

O-060-19

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3232283 BY
FAYE THWAITES & DANIEL MICHAEL LESLIE THWAITES
TO REGISTER:**

JAM JAR GIN

AS A TRADE MARK

IN CLASS 33

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 411149
BY WILKIN & SONS LTD**

Background and pleadings

1. On 19 May 2017, Faye Thwaites and Daniel Michael Leslie Thwaites (“the applicants”) applied to register **JAM JAR GIN** as a trade mark for “Gin” in class 33. The application was published for opposition purposes on 22 September 2017.

2. On 5 January 2018, the application was opposed by Wilkin & Sons Limited (“the opponent”) under sections 3(1)(a), (b), (c) and (d) of the Trade Marks Act 1994 (“the Act”). In its Notice of opposition, the opponent states:

3(1)(a)

“The term JAM JAR is used by a number of traders, thus it does not distinguish the goods of one undertaking from those of other undertakings. The word GIN merely describes the contents of the jam jar. Other traders use the term JAM JAR in combination with non-distinctive words such as COCKTAILS, SLUSHIES, CHEESECAKE, GIN & TONIC and PIMMS & GIN”.

3(1)(b)

“The mark merely describes a characteristic of the goods, in that the goods are made, or sold In Jam Jars. The term JAM JAR describes the receptacle in which the goods are placed and the word GIN is the name of the product inside the receptacle. Consumers will merely see the sign JAM JAR GIN as a descriptive term for gin sold In jam jars. They will not see it as a distinctive mark designating the goods of one trader only”.

3(1)(c)

“The term JAM JAR GIN describes goods that are made, or sold In jam jars. In this case, the applicant sells gin that is in a jam jar”.

3(1)(d)

“A number of entitles use the term JAM JAR in combination with the name of the product inside the Jam Jar, thus the term is now in common usage. Other traders use the term JAM JAR In combination with non-distinctive words such as COCKTAILS, SLUSHIES, CHEESECAKE, GIN & TONIC and PIMMS & GIN. The term JAM JAR is used by the service industry in restaurants and bars as the receptacle for cocktails and other alcoholic beverages. It is trendy to drink your alcoholic beverage out of a Jam Jar, as well as being environmentally friendly. The term is also used by people making recipes for beverages, as well as for foods other than jam that are placed in jam jars”.

3. The applicants filed a counterstatement which consists, in essence, of a denial of the grounds upon which the opposition is based. They do, however, state:

“7. In the event that it is held that the term JAM JAR GIN is not prima facie distinctive, the Applicant can demonstrate that its JAM JAR GIN mark has acquired distinctiveness through use...”

4. In these proceedings, the opponent is represented by Dummett Copp LLP and the applicant by Keltie LLP. Both parties filed evidence accompanied by written submissions. The matter came before me at a hearing held on 4 December 2018. At the hearing, the opponent was represented by Nick Zweck of Counsel and the applicants by Benet Brandreth of Her Majesty’s Counsel.

The opponent’s evidence

5. This consists of two witness statements. The first, comes from Scott Goodfellow, the opponent’s joint managing director. Mr Goodfellow explains that the opponent was incorporated in 1888 and is a:

“3...grower of fruit and vegetables and a manufacturer of, inter alia, jams, preserves, jellies, honeys, spreads, chutneys, pies, puddings, biscuits, cakes, patisserie goods, fruit juices, candles, reed infusers and fruit gin liqueurs...”

6. He states that the opponent uses around “100 million jam jars annually for its products”, adding that the opponent has been exploring new ways of using jam jars for holding products other than jams and chutneys. The opponent has, he states, used jam jars for cheesecake and natural wax candles and it plans “to introduce [its] fruit gin liqueurs in miniature bottles, placed in jam jars” which it plans to market under its TIPTREE trade mark; the product would be called TIPTREE JAM JAR GIN LIQUEURS. Similarly, as the “candles are placed in jam jars”, the opponent may, he states, market its candles as JAM JAR CANDLES. Mr Goodfellow states:

“4...We have also placed our gins in our miniature jam jars for shows and festivals and sell an etched jam jar for drinking gin and cocktails”.

7. Exhibit SG2, consists of four pages. The first three pages appear to be from the opponent’s websites i.e. www.tiptreecakes.com and www.tiptree.com. While the first page is undated, pages 2 and 3 have printing dates of 6 April 2018. The first three pages bear images of jam jars inside of which there appears a candle and cheesecakes. Page 3 looks like this:



8. The final page contains what appears to be an undated screen grab from a mobile telephone. I note the page contains the following: “10.30am – Tiptree Jam Jar Cocktails”.

9. Mr Goodfellow states that “the applicants’ product is sold as YERBURGH’S JAM JAR GIN.” Exhibit SG3, consists of two images from <https://gin-festival> printed on 6 April 2018. The first page looks like this:



10. Exhibit SG4, consists of the following:

- A page from collinsdictionary.com which includes, under the heading “Example sentences containing “jam jar”, a sentence which appeared in the *Times* and *Sunday Times* newspapers in 2014 i.e. “They were drinking beer and whisky out of jam jars”;
- An article dated 3 April 2017 from jamjarwines.com in relation to a “Strawberry Jam Jar Slushie” and “Peach Jam Jar Slushie”. The reference to “Cape Classics, Inc” suggests that this is not a UK website;
- An undated menu from The Anglers restaurant. The prices are shown in £ and the menu contains the following: “Jam Jar Trifle, Rhubarb, Stem Ginger”;

- A menu dated “10/2017” from The Cape of Good Hope pub in Warwick, which contains the following: “Jam Jar Cheesecake”;
- A recipe for a “Blueberry Jam Jar Cheesecake” which appeared in the lifestyle blog www.atnumber43.co.uk on 4 April 2014;
- A recipe for “Jam-Jar Cheesecake Puddings” from the website of Margaret Hirsch published on 24 October 2017; this does not appear to be a UK website;
- A recipe for a “No-Bake Jam Jar Cheesecake” posted on 9 February 2012 from the Doves and Figs website; this does not appear to be a UK website;
- A recipe for a “Jam Jar Trifle” dated 12 September 2013 from <http://francesquinn.co.uk>;
- Pages dated 28 May 2012 from the UK website <https://holdtheanchoviesplease> which includes a recipe for a “jam-jar Jubilee trifle”;
- Facebook pages from “Jam Jar desserts” (which appears to be a caterer in Tasmania), page 9 of which is stated to show “a Jam Jar Tiramisu”;
- Pages from hannahbakesthings.co.uk dated 24 June 2015, which includes, inter alia, a recipe for a “Jam Jar Sponge Cake”;
- Pages from www.bbcgoodfood.com from, it appears, at least April 2014, in relation to a recipe for “Chocolate jungle jam jar”;
- Pages from ringtons.co.uk printed on 5 January 2018 which contains references to “Rington’s Jam Jar Mugs With Sweets”;
- A page from www.thecocktailstore.co.uk printed on 5 January 2018. The page contains, inter alia, a reference to “12 x Jam Jar Glasses” and “The Jam Jar drinking glass is the perfect speciality glass for those fantastic home-made cocktails...”;

