

O-224-16

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER 2628288 BY ELITE OCAKBASI
RESTAURANTS LTD TO REGISTER THE MARK **BEST MANGAL** IN CLASS 43

DECISION

INTRODUCTION

1. This is an appeal from the decision of the Registrar's Hearing Officer, Mr Edward Smith, dated 18 November 2014 whereby he refused registration of UK trade mark application no. 2462760 for BEST MANGAL in Class 43 ('the application') in the name of Elite Ocakbasi Restaurants Limited ('Elite Ocakbasi') ('the applicant'). The refusal was based on sections 3(1)(b) and 3(1)(c) of the Trade Marks Act 1994 ('the Act').

2. The application was filed for the word mark BEST MANGAL covering "Services for providing food and drink; restaurant and catering services" in Class 43, on 13 July 2012.

3. The mark has been used by the applicant since 1996, initially for one restaurant in the West Kensington area of London. Two further restaurants followed in 2005 and 2009, situated reasonably close to the original restaurant. The evidence showed that they had a reasonable local following, with favourable reviews in journals such as Time Out.

4. At the heart of the case was the determination by the Hearing Officer that "mangal" is a Turkish term denoting a kind of barbecue or cuisine, with "best" being an obviously laudatory term and that the mark applied for was therefore descriptive and should not be registered in the light of the statutory provisions and relevant case law. The Hearing Officer had regard to the public policy, reflected in the Act and authorities, in preventing the monopolisation by a single trader of terms which others may legitimately wish to use to describe their goods and services. The Hearing Officer also concluded that the mark had not acquired distinctive character as a result of the use made of it.

THE APPEAL

5. The applicant contends that the Hearing Officer made a number of errors in his decision and that it should be reversed. In particular, the applicant contends that there should be registration of the mark for a limited geographical area, namely Greater London.

Principles

6. The principles to be applied on an appeal of this kind are well known. The correct approach to appeals of this kind, which I adopt here, was summarized by Floyd J's (as he then was) in *Galileo International Technology LLC v European Union* [\[2011\] ETMR 22](#) as follows

"11.Such appeals are not by way of a rehearing but are a review. The principles were set out by Robert Walker LJ in *Bessant and others v South Cone Inc* [\[2003\] RPC 5](#), at paragraphs 17 to 30. Robert Walker LJ said at [28]:

"The appellate court should in my view show real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle."

12. At paragraph 29, Robert Walker LJ said this: "The appellate court should not treat a judgment or a written decision as containing an error of principle simply because of its belief that the judgment or decision could have been better expressed."

13. In that case the High Court judge had reversed the decision of a Hearing Officer. The Court of Appeal held that he had been wrong to do so. Robert Walker LJ in dismissing the appeal said this:

"I consider that the Hearing Officer did not err in principle, nor was he clearly wrong."

14. I conclude that, unless I am satisfied that the Hearing Officer made an error of principle, I should be reluctant to interfere. I should interfere if I consider that his decision is clearly wrong, for example if I consider that he has drawn inferences which cannot properly be drawn, or has otherwise reached an unreasonable conclusion. I should not interfere if his decision is one which he was properly entitled to reach on the material before him." (see Henry Carr QC in *Healey Sports Cars Switzerland Ltd v Jensen Cars Ltd* [2014] EWHC 24 (Pat)).

7. I would add that, on an appeal concerning the application of section 3 of the Act where the central point in issue is whether a descriptive is or has become distinctive and the Registrar has held that it is not, it may be appropriate in some cases to take a particularly deferential approach to that determination. EU law recognises that tribunals such as the

Registrar have the front line role in undertaking a full and stringent examination of the facts with a view to preventing the granting of undue monopolies. That should not be lightly undermined.

8. It is also worth emphasising the importance of that public interest in cases of this kind. Where a trade mark is registered for a term which is descriptive and which other traders may reasonably want to use to describe their products in the same way, that can have a chilling effect on the ability of third parties to set up rival businesses offering the same kinds of products. That is particularly so where traders are bringing to wider public attention new kinds of products and services from foreign countries or from new frontiers of technology where a term may be in common use but which is less well known among the general public in the UK. If marks are registered for those less familiar but nonetheless descriptive terms, others are restricted in their ability to set up rival businesses (in this case restaurants offering similar food) and describe them in the appropriate way. Trade mark registration is not there to make trade harder. It is there to make it easier, for traders and consumers alike. One can imagine that the flourishing Indian restaurant scene in this country may have been adversely affected if the first restaurant in the UK to offer tandoori food had registered (and sought to enforce) the mark “Best Tandoori” for food on the basis that the restaurant was well known under that name in a neighbourhood of London and “tandoori” was not yet well known to the general public in the UK.

