

O/596/22

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK REGISTRATIONS 3231402 AND 3311810
IN THE NAME OF ANALYST
LOUNGE LTD**

FOR THE TRADE MARKS:

**NORDIC SOCK
COMPANY**

AND

**THE NORDIC SOCK
COMPANY**

IN CLASS 25

AND

**IN THE MATTER OF CONSOLIDATED
APPLICATIONS FOR A DECLARATION OF
INVALIDITY THERETO
UNDER NOS. 503924 AND 503925
BY BOKYNA GMBH**

BACKGROUND AND PLEADINGS

1. On 16 May 2017 and 18 May 2018, respectively, Analyst Lounge Ltd (“the proprietor”) applied to register the following trade marks in the United Kingdom:

United Kingdom Trade Mark (“UKTM”) 3231402

Nordic Sock Company

(“the proprietor’s first mark”)

UKTM 3311810

The Nordic Sock Company

(“the proprietor’s second mark”)

2. The proprietor’s first mark was registered on 4 August 2017 in respect of *bed socks; slipper socks; socks; thermal socks*. The proprietor’s second mark was registered on 31 August 2018 in respect of *socks; socks and stockings; socks for infants and toddlers; woollen socks*.

3. On 14 June 2021, Bokyna GmbH (“the applicant”) applied to have the aforementioned marks declared invalid pursuant to section 47 of the Trade Marks Act 1994 (“the Act”). The proceedings were consolidated on 26 August 2021 following the filing of the proprietor’s counterstatements. The applications are brought under sections 3(1)(b) and 3(1)(c) of the Act and are directed against all goods for which the contested marks are registered.

4. In regard to its claim under section 3(1)(b), the applicant contends that the earlier marks comprise elements which, when viewed as a whole, will be regarded as a description of the kind of goods being offered under the mark, i.e. a company selling socks manufactured in, or linked in some way, to the Nordic region, and are therefore devoid of distinctive character. As for its claim under section 3(1)(c), the applicant submits that the relationship between the marks and goods is sufficiently ‘direct and

specific' that the relevant public would immediately perceive a description of the goods in question, or at least one of the goods' characteristics.

5. In its counterstatements, the proprietor denies that the contested marks are descriptive or devoid of distinctive character, stating that there is no generic use or immediately understood meaning of the term 'Nordic Sock'. It acknowledges that whilst "Nordic" may have a geographical connotation, it is also used as an adjective in the context of (i) skiing, cross-country skiing, ski-jumping and recreational walking and (ii) a subdivision of the Caucasoid race. Additionally, it claims that the contested marks have an acquired distinctiveness on account of the use made of it in the UK since 2017.

6. The applicant is represented by BDB Pitmans LLP and the proprietor by Stevens & Bolton LLP. Both parties filed evidence in chief and the applicant filed evidence in reply. The applicant also filed written submissions during the evidence rounds. Both parties were given the opportunity to request an oral hearing or file written submissions in lieu and each declined to do so.

7. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive and, therefore, this decision continues to make reference to the trade mark case law of the EU courts.

EVIDENCE AND SUBMISSIONS

8. The applicant's evidence in chief comprises a witness statement from Mr Thomas Robson, an attorney with BDB Pitmans LLP, dated 26 October 2021, and supporting exhibits TR1 to TR3.

9. Enclosed at Exhibits TR1 and TR2, respectively, are dictionary definitions of the words 'Nordic' and 'sock', sourced from the Cambridge Online Dictionary. Those extracts are reproduced below:

Nordic

adjective

UK  /'nɔː.dɪk/ US  /'nɔːr.dɪk/

belonging to or relating to Scandinavia, Finland, or Iceland:

- He's a classic Nordic type - tall with blond hair and blue eyes.

sock

noun

UK  /sɒk/ US  /sɑːk/

sock noun (CLOTHES)



