

O-014-17

TRADE MARKS ACT 1994

TRADE MARK APPLICATION No. 3137440

BY HERITAGE PERSONALISED STATIONERY LTD

AND

OPPOSITION No. 406191

BY MR ROB DE LA PORTE

Background and pleadings

1. On 23rd November 2015, Heritage Personalised Stationery Ltd (“the original applicant”) applied to register the trade mark shown below in relation to ‘printed stationery’ in class 16 and ‘stationery printing services’ in class 40.



2. On 8th December 2016, an application was made to record an assignment of the trade mark application dated 1st December 2016 through which the original applicant transferred ownership of the trade mark application to Ms Zoe Ottway (“the new applicant”). The assignment application was signed by Ms Zoe Joseph, who also filed evidence as a Director of the original applicant (see below). I note that Ms Zoe Joseph, Ms Zoe Ottway and the original applicant are recorded as having the same address in Hampshire.

3. The application is opposed by Mr Rob De La Porte (“the opponent”). The opponent is a Director of a printing company called Yellow Barley Ltd. However, the opposition was brought in the name of Mr De La Porte personally.

4. The grounds of opposition are twofold. Firstly, the opponent claims that the application was filed in bad faith. According to the opponent, the applicant threatened him with infringement proceedings on 23rd November 2015 for using the word ‘heritage’ to advertise stationery. The opponent says that he asked the applicant for details of the trade mark registration he was alleged of infringing. He later found out that the opposed trade mark application was filed on the same day as this exchange. The opponent considers that the threat of infringement was unjustified because the applicant had no trade mark registration at the time. Further, he claims that the original applicant falsely represented the mark as being registered, contrary to s.95 of the Trade Marks Act 1994 (“the Act”) and then filed the application to retrospectively cover up what it had done. As the application was made in bad faith, the opponent claims that it should be refused under s.3(6) of the Act.

5. Secondly, the opponent claims that the word heritage is in general use in the printing industry to designate the kind, quality or other characteristics of the goods/services covered by the application. Consequently, the application should be refused under s.3(1)(c) of the Act.

6. The original applicant filed a counterstatement denying the grounds of opposition. As regards the opponent's claim that the trade mark is descriptive of the registered goods/services, the original applicant claimed to have traded under the mark for 25 years "*without any issues*". As regards the opponent's claim that the application was filed in bad faith, the applicant claimed that it had acquired unregistered rights in the contested mark which had been infringed by the opponent's use of 'heritage stationery' as a Google adword. The applicant says that it was entitled to complain about the opponent passing itself off. The trade mark application was filed to prevent further infringements of the applicant's established rights in the contested mark.

The evidence

7. The opponent's evidence takes the form of a witness statement by Mr De La Porte. The statement is merely a conduit for introducing the 37 attached exhibits as evidence. The first 10 exhibits consist of copies of exchanges between the original applicant and the opponent's company, Yellow Barley Ltd, or between their legal advisors. There is no need to go into this in any detail. It is sufficient to record that it shows that the original applicant complained about the opponent's use of heritage stationery. This appears to have been used as an adword and as the title of the advertisement on Google triggered by hits on that adword. The opponent's advertisement identified its website as www.personalised-stationery.com. The applicant's website appears to be www.heritage-stationery.com. It uses this website to advertises personal stationery.

8. These exchanges led to the applicant threatening to bring proceedings for passing off and the opponent threatening to bring proceedings for relief from the applicant's unjustified threats of (what the opponent perceived to be) trade mark infringement. Nothing seems to have come of any of this.

