

BL O/443/17

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK REGISTRATION 3092907
BY LUCKIES OF LONDON LIMITED IN RESPECT OF:

SCRATCH MAP

AND

APPLICATION FOR INVALIDATION UNDER NO. 501267
BY S.MILE DIREKT AG

BACKGROUND

1. Registration 3092907 stands in the name of Luckies of London Limited (the proprietor). It has a filing date of 5 February 2015, was published on 20 February 2015 and was entered in the register on 1 May 2015. The goods for which the mark is registered are as follows:

Class 16

Paper and cardboard; printed matter; photographs; stationery; instructional and teaching material (except apparatus); works of art of paper and cardboard; stickers; posters; maps.

Class 28

Toys, games, playthings, and novelties.

2. On 22 July 2016, s.mile Direkt AG (the applicant) filed an application for invalidation in which it seeks invalidation of the registration under the provisions of section 47 of the Trade Marks Act 1994 (the Act). It does so on grounds under sections 3(1)(b), 3(1)(c) and 3(1)(d) of the Act.

3. The applicant outlines its objections as follows:

“3(1)(b)

16. Considering that the Contested Mark is composed of generic words that form a meaningful expression to describe the specified goods, it follows that the Contested Mark is devoid of distinctive character. The Contested Mark is neither fanciful nor merely allusive, and does not reach the threshold of distinctiveness required to distinguish the goods of one commercial undertaking from another...

3(1)(c)

15. Scratch Maps, as offered by the Proprietor and a wide number of its competitors, feature a layer of foil that can be scratched off as countries are discovered and visited during holidays or business travels creating a personalised record of the individual’s or family’s travel adventures. In light

of the meaning of “scratch” and “map” in the English language, the average consumer will understand the Contested Mark precisely in the described manner. “Scratch map” is a meaningful expression, i.e. regarding the removal of something from a diagrammatical representation of an area of land or sea by pulling a sharp implement over it. In respect of the goods specified, this meaningful expression directly describes the kind, method of use and intended purpose of the goods, namely, a diagrammatical representation of an area of land (a “MAP”) which has a removable layer which can be removed (“SCRATCH”) by pulling a sharp implement over it to reveal the images beneath. The Contested Mark clearly falls within the scope of s3(1)(c) TMA 1994, as it directly describes the goods, and should be invalidated on this basis...

3(1)(d)

20. The average consumer, when encountering the Contested Mark, will perceive it as describing the goods. It is clear from the evidence adduced above that the Contested Mark has become customary in the English language for describing a map which is topped with a foil surface which can be scratched off, with a coin or other sharp implement, for the consumer to record those countries which it has visited.

21. It is therefore imperative that the term ‘SCRATCH MAP’ remains at the disposal of traders of this class of goods to adequately describe said goods. By granting a monopoly right over the term ‘SCRATCH MAP, the IPO has afforded the Proprietor a means by which it can unfairly stifle honest competition and prevent use of a term which is common parlance in respect of the relevant goods.”

4. The proprietor filed a counterstatement in which it denies all of the grounds raised by the applicant.

5. Both parties filed evidence and written submissions. Neither requested a hearing. Consequently, I make this decision following careful consideration of the material before me.

The applicant's evidence

Witness statement by Harry Rowe and exhibits HR1-HR8

6. Mr Rowe is an attorney at Squire Patton Boggs (UK) LLP (the applicant's representative). His witness statement is dated 21 July 2016.

7. A number of dictionary definitions for the words 'scratch' and 'map' have been provided. I will refer to them as necessary later in the decision.¹

8. A print from waybackmachine dated 25 August 2014 is taken from www.mapsinternational.co.uk and shows a product named 'Scratch World Map'.²

9. A print from waybackmachine dated 26 November 2011 is taken from www.red5.co.uk and describes a product called 'Scratch Map'.³ The image of the product is missing from the print. The product is described in the following terms:

"Scratch Map is brilliant! It's the perfect way to show off where you've been travelling while livening up your wall with a colourful word map... You get a unique, slick looking gold wall map to start with, and the idea is that you then scratch off all the places you've visited to reveal a whole new world below, featuring colour and geographical detail."

10. Exhibit HR5 is made up of a number of exhibits numbered HR5.1 to HR5.6. The first is dated 28 June 2016 and shows what Mr Howe describes as the result of an amazon search for 'scratch maps'. The product which has been returned from that search is described as 'Travelogue Travel Journal with Maps & Atlas to record your Travel Vacation'. In the product listing are the words, 'package includes 64 page log and 8 scratch maps'. At the bottom of the page under the heading 'customers who bought this item also bought' two products are listed which contain the words 'scratch map'. They are 'Luckies Travel Scratch Map' and 'Luckies Scratch Map Personalised World Map'.

¹ See exhibits HR1 and HR2

² See exhibit HR3.

³ See exhibit HR4

11. HR5.2 was taken from Amazon UK on 15 July 2016. The term in the search box at the top of the page is 'Luckies of London travelogue'. The returned product has the same title and 'includes 8 miniature scratch maps'.

12. Mr Rowe says of these exhibits:

"6...Please note the date at which the goods were first available, 12 January 2015. The Proprietor appears to also sell this product with its 'LUCKIES OF LONDON' trade mark affixed...However, we have found instances of the same product being sold which does not bear the 'LUCKIES OF LONDON' trade mark which suggests that the goods originate from the same source and are not a product manufactured by the Proprietor. As such, there are a number of entities using the term 'scratch maps', as well as the proprietor to describe this product."

13. HR6 is an internet print from www.waterstones.com. It is not dated, though Mr Rowe states that this page was accessed on 28 June 2016. The product is described as 'Scratch World Map' and is shown as 'not available'.

14. HR7 is taken from www.itunes.apple.com, dated 27 June 2016. The printed page refers to an iTunes preview for 'iScratchMap: scratch the map of your travels'. It is available to buy or download.

15. HR8 is an article taken from thenextweb.com. It was written by Nick Summers and is dated 1 April 2013. The title of the article is 'Quadstreaker is a scratch map for iPhone that records where you've been with brightly coloured squares.'

The registered proprietor's evidence

Witness statement by Jim Cox and exhibits JC1-JC34.9

16. Mr Cox is the founder and Managing Director of the proprietor. His statement is dated 17 November 2016. Mr Cox states that the product sold as SCRATCH MAP was

launched in 2010⁴ and that as far as he is aware it was the first of its kind on the market, anywhere in the world.

17. Mr Cox provides figures for the number of units sold between 2010 and 2015. The totals for the UK are as follows:⁵

Year	Units sold in the UK
2010	25188
2011	89341
2012	147554
2013	166260
2014	202352
2015	185313
Total:	816008

18. At paragraph 15 of his statement Mr Cox adds that the total number of units sold in the UK in 2016, prior to the date upon which the cancellation action was filed (21 July 2016), was 113,100.

19. Mr Cox states that since 2010 fourteen further products have been added to the SCRATCH MAP line which now includes:

“SCRATCH MAP Original
SCRATCH MAP Deluxe
SCRATCH MAP Capitals
SCRATCH MAP Oceans
SCRATCH MAP Travel
SCRATCH MAP Travel Deluxe
SCRATCH MAP UK & Ireland
SCRATCH MAP Europe
SCRATCH MAP France

⁴ It first featured in a 2009 brochure under the sign MY MAP.

⁵ Exhibit JC2

SCRATCH MAP USA
SCRATCH MAP USA Travel
Gourmet SCRATCH MAP
SCRATCH MAP Hello
SCRATCH MAP Clear”

20. He says of the products:

“The average cost of a SCRATCH MAP product is £8+ VAT (wholesale) with recommended retail price ranging from £14.00 (for the travel versions) to £24.00 (for the original sized products).”

21. A number of pricelists are provided for the years 2010-2013.⁶ They each show a range of products along with a wholesale price and a recommended retail price. Each is headed ‘LUCKIES’ or ‘LUCKIES OF LONDON’. The product in each case is listed as ‘SCRATCH MAP – Personalised World Map’.

