

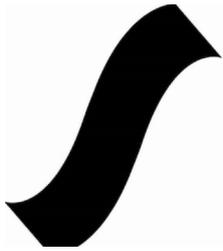
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TRADE MARKS ACT 1994

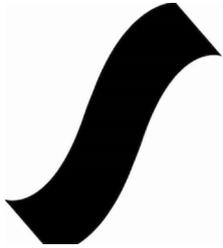
IN THE MATTER OF APPLICATION NUMBER 3685184

BY ANONIMA LIQUORI S.r.l.

TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 33



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Background

1. On 23 August 2021 Anonima Liquori S.r.l. (“the applicant”) applied to register the above mark for the following goods:

“Preparations for making alcoholic beverages; alcoholic beverages (except beers); bitters; aperitifs; wines; alcoholic beverages containing fruit; pre-mixed alcoholic beverages, other than beer-based; cocktails; spirits and liqueurs; brandy; digesters [liqueurs and spirits]; rum; vodka; whisky; distilled beverages”.

2. On 28 September 2021 the Intellectual Property Office (“IPO”) issued an examination report in response to the application. In that report an objection was raised under section 3(1)(1)(b) of the Trade Marks Act 1994 (“the Act”) on the basis that the mark is devoid of any distinctive character being nothing more than a banal shape with no other distinctive elements. It was considered that the average consumer would perceive the mark as an origin neutral shape with no indication of who is providing the goods.

3. On 31 January 2022, following an extension of time requested by HGF Limited (the attorneys) acting on behalf of the applicant, arguments were submitted in favour of accepting the application. The attorney referred to the mark as the ‘S’ logo and stated the following:

- a. the letter ‘S’ has no meaning in relation to the relevant goods and services.
- b. the mark is not banal but a modern and artistic stylisation of the letter ‘S’.
- c. the examiner has applied an excessively high and incorrect threshold for distinctiveness and referred to the findings in the decision of SAT.1 SatellitenFernsehen GmbH v OHIM Case C-329/02.

In that correspondence the attorney included examples of previous marks in the form of a letter ‘S’ which have been accepted.

4. On 14 February 2022 the examiner responded to the attorney maintaining the objection. On 14 April 2022 the attorney sent in examples of the mark in use (these

are shown at paragraph 19). This did not persuade the examiner to waive the objection and on 1 July 2022 the attorney requested a hearing.

5. A hearing was appointed and held on 18 August 2022 with me, acting on behalf of the Registrar, and Ms Wheeler of the attorneys who was attending on behalf of the applicant.

6. At the hearing Ms Wheeler referred to the submissions made in her letter of 31 January 2022 and to the examples of the mark in use submitted on 14 August 2022. Ms Wheeler could not understand why the examples of the mark in use were not considered to be trade mark use as the exhibits provided examples of the mark shown alone on the packaging.

7. I maintained the objection at the hearing. I pointed out that, regarding the submission that the mark is an artistic stylisation of a letter 'S', I felt it unlikely that consumers would see a letter 'S', but would merely see a simple shape to which they would attach no trade mark significance. At the hearing I referred to case law which confirmed that excessively simple marks are not capable of conveying a trade mark message. Further details of this case law are given at paragraph 15 below. I discussed use of the mark with the attorney who informed me that as the applicant has only been using the mark for about a year, this is not a sufficient period of time to consider filing evidence of use of the mark with a view to the application proceeding on the basis of distinctiveness acquired through use, in the circumstances I refused the application.

8. On 20 September 2022 the agent submitted a form TM5 requesting a statement of grounds for the refusal of the application.

The Law

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

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

(a) ...

(b) trade marks which are devoid of any distinctive character,

(c) ...

(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.

