

O-930-22

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO. 3408017
IN THE NAME OF THE AMTICO COMPANY LIMITED
FOR THE TRADE MARK**

SIGNATURE

IN CLASSES 19 AND 27

AND

**AN APPLICATION FOR A DECLARATION OF INVALIDITY UNDER NO. 504058
BY DISTINCTIVE FLOORING LIMITED**

BACKGROUND AND PLEADINGS

1. Amtico Company Limited (“the Proprietor”) is the owner of a UK registered trade mark for the plain text word “SIGNATURE”. The trade mark was applied for on 19 June 2019 and became registered on 17 January 2020. The mark is registered in respect of the following goods:

Class 19: Non-metallic building materials; building products; non-metallic tiles; non-metallic floor tiles; non-metallic wall tiles; floor making materials; floor tiles; floor tiles made wholly or principally of plastics.

Class 27: Floor coverings; wall coverings; wall paper; carpets and carpet tiles; rugs, mats and matting.

2. On 10 August 2021, Distinctive Flooring Limited (“the Applicant”) filed an application on Form TM26(l) to invalidate the Proprietor’s registration. There are two strands to the invalidation. First, under section 47(1) of the Trade Marks Act (“the Act”), the Applicant claims that the Proprietor’s mark should be invalidated because it is contrary to sections 3(1)(a), 3(1)(b), 3(1)(c) and 3(1)(d). Should the Applicant’s claim under section 47(1) fail, the Applicant seeks invalidation of the Proprietor’s mark under section 47(2)(b) and section 5(4)(a) of the Act. In support of this claim, the Applicant states that it has used the sign “SIGNATURE” in respect of “floor coverings” throughout the UK since March 2010. The application for invalidation is directed at all of the goods under the Proprietor’s registration

The Applicant’s case

Section 3

3. Under section 3(1)(a), the Applicant provides a definition from the Cambridge English Dictionary, which defines “SIGNATURE” as “*to refer to the special thing for which a person or place is particularly known*”. The Applicant submits that:

(i) it is customary for businesses to refer to a “signature” style, product or collection and consumers will be used to seeing such a reference;

(ii) consumers will not associate the term with one undertaking but will perceive it as indicating that a particular product is their speciality product or service;

(iii) the mark is therefore not capable of fulfilling the primary function of a trade mark which is to act as a badge of origin and distinguish the goods and services of one undertaking from those of others, as required by section 1(b) of the Act;

4. The Applicant confirms that it will adduce evidence that numerous undertakings, including those selling goods identical or similar to those of the Proprietor use the term “SIGNATURE”.

5. The Applicant’s pleadings under sections 3(1)(b), (c) and (d) all refer back to its submissions made under section 3(1)(a) and add further arguments as set out below.

6. Under section 3(1)(b), the Applicant submits that the Proprietor’s mark consists of a simple English word with a descriptive meaning in respect of the goods for which it is registered (as set out in the pleadings under section 3(1)(a)).

7. Under section 3(1)(c), the Applicant submits that the mark exclusively designates the characteristics of the goods for which it is registered, namely that they are specialist or idiosyncratic for the reasons set out in the pleadings under section 3(1)(a), or alternatively, that the term could be used to designate the characteristics of such goods. The Applicant refers to the following principles from case law:

(i) the general interest underlying section 3(1)(c) is to ensure that descriptive signs relating to one or more characteristics of the goods or services may be freely used by all traders offering such goods;¹

(ii) it is not necessary that the mark is actually in use in a manner which is descriptive for the registration to be in breach of section 3(1)(c). Rather, it is sufficient that a sign *could* be used for such purposes;²

(iii) it is sufficient that at least one of the possible meanings of the sign designates a characteristic of the goods concerned.³

¹ *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, para. 31.

² *OHIM v Wrigley*, para 32.

³ C-191/01 P, *Doublemint*

8. The Applicant concludes that “SIGNATURE” could clearly be used by manufacturers and retailers of carpets, rugs and floor tiles to describe that the goods are one of their signature products. The Applicant confirms that they will bring evidence that the term is being used descriptively by the Proprietor and also by others in the marketplace.

9. Under section 3(1)(d), the Applicant submits that the word “SIGNATURE” has, for the reasons set out under sections 3(1)(a), (b) and (c), become customary in the minds of consumers in relation to the goods for which it is registered. The Applicant defines the Proprietor’s goods as building materials, flooring and wall products, and states that the relevant consumers of the goods will be both the trade and the general public. The Applicant submits that the word “SIGNATURE” has become customary in the minds of both types of consumer, with the word being seen as describing that the goods are a company’s specialist offering.

10. The Applicant submits that the Proprietor’s mark has not acquired distinctiveness since registration.

11. The Applicant states that if its primary case under section 3 does not succeed, in the alternative, the mark should be declared invalid pursuant to section 47(2)(b) (and section 5(4)(a)).

Section 47(2)(b) and section 5(4)(a)

12. The Applicant states that the Proprietor has confirmed in correspondence that the contested mark has been in use since January 2013. The Applicant claims that it has itself used the sign “SIGNATURE” since 2010 and that between 2010 and 2019, when the application for the contested mark was filed, the Applicant had sold over 55,000 square metres of its “SIGNATURE” flooring products across the UK, with almost £1 million in revenue. The Applicant submits that if and to the extent that “SIGNATURE” is registrable as a UK trade mark, it was and is the owner of goodwill in respect of the sign “SIGNATURE”. As a result of this goodwill, the registration of the Proprietor’s mark would have been liable to be prevented under the law of passing off as the use

by the Proprietor would constitute a misrepresentation which deceives the public into thinking that the Applicant and Proprietor are economically linked. The Applicant submits that the link will have caused, or is liable to cause loss and damage.

