons, currently associated with the category of goods in question; it also applies to geographical names which are liable

to be used in future by the undertakings concerned as an indication of the geographical origin of that category of goods;

— where there is currently no association in the mind of the relevant class of persons between the geographical name and the category of goods in question, the competent authority must assess whether it is reasonable to assume that such a name is, in the mind of the relevant class of persons, capable of designating the geographical origin of that category of goods;

— in making that assessment, particular consideration should be given to the degree of familiarity amongst the relevant class of persons with the geographical name in question, with the characteristics of the place designated by that name, and with the category of goods concerned;

— it is not necessary for the good to be manufactured in the geographical location in order for them to be associated with it.

32) The General Court (–GC”) have applied the guidance provided by the CJEU in *Windsurfing* on a number of occasions. For example, in Case T-295/01, *Nordmilch EG v OHIM* [2003] E.C.R. II-4365; [2004] ETMR 70 the GC upheld the refusal to register the mark —Oldenburger” for a variety of foodstuffs, where Oldenburg is a German town well-known as the centre of an agricultural area with dairy, livestock and meat-processing industries. The Court held:

—Article 7(1)(c) of the Regulation pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the categories of goods or services in respect of which registration is applied for may be freely used by all. The provision therefore prevents such signs or indications from being reserved to one undertaking alone because they have been registered as trade marks (see, by analogy, *Windsurfing Chiemsee*, para.[25]).

30 As regards, more particularly, signs or indications which may serve to designate the geographical origin of the categories of goods in relation to which registration of the mark is applied for, especially geographical names, it is in the public interest that they remain available, not least because they may be an indication of the quality and other characteristics of the categories of goods concerned, and may also, in various ways, influence consumer tastes by, for instance, associating the goods with a place that may give rise to a favourable response (see, by analogy, *Windsurfing Chiemsee*, para.[26]).

31 Furthermore, it may be observed, first, that the registration of geographical names as trade marks solely where they designate specified geographical locations which are already famous, or are known for the category of goods concerned, and which are therefore associated with

those goods in the mind of the relevant class of persons, is excluded as, secondly, is the registration of geographical names which are liable to be used by undertakings and must remain available to such undertakings as indications of the geographical origin of the category of goods concerned (see, by analogy, *Windsurfing Chiemsee*, paras [29] and [30]).

...

33 However, Art.7(1)(c) of the Regulation does not in principle preclude the registration of geographical names which are unknown to the relevant class of persons—or at least unknown as the designation of a geographical location—or of names in respect of which, because of the type of place they designate, such persons are unlikely to believe that the category of goods concerned originates there (see by analogy *Windsurfing Chiemsee*, para.[33]).

34 In the light of all the foregoing, a sign's descriptiveness cannot be assessed other than by reference to the goods or services concerned, on the one hand, and by reference to the understanding which the relevant persons have of it, on the other.

...

37 In that connection, the Board of Appeal found at paras [27] to [29] of the contested decision that it is well-known in Germany at national level that Oldenburg is the capital of a region that is essentially centred on agriculture, in particular in the dairy, livestock and meat-processing industries, which the applicant does not deny. From that point of view, it must be observed that a large number of agricultural products carry the designation Oldenburger combined with a generic term or the designation Oldenburg combined with the name of the producer.

38 Having regard to the fact that the geographical area which is directly evoked by the relevant public is known as a region that produces the goods in question, those persons may perceive the geographical name as an indication of the geographical origin of those goods.”

33) In Case T-379/03, *Peek & Cloppenburg KG's application* [2005] E.C.R. II-4633; [2006] E.T.M.R. 33, the applicant sought to register as a Community trade mark the word mark CLOPPENBURG for retail trade services in Class 35. Cloppenburg is a small town in Lower Saxony of around 30,000. The Board of Appeal had refused the registration as an indication of geographical origin. The GC repeated the guidance it had given in *Nordmilch* and reversed the Board of Appeal's decision, finding that there was insufficient evidence that average customers in Germany knew the sign as a geographical location, but even if it could leave that question open:

—...the Board of Appeal has not demonstrated to the required legal standard that there existed, in the eyes of the public concerned, any link between the town or region of Cloppenburg and the category of services

concerned, or that the word ‘Cloppenburg’ might reasonably be supposed, in the eyes of that public, to designate the geographical origin of the category of services at issue.