THE HEARING OFFICER’S DECISION

9. The Hearing Officer began by reciting the facts, including the evidence concerning the turnover in services under the mark applied for and press articles, including from Time Out referring to the Applicant’s restaurants. He considered the procedural history and the earlier interim decisions of the Registrar which had rejected registration. He then summarised the applicable legal principles as follows:

“Underlying legal principles

13. The CJEU has repeatedly emphasised the need to interpret the grounds for refusal of registration listed in Article 3(1) and Article 7(1), the equivalent provision in Council Regulation 40/94 of 20 December 1993 on the Community Trade Mark, in the light of the general interest underlying each of them (Case C-37/03P *Bio ID v*

OHIM para 59 and the case law cited there and, more recently, Case C-273/05P *Celltech R&D Ltd v OHIM*).

14. The general interest to be taken into account in each case must reflect different considerations according to the ground for refusal in question. In relation to section 3(1)(b) (and the equivalent provisions referred to above) the Court has held that “...the public interest... is, manifestly, indissociable from the essential function of a trade mark” (Case C-329/02P *SAT.1 Satelliten Fernsehen GmbH v OHIM*). The essential function thus referred to is that of guaranteeing the identity of the origin of the goods or services offered under the mark to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin (see para 23 of the above mentioned judgment). Marks which are devoid of distinctive character are incapable of fulfilling that essential function.
15. Section 3(1)(c), on the other hand, pursues an aim which reflects the public interest in ensuring that descriptive signs or indications may be freely used by all (see Case C- 191/0P *Wm Wrigley Jr v OHIM ‘Doublemint’* at para 31).
16. In terms of the relationship between sections 3(1)(b) and (c), a sign which is subject to objection under section 3(1)(c) as designating a characteristic of the relevant goods or services will, of necessity, also be devoid of distinctive character under section 3(1)(b) - see to that effect para 86 of Case C-363/99 *Koninklijke KPN Nederland NV v Benelux- Merkenbureau (‘Postkantoor’)*. But plainly, and given the public interest behind the two provisions, they must be assessed independently of each other as their scope is different, that is to say that section 3(1)(b) will include within its scope marks which, whilst not designating a characteristic of the relevant goods and services, may nonetheless fail to serve the essential function of a trade mark in that they will be incapable of designating origin.
17. The relationship between sections 3(1)(b) and (c) has also been commented upon at National Court level. For example, in the case of BL O/313/11 *‘Flying Scotsman’*, the Appointed Person notes the following at para 19:

“Since there is no obligation to rule on the possible dividing line between the concept of lack of distinctiveness and that of minimum distinctiveness when assessing the registrability of a sign under Section 3(1)(b), see Case C-104/00 P *Deutsche Krankenversicherung AG v OHIM (‘Companyline’)* [2002] ECR I-7561 at para [20], it is not necessary to dwell on the question of how far Section 3(1)(b) may go in preventing registration beyond the scope of section 3(1)(c). It is sufficient to observe that a sign may be:

(1) distinctive for the purposes of section 3(1)(b), with the result that it cannot be regarded as descriptive for the purposes of section 3(1)(c) and must be unobjectionable on both bases; or

(2) neither distinctive for the purposes of Section 3(1)(b), nor descriptive for the purposes of Section 3(1)(c), with the result that it must be objectionable on the former but not the latter basis; or

(3) descriptive for the purposes of Section 3(1)(c), with the result that it cannot be regarded as distinctive for the purposes of Section 3(1)(b) and must be objectionable on both bases.

These considerations point to the overall importance of establishing that a sign is free of objection under Section 3(1)(b).”