The Proprietor's case

Section 3

13. In its defence and counterstatement, the Proprietor denies and rejects all the claims asserted by the Applicant. The Proprietor refers to the fact that no objection to its mark was raised at examination and submits that its mark was correctly registered. The Proprietor refers to the decision of the General Court of the European Union, *Castel Case T-320/10*, paragraphs 27 to 29 of which confirm that there is a presumption of validity afforded to registered marks.

14. Under section 3(1)(a), the Proprietor submits that its mark fulfils the requirements of section 1(1) of the Act.

15. The Proprietor denies that the contested mark is in breach of section 3(1)(b) as it submits that the mark has no descriptive meaning in respect of the goods it is registered for.

16. Under section 3(1)(c), the Proprietor submits that the contested mark does not designate any characteristic of the registered goods.

17. Under section 3(1)(d), the Proprietor submits that the contested mark is not customary in trade in relation to the registered goods.

18. The Proprietor highlights that the contested mark did not make a claim of acquired distinctiveness at the time of registration, as the examiner decided the mark was inherently distinctive. The Proprietor denies the Applicant's claim that its mark has not acquired distinctiveness through use since filing. The Proprietor asserts that its mark had at the date of filing enhanced distinctiveness through use, in addition to the inherent distinctiveness possessed by the mark.

Section 5(4)(a)

19. The Proprietor denies:

(i) that the Applicant has an unregistered right sufficient to satisfy the requirements of section 5(4)(a);

(ii) that the Applicant had goodwill in the sign "SIGNATURE" in respect of floor coverings at the filing date of the registration;

(iii) that there has been any misrepresentation, or that use of its mark would result in misrepresentation;

(iv) that the Applicant has suffered any damage from its use of the registered mark.

20. The Proprietor puts the Applicant to strict proof of each of its claims under section 5(4)(a).

Representation and papers filed

21. The Applicant's evidence in chief comprises the witness statement dated 24 January 2022, of Emma Jane Fletcher, Director of the Applicant company. Ms Fletcher introduces 12 exhibits, numbered EJF1 to EJF12. The Applicant also filed evidence in reply, comprising a second witness statement of Ms Fletcher, dated 6 June 2022 and which introduces three further exhibits, numbered EJF13 to EJF15. The Proprietor's evidence comprises the witness statement dated 23 March 2022, of Jason Shelley, Director of the Proprietor company. Mr Shelley introduces 12 exhibits, numbered JS1 to JS12. A number of witness statements from retail partners of the Proprietor have also been filed. Neither party requested a hearing and both parties filed submissions in lieu of a hearing.

22. In these proceedings, the Applicant is represented by Brown Rudnick LLP, the Proprietor is represented by Barker Brettell LLP.

DECISION

23. 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 upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

24. Section 1(1) of the Act reads:

- 1(1) In this Act “trade mark” means any sign which is capable-*
- (a) of being represented in the register in a manner which enables the registrar and other competent authorities and the public to determine the clear and precise subject matter of the protection afforded to the proprietor, and*
 - (b) of distinguishing goods or services of one undertaking from those of other undertakings.*

25. Section 3(1) reads:

- 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.

26. Section 5(4)(a) reads:

5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

27. Section 3 and section 5(4)(a) of the Act have application in invalidation proceedings because of the provisions in section 47 of the Act, the relevant parts of which read:

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, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) [...]

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

[...]

(5) Where the grounds of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

Section 3(1)(c)

28. I find it convenient to start by assessing the Proprietor's mark under section 3(1)(c) of the Act. While section 3(1)(b) and 3(1)(c) are distinct grounds, the only basis of the Applicant's case under section 3(1)(b) is that the Proprietor's mark is descriptive. Therefore, if the section 3(1)(c) ground succeeds, or fails, the same outcome will apply in respect of section 3(1)(b).

29. The case law under section article 7(1)(c) of the EU Trade Mark Regulation (which corresponds to section 3(1)(c) of the Act) was set out by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* (with most case notes omitted) as follows:

"91. The principles to be applied under article 7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in Agencja Wydawnicza Technopol sp. z o.o. (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...

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.

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.

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.

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. 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.

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.

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, 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.”*

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.⁴”*

⁴ See *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Kononklijke Nederland NV v Benelux-Merkenbureau* (C-363/99) [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97].

30. Having set out the relevant law and legal principles, I now take stock in light of the claims and evidence in this case. My task here is to decide, whether, on 19 June 2019, when the Proprietor applied for its trade mark, the mark “SIGNATURE” was descriptive of any characteristic of the goods covered by the registration. This position must be assessed from the perspective of the average consumer, who is deemed to be reasonably observant and circumspect.⁵

The average consumer

31. I remind myself that goods covered by the Proprietor’s mark are:

Class 19: Non-metallic building materials; building products; non-metallic tiles; non-metallic floor tiles; non-metallic wall tiles; floor making materials; floor tiles; floor tiles made wholly or principally of plastics.