...

49 Now, even if the relevant public does know of the town of Cloppenburg, it does not automatically follow that the sign may serve, in trade, to designate geographical origin. In order to examine whether the conditions for application of the ground for refusal to register at issue have been satisfied, account must be taken of all the relevant circumstances, such as the nature of the goods or services designated, the greater or lesser reputation, especially within the economic sector involved, of the geographical location in question and the relevant public's greater or lesser familiarity with it, the customs obtaining in the area of activity concerned and the question as to what extent the geographical origin of the goods or services at issue may be relevant, in the view of the persons concerned, to the assessment of the quality or other characteristics of the goods or services concerned.

50 In the circumstances, the relevant public is only slightly, or at the very most, moderately, familiar with the town of Cloppenburg. First, it is a small town. Secondly, the Board of Appeal has not mentioned any Class of goods or services for which that town enjoys a reputation as the place where the goods are produced or the services rendered. Moreover, the Board of Appeal has not established that it is current practice in trade to indicate the geographical origin of retail trade services. In addition, the geographical origin of such services is not usually regarded as relevant when assessing their quality or characteristics.

51 In those circumstances, the town of Cloppenburg does not present, in the view of the public concerned, any link with the category of services concerned, and it is not reasonable either to imagine that the indication at issue might in the future designate the geographical origin of those services.”

I have also kept in mind decisions referred to in Ms Shackleton’s evidence relating to GREENLAND and SUDAN.

34) For IFL, Mr Wyand argued that there was no evidence demonstrating that the country of Iceland was known for anything other than fish (particularly cod). It was argued that without such evidence it should not be assumed that ICELAND would be perceived as a description of the geographical origin of the goods and services. On behalf of the opponents, Mr Baldwin argued that the country was a very well known European country with a more diverse economy than just fish. It was argued that the mark ICELAND would send one message only, a message of geographical origin; this submission was made regardless of the goods and



services, i.e. that the country was so well known that it would perform nothing other than a description of origin.

35) The country of Iceland is a small one, at least in terms of population if not in size. Its population is just over 300,000 people, the size of an averagely sized city in the UK. Having considered the evidence, I have no doubt that the country has a reputation for fish, particularly cod. IFL do not take issue with this. The fish are likely to be caught in the waters surrounding Iceland and perhaps processed in its ports – this is how the relevant public is likely to appreciate the reputation. However, notwithstanding the evidence filed by Ms Shackleton, I do not consider that the country has a specific reputation for anything else. The country may be known for other things, banking and volcanoes spring to mind, but this is not relevant to the matters to be determined here. In any event, the infamous events surrounding Icelandic banks and the country's volcanic activity post dates the relevant date here.

36) In terms of the degree of familiarity with the country of Iceland, the relevant public for all of the goods and services are likely to know of the country. As Mr Baldwin submitted, it is a European country not an obscure, unrecognizable one. This, however, does not mean that the word ICELAND used as a trade mark in relation to the goods and services would automatically be taken as a description of geographic origin for everything. This is where the balancing act outlined in the jurisprudence needs to be taken into account.

37) As I have said, the country may be known for its fishing industry. As a matter of fact, the country does export goods other than fish. However, from the evidence provided to the tribunal, it is difficult to ascertain its significance and likely impact on the UK public. The export figures to the UK for 2002 were 35,739 million Krona. No conversion figures to £s are provided. Nor is any information provided as to what proportion of the relevant UK market the exports from the country of Iceland represent. They may be just a drop in the ocean. A high proportion of the exported goods are fish. Mineral products also seem important. So what is left is spread over what Ms Shackleton describes as a diverse export economy. When all this is weighed up, the significance on the UK public of Icelandic exports (other than fish) must, therefore, be limited.

38) Some words or phrases are more apt to be perceived as a description. For example, —Made in Iceland” sends a very direct message. The word Icelandic may also have a reasonably direct meaning. Whilst it could be said that there is little difference between ICELAND and ICELANDIC it is, nevertheless, a distinction to bear in mind as part of the factual matrix of the case. As the case-law suggests, the mark must be carefully assessed against the goods and services put forward for registration. I should add that Mr Baldwin gave various examples of what he considered to be normal descriptive use of phrases including the word ICELAND (as a reference to the country) which he says would constitute infringing use if the opposition did not succeed; I have borne the public

interest in mind when coming to the findings set out below, beyond that I do not consider it necessary to comment specifically on Mr Baldwin's examples – whether a phrase constitutes an infringement is a multi-factorial question having regard to the circumstances of the alleged infringing use.