22. Mr Cox states that the proprietor operates four websites which are accessible to the public. These are:

www.luckies.co.uk
www.scratchmap.co.uk
www.scratchmap.org
www.scratchmap.com

23. There are also two trade websites:

www.luckiesoflondon.co.uk
www.luckiesoflondon.com

24. He states that www.luckies.co.uk is the proprietor’s main website and that SCRATCH MAP products have featured on the front page of this site since at least

⁶ See exhibit JC3

November 2010. Exhibit JC5 is described as examples of the website pages. The first was accessed using waybackmachine and is dated 20 November 2010. The top left of the page features a star with the word 'Luckies' contained within it. The fourth item on the page is an indistinct image of a map. The words below the picture read:

*"Scratch Map Personalised...
Scratchable personalised..."*

25. The second part of the exhibit was printed on 3 March 2016. The first page features the following at the top left corner:



26. At the bottom of the second page is the heading 'SCRATCH MAPS (GIFTS/OCCASION/BIRTHDAY-GIFTS).' Three pictures of maps are presented below the heading. A black line on the print dissects the text but it appears to read, 'SCRATCH MAP® Original', below the first picture, 'SCRATCH MAP® Travel' below the second and 'Adventure Map' below the third. The text on the third page of the exhibit includes the following:

"Our bestselling Scratch Maps (gifts/scratch-maps) make the perfect birthday gift for anyone obsessed with travel, or an inspiring graduation gift for someone about to start their next adventure. Luckies Scratch Maps also come in travel sizes, compact enough to make cool Christmas stocking fillers..."

27. The last page of the exhibit shows several very small photographs of maps. I cannot read the text below the images.

28. Exhibits JC6-9 relate to website analysis for the various websites referred to above. With regard to website access from the UK the following figures are provided:

Website	No. of sessions	No. of visits
Luckies.co.uk	60,405	114,996
Scratchmap.co.uk	12,997	27,389
Scratchmap.org	37,233	173,560
Scratchmap.com	800	5,647

29. Mr Cox concludes from this evidence:

“31. From the data collected, a general pattern has emerged, where at least 25% of visits to www.luckies.co.uk and www.scratchmap.com are made by repeat visitors, and 75% by new visitors.

32. With regard to our other websites www.scratchmap.co.uk and www.scratchmap.org, around 20% of visitors are repeat visitors and 80% are new visitors.

33. These figures indicate that interest in our SCRATCH MAP products are continually growing and new customers are continually being introduced to and becoming aware of our products.”

30. Exhibit JC9 is described as a Google search for SCRATCH MAP. Given that such searches use parameters based on an individual’s search history and preferences, it is unlikely to be helpful in indicating the results that would be obtained by the average consumer and I do not propose to list the results here.

31. Mr Cox provides a number of witness statements from ‘professionals in the home and giftware industry.’⁷

32. Michael Sweeny’s statement⁸ is dated 8 November 2016. He has held the positions of Chairman of The British Giftware Association, Vice President and

⁷ See exhibits JC10-JC12

⁸ Exhibit JC10

President of the British Allied Trades Federation and is the Managing Director of Supernicepeople Ltd. It is not clear whether Mr Sweeney's company is a competitor of Mr Cox.

33. The last two paragraphs of his statement read as follows:

"6. My perception of the 'SCRATCH MAP' map, and that of others I have discussed the product with in my roles in the Giftware fraternity, is that with the feature of its removable foil top coat it is a unique product that has been developed and marketed by Luckies of London very successfully.

7. Luckies is recognised as the supplier of maps bearing the mark 'SCRATCH MAP' and their position with regard to the market for personalised maps in the UK could be described as dominant and substantial."

34. Daniel Black's witness statement⁹ is dated 4 December 2015. His business Black+Blum Ltd is a competitor of the proprietor and he sits on the Advisory Boards of the Design Council and ACID. He states:

"I can remember when I first saw Luckies exhibit the very first 'SCRATCH MAP' at the Autumn fair in 2009. I can remember it, because I was struck by what an original concept it was, having never seen anything like it before. I have been exhibiting at trade fairs since 2000 and within the gift sector, have a good knowledge of what products are available and this is why I believe I am able to say that the idea was original and not something I have seen before. I would definitely associate any 'SCRATCH MAP' with Luckies and believe that they were the first company to bring the concept to market and make it a recognisable range and brand."

⁹ Exhibit JC11

35. Elodie Deviras's witness statement¹⁰ is dated 15 December 2015 and is not signed. She is the co-owner and Managing Director of DOIYCUSTOM SL based in Barcelona. Mr Cox states that her products are often sold in the UK through the same retail channels as the proprietor's own SCRATCH MAP products.

36. Ms Deviras states:

"I can guarantee Luckies of London Ltd is very well known for being the originator, designer and worldwide wholesaler of the mark SCRATCH MAP and its use in respect of maps with a removable foil top coat. I can remember perfectly seeing on different trade shows I have visited since that date the original 'SCRATCH MAP' map on Luckies booth and website. I have a strong knowledge of the sector since 10 years and I can guarantee that there was no similar product available before Luckies' SCRATCH MAP product launch."

38. Mr Cox states that the SCRATCH MAP products can be bought online and instore at various well known retailers including John Lewis, Tesco.com, Waterstones, Oliver Bonas, Urban Outfitters and Menkind.

39. Exhibit JC14 is a witness statement by Rebecca Hadley, a former Buying Manager for Urban Outfitters. She purchased SCRATCH MAP for Urban Outfitters in Europe in 2011. She states:

"It became a key product for the business and the Urban Outfitters customer. The company is still re-ordering the product today. Having worked in the retail industry for 10 years and travelled the world, visiting numerous trade fairs and factories, I have a strong knowledge of products in the market. I truly believe that the SCRATCH MAP originated with Luckies. The product can be seen in shops around the world and Luckies have made this an easily recognizable brand."

¹⁰ Exhibit JC12

40. With regard to online retailers, Mr Cox provides the number of reviews the SCRATCH MAP products have received on a number of websites.

41. Notonthehighstreet.com has stocked SCRATCH MAP products since 5 December 2011. It has more than 39 million unique visitors annually. The SCRATCH MAP Original product has had nearly 1000 reviews on that site.

42. SCRATCH MAP products are also sold through Amazon.co.uk. SCRATCH MAP Deluxe is listed as the No.1 best seller in 'maps'. It has over 200 reviews. SCRATCH MAP Travel is listed at No.2 and has over 180 reviews. The SCRATCH MAP Original product is No. 3 and has over 500 reviews.

43. Iwantoneofthose.com stocks SCRATCH MAP products. SCRATCH MAP Original has 230 reviews. SCRATCH MAP Travel edition has had 92 reviews and SCRATCH MAP UK edition has had 30.

44. SCRATCH MAP Original has also had 92 reviews on Findmeagift.co.uk.

45. Mr Cox states that SCRATCH MAP products are also sold in gift shops and online at the Natural History Museum in London, the Baltic Centre for Contemporary Art in Newcastle, The British Library in London, The Design Museum in London, Ripley's Believe It Or Not in London, Camera Obscura in Edinburgh, the National Maritime Museum in London and the South Bank Centre in London.

46. Mr Cox concludes:

"69. Their presence on these high profile websites and in popular high street stores and visitor attractions, alongside the high number of positive reviews of our products, indicate that SCRATCH MAP products are exposed to and known by a wide-ranging and large number of consumers in the UK."

47. With regard to promotion of the proprietor's goods, Mr Cox states:

“70. Due to the online nature of our business, we have not undertaken a ‘traditional’ marketing campaign...

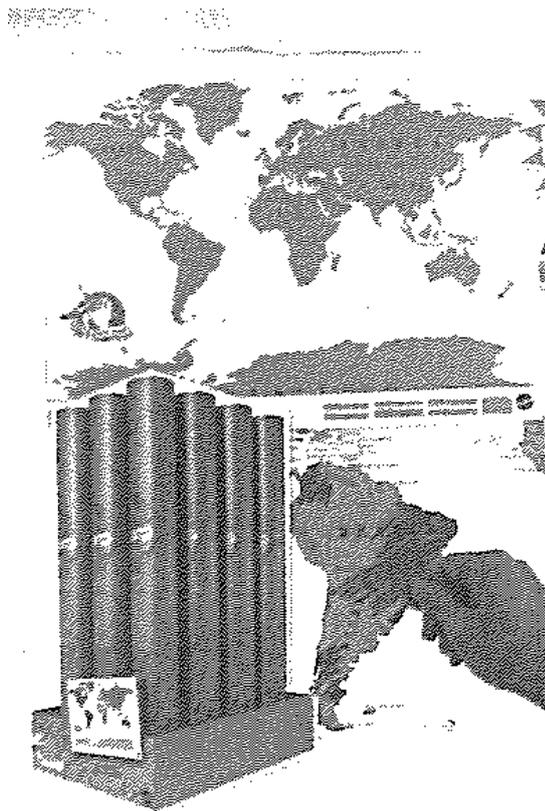
71. Instead, sales grew as people found out about our products either by seeing them in high street stores, reading reviews of them in the press, on blogs or on travel websites, or seeing them on someone else’s wall.”

