**BL O/0431/24**

IN THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NUMBER 3,851,494 MADE BY UK GREETINGS LIMITED

IN THE MATTER OF AN APPEAL FROM THE DECISION OF OLIVER ROSE MEYER (O/1015/23) DATED 31 OCTOBER 2023

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DECISION

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**Introduction**

1. This is an appeal from the decision of Oliver Rose Meyer (O/1015/23) dated 31 October 2023 where he upheld the examiner's objection under section 3(1)(b) of the Trade Marks Act 1994 in relation to an application by UK Greetings Limited to register the following trade mark (No 3,851,494) in relation to "Greeting cards" in Class 16:


**Standard of appeal**

2. The standard of appeal is by way of review. Neither surprise at a Hearing Officer's conclusion nor a belief that the Hearing Officer has reached the wrong decision will suffice to justify interference in this sort of appeal. Before that is warranted, it is necessary for me to be satisfied that there was a distinct and material error of principle in the decision in question or that the Hearing Officer's findings were rationally insupportable. The principles to be applied were summarised by Joanna Smith J in *Axogen Corporation v Aviv Scientific Ltd* [2022] EWHC 95 (Ch), [24] and in relation to findings of fact this should now be read in light of the summary of Arnold LJ in *Lidl Great Britain Ltd v Tesco Stores Ltd* [2024] EWCA Civ 262, [110] and in terms of evaluative decisions the Supreme Court's recent guidance in *Lifestyle Equities CV v Amazon UK Services Ltd* [2024] UKSC 8 at [49] where it stated that:

> …on a challenge to an evaluative decision of a first instance judge, the appeal court does not carry out the balancing exercise afresh but must ask whether the decision of the judge was wrong by reason of an identifiable flaw in the judge's treatment of the question to be decided, such as a gap in logic, a lack of consistency, or a failure to take into account some material factor, which undermines the cogency of the conclusion.

3. When considering this appeal, and applying these principles, it is important to remember the high bar set.

## Grounds of appeal

4. The Appellant challenges the Hearing Officer's decision on a number of grounds. First, the Hearing Officer is criticised for discussing descriptiveness under section 3(1)(c). Secondly, it is submitted that the Hearing Officer improperly treated the sign as a slogan. Thirdly, it is said the Hearing Officer failed to take account of the fact that the sign was on the back of the card and so it would be seen as a trade mark. Finally, the Appellant criticises the Hearing Officer for not properly considering the stylisation of the sign.

## 'Raising' an objection under section 3(1)(c)

5. In the hearing below, the Hearing Officer stated that the sign might be objectionable under both section 3(1)(b) and (c) of the Trade Marks Act 1994. He also included a section of his decision which considered the objection under section 3(1)(c). Ms Jones, for the Appellant, submits that this approach was unfair as there had been no opportunity to make submissions under section 3(1)(c).

6. It is clearly right that an applicant should have an opportunity to make submissions on every ground of objection raised by the registry in relation to an application. This is not only a matter of natural justice, but also a statutory requirement under rule 63 of the Trade Marks Rules 2008.

7. The problem with the Appellant's submission, however, is that the application was rejected only under section 3(1)(b): Decision, [33]. The Hearing Officer made it clear that he was not relying on section 3(1)(c). He described his comments as "observations" and that he was "simply commenting on my thoughts from the hearing report" (Decision, [28]). As the examiner raised the section 3(1)(b) objection and an opportunity was given (and taken up by the Appellant) to make submissions on this objection, this challenge to the Hearing Officer's decision must fail. Nevertheless, as a matter of practice, I do tend to think decisions should not discuss in detail an objection when it is not before the Hearing Officer.

## Misapplication of the descriptiveness to distinctiveness

8. The Appellant's second criticism arising from the Hearing Officer's consideration of section 3(1)(c) was that it tainted his findings under section 3(1)(b). This, Ms Jones submits, was evidenced by his discussion of *Hormel Foods Corporation v Antilles Landscape Investments NV* [2005] EWHC 13 (Ch), [2005] ETMR 54 ("*SPAMBUSTER*") at Decision at [24]:

> Additionally, whilst not specifically relating to Section 3(1)(b) alone, I note the findings in 'Spambuster' where it was held that in instances where words which are descriptive are presented in a format which encompasses elements of stylisation such as, for example, an unusual font, it may be considered that the sign merely represents those words 'in one particular manner'. This makes it clear that if there are other graphic elements present, along with descriptive words, we must consider whether such elements are sufficient to divert the consumer's attention away from, or modify, the descriptive elements. I believe the principal to be the same when it comes to non-distinctive words presented in a stylised typeface. In my opinion the graphic elements do not divert or modify the non-distinctive nature of the words.