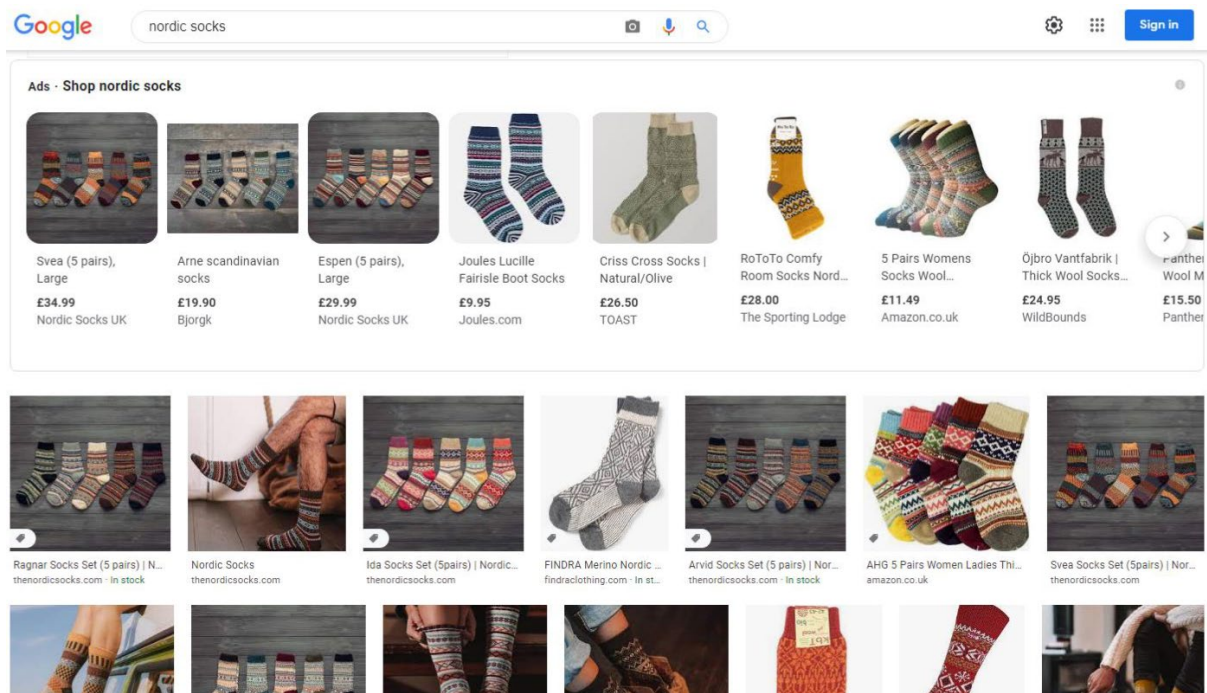
Dimedrol/Si/Stock/Getty Images Plus/Getty Images

A2 [C]

a piece of clothing made from soft material that covers your foot and the lower part of your leg:

- a pair of socks
- nylon/woollen/cotton socks
- thermal socks
- ankle/knee socks
- Put on your **shoes and** socks.
- The little boy was wearing **odd** socks (= socks of different colours).

10. At Exhibit TR3, Mr Robson attaches the results (at least the first two pages) of a Google search for the term 'nordic socks', together with a Google image search for the same term. The results show a number of third party retailer websites (and the proprietor's), including Amazon and Etsy, offering 'nordic socks' for sale. The image search results are shown below.



The screenshot shows a Google search for "nordic socks". The search bar at the top contains the text "nordic socks". Below the search bar, there are several advertisements for "Shop nordic socks". Each ad features a product image, a title, a price, and the retailer's name. The products include various styles of socks, such as "Svea (5 pairs), Large", "Arne scandinavian socks", "Espen (5 pairs), Large", "Joules Lucille Fairisle Boot Socks", "Criss Cross Socks | Natural/Olive", "RoToTo Comfy Room Socks Nord...", "5 Pairs Womens Socks Wool...", and "Öjbro Vantfabrik | Thick Wool Socks...". The prices range from £9.95 to £34.99. Below the advertisements, there are two rows of image search results, each showing a different pair of nordic socks with various patterns and colors.