The Relevant Legal Principles – Section 3(1)(b)

14. The relevant authorities at European and UK level have long established certain key legal principles to be applied in relation to section 3(1)(b) of the Act. These can be summarised as follows:

- For a mark to possess a distinctive character it must identify the product (or service) in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product (or service) from the products (or services) of other undertakings (Linde paragraphs 40-41 and 47);
- The general interest to be taken into account in each case must reflect different considerations according to the ground for refusal in question. In relation to section 3(1)(b) (and the equivalent provisions under EU law) the Court has held that "...the public interest... is, manifestly, indissociable from the essential function of a trade mark" (Case C-329/02P, *Satelliten Fernsehen GmbH v OHIM 'SAT.1'*). The essential function thus referred to is that of guaranteeing the identity of the origin of the goods or services offered under the mark to the consumer or end-user by enabling him or her, without any possibility of confusion, to distinguish the product or service from others which have another origin (see paragraph 23 of the above mentioned judgment). Marks which are devoid of distinctive character are incapable of fulfilling that essential function.
- It is also well established, in the UK at least, that the words 'devoid of distinctive character' are interpreted as meaning being 'unpossessed' of distinctive character, based on the perceptions of the average consumer and in relation to the goods and services applied for.
- Section 3(1)(b) is independent from other grounds of objection such as section 3(1)(c) and must include within its scope those marks which, whilst not designating a characteristic of the relevant goods and services (i.e. not being necessarily descriptive), will nonetheless fail to serve the essential function of a trade mark in that they will be incapable of designating origin. In terms of assessing distinctiveness under section 3(1)(b), the CJEU provided guidance in *Koninklijke KPN Nederland NV v BeneluxMerkenbureau (Postkantoor)* (C-363/99) where, at paragraph 34, it stated:

"A trade mark's distinctiveness within the meaning of Article 3(1)(b) of the Directive must be assessed, first, by reference to those goods or services and, second, by reference to the perception of the relevant public, which consists of average consumers of the goods or services in question, who are reasonably well informed and reasonably observant and circumspect (see inter alia Joined Cases C-53/01 to 55/01 Linde and Others [2003] ECR I- 3161, paragraph 41, and C-104/01 Libertel [2003] ECR I-3793, paragraphs 46 and 75)."
- It is also a well-established principle that the Registrar's role is to engage in a full and stringent examination of the facts, underlying the Registrar's frontline role in preventing the granting of undue monopolies, see to that effect

15. In addition to these well-known principles, there is good authority for the proposition that a specific category of 'sign' which, by virtue of excessive simplicity, is incapable of performing the essential function of a trade mark. At the hearing I drew the agent's attention to this, pointing out that according to well established case law a sign which is excessively simple and consists of, for example, a basic geometrical figure, such as a circle, a line, a rectangle or a conventional pentagon, is not, in itself, capable of conveying a message which consumers will be able to remember and will not regard it as a trade mark (see judgments of 12 September 2007, T304/05, 'Representation of a pentagon', paragraph 22, and of 29 September 2009, T139/08, 'Half a Smiley smile', paragraph 26). I appreciate that the mark applied for is not a basic geometrical shape, however, such objections are not limited to such marks, for example the following were not considered to be distinctive by the General Court of the European Union:



Application of legal principles

16. In this case the average consumer for the goods in question, i.e. alcoholic beverages, which are everyday products, is the general public and although they would be assumed to be reasonably circumspect these are not specialist goods which consumers would pay a high level of attention in their purchase. Unless, of course the goods in question are high end goods such as single malts or cognac, for example, where the consumers level of attention would be considerably higher.

17. Although the attorney has stated the mark is an artistic stylisation of a letter 'S' I do not see it as such. Or rather, I should say that I am not convinced by the attorney that members of the relevant public will inevitably see the mark as the letter 's', absent any contextual hints. The mark in question has to be capable of guaranteeing origin and which will resonate with consumers enabling them to repeat their purchasing experience if it proves to be positive or to avoid it should it be negative. As stated in paragraph 26 in decision T-79/00 *Lite*:

"The signs referred to in Article 7(1)(b) of Regulation No 40/94 are signs which are regarded as incapable of performing the essential function of a trade mark, namely that of identifying the origin of the goods or services, thus enabling the consumer who acquired them to repeat the experience, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent acquisition."