Section 3(1)(c)

18. A fuller expression of the legal principles involved in an objection under section 3(1)(c) can be stated as follows:

- The words ‘may serve in trade’ include within their scope the possibility of future use even if, at the material date of application, the words or terms intended for protection are not in descriptive use in trade (see, to that effect, CJEU Cases C- 108/97 and C109/97 *Windsurfing Chiemsee Produktions und Vertriebs GmbH v Boots and Segelzubehor Walter Huber and others*;
- As well as the possibility of future use, the fact there is little or no current use of the sign at the date of application is also not determinative in the assessment. The words ‘may serve in trade’ are to be interpreted as meaning, ‘could’ the sign in question serve in trade to designate characteristics of the goods/services, see e.g. BL O/096/11 ‘*Putter Scope*’, a decision of the Appointed Person at para 11;
- There must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the goods or services in question or one of their characteristics, see CJEU judgment C-468/01 P to C-472/01 P, ‘*Tabs*’, para 39, and General Court judgment T-222/02, ‘*Robotunits*’, para 34;
- The assessment of a sign for registrability must be made with reference to each discrete category of goods or services covered by an application for registration, see Case C-239/05 *BVBA Management, Training en Consultancy v Benelux- Merkenbureau* [2007] ECR I-1455 at paras 30 to 38; Case C-282/09 P *CFCMCEE v OHIM* [2010] ECR I-00000 at paras 37 to 44;
- It is also a well-established principle these days that the Registrar’s role is to engage in a full and stringent examination of the facts, underling the Registrar’s frontline role in preventing the granting of undue monopolies, see e.g. CJEU Case C-51/10 P, *Agencja Wydawnicza Technopol sp. z.o.o. v. OHIM* [2011] ECR I-1541.”

THE APPELLANTS'S CRITICISMS

10. The applicant has two main arguments for contending that the Hearing Officer erred.

(1) BEST MANGAL as a composite is not descriptive

11. I can deal with the first of the applicant's criticisms of the Hearing Officer's decision and approach to the evaluation of the mark as a whole quite briefly. The Hearing Officer gave full and well considered reasons for finding that the mark BEST MANGAL was *prima facie* unregistrable in para. [19] of the decision as follows:

“In my opinion, the words ‘BEST MANGAL’ would be perceived by the relevant consumer (the general public in this case) as a laudatory designation of quality and type of cuisine on offer. I should say that I assume the relevant public is the general public at large, based on the services being non-specialist, provision of food and drink, such as that type of service provided by restaurants. The examiner said in the original examination report that ‘mangal’ is a type of Middle Eastern cuisine. Whilst there may be regional or national variants, it is generally understood to denote, e.g. meats or vegetables cooked on a barbeque. By ‘regional or national variants’, I recognise that the word ‘mangal’ may be nuanced in different areas or regions in order to describe, in effect, the same type of cooking. But these differing regional nuances do nothing to detract from the underlying descriptive message; it is the same type of cuisine. By way of further explanation and in support of this, I have annexed a WIKIPEDIA explanation of the word ‘mangal’. In this particular case, the word ‘mangal’ is the Turkish word for this type of cuisine, which as I have said, would be available throughout the Middle East, and including former Soviet Union countries. I should also say that the word ‘mangal’ does not appear then, to refer to a specific type of barbecue, but rather, to a type or style of cuisine, although the meaning of the word may be more expansive than that. That is to say, especially to those brought up with this cuisine, the word ‘mangal’ may also have wider connotations, relating to the manner in which the food is eaten, namely that, usually, of a social gathering of friends or family. However, even accepting the wider meaning of the word, it would still be my contention that the word would be understood descriptively and therefore could very plausibly designate a characteristic of the services. It was expressly not contended by Dr Spencer, for example, that for the bulk of people in the UK, the word ‘mangal’ would not mean anything at all. Had that been contended, and for the benefit of any doubt, I would have rejected that contention on the basis that those, at the very least, of Middle Eastern origin or having other connections with the area (not an insubstantial number in the UK) would inevitably have known the meaning of the word, and in such a case there is a clear need to keep the word free for others to use.”

12. The applicant contends that the Hearing Officer was wrong to hold that the mark was not inherently distinctive and that the Hearing Officer failed to give due weight to the fact that MANGAL was a non-dictionary word with no meaning in the English language which would have no descriptive meaning to the average consumer and that BEST MANGAL comprises an unusual combination of elements.