11. In the applicant's submissions, filed alongside, it points me toward a direction laid out in the UK IPO Trade Mark Manual, specifically the examination guide. It states:

"Company names

The term 'company' or 'limited' paired with a word (or words) which describes the goods and/or services intended for protection is unlikely to meet the requirements for registration on the basis that the resulting combination would still be descriptive and/or devoid of any distinctive character. For example, the sign 'Soap Company' would not be acceptable as it merely describes a company that produces soap. Similarly, the sign 'The Organic Food Company' would also be unacceptable as there are likely to be a large number of organic food producers which would refer to themselves as being the definitive organic food company.

The addition of 'company limited' or 'Plc' may provide some capacity to indicate trade origin, rather than just as a generic reference to a particular type of business activity. For example the mark 'The Puppet Company' would be considered to be descriptive whereas 'The Puppet Company Limited' would indicate trade origin and considered to be acceptable.

The addition of a company name to words describing characteristics of the goods or services, rather than the generic name of the goods themselves, will usually be sufficient to bestow distinctive character e.g. the mark 'Soft and Gentle' would not be acceptable for soap whereas 'Soft and Gentle Limited' would be seen as fanciful and therefore acceptable."

12. Weighing that approach against its earlier definitions of *Nordic* and *Sock*, the applicant maintains that the average consumer would view the proprietor's marks as 'a company retailing socks originating or inspired in some way by the aforementioned geographical locations' and concludes that 'the marks as a whole are not more than the sum of the descriptive parts'. The applicant addresses the proprietor's submission insofar as it claims that *Nordic* is also used as an adjective in the context of various activities (detailed at paragraph 5) and a subdivision of the Caucasoid race, deeming

it irrelevant. The applicant directs me to the *Doublemint*¹ case, in which the CJEU found that a mark should be rejected if only *one* of its possible meanings designates a characteristic of the relevant goods or services. It contends that the marks will be easily perceived as a general indication of an unspecified company which markets socks of Nordic origin and that its evidence shows a public interest in keeping the term ‘Nordic Socks’ available for use (by other parties), stating that there a large number of undertakings using the term, selling socks with a Nordic connection, with the socks all appearing to be woolen, thick and (frequently) with distinctive knitted patterns.

The proprietor’s evidence in chief

13. The proprietor’s evidence consists of a witness statement from its founder and managing director, Mr Kristo Mikkonen, dated 28 December 2021, together with Exhibits KM1 to KM9. Mr Mikkonen explains that the Nordic Sock Company was established in 2017, intending to sell ‘premium quality knitted socks’ that had a link to Mr Mikkonen’s family roots in Finland. Mr Mikkonen contends that, at the time of registering the domain name www.nordicsockcompany.com in March of 2017, the name was not in use and it was not a widely used term in the UK to describe socks originating from Nordic countries. At Exhibit KM1 is an example of one of the opponent’s first designs alongside images of the socks currently offered on its website.



Early design from 2017

Our Current Range:

			
Classic Nordic Socks - Midnight Blue £12.00	Denish Hygge Socks - Nordic Noir £13.00	Denish Hygge Socks - Sky Grey £13.00	Hand Knitted Wool Finnish Socks £25.00 <input type="button" value="add to cart"/>
			
Icelandic Saga Socks - Nordic Red £13.00	Norwegian Fjord Socks - Warm Durable Winter Socks £13.00	Sisu of Finland - Baltic Blue £13.00	Swedish Lagom Socks - Heather Grey £13.00
			
Swedish Lagom Socks - Warm Ochre £13.00	Ultra Warm Finnish Wool Socks - Black £16.00	Ultra Warm Finnish Wool Socks - Charcoal Grey £16.00 <input type="button" value="add to cart"/>	

¹ Wrigley (*Doublemint*), Case C-191/01P [2003] ECR I-12447 (AG)