9. Most of the other exhibits to the opponent's statement consist of extracts from the internet showing third parties using the word heritage in relation to stationery and similar goods. Many of these do not appear to show use of that word in the UK in a relevant descriptive sense in relation to printed stationery or related services. For example, exhibits RDLP11 and 12 show use of the words "*British heritage stationery brand Smythson..*". The word 'heritage' there appears to qualify the brand Smythson rather than the word 'stationery'. Some of the other documents show use of heritage in other places, such as the USA.¹ Others appear to show Heritage being used just as a trade name rather than as a description.² It is not clear what many of the exhibits show because no context is provided, or the nature of the use is ambiguous and appears to relate to goods, such as blank paper, which are not covered by the opposed trade mark application.³

10. The most relevant examples appear to show 'heritage' being used in a descriptive sense, at least in relation to stationery at large. For example:

- Exhibit RDLP13 shows use of 'Heritage Stationery' in relation to notebooks and planners created in collaboration with historic Royal palaces, i.e. a clear reference to the heritage of the goods.
- Exhibit RDLP15 shows use of the words 'A great heritage stationery' in relation to paper on the website of Zazzle.
- Exhibit RDLP18 shows use of 'Dual heritage stationery cards' in relation to cards with a twin geographical theme on the website of Café Press, i.e. an Argentinian/Mexican greeting card.
- Exhibit RDLP27 shows use of 'heritage' in relation to paper on the website of Shepherds.

¹ See exhibits RDLP17, RDLP19, RDLP21, RDLP26, RDLP30, RDLP31.

² See exhibit RDLP 29

³ See exhibits RDLP14, RDLP16, RDLP20, RDLP22, RDLP23, RDLP24, RDLP25 & RDLP34.

- Exhibit RDLP28 shows use of ‘heritage’ on a UK website⁴ in relation to personalised printed orders of service for weddings.
- Exhibit RDLP32 shows use of ‘Heritage Stationery set’ on Tesco’s website in relation to a classic stationery set in a gift box.
- Exhibit RDLP33 shows use of ‘Heritage Lace’ on the website of Vivien B’s Bespoke Occasion Stationery in relation to wedding invitations decorated with lace, which are described as “classic in every way”.

11. Ms Zoe Joseph provided a short witness statement on behalf of the original applicant. I note that she signs it ‘Zoe Anne Joseph (Ottway)’ reinforcing my impression that Zoe Joseph and Zoe Ottway are the same person.

12. Ms Joseph states that “we” have been trading using the logo and name Heritage Personalised Stationery for 25 years. She says that she started trading as a sole trader under the name Heritage Personalised Stationery in 1991. Ms Joseph provides a copy of the sole trader accounts for 1995/6, which show Zoe Ottway trading as Heritage.⁵ I note that sales of goods and work undertaken over a 20 month period ending on 31 October 1996 produced an income of around £15k. So the business was quite small at that time. An extract from Zoe Ottway’s tax return for the year ending 5th April 2000 is also in evidence.⁶ This shows her trading as Heritage Personalised Stationery. The logo covered by the trade mark application was created in 1991. Ms Joseph says that it was first used to advertise Heritage Stationery Birth Announcement Cards in major London maternity hospitals. A copy of such an advertisement is in evidence.⁷ I note that the advertisement encouraged readers to tell others about the stationery because “*we grow our business by word of mouth*”.

13. The original applicant was incorporated on 10th November 2004. Ms Joseph says that since 28th February 2004 to the date of her statement (16th October 2016) over

⁴ The owner of the website is not clear from the page filed as evidence

⁵ See exhibit ZJ2

⁶ See ZL3

⁷ See ZJ4. This appears to date from after 28th February 2000, which is when Ms Joseph says that she acquired the domain name heritage-stationery.com, which is shown on this advertisement.

£400k was spent on advertising Heritage Personalised Stationery through Google Adwords. According to Ms Joseph, the total turnover of Heritage Personalised Stationery to date in relation to bespoke stationery products is around £3m. According to exhibit ZJ7, this represents the turnover of the original applicant between 2004 and 31st March 2016 in relation to stationery. The annual turnover in the years leading up to the date of the trade mark application averaged around £300k per annum.

Representation

14. Neither party is legally represented. No hearing was requested. This decision is therefore based on the law and the evidence and written submissions of the parties.