13. I am quite unpersuaded by this argument. It is common ground that “mangal” means a type of barbecue cuisine in Turkish. It is the kind of cuisine offered at the applicant’s restaurants. The applicant’s representative rightly accepted, in argument, that any Turkish person would understand the term “mangal” to mean a kind of barbecue or cuisine and that the term was “extremely descriptive, if you apply it to food”. I do not consider that the term “BEST” added to that reduces its descriptiveness. If anything, it increases the likelihood that the composite would be regarded as a descriptor preceded by a laudatory term. This is a case of a concatenation of two highly descriptive terms with no element of distinctiveness arising as a result.

14. The applicant suggests that it is the public in this country that should be considered and not the public in a country far removed from the UK. That is correct in principle but does not assist the argument. The Registrar was entitled to take account of the fact that there is a significant Turkish and Middle Eastern community in the UK to whom the term is likely to be wholly descriptive and of the fact that members of this community and others are likely to want to use the term to describe cuisine of this kind in future, regardless of where they may come from.

15. I have no hesitation in rejecting the argument advanced by the applicant that no account should be taken of the potential future use of the term “MANGAL” by others. To the contrary, EU law requires potential as well as actual descriptive use to be taken into account in evaluating a case under section 3 of the Act. This argument therefore seems to me as misguided as saying that because initially the words “tandoori” or “stollen” may initially have had no meaning to the majority of English speakers, they should be regarded as distinctive. I also do not think there is a material distinction to be made here with respect

to the objection under heads (b) and (c) of the sub-section and I am un-persuaded that citation of other different marks (such as THE CLAY OVEN) registered in different circumstances assists the applicant's argument.

16. I therefore reject this ground of appeal.

(2) Acquired distinctiveness in a local area

17. The second argument is more substantial and amounts to a criticism of the Hearing Officer's approach to evaluation of acquired distinctiveness, and, in particular, acquired distinctiveness in a local area.

Sections 3 and 13 of the Act

18. The proviso to Section 3 (1) of the Act allows for applications to overcome any objections raised under parts (b), (c) or (d) of this Section, if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it. The Act also allows for applications to be registered subject to a limitation or disclaimer by section 13 which provides:

“(1) An applicant for registration of a trade mark, or the proprietor of a registered trade mark, may—
(a) disclaim any right to the exclusive use of any specified element of the trade mark, or
(b) agree that the rights conferred by the registration shall be subject to a specified territorial or other limitation;
and where the registration of a trade mark is subject to a disclaimer or limitation, the rights conferred by section 9 (rights conferred by registered trade mark) are restricted accordingly.”

The Hearing Officer's reasoning

19. The Hearing Officer said as follows on the issue of acquired distinctiveness (omitting case references and footnotes):

“Acquired distinctiveness

23. The legal principles behind acquired distinctiveness can be stated as follows:

- Mere evidence of use, even if substantial, does not make the case for acquired distinctiveness;
- A significant proportion of the relevant consumers need to be educated that the words have acquired distinctiveness;

- If, to a real or hypothetical individual, a word or mark is ambiguous in the sense that it may be distinctive or descriptive then it cannot comply with the requirements of the Act for it will not provide the necessary distinction or guarantee;
- It follows that, with regard to the acquisition of distinctive character through use, the identification by the relevant class of persons of the product or service as originating from a given undertaking must be as a result of the use of the mark as a trade mark. The expression ‘use of the mark as a trade mark’ in section 3 refers solely to use of the mark for the purposes of the identification, by the relevant class of person, of the product as originating from a given undertaking;
- The mark must have acquired distinctiveness through use throughout the territory of the UK (Europolis);
- In assessing whether a trade mark has acquired a distinctive character the competent authority must make an overall assessment of the relevant evidence, which in addition to the nature of the mark may include (i) the market share held by goods bearing the mark, (ii) how intensive, geographically widespread and long-standing the use of the mark has been, (iii) the amount invested by the proprietor in promoting the mark, (iv) the proportion of the relevant class of persons who, because of the mark, identify the goods or services as emanating from the proprietor, (v) evidence from trade and professional associations and (vi) (where the competent authority has particular difficulty in assessing the distinctive character) an opinion poll. If the relevant class of persons, or at least a significant proportion of them, identifies goods or services as originating from a particular undertaking because of the trade mark, it has acquired a distinctive character;
- The position must be assessed at the date of application, being 13 July 2012.