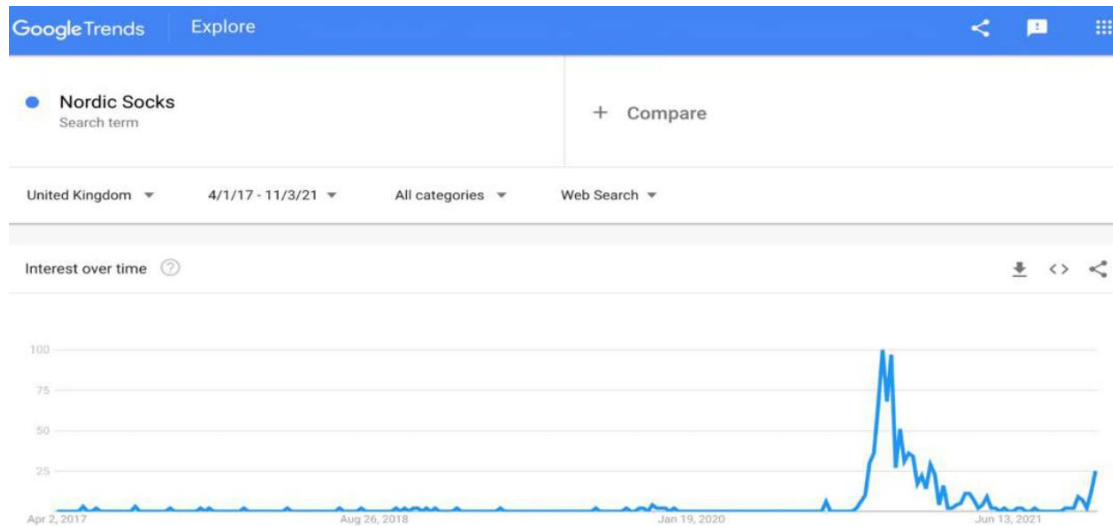
14. The proprietor’s first online sales commenced in October of 2017. At Exhibit KM2 is an email from Amazon.co.uk to the proprietor confirming a sale of its ‘Classic Nordic Socks’ on 14 October 2017. The quantity is 1 and the item price is £7.99. Since then Mr Mikkonen submits that the proprietor has ‘grown significantly’, selling through online channels via its own site, Amazon and Drury Edit; boutique resellers in London, USA and France and via partnerships with UK subscription box providers such as Mind Body & Soil.

15. In 2018 the proprietor entered The Nordic Sock Company into the Amazon brand registry. Since 2017 it has sold over 20,000 pairs of socks to UK consumers, generating sales of over £250,000. Mr Mikkonen states that ‘in the same period’, presumably from 2017 to the date his witness statement was drafted, the proprietor has invested over £25,000 on advertising and marketing. Its website has attracted more than 150,000 unique visitors (the majority from the UK) and its Amazon UK listings have generated over 100,000 views.

16. The proprietor’s brand was featured in a photoshoot for British Vogue (November 2020 issue), released in October of 2020, giving rise to what Mr Mikkonen describes as a ‘surge of interest’ (in the term ‘Nordic Socks’).



17. At Exhibit KM4 is a graph provided by Google Trends showing the prevalence of the search term 'Nordic Socks' in the UK from January 2017 to March 2021. The graph is reproduced below:



Mr Mikkonen submits that, around the time of the popularity 'surge', other companies began to imitate the style of the proprietor's goods and adopt the term 'nordic socks'.

18. The remaining content of Mr Mikkonen's statement, and the remaining exhibits, go to the applicant's behaviour from October 2020 onwards. He submits that the applicant registered the domain names *www.thenordicsocks.com* and *thenordicsocks.co.uk* in October of 2020 and that, as a consequence, the proprietor 'immediately' noticed confusion in the market and received complaints from the applicant's customers, having mistaken the parties for one another. Mr Mikkonen's understanding is that the applicant is based in Germany but does not design or manufacture its own products, instead operating as a 'dropshipper'; described by *Wired* as "the middleman in a globalized supply chain"².