The bad faith ground

15. Section 3(6) of the Act states:

“(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

16. The law in relation to section 3(6) of the Act (“bad faith”) was summarised by Arnold J. in *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited*.⁸ I have this in mind but there is no need to set out the case law here because the opponent’s bad faith ground has no prospect of success. The bad faith claim is really a complaint about the applicant making allegedly unjustified threats of infringement against the opponent. In reality the applicant appears to have been threatening to sue the opponent for passing off, but used the wrong word in its letter. However, whether that is right or wrong makes no difference to these proceedings. This is because the threat and the trade mark application are separate matters. The threat might be relevant to whether the application was filed in bad faith claim if the application was merely a vehicle to create a retrospective legal justification for the threat. However, given that the applicant has been trading under the mark for 25 years this is scarcely credible. I accept the applicant’s evidence that the application

⁸ [2012] EWHC 1929 (Ch)

was filed to help it protect its perceived reputation under the contested mark. The applicant was perfectly entitled to seek better protection for its mark by applying to register it. The fact that this may have been triggered by the opponent's use of Heritage Stationery makes no difference to this (although it entirely explains the timing of the application).

17. I therefore reject the opponent's claim that the application was filed in bad faith.

The descriptiveness objection

18. Section 3(1)(c) of the Act is as follows.

“3(1) The following shall not be registered –

- (a) signs which do not satisfy the requirements of section 1(1),
- (b) trade marks which are devoid of any distinctive character,
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above 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.”

19. The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was summarised as follows by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc.*⁹

⁹ [2012] EWHC 3074 (Ch)

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94 . Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia , *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44 , paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley* , paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94 , it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie* , paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland* , paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94 , the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to

believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56).”

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97].”

20. The opposition focusses on the descriptive nature of the words ‘Heritage’ and ‘personalised stationery’ in relation to printed stationery and printed stationery services. The words ‘personalised stationery’ are self evidently 100% descriptive of a kind of printed stationery and/or printed stationery services. Therefore, the real question is whether Heritage is also descriptive.

21. The opponent provided a copy of an entry in a dictionary which states that ‘heritage’ may be used as a modifier noun. One of the examples given is “*denoting a traditional brand or product regarded as emblematic of fine craftsmanship*”. It is not clear from the evidence which dictionary this extract was taken from, but I note that there is an identical entry in the online Oxford Dictionary. The majority of examples associated with this entry in the dictionary relate to heritage brands rather than heritage products. Third party use of Heritage just as a trade mark does not support the opponent’s claim that ‘heritage’ is descriptive. However, there are also a couple of examples of apparently descriptive use, i.e. “*You can go from ballistic nylon..... to our heritage lines of tweed and belting leather*” and “*quarried stone is used mainly for the production of roof tiles and other heritage products rather than garden rockery stone or sand and gravel.*”

22. If ‘heritage’ is a word that can be used to describe traditional products emblematic of fine craftsmanship, then it appears to be an indication which may serve, in trade, to designate the kind and/or quality of printed stationery and, by

extension, services for producing such products. As the case law makes clear, provided that consumers would recognise this meaning, it is not necessary for the opponent to show that the word heritage is already in use in this way in relation to the goods/services covered by the application. Further, if the word has a recognisable descriptive meaning in relation to the goods/services at issue, it makes no difference that the word also has other non-descriptive meanings.

23. The examples of use put forward by the opponent do not show that the word heritage was already in descriptive use, in the relevant trade in the UK, at the date that the application was filed (“the relevant date”). Apart from anything else, the evidence is undated and was probably obtained from the internet after the opposition was filed, i.e. after the relevant date. However, the examples re-produced in paragraph 10 above are sufficient to support the dictionary meaning suggested in paragraph 21 above.

24. So far as I can see, the applicant has not directly disputed this meaning. Rather, the applicant’s evidence is directed to its long established use of the contested mark prior to the date of the application.

25. Taking all these matters into account, I find that, at the relevant date, average consumers of printed stationery and services for producing such products, would have regarded the word ‘heritage’ to designate a kind and/or quality of the goods/services, as the opponent contends. By extension, the words ‘heritage personalised stationery’ as a whole would, *prima facie*, have been understood to designate traditional personalised stationery, emblematic of fine craftsmanship.