Class 27: Floor coverings; wall coverings; wall paper; carpets and carpet tiles; rugs, mats and matting.

32. The parties agree that the relevant consumer of these goods will be both the general public and those in trade. I agree with this position, although I would add that certain goods, such as non-metallic building materials and products will more likely be purchased by the professional public comprising trades people, while goods such as rugs and mats will more commonly be purchased by the general public buying such goods for their home. The degree of attention paid by the professional public when purchasing the goods will be high and I consider that the degree of attention paid by the general public will range from medium to high, depending on the product; for example, a medium degree of attention will be paid when purchasing a mat, but higher attention would be afforded in the purchase of floor tiles and wall paper.

The Applicant’s pleadings

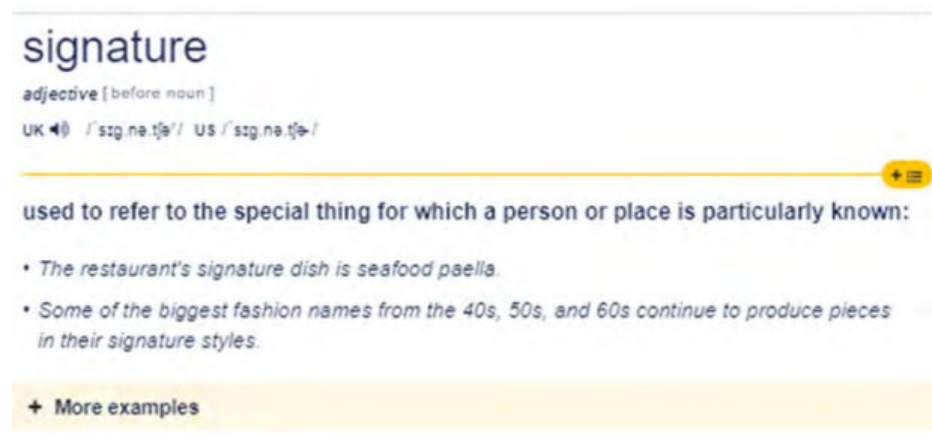
33. In its submissions in lieu of a hearing, the Proprietor asserts that the Applicant’s statement of grounds lacks precision, first because no specific characteristic is

⁵ *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04

designated, and second because no express pleading is made in respect of “*non-metallic building materials; building products; non-metallic tiles; non-metallic floor tiles; non-metallic wall tiles; floor making materials; floor tiles made wholly or principally of plastic; Floor coverings; wall coverings; wall paper; carpets, mats and matting*”. In respect of the first of these points, section 3(1)(c) refers to 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*”. The statement of grounds clearly sets out that the Applicant considers the mark to indicate an undertaking’s speciality product⁶; it also includes a statement that goods sold under the mark are “*a specialist or idiosyncratic product*”⁷. The statement of grounds does not refer to the named examples of characteristics listed in the Act. Nevertheless, section 3(1)(c) refers to “*other characteristics*” and I consider that the Applicant’s reference to “*specialist*” and “*idiosyncratic*” means that they have characterised the descriptive nature of the mark with sufficient clarity for the Proprietor to understand the claim made against their mark. I shall return to the scope of goods covered by the Applicant’s claim below.

Descriptive nature of the mark

34. The Applicant’s evidence filed in support of its claims under section 3 includes the following dictionary definition from Cambridge Dictionary in Exhibit EJF4:



⁶ Paragraph 6(a) of the Applicant’s statement of grounds.

⁷ Paragraph 6(c) of the Applicant’s statement of grounds.

35. Below are some of the examples from the Applicant's Exhibit EJF6 which feature the term "SIGNATURE" used in relation to flooring, wallpaper and tiles. Excluded from these extracts are the companies which the Proprietor states have agreements over the use of "SIGNATURE". Also, companies outside the UK are excluded, with "co.uk" addresses selected, or extracts where there are other indications that the website sells to a UK market, for example prices in £, or UK contact information. Not all of the Applicant's evidence uses the Wayback Machine, however, I see no evidence to indicate that use of "SIGNATURE" would have changed significantly in the two years between the filing of the Proprietor's mark and the gathering of evidence in support of the invalidation:

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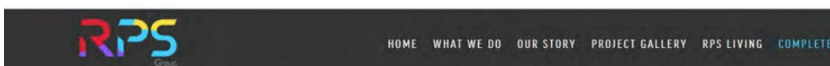
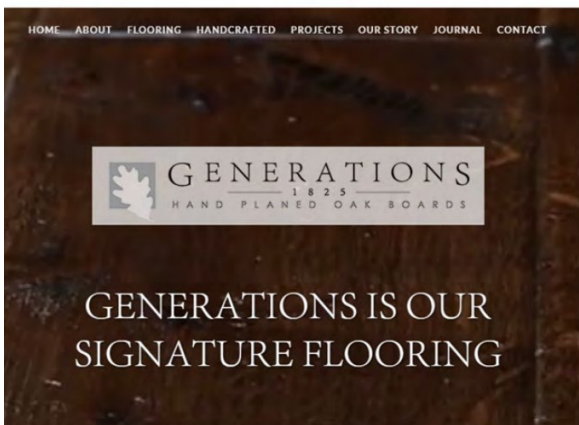
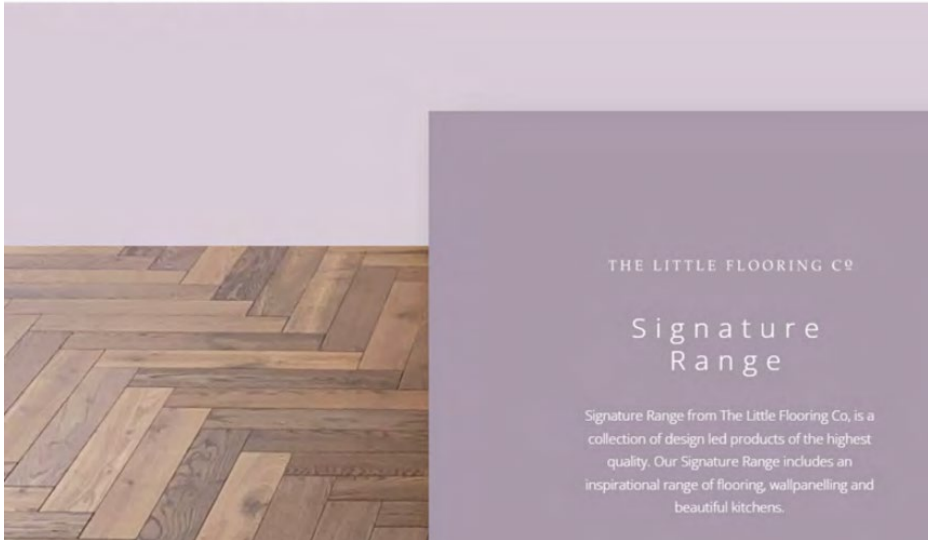
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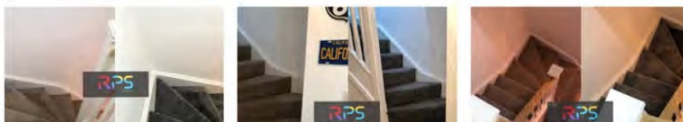
STAIRS RANGE | 20 SEPTEMBER 2020

RPS Signature Flooring Range

Project Brief | We installed our signature Grey hessian backed flooring to one of our own properties in Salford.

Works in Full | Replacement Stairs & Carpet Signature Flooring installed

Project Duration | 4 Hours



G P & J Baker Signature II Wallpaper Collection

GP&J BAKER

Signature II

Following the success of their original Signature collection, they have revisited more archival designs and created this enticing new range of designs with a very contemporary colour palette: rich teal blues and greens, and charcoal greys together with soft blush pinks and vintage creams. Taking inspiration from China and India mixed with British country style - for sophisticated homestyling.



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W45087/4 Teal / Ochre
P & J Baker Wallpapers

£122.00
£103.70 per roll



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Signature Collection



Signature Collection is exclusive and consists of handmade artisan encaustic cement tiles and terrazzo tiles designed by Otto Tiles & Design.

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Best Selling Default sorting

36. The extract below is taken from Exhibit JS8 of the Proprietor's evidence:

Hillgate
2015

Uniquely **amtico**

Create Your **Signature** Style

Create a floor that is truly unique to you with leading luxury vinyl tile specialists **Amtico**. For the ultimate choice, the **Signature Collection**, Amtico's premium range for custom design flooring, has an extensive range of products to choose from including **Wood**, **Stone** and **Abstract** enabling you to add a beautiful unique floor to your home.

37. In its submissions in lieu of a hearing, the Proprietor makes reference to case law confirming that:

(i) for a mark to be in breach of section 3(1)(c), it must be reasonable to believe that the sign will actually be seen as descriptive;⁸

(ii) any alleged meaning must be immediate and direct to enable the public concerned to immediately perceive, without further thought, a description of the good or one of their characteristics;⁹

(iii) the fact an undertaking wishes to give its goods a positive image, indirectly and in an abstract manner, yet without directly and immediately informing the consumer of one of the qualities or specific characteristics of the goods, is a case of evocation and not designation for the purpose of Article 7(1)(c).¹⁰

38. The Proprietor's mark consists solely of the word "SIGNATURE", which is a term in the English language that I consider to be well known and generally understood in the way defined in the Cambridge Dictionary definition as the special thing for which a person or place is particularly known. This meaning is reinforced by the many examples in the Applicant's evidence of use in relation to various goods, in the area of interior design and home improvement. The examples I have included above, where the term is used in relation to flooring, tiles and wallpaper, indicate that the goods marketed by the different undertakings are premium and/or they are of a style for which the company is renowned. The extract from the Proprietor's Exhibit JS8 invites the customer to "*create your signature style*", i.e. to have flooring that is unique to the customer. Taking account of the definition and usage in the market of interior design and home improvement, I consider that, as contended by the Applicant, the average consumer, even paying a higher than medium level of attention, will immediately perceive the contested mark "SIGNATURE" as designating that the Proprietor's goods are their special range of goods, for which they are renowned.

⁸ *Technopol*, Case C-51/10P.

⁹ *Europig SA v OHIM*, Case T-207/06.

¹⁰ *Ford Motor Co v OHIM*, Case T-67/07.