19. The proprietor encloses a non-exhaustive selection of messages and complaints received from third parties at Exhibits KM5 and KM6. A sample of those are shown below:

² <https://www.wired.co.uk/article/dropshipping-instagram-ads>

robin betland <robin.1961@hotmail.com>
to me ▾

Tue, Dec 8, 2020, 7:28 PM ☆ ↶ ⋮

Hello, my name is Robin Betland. On December 4, I placed an order with your company. I have not received a confirmation or order number, although the funds have been paid out for the order.
Can you please let me know if the order is being processed.
Thank you,
Robin Betland.

Nordic Sock Company <hello@nordicsockcompany.com>
to robin ▾

Tue, Dec 8, 2020, 10:44 PM ☆ ↶ ⋮

Hi Robin,

Sorry to hear this.

Recently there have been a number of stores that have popped up with very similar names and branding to ours. We get a lot of their angry customers contacting us. We are 'nordicsockcompany.com' and our email address is 'hello@nordicsockcompany.com', if you bought socks from a different URL you have not ordered from us. We only sell our socks in shops or through Amazon. We do not advertise on Facebook or Instagram, if you bought socks through a Facebook or Instagram ad you have not ordered from us.

Please check out these reviews from TrustPilot relating to a company called 'The Nordic Socks' (who are not affiliated to us), I believe you may have ordered from them:

<https://www.trustpilot.com/review/nordicsocks.com>

robin betland <robin.1961@hotmail.com>
to me ▾

Tue, Dec 8, 2020, 11:03 PM

Thank you for responding so quickly, Kristo.
Rats, I did order from a Facebook ad. Well, live and learn. I will visit your real site and buy from you. I will try to dispute the charge on my account. I will let others know of the scam.
Again, thank you for getting back so promptly.
Sincerely, Robin Betland.

Mark Smedley <mfpsmedley@gmail.com>
to me ▾

Tue, Dec 15, 2020, 9:12 PM ☆ ↶ ⋮

Hello

Does your company have any association with this company:
<https://uk.thenordicsocks.com/pages/our-story> ?

I am trying to buy genuine socks made in Europe/Scandinavia, rather than Chinese.

Yours sincerely
Mark Smedley, mfpsmedley@gmail.com, +44 (0) 7790597878

Nordic Sock Company

Wed, Dec 16, 2020, 10:29 AM ☆

Hi Mark, We have no association with them and you are right that they in fact make their socks in China. All of ou...

Mark Smedley

Wed, Dec 16, 2020, 3:32 PM

to me

Hello Kristo,

thenordicsocks.com seems to be an egregious rip-off, copying your logo design and the overall look of your website.

This Chinese outfit seems to be blitzing UK customers through Facebook and WhatsApp ads in the final two weeks before Christmas.

I think it got my WhatsApp phone number through a prior clothing order from what turned out to be a Chinese co.

Thanks for your info.

Possible counterfeit socks External Inbox x

shagrunner <shagrunner@gmail.com>
to me

Thu, Oct 21, 2:23 AM



I recently purchased a set of 5 pairs of socks from a company calling itself The Nordic Sock Company with a website of www.nordicsock.com. 3 of the 5 pairs had holes in the heels when they arrived. It looks like the company I ordered from might not be you. Please advise...

Jeff Nichols

Remove Preview · 44 w



Jackie Sinclair

I've deleted my dissatisfied comments because I've realised you are correct, the company who is providing a very poor service is thenordicsocks.com, not yourselves. How difficult for you to be fighting THEIR negative publicity and congratulations on k... See more

Like · Reply · Hide · 44 w · Edited



Author

Nordic Sock Company

Jackie Sinclair Not your fault! You would not be the first to mistake us for them.

1

Like · Reply · Commented on by Kristo Mikkonen · 44 w



Author

Nordic Sock Company

Jackie Sinclair And I thank you for it. 😊

Like · Reply · Commented on by Kristo Mikkonen · 44 w



Jackie Sinclair

Nordic Sock Company I write this comment because I notice so many people commenting and making the same error.