39) There was much discussion in the hearing about the letters of complaint sent to IFL when the country of Iceland recommenced whaling activities. There was much discussion as to the reasons why some consumers expressed dissatisfaction with IFL about this. Without direct evidence from the letter writers, there is little that can be taken from this. The reaction does not strike me as a typical one in any event and, as Mr Wyand stated, some of the letter writers may have known that IFL had Icelandic backers at that time which may have generated the letters. I read nothing significant into this evidence either way. There was also discussion of some press material in Mr Berry's evidence (such as cartoons) which made a pun between the country of Iceland and the retailer Iceland. Mr Baldwin considered this to demonstrate the capacity of the word to describe/mislead. However, I agree with Mr Wyand that this is not significant, the purpose of the pun is to provide humour and is not indicative either way of the perception of the trade mark, particularly bearing in mind the variety of goods/services that need to be considered, goods and services which I will now consider in more detail.

40) I will begin by considering the following:

“Class 20: Drinking straws”

41) Goods such as this represent IFL's highpoint and the opponents' low-point. There is no evidence of such goods being exported from Iceland. There is no evidence which demonstrates that the country has any particular reputation with regard to drinking straws. There is nothing inherent in the characteristics of the country that would create any form of association between the country and drinking straws. I must bear in mind the submission that the word ICELAND will indicate geographic origin in relation to anything. Whilst borne in mind, for goods such as these, I am not persuaded that the word ICELAND will be perceived by the relevant public as indicating the geographic origin of the goods. I must, of course, consider future use. Whilst the evidence does show that the country of Iceland has reduced its reliance on its fishing industry, the size of the population is not one where a vast range of goods will be produced in the future. **The opposition under section 3(1)(c) of the Act fails.**

42) I extend the above finding to the following goods by parity of reasoning:

Class 21: Dishcloths, stockinet rolls, dusters, floor cloths, sponge cloths, household gloves; household or kitchen utensils and containers (not of precious metal or coated therewith); cookware; storage containers and container lids; jugs and measuring jugs; glassware, porcelain and

earthenware not included in other classes; eating and drinking utensils; tableware; tray and tray covers; roasting dishes; oven trays, pizza pans, loaf pans and sandwich pans, all made of metal; combs and sponges; brushes (except paint brushes); electric and non-electric toothbrushes; toothpicks; articles for cleaning purposes; steel wool.

**The opposition under section 3(1)(c) of the Act fails for the above goods.**

43) I next consider the following:

Class 07: Dishwashers; washing machines; domestic machines; parts and fittings for all the aforesaid goods.

Class 08: Cutlery, knives, forks, spoons; all included in Class 8.

Class 11: Apparatus for heating, cooking, refrigerating, drying or ventilating; freezers, refrigerators, combined freezers and refrigerators, microwave ovens; parts and fittings for all the aforesaid goods.

44) With one exception I will come to, these goods have no real association with the country. Whilst in Ms Shackleton's evidence reference is made to exports from the country, including manufacturing goods, there is little to suggest that white goods such as these are particularly relevant. My comments regarding future use also apply here. The opposition fails. The one exception relates to apparatus for refrigerating and "refrigerators, combined freezers and refrigerators". The evidence shows a company in Iceland who produce refrigeration and freezing equipment for use by fishing fleet. Given the reputation of the country for its fishing, it would not be surprising for some ancillary equipment to be produced in the country and, for such goods, the relevant public (for those goods) may link that reputation. I consider the objection to be made out for such goods, but this could easily be overcome by limiting the goods to being for domestic use. The goods would read:

Class 11: Apparatus for heating, cooking, (domestic) refrigerating, drying or ventilating; freezers, refrigerators, combined freezers and refrigerators, all for domestic use; microwave ovens; parts and fittings for all the aforesaid goods.