48. He adds that the proprietor is active in promoting its products using social media and regularly features SCRATCH MAP products on its Facebook page, ‘Luckies of London’ Twitter account, ‘@Luckiesoflondon’, and on Instagram using its profile, ‘Luckies of London’. He concludes that the retailers and distributors of the proprietor’s products run their own advertising and marketing campaigns which bring attention to the proprietor’s goods.

49. Exhibit JC23 comprises examples of trade brochures. The first is dated Spring/Summer 2010. The front page features the following in the top right and bottom left corners:



50. The next page features the SCRATCH MAP product and includes the following images:



Scratchmap is a super high quality, super-massive wall map, featuring a gold top foil layer. Why? Because you get a unique, slick looking gold wall map to start with, and then scratch off all the places you've visited to reveal a whole new world below, featuring colour and geographical detail. The result is a totally unique and personalised world map. What a great gift. Comes packaged in a slick tube and POS.
TRADE £6.00 | PACK 12

51. The product description reads:

“Scratch Map is a super high quality, super-massive wall map. Featuring a gold top foil layer. Why? Because you get a slick looking gold wall map to start with, and then scratch off all the places you’ve visited to reveal a whole new world below, featuring colour and geographical detail. The result is a totally unique and personalised world map.”

52. The next catalogue is titled ‘LUCKIES GIFT CATALOGUE 2011 MID YEAR UPDATE’. It features the same logo at the bottom left corner of the front page. Page 15 of that catalogue shows the following:



Following what can only be described as the 'enormous' success of the original Scratch Map wall poster, we are now proud to bring you Scratch Map Travel Edition. This smaller (42x29.7cm) version makes the perfect present for any globetrotter, being designed to fit (protected by it's durable tube) into a rucksack or hand luggage. Travels and experiences can therefore be recorded 'on the go', as they happen. The rear of the map features a travel log where experiences, notes, thoughts and routes can be noted, providing an authentic document of the travel experience.

53. At paragraph 76 of his statement Mr Cox identifies a number of trade shows attended by the proprietor:

54. Spring Fair International at the NEC – Birmingham. Attended in 2012, 2013, 2014, 50. 2015 and 2016.¹¹ Largest exhibition of its sort in the UK. 64,058 visitors to the fair in 2015.

55. Autumn Fair International at the NEC – Birmingham. Attended in 2011, 2013, 2014, 2015 and 2016.¹² A must-attend event for UK and International buyers ahead of Christmas, Valentine's Day, Easter, Mother's Day and Spring. 1400 exhibitors.

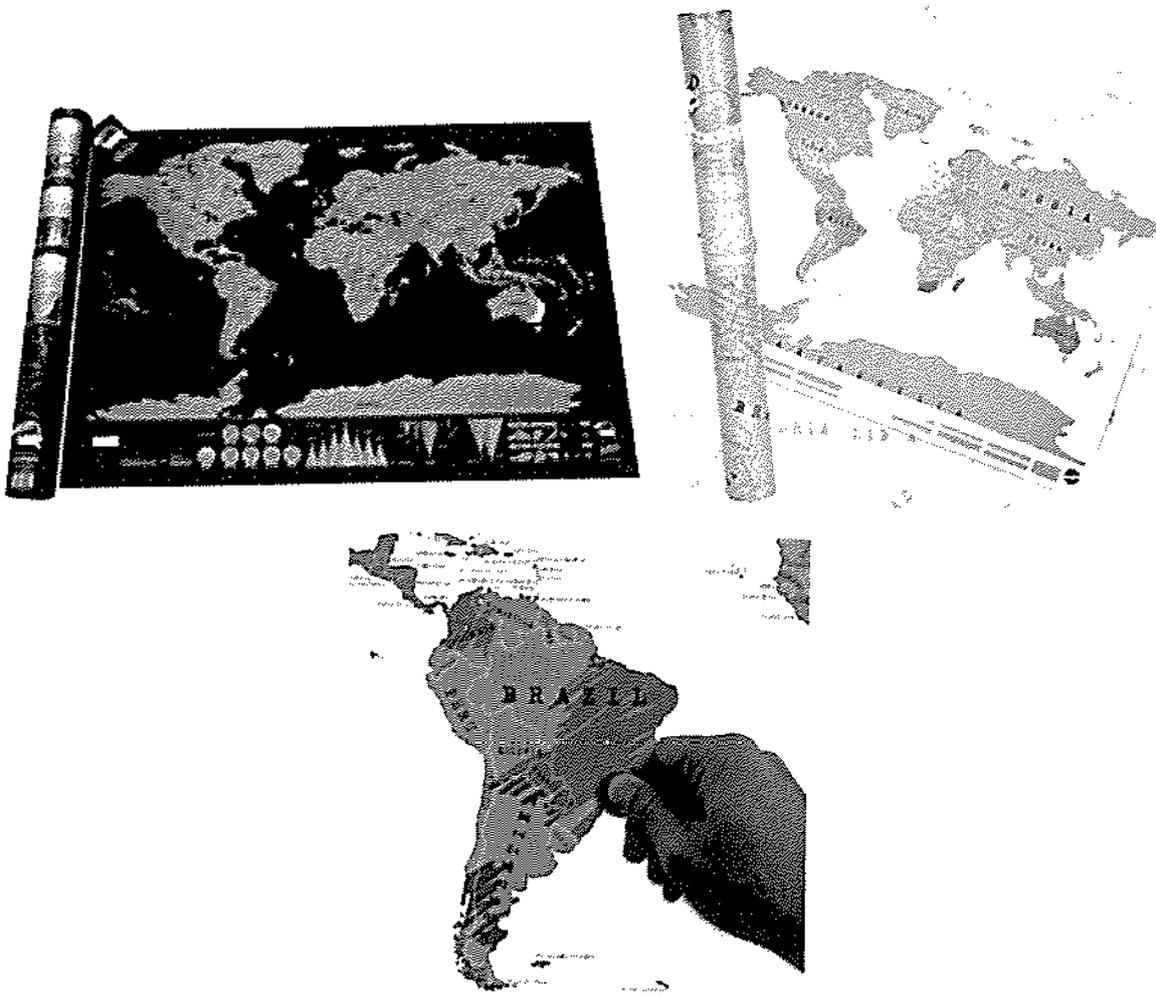
¹¹ Exhibit JC24 comprises invoices for attendance and stand space in the trade halls for 'Luckies Of London' for these years.

¹² Exhibit JC25 comprises invoices for attendance and stand space in the trade halls for 'Luckies Of London' for these years.

56. The London Stationery Show at the Business Design Centre. Attended in 2014, 2015 and 2016.¹³ Leading UK exhibition for stationery, part of National Stationery Week.

57. Harrogate Home and Gift Show – Harrogate. Attended in 2014, 2015 and 2016.¹⁴ 10,000 visitors to the show in 2015 and more than 800 exhibitors.

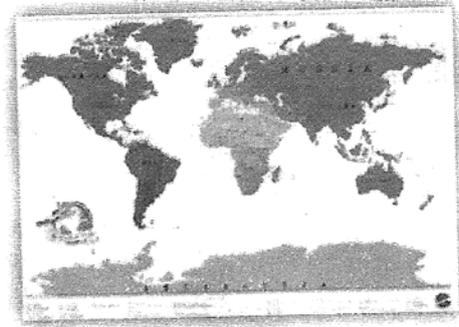
58. Exhibit JC28 comprises examples of the proprietor's goods featured in the Guardian website Christmas gift ideas December 2010, 2011 and 2013. The following three product images are shown:



¹³ Exhibit JC26 comprises invoices for attendance and stand space in the trade halls for 'Luckies Of London' for these years.