- An article dated 24 January 2009 from www.telegraph.co.uk entitled “Bar serves cocktails in drinkers’ jam jars” about the Time Bar in Leicester;
- Pages from www.britglass.org.uk printed on 5 January 2018 (but which contains a copyright date of 2013) entitled “Beatson Clark causes a stir with cocktail jam jars” and refers to inter alia, “London Rd Jam Jar Cocktails is a range of authentic flavours...”;
- A page from delicious.com.au printed on 5 January 2018 and which contains the following “Ditch the old fashioned glasses for a casual affair, and serve these cocktails in a jam jars. Because recycling will always be cool”;
- Pages from frenchweddingstyle.com which, given the reference to “bank holiday weekend” appears to be a UK site. The article was “penned” on August 28 2012, and refers to “DIY PROJECTS: WEDDING JAM JAR COCKTAILS”;
- Pages from www.jamjarcocktailclub.com which includes references to events held in the UK, the earliest of which appears to be 23 August 2017;
- Undated pages from Pinterest bearing images of drinks in jars;
- Pages from www.jamjarlights.com printed on 5 January 2018. The images provided are of a “halogen golf bulb” and a “XXL filament bulb spiral”;
- Pages from a search for “jam jar cocktail” conducted on amazon.co.uk on 5 January 2018 which includes references to, inter alia, “JAM JAR GLASSES WITH HANDLE”, “Jam Jar style drinking glasses” and “4 x Mixed Colour Jam Jar glasses...”;
- Pages from instructables.com (which appears to be a website based in the USA) and which contains instructions on how to make “Jam Jar Wedding Favors”;

- An article from the *Evening Standard* from 4 April 2011 entitled “London’s jam jar revolution” which includes the following “London has gone jam jar crazy...bars and cafes...use them as cocktail glasses...”;
- Pages from taste.com.au printed on 22 September 2017 which contains recipes for “Jam jar cocktails”;
- Undated pages from the website of “HERE Berkhamsted” which contains a reference to “Jam Jar Gin mixes...”;
- A page from <http://kikisboutique.com> printed on 22 September 2017 in relation to a “MASON JAR DRINKING GLASS WITH STRAW – GIN & TONIC” priced at £6.95;
- Pages from www.visitperthcity.com (in Australia) printed on 22 September 2017 which contains a reference to a “PIMMS & GIN JAM JAR”;
- Pages from jamjar-pr.co.uk from June 2013 which, under the heading, “jamjar PR cocktails for happy hour” contains a recipe for “The Jam Jargarita”, together with a photograph of what appears to be a cocktail in a jam jar;
- An article dated 16 September 2014 from www.independent.co.uk entitled “THE RISE AND FALL OF THE MASON JAR”;
- Pages obtained from www.mouthfulsfood.com (a UK website) from 2011, entitled “What’s wrong with drinking wine out of Jam Jars”;
- Pages from the “BLOG MENU” of www.revolution-bars.co.uk printed on 6 April 2018 and which contains references to cocktails called “TROPICAL STORM” and “DESIGNATED DRIVER” and which also contains pictures of the cocktails and the receptacles in which they are served. In relation to the first cocktail, there appears the following: “Get ready for a tropical storm in a...mason jar.”

11. The second statement comes from Lynn Harris, a trade mark attorney at Dummett Copp LLP. Ms Harris states that she is “aware of drinks being sold in jam jars and [has] been for many years.” She recalls her experience whilst visiting the USA in 1982 and at the drinks reception of the Chartered Institute of Trade Mark Attorneys (“CITMA”) held at the Foundation bar in London in 2014. She explains that as she does not have access to the photographic library of CITMA, exhibit LS1 consists of a screenshot from the Foundation Bar’s Twitter account from 6 April 2018, which, I note, shows a jam jar being used as a receptacle for a drink.

12. Ms Harris states that in 2013, the opponent’s Finance Director wanted to register JAM JAR CHEESECAKE for a range of cheesecakes in jam jars. Her advice was that the words were descriptive and unregistrable – exhibit LSH2 refers. Ms Harris states that she is also aware that the opponent:

“...uses jam jars for products other than jam and indeed, uses the term JAM JAR descriptively in relation to its range of confectionery.”

13. Exhibit LSH3 consists of what appears to be undated pages from the opponent’s website. Under the heading “JAM JAR SWEETS”, there appears a range of sweets being sold in jam jars.

The applicants’ evidence

14. This consists of six witness statements. The first, is from Faye Thwaites, the joint applicant. Ms Thwaites explains that she is also the Director of Jam Jar Gin Ltd (“JJGL”), who she has been with since it was founded in September 2014. JJGL is, she explains, “a specialist spirit producer focusing on the gin market”. Although some of her evidence is duplicative, I have, for the sake of completeness, where appropriate, included these duplications in an effort to fairly reflect the extent of her evidence. With that in mind, the main points emerging from her statement are, in my view, as follows:

- JAM JAR GIN is the UK's first crowd-funded gin. A crowdfunding campaign for the first batch of gin was launched on 26 November 2014;
- JAM JAR GIN gin has won a number of awards including: The Spirits Business Gin Masters Silver Awards Super Premium category (2015), the IWSC Silver Outstanding Award (2016), the San Francisco World Spirits Competition Silver Medal (2017), The Gin Lord's Gin of the Year Award (2016) and the "Gin of the Month & for World Gin Day at Fortnum & Mason" in June 2017;
- The first batch of gin was produced and sent out to pledgers on 19 March 2015;
- During the crowdfunding campaign, JAM JAR GIN gin was promoted on the website of The Gin Club. Extracts from that organisation's website dated 27 November and 5 December 2014 are provided in exhibit FT1. The first page from November 2014, contains the following:

"Hand's up if you've heard of Yerburch's JAM JAR GIN? No? We hadn't either. Jam Jar Gin is a new gin that hasn't even made it to market yet, but this evening they made their crowd funding target just 3 days after it went live..."

And:

"Delivered in miniature jam jars the samples looked the business. The real deal is of course going to be bottled in large jam jars..."

- JJGL "focuses on its distinctive and artesian gin" and "JAM JAR GIN...has a strong reputation as being a super-premium, luxury brand of gin...";
- JAM JAR GIN gin has "received widespread acclaim from drinks critics, bartenders and connoisseurs in the UK, USA, CANADA, Japan, Italy, Denmark and South Africa";

- JAM JAR GIN gin is available online through a number of online retailers including Master of Malt, The Whisky Exchange, Harvey Nichols, Fortnum & Mason, Amazon, Wine Mill and The Gin Festival and is recognised and listed by The Gin Guild, London;
- JAM JAR GIN gin is served and sold in luxury hotels, restaurants, bars and Stores in the UK, including the Zetter Townhouse, Harvey Nichols, Fortnum and Mason, The Shrub & Shutter, The Arbitrager, The Hide, Mr. Fogg's Tavern & Gin Parlours, Callooh Callay and Arcane;
- JAM JAR GIN gin “has attracted significant critical acclaim...on social media” including Instagram, Twitter, Pinterest and Facebook. Exhibit FT1, contains a range of quotations in relation to the applicants’ gin, the majority of which are dated prior to the filing date of the application for registration. One example from December 2014 will, I hope, give an indication of the type of comments provided i.e.