Application of the principles

24. Since the words BEST MANGAL have not acquired distinctiveness ‘throughout the UK’ this application cannot be said to have met the above requirements, irrespective of any assessment as to the other criteria above; the geographical limitation does not cure the problem either. I will, though, make some additional, purely explanatory comments to those already made in correspondence in this regard.

25. Firstly, I have looked carefully at the Appointed Person’s reasons for rejecting *The Journal* case on the offer of a geographical limitation. It is very true that the Appointed Person drew a distinction between goods and services in his analysis. But, in relation to his key reasons for rejecting geographical limitation, being: the registration of a national right; the fact that granting such a right should only be justified where the public interest no longer applies and the absence, in such a case, of the Directive making express or even implied provision for honest concurrent use; all these other reasons make no distinction between goods and services.

26. Secondly, I note, in this specific case, that the distinction drawn by the Appointed Person between goods and services is, in any event, blurred in this case

somewhat by the fact the geographical limitation is to Greater London. Goods are said, by the Appointed Person, to move around the country, in contrast to services, which may be apt to serve a particular locality. But, to what extent can Greater London be said to be such an area where, in large measure, the area is serviced by commuters from a considerable distance away? Goods move, as the Appointed Person says, but so too, do people. This case would inevitably raise then, the inherent difficulty in assessing what exact constituency, in terms of numbers of people, would constitute a significant proportion of relevant consumers for the purposes of assessing acquired distinctiveness - residents of Greater London, or both residents and commuters?

27. Thirdly, I did not understand Dr Spencer to be contending that the Greater London area would, on its own, have enough residents and/or commuters to comprise the requisite significant proportion of relevant consumers in the UK. Had he done so, and for the avoidance of any doubt, I would have rejected that contention. Accepting that Greater London is very densely populated, the relevant consumers in this case (the specification being unlimited) must comprise virtually the whole of the general public in the UK. Against that overall figure, the population of Greater London, even including commuters, cannot be said to represent a significant proportion of all relevant UK consumers.

28. For the reasons given, I do not believe this case gives me any clear opportunity to depart from the rationale in *The Journal* by accepting that a geographical limitation overcomes the section 3(1) objections.”

20. The Hearing Officer accordingly rejected the contention that the mark had acquired distinctive character.

21. The applicant contends on this appeal that the Hearing Officer erred in finding that the trade mark applied for had not acquired a distinctive character through use in that (i) he did not properly approach the identification of the relevant territory for the application (the Greater London area) (ii) wrongly applied the law as set out in the *EUROPOLIS* case and other authorities in that he gave incorrect consideration to the principles relating to the assessment of distinctiveness where a part of the United Kingdom is concerned (iii) wrongly assessed the evidence of distinctiveness. I have in the above distilled the arguments advanced in the applicant’s skeleton, grounds of appeal and oral argument under these heads and deal with them in turn.

(i) Approach to distinctiveness in a limited part of the UK

22. The applicant contends that, where it is prepared to limit the mark to a geographical area, it is only necessary and appropriate to consider the issue of distinctiveness with respect to that limited territory and that the approach of considering distinctiveness more broadly (for the whole of the UK first) and then considering whether the territory for which protection is sought forms a substantial part is unnecessary and inappropriate.

23. The Hearing Officer considered the issue in the passage I have set out and as I read the decision as a whole and with the passages taken in context he concluded that acquired distinctiveness had not been established in the manner required by the law. I cannot find fault with that approach. In so far as it is contended that the Hearing Officer should only have evaluated acquired distinctiveness in the Greater London area, in the light of the proffered limitation, in my judgment, that would be contrary to the approach taken by the CJEU and by the UK courts and tribunals. This can be seen from consideration of the next of the applicant's arguments concerning the impact of the *EUROPOLIS* case and I do not think that this head of argument is really separable from that point.

(ii) *EUROPOLIS*

24. In *Bovemij Verzekeringen NV v Benelux-Merkenbureau (EUROPOLIS)* Case C-363/99 [\[2006\] ECR I-7605](#) the ECJ was concerned with the mark *EUROPOLIS* which would not mean the same to Dutch or Flemish speakers on the one hand and French speakers on the other hand. The ECJ held that the entire relevant linguistic territory must be taken into account in determining distinctiveness. It said at [23]:

“....Article 3(3) of the Directive must be interpreted as meaning that the registration of a trade mark can be allowed on the basis of that provision only if it is proven that that trade mark has acquired distinctive character through use throughout the territory of the Member State or, in the case of Benelux, throughout the part of the territory of Benelux in which there exists a ground for refusal.”