Like · Reply · Hide · 44 w

20. At Exhibit KM7, Mr Mikkonen provides an extract from Trust Pilot showing reviews of *Nordicsocks*. There are four reviews in total, all allocating one star (of five), with their headings reading ‘This company is a total shambles’; ‘It’s a scam’; ‘If something is too good to be true...’ and ‘Inferior product’. At Exhibit KM8, a Trust Pilot review of ‘Uk Thenordicsocks’ reads:

“Awful. This is not the “real” Nordic Sock company (nordicsockcompany dot com), it’s a fake copy (thenordicsocks dot co dot uk/) and they sell terrible quality products at highly inflated prices with no customer support. They come from China and ship from Germany (if you wait forever).

I was fooled – you can avoid disappointment!”

21. Exhibit KM9 comprises pages from the applicant’s website. Mr Mikkonen also provides an image combining a screenshot from the applicant’s Facebook page with a screenshot from Ali Express where the same products are seemingly sold by an entity called ‘Cotton Idea’, shown below:



22. Mr Mikkonen's witness statement concludes with a timeline of the proceedings between the parties, summarised as follows:

23 In May 2021 I instructed our solicitors to send a letter before action to the Applicant alleging trade mark infringement and passing off. In response the Applicant:

- (a) made the present applications for cancellation of our UK trade marks;
- (b) made equivalent applications against our EU Trade Marks; and
- (c) applied for its own national German trade marks for "Nordic Socks" and its logo.

The applicant's evidence in reply

23. The applicant's second witness statement, filed in reply, was made by Mr Patrick Trost, sole shareholder and managing director of Bokyna GmbH, on 28 February 2022. Mr Trost explains that the applicant's socks were initially manufactured in China but, since 2021, have been produced exclusively in Europe. He maintains that its socks have never been purchased from Ali Express and that, for UK purchases, the socks are shipped from the applicant's warehouse.

24. As for the name NORDIC SOCKS, Mr Trost explains that it was adopted by the applicant in 2020 because it is "descriptive of the style of the products and would be a simple and straightforward communicative tool for potential customers." He also submits that the term is an adaptation of the German phrase 'Socken im nordischen Stil', often used to describe the style of socks retailed by the applicant, translated as 'socks of Nordic style' or 'Norwegersocken'.

25. Mr Prost denies that the applicant is intending to unfairly transfer the economic success of the proprietor to itself and states that the applicant's invalidation application is entirely legitimate.

Confusion between the parties

26. As I've said, much of the proprietor's submissions and evidence goes to consumers' confusion and the applicant's intention to capitalize on the opponent's

success in some way or mislead the relevant public. Notwithstanding any tension which may exist in that regard, the matter which has been brought before me to determine is whether the contested mark is objectionable under section 3(1)(b) or 3(1)(c) of the Act, and that is where I will direct my attention.

DECISION

27. In invalidation proceedings, section 3 of the Act has application because of the provisions of section 47(1), which stipulates:

“47. (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, has after registration acquired a distinctive character in relation to the goods or services for which it is registered.”

28. The relevant parts of section 3(1) of the Act read 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) [...]

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.”

29. The relevant date for determining whether the marks are objectionable under the above provisions is the filing date of the contested applications, namely, 16 May 2017 and 18 May 2018, respectively.

30. I bear in mind that the above 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)(b).³

31. Ms Anna Carboni, sitting as the Appointed Person in *Combi Steam*, BL O/363/09, explained:

“It has been said that lack of distinctive character is the essence of any objection under section 3(1)(b), (c) or (d) of the Act and that, despite its position in the list, section 3(1)(b) performs “a residual or sweeping-up function”, backing up the other two provisions, which contain specific and characteristic examples of types of marks that lack distinctive character: *Procter & Gamble Ltd’s Trade Mark Application* [1999] RPC 673 (CA) per Robert Walker LJ at 679. If a trade mark is entirely descriptive of characteristics of goods or services (and thereby prohibited from registration under section 3(1)(c)), it will also be devoid of any distinctive character under section 3(1)(b): *Case C-363/99 Koninklijke KPN Nederland BV v Benelux- Merkenbureau* (POSTKANTOOR) [2004] ETMR 57 (ECJ) at [86]. However, the converse is not true: a mark which is not descriptive may nevertheless be devoid of distinctive character for other reasons (ibid.).”