**The opposition under section 3(1)(c) fails for the above (amended) goods.**

45) I next consider:

Class 42: Website hosting; computer services related to computerised on-line searching for, ordering, delivery and transporting of foods, drinks and consumer goods.

46) Such services are rarely sold on the basis of geographical origin unless there is a key aspect of quality or other relevant characteristic which the trader is attempting to benefit from. The country of Iceland is not known for such characteristics. **The opposition under section 3(1)(c) fails.**

47) I next consider:

**Class 16:** Paper, cardboard, paper articles, cardboard articles, wrapping and packaging materials; bags of paper or plastics, all for packaging; toilet paper, paper tissues, carrier bags, plastic bags, paper and plastic sacks; closures for bags; labels; pens and pencils; transfers; price tags and tickets and holders in the nature of envelopes; stationery.

48) Reference was made at the hearing to printed matter, which may, potentially, be about the country of Iceland. However, printed matter is not listed in the specification and although the term —paper articles” is listed, I do not consider that printed matter would naturally fall within such a term. Postcards have also been mentioned, but why Iceland (the country) postcards would be sold in the UK is beyond me. This is nothing more than a hypothetical claim, as is the reference to stationery which may be sold, it was argued in the evidence, to promote Iceland. **The opposition under section 3(1)(c) of the Act fails.**

49) I next consider:

**Class 04:** Firelighters; candles; night lights; charcoal; coke; coal; wood for burning; briquettes.

50) In relation to: “firelighters; candles; night lights” and “briquettes” there is, again, no real association with the country of Iceland. Whilst care must be exercised with regard to “charcoal; coke; coal; wood for burning” given that they are natural resources, there is no evidence as to the availability of these natural resources in the country, be it for use in the country itself, let alone for export. **The objection under section 3(1)(c) of the Act fails.**

51) I extend the above finding to:

**Class 34:** Smokers articles.

**The opposition under section 3(1)(c) of the Act fails for the above goods.**

52) I next consider:

**Class 05:** Disinfectants; all included in Class 5 (I will come back to food for babies which is also in this class).

53) Again, I see no association with the country of Iceland, be it now or in the future. **The opposition under section 3(1)(c) of the Act fails.**

54) I next consider:

Class 06: Goods of common metal; small items of metal hardware; kitchen foil; all included in Class 6.

55) Whilst there is some evidence relating to mineral production, and some evidence relating to aluminum smelting, there is nothing to suggest that the country of Iceland is associated with metal production. In any event, the goods under consideration are finished products for which there is certainly no current association. My earlier comments regarding foreseeability apply here also. **The opposition under section 3(1)(c) of the Act fails**

56) I next consider:

**Class 09:** Downloadable electronic publications, in particular catalogues and directories; batteries; lighters.

**Class 41:** Providing online catalogues and directories.

57) In relation to class 9, the “batteries; lighters” are free from objection by parity of reasoning to much of what I have already set out. However, in relation to “downloadable electronic publications” I accept that these could relate to the country of Iceland. Furthermore, even if the specified electronic publications were taken to be the only electronic publications of interest then it is possible that the catalogues and directories could relate to information about goods and traders from the country of Iceland. This problem also extends to the class 41 services. However, if the specification were limited to reflect IFL’s business as a retail supermarket operator then I consider the mark to be free from objection. Therefore, for the following goods and services the **the opposition under section 3(1)(c) fails:**

Class 09: Downloadable electronic publications, namely catalogues and directories relating to retail supermarket services; batteries; lighters.

Class 41: Providing online catalogues and directories relating to retail supermarket services

58) I next consider:

Class 35: Retail supermarket services connected with the sale of toiletries, household products including cleaners, polishers, scourers, soaps, hardware, kitchen foil, electrical goods including white goods, publications and stationery, household utensils, glassware and kitchenware, foodstuffs

and drinks; shop window dressing; telesales services; ordering services; advertising, marketing and promotion of goods and services; direct mail advertising services; distribution of samples; operation of in-store self-service schemes; cost and payment calculation, monitoring, recordal and processing; organisation, operation and supervision of sales and promotional incentive schemes to consumers and/or the wholesale trade; customer advisory and consultancy services; the provision of promotional, incentive and loyalty schemes by means of customer club membership schemes; business management advice and assistance, business appraisals; business administration services; arranging business introductions; market research; personnel management advice; provision of trade information; procurement of goods on behalf of business; business advisory services relating to franchising; information and advisory services relating to all the aforesaid.