25. As the High Court noted in the *Just Employment* case (*Bignell (t/a Just Employment (a firm)) v Just Employment Law Ltd.* [2007] EWHC 2203 (Ch)), the earlier *OPTIONS* case, *Ford Motor Company v OHIM* [\[2000\] ECR II-1925](#) was to similar effect. There, the CFI held at [24] - [29]:

“24. Consequently, in order to be accepted for registration, a sign must possess a distinctive character throughout the Community. That requirement, enabling consumers to distinguish the goods or services of one undertaking from those of other undertakings in accordance with Article 4 of Regulation No 40/94, is essential for that sign to be able to exercise the function of a Community trade mark in economic life.

25. The principle of the unitary character of the Community trade mark is expressly applied in Article 7(2) of Regulation No 40/94 which provides that a trade mark is not to be registered notwithstanding that the grounds of non-registrability [laid down in Article 7(1)] obtain in only part of the Community.

26. Article 7(3) of Regulation No 40/94 must be read in the light of that principle.

27. On that basis, in order to have the registration of a trade mark accepted under Article 7(3) of Regulation No 40/94, the distinctive character acquired through the use of that trade mark must be demonstrated in the substantial part of the Community where it was devoid of any such character under Article 7(1)(b), (c) and (d) of that regulation.

28. In the present case, the applicant has not disputed the lack of distinctiveness of the word *OPTIONS* in the French language. Nor has it claimed that the trade mark *OPTIONS* has been used in such a way that it has acquired a distinctive character in a substantial part of the Community, in this case in France.

29. In those circumstances, the Office cannot be criticised for having refused registration of the word *OPTIONS* as a Community trade mark.”

26. In *Just Employment*, Robert Englehart QC also observed that: “As a matter of first principle I would think that one must have regard to the whole of the United Kingdom. This is because a registered trade mark confers a monopoly for the whole country”.

27. In *THE JOURNAL*, BL O-273-08, referred to by the Hearing Officer, the Appointed Person considered referring a point to the CJEU on the issue of whether it was permissible to claim acquired distinctiveness amongst a geographically restricted class of consumers, if the market for the product or service in question was limited to that locality or region. The Appointed Person there said:

“I think it is possible that different considerations may apply in the case of a service which is normally provided to a local clientele, such as hair dressing, than to goods.”

28. He would have referred a point to the CJEU but for the applicant’s opposition and went on to give his own view in paras. [22]-[27] of his decision as follows.

“22. Given the applicant’s opposition to a reference, however, I shall give my own answer to the question. In absence of further guidance from the Court of Justice, I

consider that it is not possible to overcome an objection under section 3(1)(b), (c) or (d) of the 1994 Act by demonstrating that the mark applied for has acquired a distinctive character within a particular locality or region. The Court of Justice's first ruling in *EUROPOLIS* appears to be quite unequivocal on this point: "registration of a trade mark can be allowed on the basis of [Article 3(3) of the Directive] only if it is proven that that trade mark has acquired distinctive character through use throughout the part of the territory of the Member State ... where there exists a ground for refusal". Moreover, its reasoning is that the mark must be free from objection throughout the Member State in question. At least in the case of goods, I do not think that it makes any difference if the market for the goods is confined to a particular locality or region, for the following reasons.

23. First, a registered trade mark is a unitary national right. It confers a monopoly throughout the Member State in question. It follows that it must be valid throughout that state and not just in part of it.

24. Secondly, as the Court of Justice pointed out in *EUROPOLIS*, Article 3(3) of the Directive is an exception to Article 3(1)(b),(c) and (d) and must be interpreted accordingly. Article 3(1)(b), (c) and (d) provide objections to registration of trade marks grounded in public policy. Thus Article 3(1)(c) serves the public interest that descriptive signs or indications may be freely used by all: see e.g. Case C-363/99 *Koninklijke KPN Nederland NV v Benelux- Merkenbureau* [2004] ECR I-1619 at [54]-[55]. It follows that Article 3(3) should only "trump" an objection under Article 3(1)(b), (c) or (d) when that public interest no longer applies because the mark has in fact become distinctive throughout the relevant territory.