39. The Proprietor refers to the General Court's finding in Case T-749/14, *Peter Chung-Yuan Chang* where it was found that electric cooking utensils did not have a direct relationship with the word "AROMA". I do not consider this case to be comparable to the case before me as it is clear that there are several steps to take to get from the pleasant smells from food preparation ("AROMA") to the electrical utensils that are used in preparing that food. In contrast, "SIGNATURE" has a clear and direct meaning, referring to products for which a company is renowned and is therefore descriptive of a characteristic of the goods under the mark.

40. The contested registration covers building products and materials, tiles, flooring, rugs, matting and wall coverings. The Proprietor claims that the Applicant has failed to make a pleading in respect of all of the goods; whereas the Applicant claims that the term "SIGNATURE" could be used by any business to describe their speciality product. The Cambridge Dictionary definition includes examples of use of the term as:

- *The restaurant's signature dish is seafood paella.*
- *Some of the biggest fashion names from the 40s, 50s, and 60s continue to produce pieces in their signature styles.*

41. The examples in the above definition indicate usage of the term in relation to food and fashion. The fact that the examples and the definition itself do not refer to the specific goods under the contested mark does not prevent the mark from falling foul of section 3(1)(c). I consider that the average consumer of all the goods under the mark will understand it as designating that the goods are the special products for which the provider is renowned, and indeed, as shown in the Applicant's evidence, consumers are used to seeing the term used in this way.

42. I consider that it is appropriate to make a separate comment about "*non-metallic building materials; building products; and floor making materials*" under Class 19. "*Non-metallic building materials*" and "*building products*" are broad terms which in my view would include flooring and tiles, meaning that the descriptive nature of "SIGNATURE" set out above extends to these goods under the contested mark.

43. In respect of “*floor making materials*” I understand these products as including the stone or wood from which flooring tiles or boards are manufactured. I consider that on these goods, “SIGNATURE” would also be seen as designating that the goods are the Proprietor’s special product for which they are renowned.

44. The Proprietor makes reference to other registrations comprising of, or including the word “SIGNATURE”, which it states have been duly accepted by the UK IPO. In respect of this argument, it is established in case law that the existence of previous registrations are not decisive. One case confirming this is *Henkel KGaA v Deutsches Patent- und Markenamt*, Case C-218/01, where the Court of Justice of the European Union found that:

“65... The fact that an identical trade mark has been registered in one Member State as a mark for identical goods or services may be taken into consideration by the competent authority of another Member State among all the circumstances which that authority must take into account in assessing the distinctive character of a trade mark, but it is not decisive regarding the latter's decision to grant or refuse registration of a trade mark.

On the other hand, the fact that a trade mark has been registered in one Member State for certain goods or services can have no bearing on the examination by the competent trade mark registration authority of another Member State of the distinctive character of a similar trade mark for goods or services similar to those for which the first trade mark was registered.”

45. While it is clear that earlier registrations are not decisive, I do not consider that the six registrations could in any event lead to the conclusion that the UK registry customarily accepts the term “SIGNATURE” for the kind of goods under the contested mark. Of the six cases, it can be seen that one features figurative elements, not found in the contested mark; three are comparable marks, which, although examined under the same overall legislative framework of EU trade mark law, were not (as contended by the Proprietor) accepted by the UK registry; and UK registration number 2321147 is registered for very specific goods, including bus stops and road signs, which have a different average consumer to the goods under the contested mark. The Proprietor’s

submission that the acceptance of the contested mark, without objection, is evidence that the mark does not fall foul of section 3 is also not persuasive as section 47 allows for marks registered in breach of section 3 to be invalidated, and such marks will inevitably have been accepted at examination.

Conclusion under section 3(1)(c)

46. The Proprietor's mark is contrary to section 3(1)(c) in respect of all the goods for which it is registered under classes 19 and 27. As the mark is contrary to section 3(1)(c), it is also devoid of any distinctive character for the same reasoning and the registration is therefore also contrary to section 3(1)(b).

Section 3(1)(d)

47. In *Telefon & Buch Verlagsgesellschaft GmbH v OHIM*, Case T-322/03, the General Court summarised the case law of the Court of Justice 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)."

48. For a section 3(1)(d) objection to apply, it must be shown that "SIGNATURE" had at the date of application for the contested mark, become customary in the current language or in the bona fide and established practices of the trade to designate the goods in respect of which the mark was registered. The Applicant's evidence has sought to demonstrate the word "SIGNATURE" is used widely in relation to flooring, tiles and wallpaper. In my view, this evidence has satisfied the section 3(1)(d) test that "SIGNATURE" was customary language in the market of these types of goods, which fall within the bracket of goods for interior design and home improvement. Therefore I find that applied for mark is also contrary to section 3(1)(d), in respect of the following goods:

Class 19: Non-metallic building materials; building products; non-metallic tiles; non-metallic floor tiles; non-metallic wall tiles; floor making materials; floor tiles; floor tiles made wholly or principally of plastics.

Class 27: Floor coverings; wall coverings; wall paper; carpets and carpet tiles.

49. I do not consider the evidence to show that the mark is customary in respect of “rugs, mats and matting” in Class 27.