59) The retail services are those of a supermarket. Whilst a variety of goods are being sold (including foodstuffs which will include fish), the service is still of a retail supermarket which will always sell a broad range of goods. Supermarkets are generalists not specialists. As such, I consider that no real association will be made. I am aware that, for example, Polish supermarkets exist and are highlighted as such. However, this is to facilitate a particular need, the need being to serve the fairly large number of Polish immigrants now living in the UK. There is nothing to suggest that there has been an influx of workers from the country of Iceland and there is nothing to suggest that there is a future risk that I need be wary of. **The opposition under section 3(1)(c) of the Act fails in respect of these services.**

60) In relation to the business type services, there is nothing in the evidence to suggest a current association or one that may come to be. **The opposition under section 3(1)(c) of the Act fails in respect of these services.** The one exception to this is perhaps “arranging business introduction; provision of trade information”. Such services may relate to the obtaining of trade contacts or information relating to doing business overseas, including in the country of Iceland. On this basis, there would be a reasonably clear association with the country. **The objection is made out here.**

61) I next consider:

Class 29: Meat; fish, poultry and game, none being live; all for food for human consumption; meat extracts; fruits and vegetables, all being preserved, dried, cooked, canned or frozen; jellies and dairy products, all for food; jams, marmalade, eggs, edible oils, edible fats; food preserves; potato crisps and potato products (for food); prepared meals and constituents therefor, snack foods, all included in Class 29.

62) Care needs to be exercised here given that many of these goods are natural products. The specification includes fish. As discussed already, the country of Iceland has a reputation and is associated with fish, particularly cod. I consider the objection to be made out for the term fish (and not just cod). In relation to “~~meat~~, poultry and game”, I am conscious that these are the types of goods that are often stamped with the name of the originating country. The goods are of the type where traceability is paramount. Whilst the evidence is not overwhelming, there are some examples of lamb and beef being exported. Whilst it is not clear as to the level of exports to the UK and whilst, therefore, I cannot say that there is a current association, these are the sorts of goods for which foreseeability may be an issue. **I consider the objection to be made out here.**

63) In relation to: “~~potato~~ crisps and potato products (for food), jams, marmalade, fruits and vegetables, all being preserved, dried, cooked, canned or frozen; jellies”. There is no current association and nor can I see a future one. Although in relation to vegetables there are some production figures in the evidence, there is little evidence of an export market. I have mentioned some of the things for which the country of Iceland is known, if there is one further thing it would be for being cold. It does not have the sort of climate that would be perceived by the relevant public as one where fruit and vegetable production is significant. The other goods are a step removed. **The opposition under section 3(1)(c) of the Act fails in respect of these goods.**

64) In relation to “meat extracts; dairy products, eggs, edible oils, edible fats; food preserves” I am not satisfied from the evidence provided that there is a current association between these goods and the country of Iceland. Whilst they may be produced, the lack of current (or foreseeable) associations means that the perception of the mark will not be one of geographic origin. The directness of the message is not as clear as other possible designations and the country of origin stamping not so prevalent. **The opposition under section 3(1)(c) of the Act fails in respect of these goods.**

65) In relation to “~~prepared~~ meals and constituents therefor, snack foods” there is the possibility that the prepared meals could contain fish. Whilst this is still a prepared meal not fish itself, the aptness of the word ICELAND is still sufficient particularly bearing in mind the country’s strong reputation for fish so that, in my view, it will be perceived by the relevant public as an indication of geographical origin. **The opposition under section 3(1)(c) of the Act succeeds in respect of these goods.** This finding also extends to “~~food~~ for babies” in class 5 for similar reasons. The above terms nevertheless have the capacity to be amended to overcome the scope of where I consider the opposition to bite. Something along the lines of “~~not~~ consisting wholly or principally of fish” may be appropriate. However, as this is not a straightforward exclusion then I consider it appropriate for the parties to be given an opportunity to comment on a suitable exclusion. I will return to this later.