¹⁴ Exhibit JC27 comprises invoices for attendance and stand space in the trade halls for 'Luckies Of London' for these years.

59. Exhibit JC29 is described as 'our SCRATCH MAP product featured in UK magazine Stylist on 12 January 2011. It does not feature 'SCRATCH MAP'. It is shown as follows:



ROUND THE WORLD

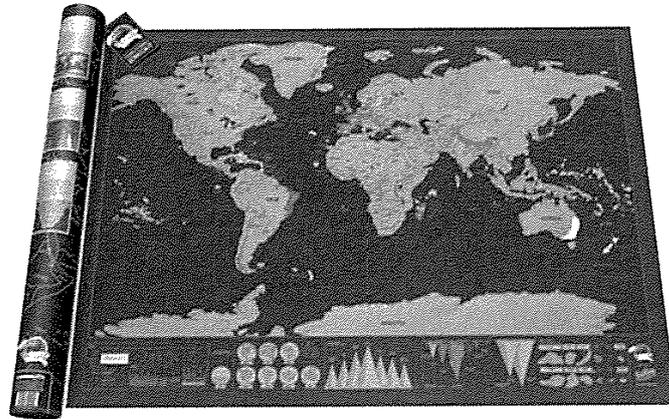
Scratch off your global travels on this 82x58cm wall-hanging world map (£14.95, luckies.co.uk).

60. JC30 is taken from the Mail Online website on 24 November 2012. The product is described as 'Luckies World Scratch Map' and appears with a number of other products, as follows:



CLOCKWISE: LUCKIES WORLD SCRATCH MAP: £14.95, luckies.co.uk; THE STIG: THE UNTOLD STORY: £9, asda.com; 100 PLACES YOU WILL NEVER VISIT: THE WORLD'S MOST SECRET LOCATIONS by Daniel Smith: £7.50, amazon.co.uk; BIKE! A TRIBUTE TO THE GREATEST CYCLING DESIGNERS by Moore & Benson: £14.25, amazon.co.uk

61. JC31 is taken from the Huffington Post and is dated 12 June 2014. It is a feature about gifts for Dad's on Father's Day. The third suggestion is 'Luckies Scratch Map' which appears as follows:



62. Exhibit JC32 is taken from www.telegraph.co.uk. The second page features the following:



63. Underneath this image are the words:

"WIN £250 to spend at www.luckies.co.uk AND a Framed Scratch Map® Deluxe worth £94.95".

64. Mr Cox states that this giveaway occurred on 2 December 2015.

65. The following page of the same exhibit is also taken from the Telegraph website on 1 November 2016. In an article titled 'The best Christmas gifts for people who love to travel', the product is shown as above at paragraph 61.

66. Mr Cox states that the proprietor's products have been featured on the websites of UK travel agencies. He provides pages from the following:

Toucan Travel – 28 April 2015

'6 ways to keep travel memories safe'. The sixth item listed is 'The Scratch Map', available from scratchmap.co.uk

Essential Travel – 29 November 2012

'Win these travel gifts', the third one listed is 'The Scratch Map from Luckies'.

Thomson – 31 August 2015

'How to beat the holiday blues'. The third suggestion is '...get your hands on a scratch map...'

First Choice/Blog – 6 June 2014

'Top 10 Father's Day Gifts He'll Actually Want'. The seventh item listed is 'Gourmet Scratch Map'.

Thomson – 30 November 2015

'Travel Gifts / The Best Christmas Ideas For Globetrotters'. Third on the list is, 'show off your well-travelled self with this Scratch Map.'

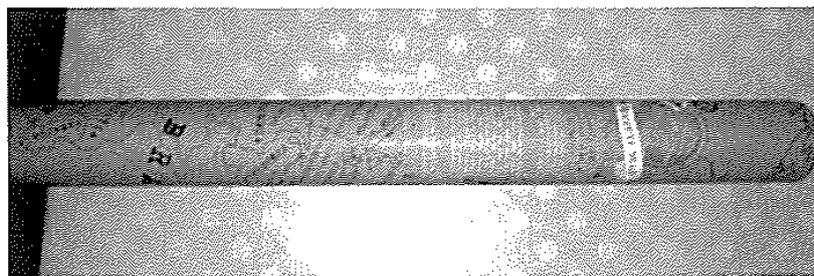
67. Exhibits JC34.1-JC34.9 are described by Mr Cox as "Examples of other online references to the mark and our SCRATCH MAP products..." The 57 examples are dated between 16 August 2010 and 22 October 2016. The exhibits include online reviews and product tests. For example, the first of these is dated 16 August 2010 and is a review of Scratch Map by Joanna Goddard for 'A Cup Of Jo'. The product is shown as follows:



68. The author comments:

“How cool is this Scratch Map? You scratch off the places you’ve been with a penny!”

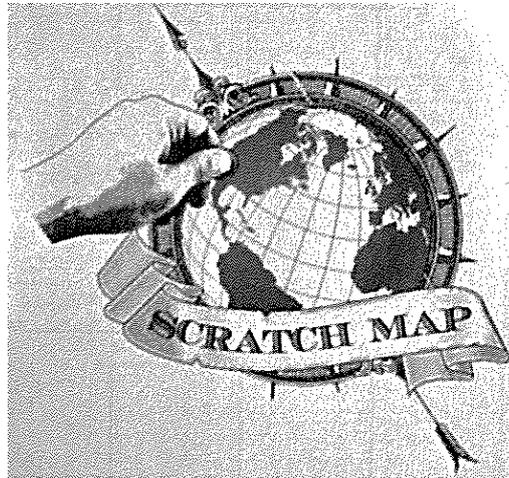
69. The review on ‘Madhouse Family Reviews’ is dated 1 October 2012. It shows a close up of what I believe to be the tube in which the product is supplied.



70. The author of the review states:

“You get a lovely big map that the older Madhouse mini-testers were already looking at with great interest, oohing and aahing at the gold covering. When I told them it was like a scratch card and that we could scratch off the places that we’ve been to, they got even more excited.”

71. An article dated 5 August 2013 is titled, 'Retomag proudly presents: The Scratch Map'. It is taken from <http://retomag.com>. The following image is used to illustrate the article:



72. The article from Architects Corner is dated 10 August 2013 and is titled 'Scratch-Off Maps Let You Display Every Place You've Been'. The first paragraph reads:

"Travel is one of the great pleasures of life, and people who have been places are usually proud of their journeys. The Scratch Map from Luckies of U.K. lets you keep a visual and ever-changing record of everywhere you've been."

73. On www.artefactshop.com on 23 August 2013 the site put the following picture online. The supporting text reads:

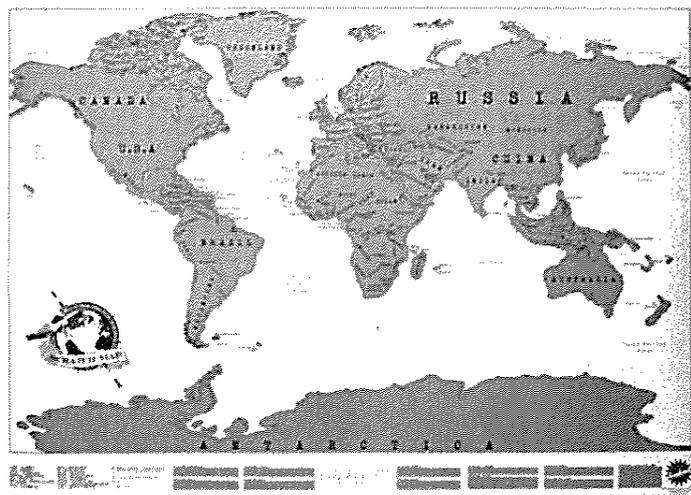
"This month, we received something wonderful in our subscription from Not Another Bill – it's a Scratch Map of the world: What's a scratch map, you ask? Well, put it this way...they give you a wee coin to go with it..."

74. The exhibit dated 4 November 2013 relates to 'Gourmet Scratch Map'. The article features on DesignTAXI.com and is titled, 'Scratchable Typographic Food Map Lists Food You Need To Try In Europe.' The product is shown as follows:

76. An article from doubletakesblog.com features the same Gourmet Scratch Map. It is dated 12 November 2013 and features the same image as the previous article. The text says:

“Remember the absolutely awesome Scratch Map? The folks at Luckies of London are at it again with their latest version of the map.”