“When you think the Gin World reached the top of its creativity, you get to try the Jam Jar Gin. An unusual style of dry gin from South London with an intriguing creamy finish (although delicious in Martinis), with the great addition of raspberry leaves in its botanicals, making it one of the most interesting craft Gins we tried recently. We at the Zetter Townhouse, were glad to review and experiment with such an amazing new gin. We can't wait to see it smashing the Gin market soon next year”;

- JJGL sponsored the Orchestra of the Age of Enlightenment ('OAE'), at the OAE Gala on 22 February 2018;
- JJGL has taken part in events including the JAM JAR GIN Afternoon Tea served throughout the month of September 2017 at Harvey Nichols;

- JJGL conducted a series of cocktail masterclasses and bespoke JAM JAR GIN evenings at the Zetter Townhouse in July and November 2017;
- Mr Thwaites was invited to speak at the Gin Guild Ginposium about JAM JAR GIN gin in April 2015;
- JAM JAR GIN gin has featured in the book (published in November 2017) 'Doctor's Orders' by multi-award winning cocktail experts Chris Edwards and Dave Tregenza of the Shrub and Shutter and First Aid Box;
- The name and trade mark JAM JAR GIN was adopted in 2014. Although the labels and packaging design have been updated, the JAM JAR GIN trade mark has been in continuous use since that time;
- Exhibit FT3, consists of samples of labels and packaging used during the crowd funding campaign in September 2014 and the various updates which have taken place since. As far as I can tell, in addition to the words "JAM JAR GIN" all of the examples provided bear the word "Yerburgh's" (in varying degrees of stylisation) and always presented above the words "JAM JAR GIN";
- Exhibit FT4, consists of (i) pages from the applicants' website www.jamjargin.com printed on 27 February 2018, (ii) screenshots from their original website launched on 25 September 2014 and (iii) screenshots from their original crowdfunding page launched in November 2014. As far as I can tell, once again, all of the packaging includes the word "Yerburgh's" (in varying degrees of stylisation) and always presented above the words "JAM JAR GIN";
- In the UK, JAM JAR GIN gin is sold in department stores, wine & spirit merchants, independent spirit boutiques, delicatessens, independent food and & farm shops, bars and restaurants and, as mentioned earlier, online through a variety of different retailers. Exhibit FT5, consists of pages obtained from the following websites in February and March 2018: Harvey Nichols, Fortnum & Mason, Master of Malt, amazon.com, ginfestival.com, thewhiskyexchange.com

and Libra Drinks. I note that with one or two exception, the undertakings concerned list the applicants' gin as "YERBURGH'S JAM JAR GIN";

- Exhibits FT6 and FT7, consist of four witness statements and one "To whom it may concern letter" (the latter of which is, as explained in Tribunal Practice Notice 5 of 2009, to be treated as hearsay). Those providing witness statements are: Ivan Dixon (Wine and Spirits Buyer at Harvey Nichols), who states he has known of JAM JAR GIN since at least August 2015 and that it has been sold by Harvey Nichols since October 2016, Justin Hicklin (founding Director of The Gin Guild), who states he has known of JAR JAR GIN since 2014, Keivan Nemati (Assistant General Manager of "the Untitled Bar", Daiston and previously Head Barman and Bar Manager at the Zetter Townhouse), who states he has known of JAM JAR GIN since 2014 and that it has been sold by the Zetter Townhouse since 2015 and Christopher Edwards (Director of Salts of the Earth Limited, a drinks consultancy and owner of The Shrub & Shutter and The First Aid Box cocktail bars and restaurants), who states the Shrub & Shutter has served JAM JAR GIN since 2015. The "To whom it may concern letter" is from Nicholas Cook (Director General of The Gin Guild). Mr Dixon states:

"5. The words JAM JAR GIN mean to me the trade mark of Faye and Dan Thwaites and I know of no other party using this mark."

Although the other individuals give evidence to a similar effect, I note that Mr Cook states:

"To me, the words JAM JAR GIN mean the trade name adopted and utilised by Faye and Dan Thwaites and is also known as Yerburch's Jam Jar Gin":

- JAM JAR GIN gin is available in award winning and prestigious restaurants and bars throughout the whole of the United Kingdom including the boutique hotel, the Zetter Townhouse, Marylebone & Clerkenwell, London, the Shrub & Shutter

& First Aid Box, London, Harvey Nichols Bar & Restaurant ,The Arbitrager & The Hide, London, Mr Fogg's Tavern & Gin Parlours, Mayfair & Covent Garden, London, Arcane Cocktail Bar, Manchester; Noho, Manchester and Evil Eye Gin Lounge, York;

- Gin sold under the JAM JAR GIN trade mark has been advertised since its launch in 2014 through national press and lifestyle and food/beverage publications. Exhibit FT10, consists of extracts from *The Lady* (September 2017), *Vogue* (October 2015, July 2016), *House & Garden* (July 2016) and *GQ* (October 2015). I note that when the articles refer to the applicants' gin they do so as follows: "Yerburgh's JAM JAR GIN";
- The JAM JAR GIN trade mark is made known to the public through editorials in national publications including newspapers and trade publications;
- Exhibit FT12, consists of the results of a Google search for the term "JAM JAR GIN" conducted on 6 June 2018. The vast majority of the "hits" relate to the applicants and many include a reference to "Yerburgh's Jam Jar Gin";
- Exhibit FT13, consists of what Ms Thwaites describes as "examples of blogs and blogger adverts/social media posts". They date from November 2014 to February 2018. Once again, many of the articles either contain a reference to "Yerburgh's" or contain a photograph of the applicants' gin in a receptacle bearing that word;
- JAM JAR GIN has been advertised on third party websites since 2014, including Harvey Nichols, Fortnum & Mason, OAE Gala 2018, The Lady, Dlux, The Zetter Townhouse, Knight Frank, The Hollies Farm shops, Luxury Delis, Fever-Tree, The Arbitrager, Hammonds of Knutsford, The Gin Explorer, the Gin Festival, The London Standard, Cafe Nero, Billington's Deli and Ice cream, The Bell Inn Chittlehampton, Google, DrinkSupermarket.com and The Fine Spirits Company (exhibit FT14 refers);

- JAM JAR GIN has gained public recognition via social media. Its Facebook page went live on 30 September 2014, its Twitter page on 6 October 2014, its Instagram page on 31 March 2015 and its Pinterest account was set up on 27 September 2015. Facebook posts at, I assume the date of Ms Thwaite's statement in June 2018, had reached 954,887 people and the number of impressions on its Facebook posts was 2,244,649. As of 31 May 2018, the applicants had 8262 followers on Facebook. The pages provided show that the applicants have 702 followers on Instagram, 1282 followers on Twitter, and that its Pinterest account receives "1500 monthly unique viewers" (exhibits FT15 and FT 18 refer).
- From November 2014, the applicants' gin has been promoted through email shots sent to "667 customers and partners in the UK" (exhibit FT16 refers);
- The applicants' gin has been promoted at tradeshow, exhibitions and gin festivals throughout the UK. Exhibit FT17, consists of photographs taken at trade shows and gin festivals from as early as February 2017. In all the photographs provided, the applicants' goods appear to be sold in receptacles bearing the words "Yerburgh's JAM JAR GIN";
- In the period 2014-2018, the applicants' total turnover of its gin in the UK amounted to £109k/10,911 bottles. Turnover/number of bottles sold in 2015/2016 and 2016/2017 amounted to £29k/911 and £40k/5,000, respectively;
- Examples of partially redacted Purchase Orders are provided from: (i) April 2016 to 23 February 2018 from Hammonds of Knutsford (who serve the licensed trade) all of which refer to "Yerburgh's Jam Jar Gin", (ii) from Speciality Drinks of London of 2 November 2017, which refers only to "Jam Jar Gin", as do (iii) the emails from Harvey Nichols which are dated October and November 2016 and December 2017.

15. The final statement is from Rosemary Cardas, a trade mark attorney at Keltie LLP. Attached to her statement are four exhibits, all of which consist of details of trade marks which have been registered by either the EUIPO or UK Trade Marks Registry. Details of these trade marks are shown in the Annex to this decision.