66) I next consider:

**Class 30:** Coffee, tea, sugar, rice, tapioca, sago; mixtures of coffee and chicory, coffee essences and coffee extracts; chicory and chicory mixtures, all for use as substitutes for coffee; flour, preparations made from cereals for food for human consumption, bread, biscuits (other than biscuits for animals), cakes, pastry, non-medicated confectionery; edible ices; refreshing ice; honey, treacle; yeast, baking-powder, salt (for food), mustard, vinegar, pepper, sauces, salad sauces; spices (other than poultry spice); prepared meals and constituents therefor, snack foods, all included in Class 30.

67) For similar reasons to those expressed in paragraphs 63-64, **the opposition under section 3(1)(c) of the Act fails in respect of these goods.**

68) In next consider:

**Class 31:** Agricultural, horticultural and forestry and grain products, not included in other classes; living animals; fresh fruits and vegetables; seeds; natural plants and flowers; animal feeds, malt.

69) By parity of reasoning with my findings in relation to classes 29 and 30, **the opposition under section 3(1)(c) fails in respect of most of these goods.** The one exception is in relation to “living animals”. The association I described with respect to meat and fish etc in class 29 is likely to spill over here, as is the requirement for designating the geographical origin of the animals. **The objection is made out here.**

70) I next consider:

**Class 32:** Beers, mineral and carbonated waters and other non-alcoholic beverages; fruit drinks and fruit juices; syrups and other preparations for making beverages.

**Class 33:** Alcoholic beverages; wines, spirits and liqueurs.

71) There is nothing in the evidence to suggest a current association with regard to these goods. There is a reference to an Icelandic beer but its significance in the UK is not clear. There is stronger evidence that a spring water supplier has been operating in the UK for some time. This, though, is just one trader. Nevertheless, water is the most natural of all products and is often sold on the basis of geographic origin. The climate of Iceland may also predicate the perception of the relevant public, a perception that the country will be suitable for spring water supply. None of the other goods, have, in my view, any real association and there is nothing to suggest that foreseeability is an issue. **The objection is made out in relation to mineral and carbonated waters but fails**



**in relation to everything else.** However, because the wide term —~~the~~ non-alcoholic beverages would cover water, the term will require amendment to read —~~no~~-alcoholic beverages other than water and mineral and carbonated waters”.

72) I next consider:

**Class 43:** Cafe, cafeteria, catering and restaurant services.

73) Whilst the country of Iceland may have a reputation for the quality of its fish, particularly cod, it seems to me that such services are at least one step removed. The country of Iceland is not currently associated with a particular style of cooking or dishes, such that the mark will be perceived by the relevant public as a descriptor of any kind. There is nothing in the evidence to suggest that foreseeability is an issue. **The opposition under section 3(1)(c) fails in respect of these services.**

74) I finally consider:

**Class 03:** Non-medicated toilet preparations; anti-perspirants; cosmetics; perfumes; toilet waters; soaps; toilet articles; shampoos; dentifrices; non-medicated preparations and substances, all for the treatment, conditioning and care of skin and scalp; essential oils; cleansing, polishing and scouring preparations and substances; detergents; all included in Class 3.

75) The evidence contains information relating to an Icelandic skin care company. I am also aware from my own knowledge of the popularity of skin care products produced by Scandinavian companies, utilising what will be perceived as knowledge of products used in harsher conditions than the UK. The country of Iceland is not in Scandinavia but similar perceptions may arise. As with the water based beverages, perceptions of natural ingredients may predicate the perception of the relevant public. **For these reasons combined, I am persuaded that for goods which could be used for the care of the skin, together with any closely related goods (but not anti-perspirants; perfumes; shampoos; dentifrices, which I consider a step removed), the objection is made out.** In relation to —cleansing, polishing and scouring preparations and substances; detergents” — such goods strike me as more domestic than personal. I consider the objection does not arise, therefore, in relation to:

**Class 03:** Anti-perspirants; perfumes; shampoos; dentifrices; cleansing, polishing and scouring preparations and substances; detergents; all included in Class 3.

## Acquired distinctiveness

76) I only intend to consider the position in respect of the goods for which the opposition has so far been upheld. The *Windsurfing* case is also instructive here. The CJEU stated:

-49. In determining whether a mark has acquired distinctive character following the use made of it, the competent authority must make an overall assessment of the evidence that the mark has come to identify the product concerned as originating from a particular undertaking, and thus to distinguish that product from goods of other undertakings.