32. In *Flying Scotsman*, BL O/313/11, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, observed:

³ *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P, paragraph 25

“19. Since there is no obligation to rule on the possible dividing line between the concept of lack of distinctiveness and that of minimum distinctiveness when assessing the registerability of a sign under Section 3(1)(b), see Case C-104/00 P *Deutsche Krankenversicherung AG v OHIM (COMPANYLINE)* [2002] ECR I7561 at paragraph [20], it is not necessary to dwell on the question of how far Section 3(1)(b) may go in preventing registration beyond the scope of Section 3(1)(c). It is sufficient to observe that a sign may be:

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

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

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

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

33. In applying the above caselaw, if I were to find that the contested marks are descriptive, it follows that they would necessarily be devoid of any distinctive character.

34. The position under the above grounds must be assessed from the perspective of the average consumer, who is deemed to be reasonably observant and circumspect.⁴ The average consumer will vary depending on the particular goods and services concerned. In the present proceedings, the average consumer of the goods is likely to be a member of the general public. In my experience, the purchase will be relatively frequent and the goods are typically inexpensive. It seems likely, on balance, that

⁴ *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04

between a low and medium degree of attention will be paid to the goods' purchase, with the consumer alive to considerations such as comfort, size and durability.

35. 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)."

36. Each of the contested marks comprise word elements only; one comprising three words and the other four words. In both marks, the words hang together as a unit, with none appearing of greater dominance, though admittedly the word 'The' in the proprietor's second mark plays a lesser role on account of its nature, typically serving as a determiner. As the definitions of 'Nordic' and 'Sock' provided by the applicant in its evidence in chief marry with my own understanding and, in my experience, are indicative of how the words will be interpreted by the average consumer, I am willing to accept them. Additionally, I am confident that the word 'Company' will be readily understood as a reference to a commercial business.

37. The marks are registered for a variety of 'socks'; *bed socks*; *slipper socks*; *socks*; *thermal socks*; *socks for infants and toddlers* and *woollen socks*. I will return to consider the proprietor's *stockings* later. Reflecting on the marks' components, collectively, the words in combination, will convey an impression of a business producing, or trading in, 'Nordic socks'. Whilst I accept that there are some common aesthetic similarities amongst the Google images generated by a search for 'Nordic socks', whether or not the marks will paint a precise picture of what a 'Nordic sock' looks like, they will nonetheless signal to the consumer that they are indicative of companies which offer socks originating from, or associated with, a Nordic country. Given what, in my experience, the average consumer will understand the typical climate of those countries to be, it will likely expect that the socks sold under the marks will be thicker than normal, or at least have a thermal function to some extent. That being so, I am inclined to agree with the applicant's assessment of the contested

marks; the marks are not more, as a whole, than the sum of their descriptive parts; instead they will be viewed as an indication that the goods offered under the marks are offered by a company related, in some capacity, to a Nordic region. I have considered the guidance provided in the UK IPO Trade Mark Manual (cited above). To my mind, the marks at issue here are more in alignment with the first examples, specifically 'The Soap Company' or 'The Organic Food Company', which are deemed "unlikely to meet the requirements for registration" as "the term 'company' ...paired with a word (or words) which describes the goods...intended for protection... would still be descriptive and/or devoid of any distinctive character." As such, I find that the proprietor's marks consist exclusively of signs or indications which may serve, in the course of trade, to designate the kind and/or geographical origin of the goods for which they are registered in class 25. I therefore conclude that the proprietor's marks are objectionable under section 3(1)(c) of the Act.