9. The Hearing Officer was, in my view, quite correct in his suggestion that he had to consider whether the graphical elements in the Appellant's sign were sufficient to give distinctiveness to non-distinctive words and he applied a test similar to that suggested by Emma Himsworth QC, sitting as an Appointed Person, in *CANNABIS CLINIC* (O/777/21), [57]. Indeed, I can see no logical reason why the approach from *SPAMBUSTER* (and *CANNABIS CLINIC*) should be appropriate for descriptive signs, but inappropriate for non-distinctive words. Accordingly, I dismiss this ground of appeal.

**Slogan**

10. The second ground of appeal is that the Hearing Officer improperly treated the sign as a slogan. Ms Jones relies on the Hearing Officer findings in Decision, [21]:

> Having established that the average consumer of greeting cards consists of the general public at large, I consider that when faced with words 'THINKING OF YOU', consumers would be unlikely to undertake a rigorous mental analysis of the sign; they would instead read the words, and applying their understanding of the normal rules of English grammar, take the words at face value, and perceive nothing more than a non-distinctive expression of sentiment. In my view the words are considered to be ordinary dictionary words, which make up an everyday expression, used to convey a message of sympathy, compassion or condolence, following a traumatic event such as an illness or bereavement. The words would merely convey the consumer's sense of feelings towards the recipient of the goods, demonstrating that the recipient is in their thoughts. The sign is therefore unlikely to indicate trade origin when considered in respect of the goods concerned…

11. Ms Jones submits that THINKING OF YOU is not a slogan, and she referred me to the case law on slogans: C-64/02P *OHIM v Erpo Möbelwerk GmbH* [2004] ECR I-10031 and C-398/08 *Audi v OHIM* [2010] ECR I-535.

12. The difficulty I have with Ms Jones's submission is that the Hearing Officer did not ever suggest that THINKING OF YOU was a slogan, and neither did he apply any standard to the sign different from that which would be applied to any other type of sign. He simply made a finding of fact as to how consumers would see the words THINKING OF YOU. He was perfectly entitled to reach the conclusion he did and so I also dismiss this ground of appeal.

**'Trade mark use'**

13. The next challenge to the Hearing Officer's decision was that he did not properly consider the fact that including the sign THINKING OF YOU on the back of the card (usually called page 4 in the trade) would be seen as using that sign as a trade mark.

14. Ms Jones submits, and I entirely accept, that the Hearing Officer had to consider all practically significant uses of the sign in the economic sector concerned when he was determining whether THINKING OF YOU will be seen by the relevant public as a trade mark: C-541/18 *AS v Deutsches Patent-und Markenamt*, EU:C:2019:725, [26]. Accordingly, the placement of the sign on the back of a greeting card was something the Hearing Officer should have addressed. And he did consider it in the hearing report:

> Whilst I appreciate Ms. Coles submissions that if the sign is to be used in a trade mark sense on the back of greetings cards then it should be accepted, I do not necessarily agree. Due to the highly descriptive nature of the phrase, I do not believe that the placement of the mark on the goods would be considered indicative of the trade origin by the average consumer.

15. This point was not explored in detail in the final decision. The Hearing Officer did, however, refer to the suggestion of Ms Cole (the Appellant's representative below) that the sign was being used as a trade mark: Decision, [26]. So while it would have been better had the placement point been addressed expressly in the final decision (and not just in the hearing report), it is clear that he did properly consider and dismiss it.

16. Ms Jones further criticises the Hearing Officer for mentioning the descriptive nature of the phrase THINKING OF YOU in his hearing report reasoning. Once more, she submits, that this is evidence of reasoning under section 3(1)(c) creeping into the Hearing Officer's consideration of section 3(1)(b). She goes further and suggests that the descriptiveness of a sign can only be relevant for section 3(1)(b) once it has been established for the purposes of section 3(1)(c). This, she submits, is to ensure the strict descriptiveness standard applied under section 3(1)(c) is not undermined by using section 3(1)(b) as a backdoor way of applying a less strict standard.