The opponent's evidence-in-reply

16. This consists of two further statements. The first, is from Mr Goodfellow. I have read his statement and will keep it in mind in reaching a conclusion. I do, however, note that in relation to his exhibit SG2, he states:

“7... the attorneys [for the applicants] state that the last page of Exhibit SG2 has not been explained. This related to a food festival, at which [the opponent] organised a cocktail making class using our gins and drinking vessels. The organisers called the event TIPTREE JAM JAR GIN MASTERCLASS, due to the use of gin and jam jars...the organisers themselves created the event title as a natural consequence of using gin and jam jars. When [the applicants] complained to us, we immediately asked the organisers to change the title to the Tiptree Jam Jar Cocktail Masterclass as a gesture of goodwill towards [the applicants]. In any event, I believed then and still believe, that the term JAM JAR [name of product] is descriptive, so the organisers were merely describing the event taking place.”

17. The second statement is from Ms Harris. She provides as exhibit LSH4, further pages from the applicants' website in support of the opponent's contention that it is the trade mark “YERBURGH'S JAM JAR GIN” that is used. In response to the applicants' turnover figures, Ms Harris provides as exhibit LSH6, articles from *The Guardian* dated 8 December 2016 and 17 April 2017. The first article is entitled:

“The year of gin! Spirit enjoys record sales as drinking habits change”, “About 40m bottles were sold over the past 12 months – enough to make 1.12bn gin and tonics – as Spain and US become key markets”.

The article also includes the following:

“Annual gin sales rose 16% to smash through the £1bn barrier for the first time in the UK, leading the drink industry to declare 2016 the “year of gin”.

18. Also provided as exhibit LSH6, are the Annual Report and Unaudited Financial Statements (for the period ending 31 December 2016) of Sipsmith Limited (company no. 6373864). In its submissions, the opponent states:

“Ms Thwaites's Witness Statement paragraph 32 lists the volume of sales of the Applicants' gin. 5000 bottles/£40,000 per year is a drop in the ocean of gin sales generally. According to the Guardian newspaper, in 2016, British gin drinkers bought 40 million bottles at a value of over £1 billion. Even if one were to limit to the 'premium' or 'boutique' end of the gin market, the figures for YERBURGH'S JAM JAR GIN are still extremely small. Again, according to the Guardian, Sipsmith Limited, the founder of the boom in premium artisan distilleries, was sold by its three founders in 2016 for £50 million. Sipsmith's turnover for the year ended 31 March 2016 was over £7 million. Based on these figures alone, the turnover of the Applicants is de minimis in the premium gin market.”

The applicants' request to file further evidence

19. Although the above concludes my summary of the evidence filed during the normal evidence rounds, on 12 November 2018, the applicants sought leave to file further evidence. This was dealt with as a preliminary issue at the substantive hearing. The basis of the request was said to be to “clarify a point raised by the opponent in its submissions”. The paragraph in the opponent’s submissions to which the applicants refer reads as follows:

“In FT12, page 1, we assume the Applicant is trying to prove that by ranking as the first entry in a Google search for JAM JAR GIN, this makes the term

distinctive, which is clearly misleading. It is well known that traders pay for search engine optimisation (SEO), so that their brand goes to the top of any search results. The Applicant needs to show that it has not paid Google to get its brand top of the list and that the only references in such a search only refer to their own product in order to demonstrate that the term JAM JAR GIN is distinctive”.

20. The applicants indicated they wished to file:

“A copy of [their] Google account showing that they have not paid for the Google hits for search engine optimisation in order for JAM JAR GIN to appear at the top of the list as questioned by the Opponent...”.

21. The additional evidence consists of a further statement from Ms Thwaites. By reference to exhibit FT20 which, she states is:

“...a true and accurate screenshot from our Google account at dmlthwaites@gmail.com which includes the transactions of Jam Jar Gin's Google account from 01 January 2014-10 November 2018 showing that we have not paid for search engine advertising.. Further, we have not commissioned any specialists who produce content for brands in an attempt to increase natural traffic...”

22. The Tribunal sought the opponent’s views on the applicants’ request and, on 16 November 2018, the opponent responded by filing a statement from Christopher Newenham, the opponent’s joint managing director. In its covering letter, the opponent stated:

“In light of the Opponent’s comments regarding the Applicant’s Google account, we request that the Applicant provide us with screenshots showing the account details, specifically, when it was set up and the payment method on the account.”

23. In his statement, Mr Newenham states, inter alia:

“4)... All this screenshot demonstrates is that this is the account of someone whose email address is drnthwaites@gmail.com. Gmail is an email account operated by Google and anyone can own an email address with this suffix. It is usually used for personal accounts, not business accounts. In other words, the transactions shown in this Exhibit relate to those for an individual called 'dmthwaites'. I would expect a business to use the company or trading name for their email address. For instance, Wilkin uses the "tiptree.com" email address. TIPTREE is one of Wilkin's registered trade marks and is a trading name that we use. This Exhibit does not prove that no payments for search engine optimisation were made in relation to JAM JAR GIN, therefore.”

24. Exhibit CWN1 to his statement consists of page one of a Google search for the words “jam jar gin” conducted on 14 November 2018. Mr Newenham makes various observations on this exhibit, which are, I think, summed up by the following:

“5...It is quite clear, therefore, that it is YERBURGH'S JAM JAR GIN that is being searched and offered for sale.”

25. In reaching a conclusion, I was guided by the following which appears in the Tribunal section of the Trade Marks Registry's Work Manual:

“4.8.9 Challenging evidence

It is normally unacceptable for parties to invite a Hearing Officer to disbelieve the factual evidence of a witness without that witness having had the opportunity to respond to the challenge either by filing further written evidence or, by answering the challenge that his or her evidence is untrue in cross-examination(EXTREME Trade Mark BL O/161/07).

Normally, this will mean the opposing party making written observations within the period allowed for filing its evidence in response to the witness's evidence explaining why the witness should not be believed. Alternatively, the opposing party can file factual evidence in reply of its own which shows why the evidence in question should not be believed. In the further alternative, the opposing party can ask to cross-examine the witness in question at a hearing.

However, requesting cross-examination may be disproportionate and unnecessarily costly and burdensome, since in trade mark proceedings the evidence stages are sequential, providing opportunities to deal with points during the proceedings (BRUTT Trade Marks (2007) RPC 19). In addition, cross-examination may not be permitted if the truth or otherwise of the challenged statement manifestly has no bearing on the outcome of the case. Written submissions, or evidence which contradicts the witness's evidence, are therefore likely to be the most satisfactory ways to dispute the factual evidence of the other side in the majority of cases..”

And:

“4.8.5 Additional evidence

A party may ask to file additional evidence. The Tribunal will consider the reasons for the request, the nature of the evidence and the views of the other party. In considering a request to file additional evidence the Tribunal will primarily consider the following (Property Renaissance Ltd v Stanley Dock Hotel & Ors (2016) EWHC 3103 (CH)):

- the materiality of the evidence in question to the issues that the Registrar has to determine;
- the justice and fairness of subjecting the opposite party to the burden of evidence in question at the stage that the registry proceedings have reached, including the reasons why the evidence was not filed earlier;

- whether the admission of the further evidence would prejudice the opposition party in ways that cannot be compensated for in costs (for example excessive delay); and
- the fairness to the applicant of excluding the evidence in question, including prejudice to the applicant if it is unable to rely on such evidence.”

26. The applicants’ request for leave to file further evidence arose as a result of comments made in the opponent’s submissions filed together with its evidence in reply. On 16 November 2018, the opponent (who would normally be the last to file evidence), reacted to the applicants’ further evidence by requesting leave to file further evidence of its own. Having applied the guidance mentioned above (and as neither parties’ skeleton arguments appeared to take issue with the various requests for leave to have the further evidence admitted into the proceedings), my initial view was that the further evidence of both parties should be admitted. At the hearing, I asked the parties for their view of the matter. As both had come to the same conclusion, I admitted the second witness statement of Ms Thwaites and the statement of Mr Newenham (and the associated exhibits) into the proceedings.