77. The exhibit also includes an article from www.chronicallyvintage.com, titled ‘Vintage Holiday Shopping Guide’. It is dated 8 December 2013. The following image is shown on the second page:



78. Under this image the text reads:

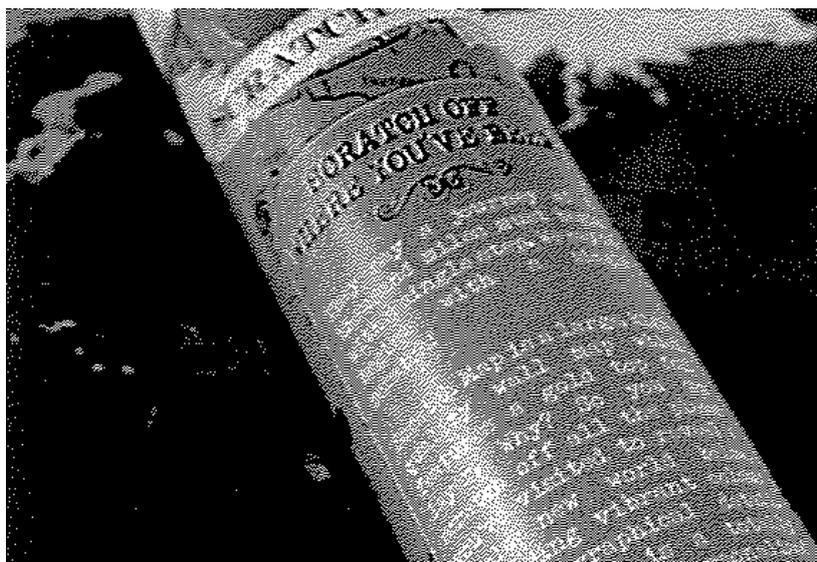
“...Taking the time honoured lottery ticket concept to a new level, the Scratch Map utilises scratch off technology to enable users to customize their own map by removing the coating over different locations”.

79. An article from www.almostnerdy.com dated 8 December 2013 is titled, ‘How to Turn Your Child Nerdy This Christmas’. Under the sub-heading ‘Nerdy gifts for your child: Teach them about the world’, is the following:

“Having a sweet Star Wars poster on your wall is cool and all, but what does it teach you? To not go over to the Dark Side? We need to do better for your growing nerd. I propose you check out the Scratch Map series where

you scratch off locations you've been to, like a lottery ticket except all you win is adventure."

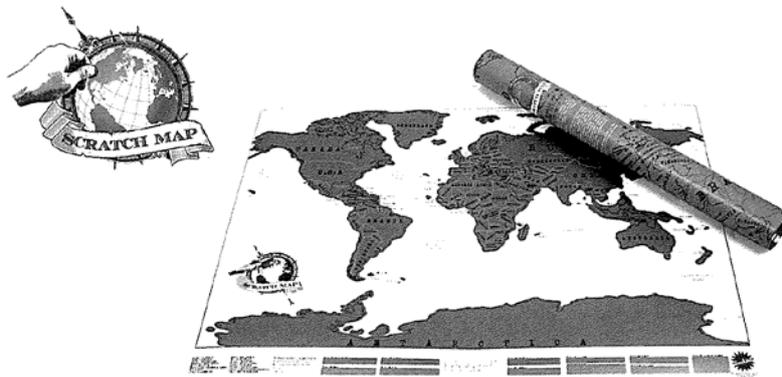
80. Two different views of the product and its packaging are shown in article from www.dreamsthatglitterxoxo.com, which appears to date from January 2014. The first line reads, "I want to dedicate this post to my favourite ever Christmas present: a scratch map!"



81. Mr Cox provides an article from www.pacsafe.com/blog, titled '8 Gift Ideas for the Traveller in Your Life'. It is dated 18 April 2014. Under the heading, 'Where in the World', the article reads as follows:

"A gift that your traveller can leave at home is a scratch map: a personalised map of the world which can be scratched off, much like a scratch-and-win lottery ticket, so that your traveller can track where they've been around the world – and plan future getaways".

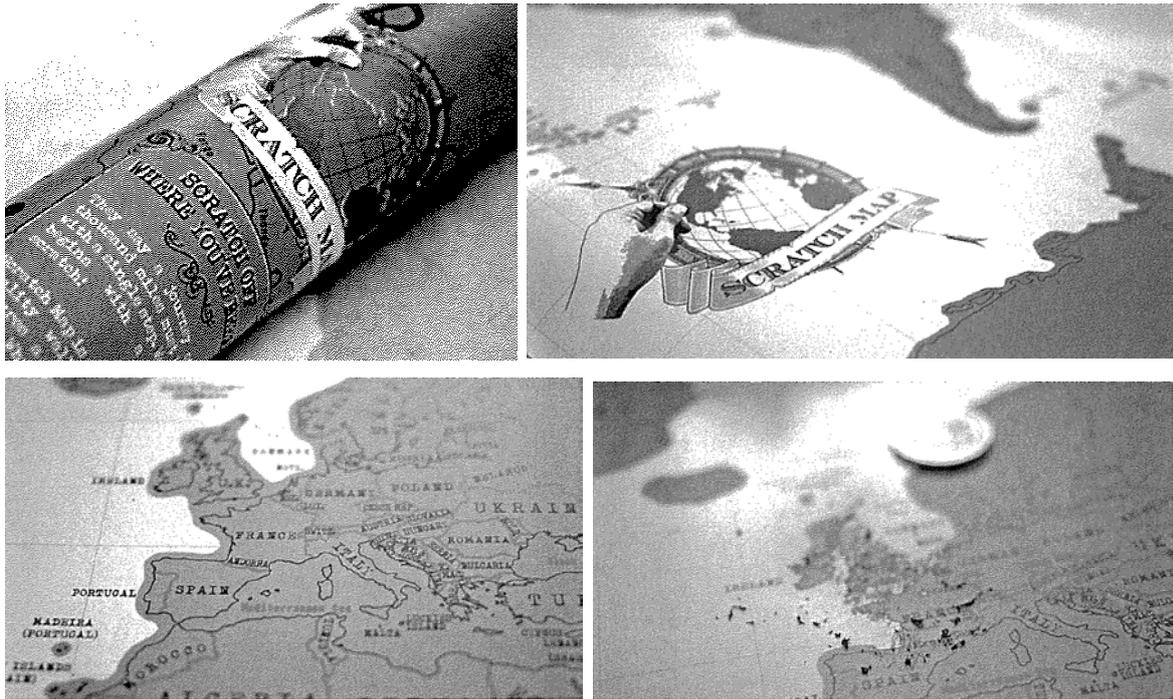
82. The following article from www.prettygreentea.com, dated May 2014, is titled 'MADE IN THE UK: SCRATCH MAP'. The product is shown as follows:



83. Underneath the image are the words, "photo and video taken from the Scratch Map website". The product description reads:

"This fancy poster (if you can call it that) is made from gloss finish paper with a gold foil print. The idea is very simple, just scratch off the places you've visited with a coin. It's just like a scratch card but instead of the potential of a big cash prize, you unlock memories and create a wonderful talking point in your home."

84. An article dated March 2015 from www.lilianlau.com is titled 'So many places...'. The following images are featured in the article



85. Mr Cox concludes:

“82. A large number of the articles in Exhibits JC34.1-JC34.9 consist of independent reviews of products from our SCRATCH MAP range. The reviews are often followed by comments made by readers, relating to their experience or thoughts on our SCRATCH MAP products. This suggests some reinforcement of the mark and product in the mind of consumers and potential consumers.

83. Moreover, these articles feature on a spectrum of websites directed at consumers with an interest in travel, gifts, design, fashion and homewares. This indicates that a wide range of consumers would be familiar with our product and would recognise the mark SCRATCH MAP as an indication of their origin.”

Witness statement by Laura Morrish and exhibits LM1 – LM2

86. Ms Morrish is a trade mark attorney with the proprietor’s representative. Her statement is dated 7 December 2016.

87. Exhibit LM1 is described as an extract from www.notonthehighstreet.com showing the current listing of the Scratch The World product of Maps International. The following image is shown on the first page of the exhibit:



88. The product is described as:

“Brilliant concept map allowing visited destinations to be scratched off, revealing the beautifully styled up-to-date world map underneath.”