25. Thirdly, goods may easily circulate outside a particular locality or region, and so may their consumers. Taking the hurling sticks example, London has a substantial population of consumers who are Irish or of Irish descent. I would not be surprised to find that some of them play hurling occasionally. Someone might decide that it was worth their while to set up a small business making and selling hurling sticks in London. Why should not such a person use a descriptive term for hurling sticks without fear of infringement of a United Kingdom registered mark even if it happens to be distinctive in Northern Ireland? It is no answer to say, as the applicant's attorney did, that such a person would have a defence under section 11(1)(b) of the 1994 Act: see Case C-104/01 *Libertel Group BV v Benelux-Merkenbureau* [2003] ECR I-3793 at [57]-[59].

26. Fourthly, the Directive does not expressly contemplate registration of trade marks on the basis of honest concurrent use. While this may perhaps be the effect of the provisions of the Directive in certain circumstances, in the present case it seems unlikely that someone who used one of the marks in issue for similar magazines in a different region, say Cornwall, would succeed in obtaining concurrent registration if the present application were to be accepted. Although the goods would not be identical if specified as "lifestyle regional magazines containing information about and relevant to Cornwall", they would clearly be similar. Unless experience showed to the contrary, one would anticipate a likelihood of confusion, since a consumer who moved from East Yorkshire to Cornwall would be likely to think that the magazines were published by the same

or economically-linked undertakings. But in that case the applicant would acquire a national monopoly on the strength of purely local distinctiveness.

27. Accordingly, I conclude that the marks sought to be registered have not acquired a distinctive character through use, since the applicant's evidence only shows use of them in East Yorkshire."

29. With respect to Mr Richard Arnold QC, as he then was, I agree with this conclusion and his reasoning. Moreover, a contrary interpretation of the Directive would give rise to the prospect of a proliferation of "micro-trade marks" circumscribed by geographical limitation or disclaimer and which were only validated (by proof of distinctiveness) in limited, and possibly uncertain, geographical territories. In my judgment, had the EU and UK legislature intended the scheme of trade mark registration to provide for such, the Directive and the Act would have been different.

30. The approach taken by the Appointed Person in *THE JOURNAL* is also consistent with the approach taken by the relevant Registrar's guidance which has been in place for some time. As the Appointed Person noted in *THE JOURNAL* at para. [16]

"16. The Registrar considers that *EUROPOLIS* establishes that "it is not possible to register a trade mark on the basis of distinctiveness acquired on a local or regional basis", and that this cannot be circumvented by means of a geographical limitation under section 13(1)(b) of the 1994 Act: see paragraph 45.9 of the Work Manual as amended by Practice Amendment Notice 6/07."

31. Finally, in *THE JOURNAL*, the Appointed Person noted that the applicant in that case had not sought to argue that it was possible to obtain and justify a more limited mark by way of a geographical limitation. The applicant in that case accepted that, where a ground of objection such as descriptiveness exists throughout a particular linguistic area of the Member State in which the trade mark is sought to be registered, then *prima facie* acquired distinctiveness must be demonstrated throughout that linguistic area. The applicant in that case also contended a mark which was otherwise objectionable could not be registered simply on the basis of local acquired distinctiveness. Nor could this be achieved by means of a direct geographical limitation.

32. It is evident from the extract I have cited above that the Hearing Officer in the present case followed the guidance in *EUROPOLIS* as interpreted in *THE JOURNAL* and

other cases. His approach was supported by the CJEU, by domestic decisions and the practice of the Registry.

33. The applicant contends that this case is unlike *EUROPOLIS* and that the Hearing Officer ought to have followed a different approach. Although it is true that the facts and the markets for the products the subject of application were different in the respective cases, I do not accept that that would have been appropriate in a case of this kind to take a different approach. Although the applicant submitted that, in other cases, the approach taken in those cases was not treated as a bar to registration (the applicant referred to the first instance decision of the Registrar in “*SCOTLAND’S ANIMAL WELFARE CHARITY*” trade mark), there were, in that case, in any event, materially different facts.