18. Absent education through use I consider the mark applied for to fall into this category. As stated in Joined Cases T-678/15 and T-679/15 at paragraphs 39 to 41:

39. That said, a finding that a mark has distinctive character within the meaning of Article 7(1)(b) of Regulation No 207/2009 is not subject to a finding of a specific level of linguistic or artistic creativity or imaginativeness on the part of the proprietor of the trade mark. It suffices that the trade mark enables the relevant public to identify the origin of the goods or services which it covers and to distinguish them from those of other undertakings (see judgment of 29 September 2009, Representation of half a smiley smile, T-139/08, EU:T:2009:364, paragraph 27 and the case-law cited).

40. In the present case, it is common ground that the signs at issue do not represent a geometrical figure. However, that circumstance, as such, does not suffice to support the view that they have the minimum distinctive character necessary for registration as EU trade marks.

41. There must also be certain aspects of the signs at issue which may be easily and instantly memorised by the relevant public and which would make it possible for those signs to be perceived immediately as indications of the commercial origin of the goods they cover (see, to that effect and by analogy, judgment of 29 September 2009, Representation of half a smiley smile, T-139/08, EU:T:2009:364, paragraph 31).

19. At paragraph 21 I have included examples of the mark in use on the packaging of the goods sent in by the attorney prior to the hearing. It is often the case that applicants will furnish the registrar with examples of their own use and it is important to say exactly how the registrar responds and what legal status such examples have. In particular, such examples provided by the applicant are not determinative or dispositive of the question confronted by the registrar, namely can the mark be properly registered in the prima facie?.

20. These examples may, at most, be considered as factors in the overall question as to whether a sign can be registered in the prima facie. They may serve to reinforce the objection or to undermine it. Either way, they do not determine it; to suggest otherwise would be to wholly undermine the legal, stringent and proper recourse to acquired distinctiveness. If all an applicant had to do to overcome an objection was to show their own use and that use was as a trade mark, the whole question and purpose of acquired distinctiveness would effectively disappear. Against that background the applicant has chosen to provide me with examples of its own use in this case.

21. For the sake of completeness the examples are shown below.



22. I prefer not to make any finding that this use is plainly and only decorative and does not show trade mark use in the wider context. It is safer to simply say that the examples of use have not, in this case, diverted me from my initial and fundamental appraisal that, absent evidence of acquired distinctiveness, the mark as filed is too simple to function as a trade mark. The perceptions and recollections of the relevant consumer in this case will not, in my opinion, operate as an indication or guarantee of origin in the prima facie case.

23. The Trade Marks Act 1994 is largely derived from EU law (Directive 2015/2436). In relation to the interpretation of such retained law, the case law of the Court of Justice of the European Union (CJEU) (including the General Court) issued before the end of the transition period continues to apply, and is binding, as retained EU case law under section 6 of the Withdrawal Act. I have referenced General Court decisions here to support the view that simplicity or banality of a mark as a basis of objection is not confined to geometrical shapes per se.

24. Regarding the earlier marks referred to by the attorney, I do not agree that this mark is on a par with those marks, as I do not consider this mark would be seen as a letter 'S' in the first place. In any event I am bound to determine the mark's acceptability in accordance with the relevant legal principles rather than assessing the mark based on the state of the register. This well-established principle in trade mark law was cited in the *Treat* case and has been summarised recently in *BREXIT O-262-18*, where the AP (James Mellor QC) stated:

'11. In addition, just because a mark is on the Register does not mean it will be held valid when challenged. Furthermore, if the touchstone for registration was to be a comparison with marks already on the register, then registration would come to depend on the lowest common denominator. In any event, it is quite clear that the application of the section 3(1)(b) ground requires an assessment not against other marks on the register, but against the standard laid down in that provision, as interpreted in the case law.'

25. For the reasons given above I do not consider the mark to be distinctive or capable of functioning as an indicator of trade origin and the application is hereby refused under Section 3(1)(b) of the Trade Marks Act 1994.

Dated this 26th day of October 2022

**Linda Smith
For the Registrar
Comptroller-General**