89. Exhibit LM2 is described by Ms Morrish as, ‘an invoice from Luckies of London to red5retail.com relating to an order for its SCRATCH MAP and SCRATCH MAP Travel Edition products’. It is dated 14 November 2011. The supplier reference is LUCKIE01 and the invoice contact provided is @luckies.co.uk. The products are listed as ‘Scratch Map’ and ‘Scratch Map Travel Edition’. An extract from the website showing those two products on the red5 website is also provided.

90. The applicant’s evidence in reply takes the form of a witness statement by Christopher Stevens-Smith, a trainee attorney with the applicant’s representative. The witness statement takes the form of submissions. I will refer to it as necessary below along with all other material before me in this case. That concludes my summary of the evidence to the extent that I consider it necessary.

THE DECISION

91. Section 3(1) of the Act reads as follows:

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

(a) ...

(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.”

92. It must be borne in mind that these grounds are independent and have differing general interests. It is possible, for example, for a mark not to fall foul of section 3(1)(c), but still be objectionable under section 3(1)(d) and/or 3(1)(b) of the Act. In *SAT.1 SatellitenFernsehen GmbH v OHIM*¹⁵, the Court of Justice of the European Union ('CJEU') stated that:

“25. Thirdly, it is important to observe that each of the grounds for refusal to register listed in Article 7(1) of the regulation is independent of the others

¹⁵ *Case C-329/02 P*

and requires separate examination. Moreover, it is appropriate to interpret those grounds for refusal in the light of the general interest which underlies each of them. The general interest to be taken into consideration when examining each of those grounds for refusal may or even must reflect different considerations according to the ground for refusal in question (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-0000, paragraphs 45 and 46).”

93. The date at which the proprietor’s trade mark must be assessed is the date of the application for registration, that is, 5 February 2015. I must first make an assessment on the basis of the trade marks’ inherent characteristics, and, if I find the trade mark is open to objection on that basis, I must then determine, whether the trade mark has, in fact, acquired a distinctive character as a result of the use made of it, prior to the date of application for cancellation, namely, 22 July 2016.

The opposition under section 3(1)(c)

94. Section 3(1)(c) of the Act is the equivalent of Article 7(1)(c) of the Community Trade Mark Regulation, the relevant case-law was summarised by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [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]."

95. I bear in mind *Matratzen Concord AG v Hukla Germany SA*,¹⁶ in which the CJEU held that:

¹⁶ Case C-421/04

*“24. In fact, to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say in trade and or amongst average consumers of the said goods or services, reasonably well-informed and reasonably observant and circumspect, in the territory in respect of which registration is applied for (see Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 29; Case C-363/99 *Koninklijke KPNNederland* [2004] ECR I-1619, paragraph 77; and Case C-218/01 *Henkel* [2004] ECR I-1725, paragraph 50).”*

96. I note that at paragraphs 49-51 of his witness statement Mr Cox concludes that as the proprietor’s goods fall into several categories including travel, gifts, homeware and design, the ‘typical consumer’ is difficult to define. I disagree. The relevant public for these goods, which are fairly low cost maps with a scratchable surface, are members of the general public and third party traders who stock the applicant’s goods, both of whom are to be regarded as “reasonably well-informed and reasonably observant and circumspect”.

97. With regard to the objection under this section of the Act, the applicant states:

10. The Contested Mark is registered in relation to ‘paper, cardboard; printed matter; photographs; stationery; instructional and teaching material (except apparatus); works of art of paper and cardboard; stickers; posters’ in Class 16 and ‘toys, games, playthings and novelties’ in Class 28. These are broad terms, many of which encompass maps, including maps with a foil coating. Indeed, it requires no real imagination on the part of the average consumer to draw a direct descriptive link between the contested mark and paper and cardboard, printed matter or novelties by thinking of a ‘map’ that can be ‘scratched’.

11...The low price point of the goods means that the average consumer, during the purchasing process, will pay a lesser degree of attention. As a

result, without further reflection, the average consumer will perceive the sign as directly describing the characteristics of the goods in relation to which it is used, rather than investing the necessary time during the purchasing process to establish that the sign is, as alleged, a designator of trade origin.

12. The Proprietor admits that, ‘the mark SCRATCH MAP might allude to certain properties of these goods (i.e. that their surface is removable)’. The statements that the Proprietor makes as to the Contested Mark being distinctive by virtue of it being ‘grammatically incorrect’ and an ‘unusual combination’ lack any persuasive force. There is nothing inherently distinctive about placing a verb in front of a noun for the purposes of a registered trade mark, nor is there anything inherently distinctive about incorrect grammar.

13. It is clear that the Contested Mark has no innate distinctive quality and that it amounts to a description of the goods in question.”

98. The proprietor submits:

“19. It is highly unlikely that upon seeing the mark SCRATCH MAP a direct link would be created in the mind of the relevant consumer to relevant goods.

20. The two words that make up the mark are not words that would be placed together in everyday language. The use of scratch alongside MAP creates a question mark and sparks a thought process in the mind of the consumer, rather than a direct and descriptive link to the relevant goods. Whilst the mark SCRATCH MAP might allude to certain properties of these goods, it is not a term that is directly descriptive of, or linked to, them.

99. The proprietor also draws my attention to the fact that the applicant has focussed on the individual elements of the proprietor’s mark, namely, SCRATCH and MAP rather than focussing on the mark as a whole. The proprietor concludes:

“23. On this basis, it cannot be claimed that the mark would create a direct and specific link to the relevant goods, as some effort would be required on the part of the consumer to create the link. Overall, an immediate link between the mark and the contested goods has not been proven.

24. The two elements of the mark simply create a whole that is to some extent allusive, but not directly descriptive, of the relevant goods...

25. In this case the unusual nature of the combination of the words SCRATCH and MAP does create an impression sufficiently far removed from that produced by the mere combination of the meaning of these elements. The mark when considered as a whole is more than the sum of its parts.”

100. In support of its point at paragraph 24 that its mark is allusive, rather than descriptive, the proprietor relies on a previous decision of this tribunal in respect of the marks MEDI-MATT and MEDI-FOAM¹⁷ (for mattresses) in which the hearing officer found those marks to be allusive rather than descriptive of the goods at issue. The proprietor's mark is made up of two words which are commonly understood in the English language, namely SCRATCH and MAP which are not abbreviations of the sort at issue in those proceedings. The hearing officer in that case applied the necessary tests applicable to the situation before her and I must do the same.

101. In considering the points put forward by both parties, I bear in mind the decision in *Campina Melkunie BV and Benelux-Merkenbureau*¹⁸, in which the CJEU held that, as a general rule, the mere combination of elements, each of which is descriptive of characteristics of the goods in respect of which registration is sought, itself remains descriptive of those characteristics even if the combination creates a neologism, unless it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements.

¹⁷ *BL O/250/16*

¹⁸ *Case C-265/00*

102. I am also mindful of the decision in *PutterScope*,¹⁹ in which the appointed person held that, though it is necessary for the purpose of explanation to break down the mark into its component parts, one must be aware of the danger that such an iterative approach may be unfair to the applicant. Each individual part of a mark may be non-distinctive, but the sum of the parts may have distinctive character.

103. The question here is whether the mark SCRATCH MAP is a description of the goods or of some characteristic(s) of those goods and, thus, should be kept free for the legitimate use of other traders.

104. The applicant has provided numerous definitions of the two words which make up the mark SCRATCH MAP.²⁰ At paragraph 14 of its statement of grounds it chooses to focus on the following, which I agree are the most relevant definitions in this case:

SCRATCH - Remove (something) from something else by pulling a sharp implement over it.

MAP - A diagrammatic representation of an area of land or sea showing physical features, cities, roads, etc.