DECISION

27. The opposition is based upon sections 3(1)(a), (b), (c) and (d) of the Act which read 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.”

The opposition based upon section 3(1)(a) of the Act

28. In his skeleton argument, Mr Zweck stated:

“2...The section 3(1)(a) ground advanced to date is not advanced independently as it takes the opponent’s case no further than the grounds set out above [i.e. those under sections 3(1)(b), (c) and (d)].”

The opposition based upon sections 3(1)(b) and (c) of the Act

29. In his skeleton argument and at the hearing, Mr Brandreth argued that the opposition based upon both sections 3(1)(a) and (b) added nothing to those based upon sections 3(1)(c) and (d). As the opposition based upon section 3(1)(a) is not being pursued, I need say no more about it. Insofar as the objection based upon section 3(1)(b) of the Act is concerned, at the hearing, Mr Zweck stated:

“In relation to section 3(1)(b) - I just flag this as a matter of completeness - I think I am probably ad idem with Mr Brandreth that I don't think my case goes

any further than descriptiveness. The reason I flag distinctiveness as a separate head is just in case there is a gap and you decide that there is some extra provided by the "Js" or the "Gs" of the words, the order or something like that, which you think takes it beyond some pure distinctiveness (sic). I say, even if that is the case, you have not crossed over. There is not sufficient distinctiveness to make this a distinctive mark.”

30. I will bear that submission in mind when I return to the opposition based upon section 3(1)(b) of the Act later in this decision.

The relevant case law

31. The principles to be applied in determining whether a trade mark is open to objection under sections 3(1)(b), (c) and (d) of the Act and, if it is, whether or not it has acquired distinctive character by virtue of the use that has been made of it are well-established and have been restated many times by courts at varying levels. These principles are enshrined in a range of cases (to which this tribunal routinely refers and to which I will refer below), many of which were also referred to by the parties in their skeleton arguments and at the hearing. In reaching a conclusion I will, of course, keep all of the cases mentioned by the parties firmly in mind, referring to them to the extent I consider it necessary to do so.

The basis of the applicants’ defence

32. The applicants’ defence to the opposition has two limbs. The first, is that their trade mark is acceptable prima facie; if that defence fails, they rely upon the use that has been made of the trade mark under the proviso to section 3(1) of the Act.

The opposition based upon section 3(1)(c) of the Act

33. I shall first consider the opposition based upon section 3(1)(c) of the Act. Before doing so, I remind myself that as the Court of Justice of the European Union (“CJEU”) pointed out in *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P, sections 3(1)(b) and (c) of the Act are independent and have differing general interests.

The average consumer

34. In *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04, the CJEU held:

“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).”

35. As the evidence shows, the average consumer of the goods at issue comprises members of the general public and, broadly speaking, those engaged in the trade, for example, drinks wholesalers and buyers and individuals working in bars and restaurants.

36. 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 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 Technool 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].”

37. In his skeleton argument and at the hearing, Mr Brandreth drew heavily from the comments of Floyd LJ in *JW Spear & Sons Ltd and Others v Zynga Inc.* [2015] EWCA Civ 290 in relation to which at the hearing, Mr Zweck stated he was:

“...happy with that analysis. I accept that that is a useful rubric or analytical tool to use when considering the question of descriptiveness. In addition to my submissions, I just wanted to note that I am very happy to accept that that is a correct statement of the law and a useful guide.”

38. In particular, Mr Brandreth drew my attention to the following comments:

“79 Thus it is the presumed perception of the average consumer which is relevant. It is not of course enough if the connection between the signs and a

characteristic of the goods does not dawn immediately on the average consumer. If it requires any thought or explanation it is not “easily recognisable”.

80...

81...

82 It is nevertheless the case that signs which are candidate trade marks lie on a continuum between the entirely generic, through the descriptive to the inherently distinctive. Not every word which alludes to or is suggestive of some aspect of the goods or services is necessarily unregistrable. **It is of course trite that it is not an objection to registration that the word has a dictionary meaning, or is an ordinary English word. The objection bites on relationships between the word and the characteristics of the goods or services for which it is sought to be registered which the average consumer will immediately perceive.** (Mr Brandreth’s emphasis).

83 I have found helpful and agree with the analysis of the Advocate General in his opinion in *Doublemint* at [61]–[64]. He draws attention to the fact that that there is no clear-cut distinction between indications which designate a characteristic and those which merely allude suggestively to it and suggests three considerations which may determine on which side of the line the indication lies. Although the entire passage repays reading, I will summarise his three points as: (i) how factual and objective is the relationship between an indication and the product or one of its characteristics? (ii) how readily is the message of the indication conveyed? and (iii) how significant or central to the product is the characteristic? Asking these questions will assist a fact-finding tribunal to determine whether it is likely that a particular indication may be used in trade to designate a characteristic of goods.”

The opponent's position in relation to the trade mark's descriptive character

39. In Mr Zweck's view, the position is straightforward i.e. the natural meaning of the words JAM JAR GIN are, inter alia, descriptive of gin sold in a jam jar. As the applicants' product is a liquid, the vessel in which it is sold must, he argued, be regarded as a characteristic of the product. By reference to the comments of Floyd LJ in *JW Spear*, at the hearing he stated:

“...It is the immediate thought process which would occur to the average consumer. That is not a difficult thought process. It is not one that requires thought at all.”

40. Although Mr Zweck commented that the opponent did not need to rely upon the evidence it had filed in relation to this ground of opposition, as, in his view, its evidence demonstrated that “in the marketplace this form of words “jam jar” with some sort of substance that it contains, which is a non-jam jar substance, is quite common...”, it provided what he described as a “helpful double check”. Mr Zweck answered the three questions posed by Floyd LJ in *JW Spear* (which Mr Brandreth had suggested as appropriate) as follows:

- (i) “there is, obviously, a clear direct factual relationship as a jam jar that may be used as a container to sell gin”,
- (ii) “...very readily. JAM JAR GIN immediately calls to mind gin in a jam jar”;
- (iii) “I say very. Gin is a drink. It needs to be sold in a container. So the nature of the container is a central characteristic of the product that is sold.”

The applicants' position in relation to the trade mark's descriptive character

41. The applicants do not dispute that "JAM JAR" will, as Mr Brandreth puts it, be understood as "...the (usually glass) vessel in which jam comes..." and that "GIN" is the goods for which registration is being sought. In support, Mr Brandreth pointed to a number of examples which, in his view, demonstrated that: "There is not an immediate appreciation...that the name of the product JAM JAR GIN is understood descriptively." These examples, are as follows:

"So, being me, I decided to buy myself a bottle of gin. And one that is only in its second batch of production! Jam Jar Gin..." (Instagram - 20 February 2017) – exhibit FT15, page 3;

"The coolest bottle of alcohol I've seen" (Instagram - 12 November 2016) – exhibit FT15, page 4;

"I do love that in comes in "jars" rather than bottles..." (Instagram - October 2016) – exhibit FT15, page 4;

"Next, a gin and tonic made with the jam jar gin. This was surprise favourite. I wasn't sure of the point of it being in a jam jar but once I used it I understood..." (positivefridays.com – 17 November 2016)) – exhibit FT13, page 2.