Conclusion under section 3(1)(d)

50. The invalidation under section 3(1)(d) succeeds in part.

Section 3(1)(a)

51. This ground can be dealt with briefly. Sections 1(1) and 3(1)(a) must be read together. The Proprietor’s mark comprises the word “SIGNATURE” which I find satisfies the first requirement in section 1(1) that the mark be “*represented in the register in a manner which enables the registrar and other competent authorities and the public to determine the clear and precise subject matter of the protection afforded to the proprietor*”. I also note that *words* are included in the examples of what a trade mark may comprise, which are listed in section 1. With regards to the second requirement under section 1(1) that of being capable of “*distinguishing goods or services of one undertaking from those of other undertakings*”, I find that as a word, the contested mark has, in the abstract, the ability to distinguish the goods of one undertaking from those of another. Being capable of distinguishing is a different consideration to whether the mark does distinguish the goods which is a relevant consideration under sections 3(1)(b), (c) and (d).

Conclusion under section 3(1)(a)

52. The invalidation under section 3(1)(a) fails.

Distinctiveness acquired through use

53. As the Applicant’s claim has succeeded under sections 3(1)(b) and (c), and in part under section 3(1)(d), I now turn to assess the Proprietor’s claim that its mark had acquired distinctiveness through use, under the proviso to section 47(1). In invalidation proceedings, the burden of proof is on the proprietor to show that their mark had

acquired distinctiveness.¹¹ The Proprietor must demonstrate that its mark had acquired distinctiveness by the date of the Application for invalidity, that is 10 August 2021.¹²

54. The Court of Justice of the European Union 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

¹¹ *Oberbank AG & Banco Santander SA and Another v Deutscher Sparkassen- und Giroverband eV* Joined cases C-217 and 218/13.

¹² *Alcon Inc v OHIM*, Case T-237/01.

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)."

55. In Case C-215/14, *Société des Produits Nestlé SA v Cadbury UK Ltd*, the CJEU considered a preliminary reference from the High Court of England and Wales which sought guidance about the legal test for showing that a trade mark had acquired a distinctive character. The CJEU understood the question as follows:

"By its first question the referring court asks, in essence, whether an applicant to register a trade mark which has acquired a distinctive character following the use which has been made of it within the meaning of Article 3(3) of Directive 2008/95 must prove that the relevant class of persons perceive the goods or services designated exclusively by that mark, as opposed to any other mark which might also be present, as originating from a particular company, or whether it is sufficient for that applicant to prove that a significant proportion of the relevant class of persons recognise that mark and associate it with the applicant's goods."

56. The CJEU answered the question in these terms:

"In order to obtain registration of a trade mark which has acquired a distinctive character following the use which has been made of it within the meaning of Article 3(3) of Directive 2008/95, regardless of whether that use is as part of another registered trade mark or in conjunction with such a mark, the trade mark applicant must prove that the relevant class of persons perceive the goods or services designated exclusively by the mark applied for, as opposed to any other mark which might also be present, as originating from a particular company."

57. The Court of Appeal - [2017] EWCA Civ 358 - subsequently indicated that it understood the CJEU's answer to mean:

(i) A non-distinctive mark can only acquire distinctive character if, as a consequence of the way(s) that it has been used, a significant proportion of the relevant public would, at the relevant date, have taken the mark, by itself,

to mean that the goods/services sold under it are those of a single undertaking, which is responsible for their quality.

(ii) In answering this question it is necessary to distinguish between, on the one hand, mere recognition of the mark in the abstract and, on the other hand, the likely use of that mark during the course of trade, by the relevant public, for the purposes of distinguishing the source of the goods/services.

(iii) It is not necessary to show that a significant proportion of the relevant public have in the past placed reliance on the mark for this purpose. This may be particularly difficult where the mark has been used with, or as part of, other distinctive marks.

(iv) However, evidence of such reliance will mean that the mark has acquired a distinctive character.

(v) It is necessary to consider all the evidence, particularly the way(s) in which the mark has been used and promoted, together with the duration and extent of the use.




The Proprietor's evidence

58. The Proprietor's evidence is introduced through the witness statement of Jason Shelley, the HR Director of the Proprietor's company since 2008. Mr Shelley states his view that the Proprietor is a leading provider of luxury vinyl flooring under the SIGNATURE brand in the UK. The specific flooring provided by the Proprietor is "Luxury Vinyl Tile", or "LVT", which is manufactured from sheets laminated together and which results in flooring that looks like real wood or stone. Mr Shelley describes the training courses that the Proprietor offers through its Academy to train fitters to install this particular type of flooring.¹³ Mr Shelley refers to various industry nominations and awards received for the Proprietor's SIGNATURE, however, no evidence such as nomination lists, certificates or press releases confirming these awards has been filed to corroborate this. Mr Shelley also makes reference to the Proprietor being the finalist in the House Beautiful Awards over several years. I understand House Beautiful to be a magazine with the witness statement indicating that it has a readership of 613,000 female readers in 2020. No extracts from these

¹³ Exhibits JS4 and JS6.

awards, or the magazine are provided in the evidence, so it is not possible to see how consumers would have encountered the contested mark.