105. The applicant concludes:

“Scratch Maps, as offered by the Proprietor and a wide number of its competitors, feature a layer of foil that can be scratched off as countries are discovered and visited during holidays or business travels creating a personalised record of the individual’s or family’s travel adventures. In light of the meaning of “scratch” and “map” in the English language, the average consumer will understand the Contested Mark precisely in the described manner. “Scratch map” is a meaningful expression, i.e. regarding the removal of something from a diagrammatical representation of an area of

¹⁹ *BL O/96/11, paragraph 8*

²⁰ *They have been taken from www.oxforddictionaries.com and have a copyright date of 2016.*

land or sea by pulling a sharp implement over it. In respect of the goods specified, this meaningful expression directly describes the kind, method of use and intended purpose of the goods, namely, a diagrammatical representation of an area of land (a “MAP”) which has a removable layer which can be removed (“SCRATCH”) by pulling a sharp implement over it to reveal the images beneath. The Contested Mark clearly falls within the scope of s3(1)(c) TMA 1994, as it directly describes the goods, and should be invalidated on this basis.”

106. I remind myself that it is not necessary for a sign to already be in descriptive use in order to fall foul of the prohibition in s.3(1)(c): it is sufficient that the mark is capable of being used as a descriptive designation.²¹ There can be no argument that, in relation to various goods in the registration i.e. printed matter, photographs, stationery, instructional and teaching materials, works of art on paper and cardboard, stickers, posters and maps in class 16 and toys, games, playthings and novelties in class 28, which take the form of maps, the word MAP is descriptive. As to the word SCRATCH, the meaning provided by the applicant is given above. I am satisfied that it is a word with which the relevant public would be familiar and find that it will be considered to mean scraping or marking something either with one’s own hand (or more accurately a person’s nails) or with an implement.

107. In its submissions filed in lieu of a hearing, the proprietor submits that maps which have a removable foil surface or other means of indicating places visited are commonly referred to as ‘personalised maps’. Mr Cox concludes that the phrase ‘scratch map’ is not one used by third parties to refer to these goods either individually or as a group.

109. In considering whether the relevant person would understand the mark SCRATCH MAP to refer to goods of the type contained in the proprietor’s specification, I note that in the proprietor’s evidence there are a number of examples of reviews

²¹ See the CJEU’s judgement in case C-191/01P (Doublemint).

where the reviewer is attempting to describe the proprietor's goods and does so by analogy to a lottery scratch card. For example:²²

"...When I told them it was like a scratch card and that we could scratch off the places that we've been to, they got even more excited."

"...What's a scratch map, you ask? Well, put it this way...they give you a wee coin to go with it..."

"...Taking the time honoured lottery ticket concept to a new level, the Scratch Map utilises scratch off technology to enable users to customize their own map by removing the coating over different locations"

"...I propose you check out the Scratch Map series where you scratch off locations you've been to, like a lottery ticket except all you win is adventure."

"...a personalised map of the world which can be scratched off, much like a scratch-and-win lottery ticket..."

"...The idea is very simple, just scratch off the places you've visited with a coin. It's just like a scratch card but instead of the potential of a big cash prize, you unlock memories and create a wonderful talking point in your home."

110. The proprietor's mark is a neologism. In assessing such a newly coined expression I must consider how the mark as a whole will be viewed by the relevant public. Clearly, the product reviewers and traders describing the proprietor's product, in the examples above, view an analogy to a scratch card as an effective way of explaining how the proprietor's product is used. The average consumer is reasonably well informed and circumspect and, according to the evidence filed by the proprietor, likely to be familiar with the term 'scratch card'. When faced with the combination of MAP, which is descriptive and SCRATCH to create the proprietor's mark SCRATCH

²² See reviews at exhibit JC34

MAP, I find that the trade mark would be understood by the public when applied to the goods of the specification as an indication of the function of those goods rather than providing an origin message to the consumer. The combination does not create a mark which is greater than the sum of its parts. The mark describes a map which may be scratched to reveal something underneath. To the extent that any explanation is necessary, it is because of the novelty of the product, not the aptness of the mark to describe it. Consequently, I find that the mark is *prima facie* invalid in respect of the goods in classes 16 and 28 under s.3(1)(c) except paper and cardboard in class 16, for which it is distinctive.²³

The objection under section 3(1)(b)

111. The applicant stated in its submissions filed in lieu of a hearing:

“It is clear that the Contested Mark has no innate distinctive quality and that it amounts to a description of the goods in question. As such, we maintain that the Contested Mark should be invalidated on one or both of the grounds set out under s.3(1)(b) TMA 1994 and s.3(1)(c) TMA 1994.”

112. The proprietor did not offer any further submissions in respect of this ground. In its submission filed in lieu of a hearing it stated:

“...since the mark is not directly descriptive of the goods against which the objection is raised, it did not fall within the scope of Section 3(1)(c) or Section 3(1)(b) at the filing date.”

113. No other basis has been identified for finding that SCRATCH MAP is incapable of identifying the commercial source of the goods covered by the registration over and above the reasons provided by both sides in support of their positions under the 3(1)(c) ground. The opposition under s.3(1)(b) cannot therefore succeed to any greater extent than the opposition under s.3(1)(c) and I find that the mark is *prima facie* invalid in

²³ Paper and cardboard are not ‘paper products’ but are simply paper and cardboard. ‘SCRATCH MAP’ has no descriptive meaning for these goods.

respect of the goods in classes 16 and 28 of the registration identified in paragraph 110 above.

The objection under 3(1)(d)

114. The general principles with regard to this section of the Act are provided in *Telefon & Buch Verlagsgesellschaft mbH v OHIM*:²⁴

“49. Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma* (BSS) [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public’s perception of the mark (BSS, paragraph 37).

50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (BSS, paragraph 38).

51. Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade

²⁴ *T-322/03 (GC)*

in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and BSS, paragraph 39).

52. Finally, signs or indications constituting a trade mark which have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not therefore fulfil the essential function of a trade mark (see, by analogy, *Merz & Krell*, paragraph 37, and BSS, paragraph 40).”

115. I bear in mind that there are two ways in which the test under section 3(1)(d) may be satisfied. These were outlined by the Appointed Person in STASH²⁵ in which it was stated:

“29...[The Appellant] submits that the concluding words of section 3(1)(d) qualify both the preceding phrases in that sub-paragraph, so that a mark must have become customary either “in the current language [*of the trade*]” or “in the *bona fide* and established practices of the trade” (emphasis in square brackets added).

30. I am unable to accept that argument. On my reading, there are two separate limbs of section 3(1)(d). A mark must be refused registration if, in relation to the goods or services applied for, it has become customary:

(a) in the current language; or

(b) in the bona fide and established practices of the trade.

It is clear from the proviso to section 3(1), that the general objection to marks which fall within section 3(1)(b) – (d) is that they are lacking in distinctive character (Case C-299/99 *Koninklijke Philips Electronics NV v.*

²⁵ BL O/281/04

Remington Consumer Products Ltd [2002] ECR I-5475, para. 58) . If the relevant public has come to view a sign in current language use as a generic name for the goods or services in question, then the objection is satisfied because the mark is prima facie lacking in distinctive character. An added requirement that the name must have become customary also in the current language of the trade is superfluous. I note that the District Court of The Hague, Civil Section D, expressed a similar view on parallel legislation in *Healing Herbs Limited v Bach Flower Remedies Limited*, Case 02/244, 30 June 2004.”

116. The relevant question is whether the mark SCRATCH MAP had ‘become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration is sought’. That question must be answered taking account of the expectations of the average consumers of the goods at issue in this case.

117. In respect of its pleadings under this section the applicant submits:

“21. By granting a monopoly right over the term ‘SCRATCH MAP’, the IPO has afforded the Proprietor a means by which it can unfairly stifle honest competition and prevent use of a term which is common parlance in respect of the relevant goods.”

118. The proprietor submits that there is no evidence to show that SCRATCH MAP has become customary in the trade in this jurisdiction.

119. Registration should only be refused under this section of the Act where the contested mark has become customary in the current language or in the bona fide and established practices of the trade to designate the goods for which registration is sought (the proprietor’s goods in classes 16 and 28).

120. Evidence in support of the applicant’s case is contained in exhibits HR3-HR8. It comprises internet prints from a number of retailers and an article from a technology and business website. The evidence does show examples of products being sold

under the term 'SCRATCH MAP'. However, exhibits HR4 and HR5 refer to the proprietor's own goods sold through a number of different online retailers. Other exhibits in HR5 refer to US websites with prices provided in dollars which do not assist in showing that the proprietor's mark is customary in the trade in the UK.