42. At the hearing, Mr Brandreth stated:

"We see that in the remark that is made on the bottle in other cases. We say that there is no obvious reason why a jam jar would be used in the making of gin either...There is an oddity, we say, also to the construction of this particular sign. The JAM JAR directly qualifies the GIN, suggesting it is something to do with the gin itself, and that we say is plainly nonsensical. For that reason, we say that there is not an immediately obvious message for the average consumer."

43. Mr Brandreth further argued that although the message conveyed by the applicants' trade mark may be "unpicked", it would be necessary for one to, for example:

"...read into it a missing preposition [i.e. in, from] and overcome the idea that jam jars, although plainly capable of being used as a drinking vessel, aren't usually used as such."

44. Finally, he argued that as the opponent has not argued that the words "JAM JAR" are descriptive of gin, "then it cannot be said that the vessel is other than ancillary [or subsidiary as mentioned in *JW Spear*] to the product in question."

45. In reaching a conclusion, I note that exhibit SG4 to Mr Goodfellow's statement contains the following: (i) an article dated 24 January 2009 from www.telegraph.co.uk entitled "Bar serves cocktails in drinkers' jam jars" in relation to the Time Bar in Leicester. This article is dated over eight years prior to the date of the application and appears on the website of a national newspaper, in relation to which, on the basis of judicial notice, I note has a not insignificant readership, (ii) an article from the *Evening Standard* from 4 April 2011 (over six years prior to the date of application), entitled "London's jam jar revolution" which includes the following "London has gone jam jar crazy...bars and cafes...use them as cocktail glasses..."; once again, I take judicial notice that the *Evening Standard* is a newspaper serving London (the UK's largest city) which also has a not insignificant readership, and (iii) a page from collinsdictionary.com which includes, under the heading "Example sentences containing "jam jar", a sentence which appeared in the *Times* and *Sunday Times* newspapers in 2014 i.e. "They were drinking beer and whisky out of jam jars"; this entry is from at least two and a half years prior to the date of the application and, once again, I take judicial notice of the fact that the *Times* and *Sunday Times* are national newspapers with not insignificant readerships.

46. There is no dispute that by the date of the application in May 2017, the average consumer would have been familiar with both the use of the word "GIN" and the words

“JAM JAR” (the latter to mean a jar in which jam is traditionally sold). However, notwithstanding the examples referred to by Mr Brandreth shown above, by that date it appears to me that a not insignificant number of average consumers would also have been familiar with the use of the words “JAM JAR” as describing an alternative receptacle for holding and out of which one may drink an alcoholic beverage such as a cocktail.

47. Approaching Floyd LJ’s test in *JW Spear* on that basis, I think the questions he posed ought to be answered in the following manner:

- (i) there is a clear relationship between gin and a word which describes, inter alia, a characteristic of the receptacle in which it is sold:
- (ii) a not insignificant number of average consumers would readily construe the applicants’ trade mark as describing gin being sold in a jam jar; and
- (iii) the fact that gin is being sold in a jam jar is an important characteristic.

Having reached those conclusions and absent use, in my view, the applicants’ trade mark falls foul of section 3(1)(c) of the Act. The trade mark describes the kind of goods i.e. gin and the receptacle in which it is sold. The combination sends a clear and direct descriptive message.

Section 3(1)(b) of the Act – legal principles

48. The principles to be applied under article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation, and is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act) were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

“29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared

with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37).”

49. Earlier in this decision, I mentioned that Mr Brandreth considered that if the opposition did not succeed under either sections 3(1)(c) or (d) of the Act, it would not succeed at all, and I highlighted Mr Zweck’s submission in relation to section 3(1)(b) in this regard (in which he broadly agreed with Mr Brandreth’s position). Having reached what I regard as a very clear conclusion under section 3(1)(c) of the Act, I see nothing in the presentation of the applicants’ trade mark (or as Mr Zweck put it that there is something “extra provided by the "Js" or the "Gs" of the words, the order or something like that...”), which lends the trade mark any additional distinctiveness and, as a consequence, it follows that the application is also to be regarded as devoid of any distinctive character under section 3(1)(b) of the Act.

Conclusions in relation to the prima facie acceptability of JAM JAR GIN

50. I have concluded that absent use, the opposition based upon sections 3(1)(b) and (c) of the Act succeed. That of course is not an end of the matter, as the applicants have filed evidence in an effort to establish that the trade mark the subject of their application has acquired distinctiveness through use. I shall return to this question later in this decision.

The opposition based upon section 3(1)(d) of the Act

51. In *Telefon & Buch Verlagsgesellschaft GmbH v OHIM*, Case T-322/03, the General Court (“GC”) summarised the case law of the CJEU under the equivalent of s.3(1)(d) of the Act, as follows:

“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 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)."

The decisions in *Merz & Krell GmbH & Co* [2002] ETMR 21 (CJEU) and *Stash Trade Mark* – BL O/281/04 (Appointed Person) are also relevant.

52. While at the hearing Mr Zweck accepted that the average consumer included both those in the trade and end users, he characterised the relevant trade as “the food and beverage section of the ordinary consumer goods market”, pointing out it was the views of the end user that were decisive. If I was against him on his characterisation of the relevant trade mentioned above, he argued that the relevant trade should be regarded as “the alcoholic beverages industry or the section within that trade.” He further argued:

“The question is not whether the precise formulation of the sign has become customary in the trade, in my submission, but whether the sign, as the words of the Act say, “consists exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade”. In other words, whether it consists entirely of signs which have become customary....”

And:

“In my submission, the evidence here demonstrates that consumers in the food and beverage industry would have understood “jam jar”, when combined with some non-jam product to refer to the vessel in which the product was being sold. In other words, it is customary of non-jam jar use as a container.”

53. By reference to exhibit SG4, at the hearing, Mr Zweck took me through a number of examples which he felt assisted the opponent’s case. These included:

24 June 2015 (UK) – “Jam Jar Sponge Cake” (page 37);

24 January 2009 (UK) – “Bar serves cocktails in drinkers’ jam jars” (page 52);

2013 (UK) – “Beatson Clark causes a stir with cocktail jam jars” which, Mr Zweck noted, contained a reference to a Singapore Sling i.e. a gin based cocktail (page 53);

28 August 2012 (UK) – “...WEDDING JAM JAR COCKTAILS” (page 56);

4 April 2011 (UK) – “London’s jam jar revolution” (page 88).

54. Although I have not included: (i) examples which Mr Brandreth pointed out were references to the applicants, (ii) those which are from after the material date or (iii) from outside the UK, in reaching a conclusion, I keep in mind that in relation to points (ii) and (iii), Mr Zweck noted that in *Alcon Inc v OHIM*, Case C-192/03 P, the CJEU stated:

“41. Moreover, the Court of First Instance could without inconsistency in its reasoning or error of law take account of material which, although subsequent to the date of filing the application, enabled the drawing of conclusions on the situation as it was on that date (see, by analogy, the order in Case C-259/02 *La Mer Technology* [2004] ECR I-0000, paragraph 31).

42. In the second part of this plea, the appellant submits that the Court of First Instance took into consideration, in [44] of the judgment under appeal, certain documents published in the United States. However, that circumstance does not establish that the Court of First Instance based its analysis on evidence that did not affect the target public. By stating in [42] of the judgment under appeal that English was the technical language of specialists in the relevant field, and by referring in [43] of the judgment under appeal to the perception of the term BSS as a generic term by the “scientific community”, the Court of First Instance necessarily considered that those documents, although published outside the European Union, supported the conclusion that the target public regarded that term as having become customary. In so doing it made an assessment of pure fact, which the appellant cannot challenge on appeal.”