50. In that connection, regard must be had in particular to the specific nature of the geographical name in question. Indeed, where a geographical name is very well known, it can acquire distinctive character under Article 3(3) of the Directive only if there has been long-standing and intensive use of the mark by the undertaking applying for registration. A *fortiori*, where a name is already familiar as an indication of geographical origin in relation to a certain category of goods, an undertaking applying for registration of the name in respect of goods in that category must show that the use of the mark — both long-standing and intensive — is particularly well established.

51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: 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.

52. If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied. However, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data such as predetermined percentages.”

77) IFL filed significant evidence of use, however, many of the headline figures focus on its primary services as a supermarket retailer. In terms of own branded goods these include: cheese, desserts, sauces, ham, chicken, salmon, pizza, ice-cream, ready meals, burgers, frozen potatoes, orange juice, doughnuts, tuna, potatoes, prawns, veg, rice, plaice.

78) In terms of where the objection remains goods such as ham, chicken, salmon, tuna, prawns and plaice may be relevant. However, the witness provides no breakdown as to the length of use or sales in relation to these goods (or indeed any others). I am not, therefore, satisfied that the mark will have acquired a distinctive character through its use.

### **The other marks and the other grounds under section 3(1) of the Act**

79) It was conceded by Mr Baldwin at the hearing that the objection under section 3(1)(d) of the Act added little. I agree, I need not probe this ground any further. Under section 3(1)(b), the lack of distinctiveness was argued primarily on the basis that if the mark designates origin then it was devoid of distinctive character. In view of this, the ground adds little. If there is any other reason to suggest that the mark falls foul of section 3(1)(b) for other reasons, then this is not clear from either the arguments before me, or the evidence presented. The opposition under section 3(1)(a) does not advance the case of the opponents beyond that already decided.

80) In terms of the various deceptiveness grounds under sections 3(3) and 3(4) then for the goods which I have found not to fall foul of section 3(1)(c), it follows that they are free from objection under these grounds also. If the mark will not be perceived as indicating geographical origin then it can hardly be deceptive. In terms of the objection under 3(3)(a), this is untenable – there is no prohibition on the registering of geographical names as long as they do not fall foul of the grounds already discussed.

81) In terms of the figurative marks, they stand and fall with the word mark. The opponents are in no stronger position to argue against them. For IFL, the stylisation of the additional marks is not sufficient to imbue the mark as a whole with distinctive character in respect of the goods for which I have upheld the opposition. Nor is the lack of specificity in the evidence of IFL cured.

### **Summary of outcome**

82) The opposition fails in respect of:

**Class 03:** Anti-perspirants; perfumes; shampoos; dentifrices; cleansing, polishing and scouring preparations and substances; detergents; all included in Class 3.

**Class 04:** Firelighters; candles; night lights; charcoal; coke; coal; wood for burning; briquettes.

**Class 05:** Disinfectants; food for babies (**subject to an appropriate exclusion**); all included in Class 5.

**Class 06:** Goods of common metal; small items of metal hardware; kitchen foil; all included in Class 6.

**Class 07:** Dishwashers; washing machines; domestic machines; parts and fittings for all the aforesaid goods.

**Class 08:** Cutlery, knives, forks, spoons; all included in Class 8.

**Class 09:** Downloadable electronic publications, namely catalogues and directories relating to retail supermarket services; batteries; lighters

**Class 11:** Apparatus for heating, cooking, (domestic) refrigerating, drying or ventilating; freezers, refrigerators, combined freezers and refrigerators, for domestic use; microwave ovens; parts and fittings for all the aforesaid goods.

**Class 16:** Paper, cardboard, paper articles, cardboard articles, wrapping and packaging materials; bags of paper or plastics, all for packaging; toilet paper, paper tissues, carrier bags, plastic bags, paper and plastic sacks; closures for bags; labels; pens and pencils; transfers; price tags and tickets and holders in the nature of envelopes; stationery.

**Class 20:** Drinking straws.

**Class 21:** Dishcloths, stockinet rolls, dusters, floor cloths, sponge cloths, household gloves; household or kitchen utensils and containers (not of precious metal or coated therewith); cookware; storage containers and container lids; jugs and measuring jugs; glassware, porcelain and earthenware not included in other classes; eating and drinking utensils; tableware; tray and tray covers; roasting dishes; oven trays, pizza pans, loaf pans and sandwich pans, all made of metal; combs and sponges; brushes (except paint brushes); electric and non-electric toothbrushes; toothpicks; articles for cleaning purposes; steel wool.