59. At Exhibit JS5 are produced the initial results of a Google search for “signature laying pattern”:

<p>https://www.amtico.com › flooring › products › laying-... ⋮</p> <p>Create unique flooring designs with Amtico Laying patterns</p> <p>Laying patterns are templates and designs for the arrangement of our planks and tiles on your floor. They provide a quick and easy way to create inspiring and ...</p>	
<p>https://www.amtico.com › commercial › laying-patterns ⋮</p> <p>LVT Laying Patterns Dedicated to pattern innovation ...</p> <p>Laying Patterns are a foundation for creativity, a framework for you to experiment with products, shapes and tile sizes to produce extraordinary floors.</p>	
<p>https://www.flooring4youltd.com › blog › amtico-lvt-fl... ⋮</p> <p>Amtico LVT Flooring – Laying Patterns explained</p> <p>For a look of Versailles and a floor of palatial distinction, the French Weave laying pattern is available from Amtico Signature in nine different colours.</p>	

60. At Exhibit JS7, residential and commercial warranty documents are produced, which bear the name “Amtico Signature”. The residential warranty also bears the badge:



61. At Exhibit JS8 Mr Shelley introduces a collection of press releases and communications. The documents show different styles of flooring, alongside descriptions of the products styles and pricing. The Proprietor name “Amtico” appears in the heading on many of the documents, with the mark “SIGNATURE” sometimes appearing in the heading, but more often within the text:

December 2015



The Signature Collection

Hillgate

February 2016

Create a soft rustic look this spring with the wood collection from the Amtico Signature range. Combine stunning wood effects such as Farmhouse Oak, Lime Washed Wood and Harbour Pine with a simple colour scheme of warm soft pastel tones and greys, creating a beautiful spring design. All Signature flooring is expertly crafted in the UK, creating a quality product which comes with a Lifetime Warranty. Priced at around £70.00 per m2. For more information please visit www.amtico.com

Rustic Flooring



July 2017

Amtico Décor

with Amtico Signature

2020



Uniquely Amtico

COLOUR EDIT

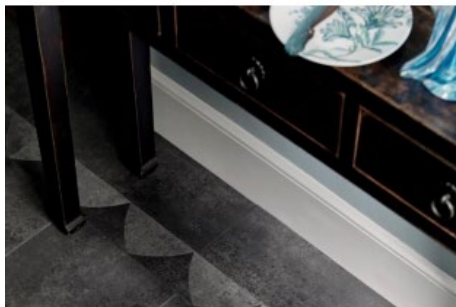
Colourful flooring has undergone a revival and with a range of rich and delicate hues in Amtico's Colour Edit, a world of unique possibilities is now available for the home.

Part of Amtico's existing premium Signature range, Colour Edit comprises four palettes that offer the perfect balance of subtlety and drama. Diffusion, Modernist, Stucco and Encaustic all vary in tone and texture, creating unique, eye-catching flooring solutions.

2019

Endless Possibilities

Flooring that is truly individual....



Endless Possibilities is a function from Amtico that has been designed specifically for style-conscious consumers who want to create a floor that is personal to them.

Engineered to be straightforward and time-efficient, Endless Possibilities allows consumers to choose any laying pattern from the Designers' Choice collection with any colour or product from the Signature range. The two can be combined to create a flooring look that is entirely unique to each individual.

62. The use of the mark in Exhibit JS8 appears in various ways, including “*Signature Collection*”; “*Amtico’s Signature Collection*”; “*Signature flooring*”; “*Signature range*”; the mark also appears alongside different sub-types of the product, for example “*Signature Modernist Frame*”; “*Signature Stucco Encaustic Kyanite*”; and “*Signature Reclaimed Oak*”. Mr Shelley highlights that the Royal Institute of British Architects (RIBA) refer to the Proprietor’s “*Signature Collection*”. This extract within the witness statement refers to a competition organised between the Proprietor and RIBA to create the best pattern of the Proprietor’s latest designs under its “*premium Signature range*”.

63. Mr Shelley’s witness statement indicates that between January 2013 and December 2019 SIGNATURE sales equated to “*approximately £100*” million and from January 2019 to March 2022, sales of SIGNATURE were “*just under £40 million*”. I note that Mr Shelley has covered 2019 in both of the reported figures and that March 2022 extends beyond the relevant date of 10 August 2021. At Exhibit JS9, Mr Shelley introduces a number of redacted invoices. The contested mark does not appear on the invoices, and Mr Shelley explains that the product names correspond to Signature products shown in a product catalogue from 2018. The catalogue features the contested mark on the front page, alongside “*amtico*”:



64. At Exhibit JS11, Mr Shelley introduces eight witness statements from retail partners who confirm their opinion that within the flooring industry “SIGNATURE” is synonymous with the Amtico LVT product. The statements are all based on the same template:

WITNESS STATEMENT

1. I, Jonathan Smith, of 347 Yorktown Road, College Town, Sandhurst, GU47 0PX and I am the Owner of Tyne Carpets & Flooring Ltd, a position which I have held since 1998. I have 35 years of experience in the flooring industry. The facts in this statement come from my personal knowledge and experience.

2. I have worked with Amtico for at least 40 years and consider them to be a leading provider of flooring in the UK market.

3. Specifically I consider Amtico to be an established provider of luxury vinyl flooring which is offered under the product range name of SIGNATURE. I have been aware of this SIGNATURE range since at least as earlier as 2001.

4. I associate SIGNATURE exclusively with Amtico within the UK luxury vinyl flooring market.

5. The fact in this witness statement are true to the best of my knowledge and belief.

65. Keeping in mind the guidance set out in *Windsurfing Chiemsee*, I consider that the Proprietor has shown longstanding use of its mark over at least seven years prior to the application for invalidity. In terms of geographical spread, the witness statements indicate that the Proprietor has retail partners in the South East of England and Northern Ireland; with the invoices showing sales to a wide variety of UK postcodes (the rest of the addresses are redacted).