55. For his part, Mr Brandreth argued:

“This head of objection, we say, requires evidence that the mark has become generic for goods for which it is seeking registration; that is to say, that JAM JAR GIN has become a customary reference for gin...”.

56. Mr Brandreth argued that the opponent had not come close to making out its objection under this ground. He stated:

“...These are the exhibits where we have alcohol being put in a jam jar glass... We say that these pages simply demonstrate what was already acknowledged, namely, that you can drink out of a jam jar. That's why the references are all to generic cocktails. They are not to a particular product. Importantly, there is no reference here...to JAM JAR GIN, although there are some cocktails that we might assume contain gin. But the absence of others using JAM JAR GIN to identify gin is, in my submission, fatal to the 3(1)(d) ground...”

57. Notwithstanding Mr Zweck's submissions to the contrary, to use his words, it is, in my view, the “precise formulation” of the trade mark applied for that I must consider by reference to the relevant trade, which, in my view, is the trade in gin (and not the alternatives suggested by Mr Zweck).

58. While the opponent's evidence includes, inter alia, examples from the United Kingdom which are dated prior to the material date and which show use of the words “Jam Jar” in relation to a range of goods (including cocktails), there is, as Mr Brandreth points out, no evidence of the words “JAM JAR GIN” being used by others conducting a trade in gin. In my view, absent such evidence, the opposition based upon section 3(1)(d) of the Act cannot succeed and is, as a consequence, dismissed accordingly.

Acquired distinctiveness

59. Having concluded that when considered on a prima facie basis the applicants' trade mark is open to objection under sections 3(1)(b) and (c) of the Act, I must now go on and determine if it has acquired a distinctive character as a result of the use that has been made of it prior to the date of application in May 2017.

60. The CJEU provided guidance in *Windsurfing Chiemsee*, Joined cases C-108 & C-109/97, about the correct approach with regard to the assessment of the acquisition of distinctive character through use. The guidance is as follows:

“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).”

Overview of the applicants’ use

61. In summary, the applicants’ evidence shows that a crowdfunding campaign for their gin was launched on 26 November 2014 (i.e. some two and a half years prior to the filing of their application for registration). However, the trade mark the subject of the application appeared on the applicants’ website in September 2014. Although the applicants’ trade mark has been updated since its first use, in all the examples provided, *inter alia*, the word “Yerburgh’s” (in varying cases and degrees of stylisation) appears in smaller letters above the words “JAM JAR GIN”, some examples of which are shown in exhibit FT3 and look like this:





62. On 19 March 2015, the first batch of gin was sent to those who had supported the crowd-funding campaign. The fact that the applicants' gin was, inter alia, the UK's first crowd-funded gin generated attention, initially in the trade press and later in a range of main stream publications, such as *Vogue*, *House & Garden* and *GQ*. The applicants' gin has appeared in a wide range of social media posts and on its own Facebook page (from September 2014), Twitter (from October 2014), Instagram (from March 2015) and Pinterest (from September 2015). The activity on these social media platforms is shown earlier in this decision. The applicants' gin has been promoted through email shots and at trade shows, exhibitions and gin festivals.

63. The applicants' gin, has won a number of awards in, inter alia, the UK and is sold by a wide variety of retailers (including on line) by, for example, Harvey Nichols, Fortnum & Mason and Amazon; in addition, it is served in a wide range of hotels, bars and

restaurants. In the period 2014-2018 the applicants' turnover amounted to £109k, with turnover in the periods 2015/16 and 2016/2017 amounting to £29k and £40k, respectively.

64. In support of their application, the applicants have provided four witness statements and a "to whom it may concern" letter (the latter of which it was agreed at the hearing should be treated as hearsay evidence). These statements are from individuals in the trade who all attest to knowing of JAM JAR GIN (since as early as 2014), associate it with the applicants and know of no other party using these words as a trade mark.

The opponent's position

65. At the hearing, Mr Zweck stated:

"The evidence, in my submission, that has been provided overwhelmingly amounts to evidence of use of the sign in the context of the sign YERBURGH'S JAM JAR GIN as distinct from JAM JAR GIN solus. No doubt Mr Brandreth will take you to the one or two instances of use where we could see texts which just said "JAM JAR GIN", but if you look at the actual trade mark use there is almost inevitably either a picture of the YERBURGH JAM JAR with the label or the writing says "YERBURGH JAM JAR GIN".

66. As to the evidence of the results of a Google search for the term "JAM JAR GIN" conducted on 6 June 2018 and provided as exhibit FT12 (upon which the opponent commented in its reply evidence and which led to the filing of further evidence by both parties), at the hearing, Mr Zweck stated:

"...for that reason that I do not see their forensic benefit, if you like, to the applicant. All they show is that if you type "JAM JAR GIN" into Google you get some hits. The results that come up are YERBURGH JAM JAR GIN. That is the descriptive part of the trade mark. I just do not see how it cures the *British Sugar*

problem. In my submission, the search results just do not get the applicant anywhere.”

67. Insofar as the trade evidence is concerned, Mr Zweck submitted that it was evidence of the individual’s perception in 2018 and not at the material date. He further submitted that even if it did relate to the material date, as the evidence was from traders (and not the general public) and as those providing evidence were not independent: “because they have a vested interest in giving helpful evidence to the applicants because of their commercial or trade connections to the applicants”, it did not assist the applicants in any case.

68. Finally, Mr Zweck argued that irrespective of the above, given the size of the gin market in the UK (in relation to which he referred to exhibit LSH6), the quantum of use by the applicants was simply too low to justify acceptance on the basis of acquired distinctiveness through use.

The applicants’ position

69. The Google search was conducted over a year after the material date. At the hearing, Mr Brandreth submitted:

“They are all references to my client’s product, even if you go deep, deep into the Google search.”

70. In relation to Mr Zweck’s criticisms of the applicants’ evidence from the trade, I agree with Mr Brandreth that: (i) the views of such individuals have some relevance and must be taken into account, (ii) when read in context the individuals concerned speak to the position prior to the material date, and (iii) with the possible exception of Mr Edwards (whose business is an official partner of the applicants), the other individuals are, it appears, to use Mr Brandreth’s words “not beholden” to the applicants. Although Mr Cook’s evidence is to be regarded as hearsay, as his evidence is to the same effect

as, inter alia, that of Mr Hicklin (also from the Gin Guild), applying the guidance provided in section 4 of the Civil Evidence Act 1995, it can, in my view, be given a reasonable amount of weight.

71. In relation to Mr Zweck's submissions regarding the use of the words "JAM JAR GIN" with the word "Yerburgh's", in his skeleton argument, Mr Brandreth pointed out that: "It is no objection to acquired distinctiveness that JAM JAR GIN was used alongside another mark." In his skeleton argument, he stated:

"27. A point that is taken by the Opponent is that the sign used by the Applicant is "Yerburgh's Jam Jar Gin". It is correct that the packaging and some other references use "Yerburgh" in addition to JAM JAR GIN. However, only the latter is used on every occasion. The gin is never referred to as "Yerburgh's" alone. However, it is frequently identified as JAM JAR GIN on its own; in the domain name for example..."

72. Some of the examples referred to by Mr Brandreth (in his skeleton argument and at the hearing) are shown below.

27 November 2014 (FT1, page 2):

GIN REVIEW, NAKED TASTING

Gin tasting: Jam Jar Gin, Botanical No. 1

NOVEMBER 27, 2014

LADYJENEVER

COCKTAILS, GANDT, GIN,
GINANDTONIC, GINCLUB,
HOMEBAR, JAMJARGIN,
MIXOLOGY

LEAVE A COMMENT

Hand's up if you've heard of Yerburgh's JAM JAR GIN? No? We hadn't either. Jam Jar Gin is a new gin that hasn't even made it to market yet, but this evening they made their crowd-funding target just 3 days after it went live. You can imagine how chuffed we were here at The Gin Club to get some samples of their first born to try! We tried Botanical No. 1 and can confirm it really does the Founders, Dan and Faye Thwaites, proud.