34. I am therefore not satisfied that the Hearing Officer made any error of principle in following the guidance in *EUROPOLIS* and *THE JOURNAL* and applying it in this case.

(iii) Evaluation of evidence

35. Finally, the applicant contends that the Hearing Officer, in effect, applied too high a standard for the proof of acquired distinctiveness and that he should have regarded the fact that the applicant’s restaurants were referred to and reviewed by name in journals of wide circulation in London such as Time Out as conclusive of acquired distinctiveness and should have had greater regard to the longevity of use.

36. I am not persuaded by this criticism.

37. First, in making evaluations of acquired distinctiveness where a mark is prima facie descriptive, particular attention must be paid to the requirements of showing that it has become a guarantee of origin.

38. Second, it is not always enough to show that some people use the mark in question in some circumstances to denote a specific source of goods or services. Doubtless, if a fashionable restaurant were to set up in London and call itself “THE BEST

RESTAURANT IN TOWN”, such would be reviewed under that name by those such as Time Out and, in some contexts, such a term would unambiguously identify that establishment. But that would not of itself be sufficient in to establish that the term had acquired distinctive character in the sense required by the Act. That is why the Registrar was, in my view right to express scepticism about the evaluation of acquired distinctiveness in the earlier decisions on this case. The Hearing Officer recorded at para. [10] of the decision:

“I also said in my letter that, notwithstanding that the examiner had acknowledged that the applicant had a ‘reputation’ in London, on reflection, a finding that acquired distinctiveness had been shown in the Greater London area may be generous. As in The Journal (paragraph 28), the only available evidence to support the plea of (limited) acquired distinctiveness is a single witness statement, this time by the Managing Director, and bearing in mind the legal principles set out in cases such as Vibe Technologies Application (BL O/166/08) at paragraph 62 and following, a finding of acquired distinctiveness, even based in the limited area of Greater London, would be generous. I did, however, say in my letter that the evidence on file presents a credible starting point on the question but not necessarily as an overwhelmingly convincing case. For example, there is a lack of market share figures to put the application into context. Nor is it clear just how many readers the publications of TIME OUT and the LONDON EVENING STANDARD have actually reached within the geographically limited area. However, I concluded in my letter that I would not reject this case out of hand on the basis that acquired distinctiveness has not even been shown in Greater London. By this I meant that, should the applicant appeal, there will be inevitable benefit for the Registrar and third parties in terms of having the quandary highlighted in The Journal considered again and determined. There would be a danger that no such consideration would be deemed necessary if either I or an appeal body were to conclude, on the evidence, that there was not even acquired distinctiveness throughout the limited geographical area.”

39. I agree with the Hearing Officer’s reservations. Had I been deciding the matter at first instance, it would have found it difficult, on the evidence, to conclude that distinctiveness had been established for Greater London. That is partly for the reasons given above and with regard to the importance of bearing in mind the difference between evidence showing that the mark *can* be used (or even is used) in certain contexts to distinguish the services of a given trader and establishing that the mark *is* truly distinctive in the sense required by the Act. That is particularly so since there was in evidence in this case references to other restaurants using the term MANGAL which were unconnected

with the applicant. The issue of preserving the term free for use by others was therefore not merely theoretical. However, since it is not necessary for disposition of this appeal to address this issue separately, I am content to assume the correctness of the evaluation and base the reasoning in this appeal on the points above.

40. Third, I have considered the Hearing Officer's evaluation of the evidence again with some care and do not consider that he was at fault.

41. I therefore reject this argument on appeal.

OVERALL CONCLUSION

42. Despite the effective and concise submissions made on behalf of the applicant, the Hearing Officer was right to hold that the requirements for registration of this mark under the Act had not been satisfied. The appeal must be dismissed.

43. I would observe, for completeness, that neither the applicant nor the Registrar (who made brief written observations on this appeal) encouraged a reference to the CJEU and, for the reasons given above, I do not think such would be appropriate in this case in any event. Although the issues raised by the Appointed Person in *THE JOURNAL* may merit consideration on a different occasion, where the facts are different, a reference is not necessary to decide this appeal.

COSTS

44. This is an ex parte appeal and there will be no order as to costs.

DANIEL ALEXANDER QC

Appointed Person

4 May 2016

Representation:

Dr Michael Spencer of Bromhead Johnson for the applicant/appellant