66. The manner of use of the contested mark "SIGNATURE" shows that it is being used by the Proprietor in its "*press releases and communications*" to distinguish its premium range of flooring. However, the mark mainly features alongside its house mark "Amtico" and how far the press releases and communications are distributed is not stated. The documents in Exhibit JS8 are not described by Mr Shelley as constituting brochures and it is not clear how the Proprietor's customers encounter the contested mark when choosing flooring. The 2018 product guide would be seen by the customer, however, the mark only appears on the front page and together with "amtico". The witness statements from flooring retailers indicate that the Proprietor makes sales through retailers, but no information is provided as to how their product is viewed and sold through this avenue. Mr Shelley does not indicate how much the Proprietor spends on promoting its mark.

67. Mr Shelley reports impressive sales figures of £100 million in the seven years from 2013 to 2019, however, there is a lack of clarity around when and how these figures were achieved. Individual invoices show sales of between 50 and 100 square metres of their product, which, at a price of around £70 per square metre,¹⁴ would require a very significant number of sales to account for the £100 million reported. It would have been more useful for example, to see the total amount of sales made through different retailers, and for the figures to have been broken down by year. The evidence refers to the Proprietor's training Academy and it is not clear whether the reported sales figures also cover revenue from this service.

68. The overall market for flooring across commercial and residential settings would be very large, and I know from the evidence that it has its own awards. Mr Shelley does not quantify the size of the market for vinyl flooring, meaning it is not possible to assess what an average of £15 million in annual sales would represent as a proportion of the market for this subset of flooring.

69. In conclusion the evidence does not show how consumers encounter the contested mark, with materials mentioning the mark being press releases and communications. Where the mark is shown in these documents, it features alongside the mark "Amtico". There is no information in the evidence as to how the Proprietor has promoted its mark, and Mr Shelley is vague about the amount of sales made under the mark. In terms of statements from trade associations, while RIBA refers to the Proprietor's Signature Collection, there is no statement from this organisation, or any other trade body, that the Proprietor's mark "SIGNATURE" is recognised as a trade mark. I acknowledge the testimony from retail partners, who will be experienced in the market, however, I do not consider these statements, from the Proprietor's customers to be persuasive in showing that the contested mark had become distinctive of the relevant goods. In a recent decision, Mr Geoffrey Hobbs, QC, as the Appointed Person stated that:

¹⁴ As noted from Exhibit JS8.

“The fact that a designation is recognised and associated with a trader’s goods or services does not necessarily imply that it is distinctive in the sense of individualising such goods or services to a single economic undertaking”¹⁵

70. The descriptive nature of the mark and how it has been shown to be customary in relation to flooring means that it is quite a high bar for the Proprietor to reach in showing that a significant proportion of the relevant public have taken the mark “SIGNATURE”, by itself, to mean that the goods are those of a single undertaking.

71. While the Proprietor has shown that it has made use of the contested mark, I find that the use displayed is not sufficient to show that the mark is distinctive in that it designates a single undertaking. From my analysis of the evidence, I find that the Proprietor has not shown that its mark had acquired distinctiveness through use by the relevant date.

Conclusion on distinctiveness acquired through use

72. The Proprietor’s claim that its mark has acquired distinctiveness fails.

Section 47(2)(b) and section 5(4)(a)

73. The Applicant’s primary case under section 47(1) and sections 3(1)(b), (c) and (d) has succeeded in full. I note that the section 47(2)(b) and section 5(4)(a) grounds were expressly claimed in the alternative, to be considered in the event that the primary grounds did not succeed. I will therefore only address these grounds briefly.

74. The Applicant’s evidence shows use of the sign in the form of “SignatureLabel”; “Signature Collection”; and “SignaturePlank”; the sign appears alongside the Applicant’s house mark and website, which appears in the following variations: Distinctive; Distinctive Flooring; Distinctive Design Flooring; and

¹⁵ Kerly’s Law of Trade Marks and Trade Names 16th Edn (2018) paras.10-027 to 10-032, Quoted at paragraph 39 of Case BL O/558/22.

distinctiveflooring.co.uk. The house mark also appears alongside a device as shown below:



75. Taking account of the descriptive and customary nature of the sign “SIGNATURE” in relation to flooring, and that the use made is alongside the Applicant’s house mark, I find that the Applicant would be unable to rely on goodwill associated with the word “SIGNATURE” on its own and there would be no misrepresentation.

OVERALL OUTCOME

76. The invalidation has succeeded. Subject to any successful appeal, the Proprietor’s registration will be invalidated in full and deemed never to have been made.

COSTS

77. As the Applicant has been successful, it is entitled to a contribution towards its costs on the basis of Annex A of the Tribunal Practice Notice (TPN) 2/2016. Applying the guidance of the TPN, I award costs to the Opponent on the following basis:

Form TM261 official fee	£200
Preparing a statement and considering the other side's statement	£400
Preparing evidence and considering and commenting on the other side's evidence	£1,000
TOTAL	£1,600

78. I order The Amtico Company Limited to pay Distinctive Flooring Limited the sum of £1,600. The above sum should be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 26th day of October 2022

**Charlotte Champion
For the Registrar**