26. The contested mark does not only consist of these words. It also includes the stylised crown device shown in paragraph 1 above. In *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc*,¹⁰ Arnold J. held that a descriptive word with a minor figurative embellishment was unregistrable under the provision in the Community Trade Mark Regulation which is equivalent (and identical to) to s.3(1)(c) of the Act.

¹⁰ [2013] F.S.R. 29

The judge said that:

“116. Taking all of the evidence into account, I conclude that the CTM is precluded from registration by art.7(1)(c) in relation to the services in issue because NOW would be understood by the average consumer as a description of a characteristic of the service, namely the instant, immediate nature of the service. The figurative elements of the CTM do not affect this conclusion. In the alternative, if the inclusion of the figurative elements means that the CTM does not consist exclusively of the unregistrable word NOW, I consider that the CTM is devoid of distinctive character and thus unregistrable by virtue of art.7(1)(b) .

117. I would comment that it appears to me that PCCW only succeeded in obtaining registration of the CTM because it included figurative elements. Yet PCCW is seeking to enforce the CTM against signs which do not include the figurative elements or anything like them. That was an entirely foreseeable consequence of permitting registration of the CTM. Trade mark registries should be astute to this consequence of registering descriptive marks under the cover of a figurative figleaf of distinctiveness, and refuse registration of such marks in the first place.”

27. The mark at issue in that case looked like this.



28. The EU courts appear to have taken a similar approach to the construction and scope of article 7(1)(c) of the Community (now EU) Trade Mark Regulation. In *Smarter Travel Media LLC v EU IPO*¹¹, the General Court found that the mark shown below was not registrable.

¹¹ Case T-291/15

This was because the words ‘smarter travel’ were descriptive of services relating to the travel sector. The blue figurative element was considered to be a representation of a stylised suitcase, which reinforced the descriptive meaning of the word element. Thus the mark as a whole was excluded from registration under article 7(1)(c).

29. A crown alludes to tradition and enduring qualities. Therefore, in this case the inclusion of a crown based device element would, if anything, reinforce the descriptive meaning of the words ‘Heritage personalised stationery’ as designating traditional personalised stationery, emblematic of fine craftsmanship.

30. For these reasons, I find that the application is excluded from *prima facie* registration by s.3(1)(c) of the Act.

31. That is not the end of the matter because the applicant claims that the contested mark has been used for 25 years. Therefore the question arises whether “...before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

32. The applicant has not pleaded such a case expressly. However, given that the applicant is acting without legal representation and has provided evidence of use of the contested mark, I consider it right to consider whether the proviso to s.3(1)(c) applies.

33. The onus is on the applicant to show that the mark had acquired a distinctive character by the relevant date.¹²

34. The Court of Justice of the European Union (“CJEU”) provided guidance in *Windsurfing Chiemsee*¹³ about the correct approach with regard to the assessment of the acquisition of distinctive character through use. The guidance is as follows:

¹² *Oberbank AG & Banco Santander SA and Another v Deutscher Sparkassen- und Giroverband eV* (CJEU, joined cases C-217 and 218/13)

“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.

53. As regards the method to be used to assess the distinctive character of a mark in respect of which registration is applied for, Community law does not preclude the competent authority, where it has particular difficulty in that connection, from having recourse, under the conditions laid down by its own national law, to an opinion poll as guidance for its judgment (see, to that effect, Case C-210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 37).”

35. The contested mark, or at least the words ‘Heritage personalised stationery’, appear to have been in use for many years prior to the relevant date. Further, given that these words make up the original applicant’s corporate name, and appear to have also been used as its trading name, there does not appear to be any reason to doubt that the words have been used to distinguish the commercial origin of the

¹³ Joined cases C-108 & C-109/97

applicant's goods (as opposed to being used purely for descriptive purposes).¹⁴ The original applicant appears to have promoted the mark mainly through the use of Google adwords. It has spent a significant sum of money on such promotion and established a small internet-based business in the field of personalised bespoke stationery. There is no information about the size of this market, or the original applicant's share of it, but I think it likely that it is a relatively niche market, albeit one of significant size. Given the length of time that the applicants have traded in this market under the name Heritage Personalised Stationery, and the amount of money spent attracting searchers to the original applicant's website, I think it more likely than not that the original applicant's name was distinctive to a significant proportion of UK consumers in this market at the relevant date. And as the name is the dominant element of the contested mark, it follows that the same applies to the contested mark as a whole.