38. I turn now to consider whether the above finding extends to *stockings* (for which the proprietor's second mark is registered). As I understand it, stockings are a clothing item which are, in terms of their physical nature, fairly similar to socks, intended to cover the feet and leg, and in my experience it is not unusual for a single entity to provide both and for the goods to move via the same channels of trade. They are so closely tied, in my view, that the average consumer, upon meeting either of the contested marks used in respect of stockings, that the goods originate from a company offering socks and other similar goods associated with, or originating from, a Nordic region. Whilst the word SOCK is not necessarily directly descriptive, as per my earlier considerations, the marks' impact on the consumer remains the same.

39. Even if I am wrong in my finding under section 3(1)(c), I am of the view that the proprietor's marks would also be declared invalid in respect of the class 25 goods under section 3(1)(b). Whilst I acknowledge that only a minimum degree of distinctiveness is sufficient to overcome an objection under this ground⁵, I do not consider that the proprietor's marks would serve to identify (any of) the goods for which they are registered as originating from a particular undertaking and therefore distinguish those goods from those of other undertakings.⁶ The proprietor's marks

⁵ Case T-34/00 *Eurocool Logistik GmbH v OHIM*

⁶ Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM*, paragraph 34

are devoid of distinctive character for the goods they are registered for and I do not believe either mark would be perceived as an indicator of trade origin.

Acquired distinctiveness

40. In *Windsurfing Chiemsee*,¹¹ the CJEU provided the following guidance about the correct approach with regard to the assessment of the acquisition of distinctive character through use:

“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).”

41. Keeping the above guidance in mind, I begin by noting that I do not have any indication of the size of the relevant market, nor the share claimed by the proprietor, but I would expect the UK clothing market to be vast. The proprietor's mark has been used since 2017 and, since then, the proprietor has sold over 20,000 pairs of socks to UK consumers, generating sales of over £250,000. The proprietor has invested over £25,000 in the advertising and marketing of its products. Its website has attracted more than 150,000 unique visitors, with the majority being UK consumers. Its goods are sold on its own website, Amazon and Drury Edit, boutique resellers in London, USA and France and via partnerships with UK subscription box providers such as Mind Body & Soil. It is not clear how many subscription boxes incorporating the proprietor's goods have been procured, nor how the sales the proprietor has cited are shared amongst those channels. The proprietor has not provided the readership for British Vogue, which featured its goods in October/November of 2020, though I accept it is likely to be substantial. Though I note the 'surge' in the number of Google searches for 'Nordic Socks' after the publication of the Vogue article, which the proprietor directs me to, I cannot be sure that the 'searchers' were looking for the proprietor specifically, or simply a pair of socks with Nordic origin; perhaps of a similar style to that which were featured in the article. The marketing investment made by the proprietor is not insignificant but does not strike me as particularly large, in the context of the relevant goods and wider market, at least for the purpose of supporting a claim to acquired distinctiveness. Notwithstanding the amount of sales secured by the proprietor, to my mind, the evidence before me falls short of establishing that a significant proportion of the relevant public would identify the proprietor's goods as originating from a particular undertaking because of the marks it has registered.

42. The applications for a declaration of invalidity under sections 3(1)(b) and (c) succeed in their entirety, in respect of both marks.

CONCLUSION

43. The application has succeeded and, subject to any appeal against my decision, the registrations will be declared invalid.

COSTS

44. The applicant has been successful and is entitled to a contribution towards its costs. Costs in tribunal proceedings are governed by the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of **£1500** as a contribution towards the cost of the proceedings. This sum is calculated as follows:

Filing two applications for a declaration of invalidity	£400
Preparing the applications and considering the counterstatements	£400
Preparing evidence and commenting on the other side's evidence	£500
Filing written submissions	£200

45. I therefore order Analyst Lounge Ltd to pay Bokyna GmbH the sum of **£1500**. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 12th day of July 2022

Laura Stephens

**Laura Stephens
For the Registrar,
The Comptroller-General**