**Class 29:** Meat extracts; fruits and vegetables, all being preserved, dried, cooked, canned or frozen; jellies and dairy products, all for food; jams, marmalade, eggs, edible oils, edible fats; food preserves; potato crisps and potato products (for food); prepared meals and constituents therefor, snack foods (**subject to an appropriate exclusion**), all included in Class 29.

**Class 30:** Coffee, tea, sugar, rice, tapioca, sago; mixtures of coffee and chicory, coffee essences and coffee extracts; chicory and chicory mixtures, all for use as substitutes for coffee; flour, preparations made from cereals for food for human consumption, bread, biscuits (other than biscuits for animals), cakes, pastry, non-medicated confectionery; edible

ices; refreshing ice; honey, treacle; yeast, baking-powder, salt (for food), mustard, vinegar, pepper, sauces, salad sauces; spices (other than poultry spice); prepared meals and constituents therefor, snack foods, all included in Class 30.

**Class 31:** Agricultural, horticultural and forestry and grain products, not included in other classes; fresh fruits and vegetables; seeds; natural plants and flowers; animal feeds, malt.

**Class 32:** Beers; non-alcoholic beverages other than water, mineral and carbonated water; fruit drinks and fruit juices; syrups and other preparations for making beverages.

**Class 33:** Alcoholic beverages; wines, spirits and liqueurs.

**Class 34:** Smokers articles.

**Class 35:** Retail supermarket services connected with the sale of toiletries, household products including cleaners, polishers, scourers, soaps, hardware, kitchen foil, electrical goods including white goods, publications and stationery, household utensils, glassware and kitchenware, foodstuffs and drinks; shop window dressing; telesales services; ordering services; advertising, marketing and promotion of goods and services; direct mail advertising services; distribution of samples; operation of in-store self-service schemes; cost and payment calculation, monitoring, recordal and processing; organisation, operation and supervision of sales and promotional incentive schemes to consumers and/or the wholesale trade; customer advisory and consultancy services; the provision of promotional, incentive and loyalty schemes by means of customer club membership schemes; business management advice and assistance, business appraisals; business administration services; market research; personnel management advice; procurement of goods on behalf of business; business advisory services relating to franchising; information and advisory services relating to all the aforesaid.

**Class 41:** Providing online catalogues and directories.

**Class 42:** Website hosting; computer services related to computerised on-line searching for, ordering, delivery and transporting of foods, drinks and consumer goods.

**Class 43:** Cafe, cafeteria, catering and restaurant services.

but succeeds in relation to everything else.

83) In relation to “~~fo~~od for babies” in class 5 and “~~pr~~epared meals and constituents therefor, snack foods” in class 29, these terms must be amended with an appropriate exclusion. The parties are permitted one month from the date of this decision to provide written submissions on what it considers to be a suitable exclusion having regard to the scope of success I have outlined in paragraph 65 above.

### **Costs**

84) IFL has been the most successful party and I consider it is entitled to a contribution towards its costs. However, given that the opposition did succeed in part, I will reduce such contribution by a proportionate amount. Although not consolidated, the oppositions have been dealt with as one and there is a large overlap in evidence in terms of that filed by IFL and that filed by Ms Shackleton. The total amount will, therefore, be split between the six sets of opposition proceedings. The total amount is the sum of £1800 calculated as follows:

Preparing statements and considering the other sides’ statements  
£400

Filing evidence and considering the other sides’ evidence  
£800

Attending the hearing  
£600

85) For each set of proceedings, the relevant opponent(s) shall, therefore, pay IFL the sum of £300 each. In the case of opposition 94466 from the Ministry of Foreign Affairs (and others), the eight joint opponents shall be jointly and severally liable for such a sum. This should be paid within seven days of the expiry of the appeal period (which will begin when I issue a supplementary decision dealing with the point in paragraph 83) or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated 8<sup>th</sup> of August 2012**

**Oliver Morris  
For the Registrar,  
The Comptroller-General**