121. The proprietor states that the product shown at HR3 and HR6 was previously branded SCRATCH WORLD MAP but has subsequently rebranded to SCRATCH THE WORLD POSTER. It is not clear whether this was due to the proprietor having made contact with Maps International (the publisher of that product).

122. The exhibit at HR7 shows a mobile phone application called iScratchMap which is available from the iTunes store in the UK.

123. The article at HR8 is taken from thenextweb.com and refers to the term SCRATCH MAP, which is highlighted in red. The proprietor states that the link from that word in the article takes the reader to its own SCRATCH MAP products.

124. In conclusion, the exhibit at HR7 of the mobile phone application branded iScratchMap is the only example provided by the applicant in support of its claim under this section of the Act which shows a third party using a term similar to 'scratch map' (with the prefix 'i') which is directed at customers in the UK. In accordance with the guidance in *Telefon* outlined above, the matter must be decided in accordance with current usage in the relevant trade sectors, by reference to the goods for which the mark is registered and taking account of the perceptions of the target public regarding those goods. Clearly, this exhibit relates to goods which are not in the same class as the proprietor's goods in this case and this could hardly be said to show customary use.

125. Consequently, the applicant has failed to show that 'SCRATCH MAP' is used in the bona fide and established practices of the trade to designate the goods for which registration is sought. The applicant has not filed evidence to support its case with regard to SCRATCH MAP being more widely customary in the current language and having considered all of the papers on file, I am not persuaded that this is the case.

126. Consequently, the invalidation under section 3(1)(d) fails.

Acquired distinctiveness

127. The proviso included in section 3 of the Act states:

“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.”

The proprietor has provided evidence of use of its mark since 2010, consequently, I must examine whether the evidence shows that the mark acquired a distinctive character by the relevant date and, as this case is brought against a mark which is registered, I must also determine whether the proprietor’s mark had acquired distinctiveness up until the date of application for invalidation, namely, 22 July 2016.

128. Guidance on this matter is provided by the CJEU in *Windsurfing Chiemsee*²⁶ according to which:

“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

²⁶ *Joined cases C-108 & 109/07*

which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data such as predetermined percentages.”

129. Mr Cox has not provided turnover figures but has provided details of the number of goods sold under the SCRATCH MAP mark from 2010 to the end of the first half of 2016, which amounts to 929,108 units. Given that the product is a fairly specialised product this is not an insignificant number.

130. Mr Cox confirms in his witness statement that the proprietor does not invest money in marketing, but relies on marketing by its stockists. However, from the evidence it is clear that the proprietor has three ‘SCRATCH MAP’ websites, on which Mr Cox states SCRATCH MAP has been featured on the first page since 2010, and a number of social media pages as well as a presence on the websites of those that stock its goods. It sells its products throughout the UK in store and online at retailers such as iwantoneofthose.com, TESCO, John Lewis and Urban Outfitters and has a UK-wide presence in the physical gift shops in a number of locations, including Camera Obscura in Edinburgh, The Baltic Centre for Contemporary Art in Newcastle and a number of locations in London, including but not limited to The Design Museum and The South Bank Centre.

131. Witness statements have been provided by a former Chairman of the British Giftware Association, a buyer for Urban Outfitters (a stockist of the proprietors SCRATCH MAP goods) and two competitors of Mr Cox’s company (one of whom sits on the Advisory Board to The Design Council and ACID). It is clear that the witnesses are aware of Mr Cox and the proprietor and they all state that it is well known within their respective trades that SCRATCH MAP products originate from the proprietor. However, the evidence relates more to the novel nature of the product and is less concerned with the nature of SCRATCH MAP as a trade mark. What it clearly shows is that the witnesses see SCRATCH MAP as being a product from Luckies.

132. I have found earlier in this decision that SCRATCH MAP is inherently non-distinctive. ‘Luckies’, on the other hand, is clearly distinctive in respect of the proprietor’s goods. It is always more difficult to prove acquired distinctiveness in

respect of an otherwise non-distinctive sign if used with other distinctive marks and on this point I bear in mind *Audi AG, Volkswagen AG v OHIM*,²⁷ in which the General Court stated that:

“73. in the advertising material submitted by the applicants and included in the administrative file, the sign TDI always appears with another mark belonging to the applicants, such as the trade marks Audi, VW or Volkswagen. The Court has, however, held on numerous occasions that advertising material on which a sign which is devoid of any distinctive character always appears with other marks which, by contrast, do have such distinctive character does not constitute proof that the public perceives the sign applied for as a mark which indicates the commercial origin of the goods (*Shape of a beer bottle*, cited in paragraph 41 above, paragraph 51, and *Shape of a lighter*, cited in paragraph 27 above, paragraph 77). In any event, by quoting an internet site indicating that the Spanish public perceives the sign TDI as an abbreviation which refers to the type of direct fuel-injection diesel engine, irrespective of the car manufacturer, the Board of Appeal established that, despite all the applicants’ advertising efforts in Spain, the relevant public did not perceive that sign as identifying the commercial origin of the goods in question, but as a descriptive and generic term.”

134. However, a mark may acquire a distinctive character as a result of it being used as part of, or in conjunction with, another mark and I also have regard for *Société des Produits Nestlé SA v Mars UK Ltd*,²⁸ in which the CJEU determined that:

“The distinctive character of a mark referred to in Article 3(3) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks may be acquired in consequence of the use of that mark as part of or in conjunction with a registered trade mark.”

²⁷ *Case T-318/09*

²⁸ *Case C-353/03*

135. The proprietor's use of SCRATCH MAP throughout the evidence is somewhat inconsistent. It is regularly shown as Luckies Scratch Map, Luckies of London Scratch Map and Scratch Map from Luckies (or Luckies of London).

136. The proprietor has not provided any examples of its packaging for the goods other than examples which are included in blogs and online reviews. I cannot see the totality of packaging for any of the goods sold by the proprietor. Statements I make with regard to the presentation of the mark on packaging have been gleaned from the pictures which are included in prints from online blogs and review sites. On this basis, it seems that the mark is used in a number of forms, including in text as 'Luckies Scratch Map' and 'Scratch Map' and also in the form of a hand and globe device and a plate device with a knife and fork, shown below:



137. From the images provided within the reviews which Mr Cox has put in evidence, it is possible to conclude that a number of the proprietor's map goods are provided in tubes which feature the above referred 'globe and hand' device fairly prominently.²⁹ The same device can be seen on the map itself in a number of cases.³⁰ The product called 'Gourmet Scratch Map' uses the second logo pictured above.³¹ In the vast majority of cases where the product is being reviewed in an online magazine, newspaper or blog, it is clear in the article that the product referred to is from Luckies/Luckies of London. Readers' comments below the articles are made on this basis and are not indicative of their perception of SCRATCH MAP, rather, they are a response to the particular product identified in the article.

²⁹ See paragraphs 69, 80 and 84 of this decision

³⁰ See paragraphs 77, 82 and 84 of this decision

³¹ See paragraph 74 of this decision

138. ‘Luckies’ is clearly a distinctive sign for the goods at issue in this case. ‘SCRATCH MAP’ is inherently non-distinctive resulting in the public being likely to take the former as the trade mark and the latter as a description. Having considered all of the material before me I am not persuaded that the proprietor’s use of SCRATCH MAP has done anything to alter this position. The trade evidence supports the fact that SCRATCH MAP is an innovative product which originates from Luckies.

Overall outcome

139. The application for invalidation succeeds under sections 3(1)(b) and 3(1)(c) except in respect of paper and cardboard in class 16.

140. The application for invalidation fails in respect of section 3(1)(d) of the Act.

141. This means that the registration will be partially cancelled and the mark deemed never to have been registered other than for:

Class 16
Paper and cardboard

COSTS

142. The invalidation having largely succeeded the applicant is entitled to an award of costs, adjusted to take account of its unsuccessful claim under section 3(1)(d) of the Act and the remaining goods in class 16. These proceedings were commenced on 26 July 2016 and so the scale contained within Tribunal Practice Notice 2/2016 applies. I award costs on the following basis:

Preparing a statement and considering the other side’s statement:	£300
Preparing submissions:	£300
Filing and considering evidence:	£500
Total	£1100

143. I order Luckies of London Limited to pay s.mile Direkt AG the sum of £1100. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 19th day of September 2017

**Ms Al Skilton
For the Registrar,
the Comptroller-General**