March 2015 (FT9, page 8):

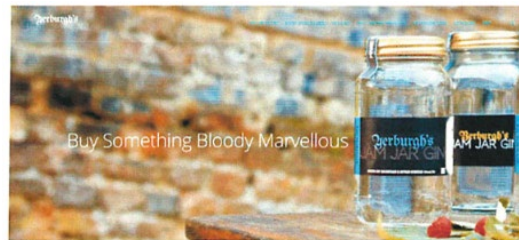


June 2015 (FT16, page 13):



Now even more people can get their hands on Jam Jar Gin!

And:



Jam Jar Gin - now available online!

July 2016 – *Vogue*: “11. Yerburch’s **JAM JAR GIN**...is the best of British summer in a jar...” (FT10, page 2);

July 2016 – *House & Garden* – substantially as above (FT10, page 3);

October 2016 (FT2, page 22):



November 2016 (FT13, page 2):



Next, a gin and tonic made with the Jam Jar gin. This was surprise favourite. I wasn't sure of the point of it being in a jam jar but once I tried it I understood. A fruity and almost creamy gin, this tasted like summer. Beautiful with the tonic. The full size gin comes in a mason jar, which is a tad cutesy but I'll over-look it because I enjoyed it so much.

And:



January and March 2017 (FT14, page 7):



Considerations and conclusions on acquired distinctiveness

73. In reaching a conclusion, I begin by reminding myself that earlier in this decision I concluded that the words “JAM JAR GIN” were, absent use, open to objection under sections 3(1)(b) and (c) of the Act.

74. At the hearing, Mr Brandreth’s submitted that although the words “JAM JAR GIN” have been used together with the word “Yerburgh’s”, that does not prevent them acquiring distinctive character in their own right. That is, of course, correct and is borne out by comments of the CJEU in *Société des Produits Nestlé SA v Mars UK Ltd*, Case C-353/03, when it held:

“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.”

75. However, in reaching a conclusion, I remind myself of the comments of the GC in *Audi AG, Volkswagen AG v OHIM*, Case T-318/09, in which the court stated:

“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)...”.

76. At the material date, the applicants’ had used the words the subject of the application for a little under three years. I accept that the applicants’ gin has attracted a good deal of interest, has featured in a wide range of publications, on websites and social media platforms, has won a number of awards and been promoted at tradeshow, exhibitions etc. Their gin is sold by a range of retailers (some of which are very well-known) both from bricks and mortar retail outlets and on-line and is available in a range of bars and restaurants. The evidence indicates that the applicants’ premium gin is well regarded. Although in the period 2014-2018 the applicants sold £109k of their gin bearing the above words, given the material date in these proceedings, not all of these sales can be taken into account.

77. The article from the *Guardian* provided as exhibit LSH6 indicates that in 2016, the market for gin in the United Kingdom amounted to £1bn. In her statement, Ms Harris stated:

“Even if one were to limit to the 'premium' or 'boutique' end of the gin market, the figures for YERBURGH'S JAM JAR GIN are still extremely small..... Based on these figures alone, the turnover of the Applicants is de minimis in the premium gin market.”

78. Although the applicants' have not provided any indication of the percentage market share their gin enjoys, even if one considers the totality of their turnover from 2014-2018 (i.e. £109k) in the context of the (smaller) premium gin market, I find Ms Harris' conclusions difficult to fault.

79. Finally, there are the statements from the trade indicating that the five individuals concerned: (i) recognise the words JAM JAR GIN as indicating the trade origin of the applicants' gin, (ii) know of no other party using these words, and (iii) the various examples referred to by Mr Brandreth in which members of the general public appear to be construing the words JAM JAR GIN as indicating trade origin. At the hearing, Mr Brandreth pointed out that the opponent had not filed any evidence to counter the applicant's evidence from the trade; that is true.

80. However, while I accept Mr Brandreth's submission that "the courts have set their face against survey evidence and the costs associated with it", in cases such as this where a consumer product such as gin is in issue and the trade mark for which registration is being sought is, in my view at least, descriptive, it is the views of the end consumer i.e. members of the general public that are, in my opinion, of paramount importance.

81. I accept that, inter alia, some members of the general public have identified the words JAM JAR GIN as denoting trade origin. However, keeping in mind, inter alia, the descriptive nature of those words for gin sold in a jam jar, the relatively short duration of use prior to the material date, the size of the UK market for gin in 2016 (of which the market for premium gin is likely to be significant) and the very modest turnover achieved by the applicants, I am not prepared to accept that on the basis of the evidence provided, that reaction would apply to a significant proportion of such average consumers.

82. The fact that the vast majority of the applicants' evidence shows the words "JAM JAR GIN" being used together with a distinctive house mark i.e. the word "Yerburgh's"

is, in my view, far more likely than not to indicate to the vast majority of gin buying members of the general public, that the applicants' gin is sold in a jam jar and emanates from a undertaking called "Yerburgh's". In view of those conclusions, the evidence filed by the applicants is, in my view, insufficient to justify acceptance of the application on the basis of acquired distinctiveness and the opposition based upon Sections 3(1)(b) and (c) of the Act succeeds accordingly.

Overall conclusions

83. Although the opposition based upon section 3(1)(d) of the Act has failed, the oppositions based upon sections 3(1)(b) and (c) of the Act have succeeded and, subject to any successful appeal, the application will be refused.

Costs

84. As the opponent has been successful, it is entitled to a contribution towards its costs. At the hearing, both counsel agreed that costs should be on the scale. Awards of costs in proceedings are governed by Annex A of Tribunal Practice Notice 2 of 2016. Applying the guidance in the TPN, I award costs to the opponent on the following basis:

Preparing a Notice of Opposition and reviewing the counterstatement:	£300
Official fee:	£200
Preparing evidence and considering and commenting on the other side's evidence (including the further evidence):	£1000

Preparing for and attending a hearing £1000
(including written submissions filed during the
evidence rounds):

Total: £2500

85. I order Faye Thwaites and Daniel Michael Leslie Thwaites (being jointly and severally liable) to pay to Wilkin & Sons Ltd the sum of **£2500**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 29th day of January 2019

C J BOWEN
For the Registrar

(1)

Trade Mark No: EUTM 8372856
Mark text: JAMJAR
Date applied for: 18/6/09
Date registered: 1/12/09
Goods: Wine
Owner: Cape Classics Brands, LLC

(2)

Trade Mark No: UK 3129992
Mark text: GLASS VODKA
Date applied for: 5/10/15
Date registered: 4/3/16
Goods: Vodka
Owner: Lachselian Wine & Spirits LLLP

(3)

Trade Mark No: UK 3239786
Mark text: Sea Glass Gin
Date applied for: 27/6/17
Date registered: 27/10/17
Goods: Gin
Owner: Gin Corporation Limited

(4)

Trade Mark No: UK 3112057

Mark text: Gin Jar

Date applied for: 5/6/15

Date registered: 11/12/15

Goods and services:

Class 33 - Gin; Distilled spirits; Distilled beverages; Alcoholic beverages containing fruit; Alcoholic beverages except beers.

Class 40 - Spirits distillery services.

Owner: Christopher Jefferies