36. I acknowledge that the applicant's evidence could have been stronger. For example, it could have provided copies of invoices showing sales to individual customers, references to the applicant's name/mark in trade publications and provided information showing the volume of traffic to its website. The absence of evidence of this kind has made this a difficult decision. I nevertheless find that, on the balance of probabilities, the mark had acquired the necessary distinctive character through use prior to the relevant date in relation to *personalised printed stationery* and *personalised stationery printing services*.

37. The application currently covers descriptions of goods/services which are likely to be wider than the original applicant's reputation. Consequently, the opposition under s.3(1)(c) succeeds in relation to the published list of goods/services. However, I find that the trade mark qualifies for registration under the proviso to s.3(1) of the Act in relation to the more precise descriptions of goods/services stated in the

¹⁴ The original applicant's website is Heritage Stationery. However, a domain name is not necessarily the trading name. In any event, as the only possible distinctive element of Heritage personalised stationery is the word 'heritage', the difference between the trading name and the domain name is immaterial.

previous paragraph. The opposition therefore fails in so far as this narrower list of goods/services is concerned.¹⁵

38. In reaching this conclusion I have given due consideration to the policy behind s.3(1)(c) of the Act, namely that signs which describe characteristics of the goods/services should not normally be registered so that they “*may be freely used by all traders offering such goods or services*”. However, as is clear from the wording of s.3(1) itself, this policy is not an absolute block on the registration of descriptive signs as trade marks. Where the descriptive sign has been shown to have acquired a secondary meaning as a trade mark through use, it may be registered. This does not mean that third parties are then prohibited from making any descriptive use of the sign. Section 11(2)(b) of the Act permits descriptive use of signs corresponding to registered trade marks, provided that such use is in accordance with honest practices. Further, the case law of the CJEU indicates that the use of the trade marks of third parties as adwords (i.e. words that operate only in search software in order to trigger advertisements from competitors of the trade mark proprietor) does not necessarily constitute an infringement of the rights of the trade mark proprietor. Such use cannot be restrained (even if the operative adword is identical to the registered trade mark of a third party) provided that the advertisements triggered by ‘hits’ on the adword enable consumers to distinguish, without difficulty, advertisements placed by third parties from commercial offers made by the trade mark proprietor himself, or by undertakings commercially connected with the proprietor.

39. In order to fall within these legal defences and exceptions third parties must respect their obligation to act with due regard to the legitimate interests of the trade mark proprietor. In particular, third parties must take steps to avoid, or at least minimise, any likelihood of confusion.¹⁶ For example, an advertisement for ‘Yellow Barley’s heritage range of stationery’ would be much less likely to infringe the

¹⁵ Tribunal Practice Notice 1/2011 explains why an application should not be refused in total where the mark is registrable for some of the goods/services listed in the application. The addition of the qualification “personalised” adequately identifies the goods/services for which the mark is distinctive without the need to rewrite the description of the goods/services.

¹⁶ See *Hotel Cipriani v Cipriani (Grosvenor Street)* [2009] RPC 9, *Supreme Petfoods Limited v Henry Bell & Co (Grantham) Limited* EWHC [2015] 256 (Ch) and *Marks and Spencer v Interflora*, Case C-323/09, paragraphs 44-66 and 91

registration of the contested mark than an advertisement for 'Heritage Stationery' (assuming that 'heritage' is being used to indicate the traditional character and quality of the goods, i.e. as a description).

Outcome

40. The opposition partly succeeds, but it fails in relation to *Personalised printed stationery* in class 16 and *Personalised stationery printing services* in class 40. Subject to appeal, the trade mark will be registered for these goods and services.

Costs

41. Both sides have achieved a measure of success. I therefore direct that each side should bear its own costs.

Dated this 18th Day of January 2017

A handwritten signature in black ink, appearing to be 'AJ' followed by a large, stylized flourish.

Allan James
For the Registrar