17. While there is some logic to this submission, I do not accept it. First, there is a long-standing rule that each objection under section 3(1) operates independently: C-53/01 *Linde* [2003] ECR I-3161, [67-68]. This rule was expressly acknowledged by the Hearing Officer: Decision, [17]. Secondly, it is also well established that a sign which is descriptive in relation to particular goods is necessarily devoid of distinctive character for those goods: C-90/11 and C-91/11 *Alfred Strigl and Securvita*, EU:C:2012:147, [39]; C-363/99 *Koninklijke KPN Nederland NV* [2004] ECR I-161, [86].

18. So it is quite clear that the descriptiveness of a sign is relevant to its distinctiveness. Furthermore, the independence of each ground of objection would be undermined if a sign had to be found to be descriptive for the purposes of section 3(1)(c) before descriptiveness could be considered under section 3(1)(b). It also appears that the General Court has allowed descriptiveness to be considered explicitly under the equivalent of section 3(1)(b) without first engaging in a section 3(1)(c) analysis.

19. For instance, in T-470/09 *medi Gmb v OHIM*, EU:T:2012:369, [36] the sign "medi" was held to lack distinctive character because it provided information about the nature of the goods and services in question and so did not indicate the origin of those goods and services. Similarly, in T-145/12 *BWM v OHIM*, EI:T:2013:220 at [32], the General Court held that an objection under the equivalent of section 3(1)(b) could be properly made out if the "public will perceive the semantic content of that sign as providing information on certain characteristics of the goods concerned and not as indicating their origin."

20. I see no material difference between these findings by the General Court and that made by the Hearing Officer in this case. Accordingly, his finding (as expressed in the hearing

report) is one he was entitled to make and cannot be disturbed on appeal. I therefore reject this ground of appeal as well.

**Stylisation**

21. The final ground of appeal was that the Hearing Officer did not properly consider the stylisation of the sign.

22. In support of this ground, the Appellant tentatively relies on what is commonly called "state of the register" evidence. This was in the form of a table of registered trade marks each of which comprise words expressing sentiment along with figurative elements. Ms Jones submits that this evidence demonstrates that the stylisation in relation to THINKING OF YOU was sufficient to make it distinctive.

23. She goes on to submit that there must be a degree of uniformity of approach between marks which are accepted and those which are not. While it was not expressly stated by Ms Jones, this appears to be a reference to principles of equal treatment and sound administration routinely referred to before the EUIPO.

24. These principles were applied in C-39/08 and C-43/08 *Bild digital* [2009] ECR I-20, [17] and [18] where it was held that while a registry in a Member State may take into account earlier decisions, it is not bound by them. Critically, the Court of Justice stated that an unlawful act (ie registration) in favour of one applicant may not be relied upon by another applicant to obtain a decision in its favour: Case 188/83 *Witte v European Parliament* [1984] ECR 3465, [15] and Case 134/84 *Williams v Court of Auditors* [1985] ECR 2225, [14].

25. This approach has been consistently applied at the EUIPO. So former decisions of that Office are considered by the EUIPO and on appeal by the courts, subject to those caveats: C-51/10P *1000* [2011] ECR I-1541, [74 to 77]; C-564/16P *EUIPO v Puma*, EU:C:2018:509 at [61 to 66]. A summary of how this works was set out in *EUIPO v Puma*, [66]:

> it is incumbent on the competent EUIPO bodies to take into account the decisions which they have already adopted and to consider with especial care whether it should decide in the same way or not …Where those bodies decide to take a different view from the one adopted in those previous decisions, they should, having regard to the context in which they adopt their new decision, since reliance on those previous decisions forms part of that text, provide an explicit statement of their reasoning for departing from those decisions.

26. It is questionable the extent to which EUIPO procedural rules are relevant to domestic practice. And even more so when the United Kingdom does not consider equal treatment and substantive fairness to be free-standing requirements of domestic public law (albeit equal treatment might be an element of a legitimate expectation): *Gallaher Group Ltd, R (on the application of) v The Competition and Markets Authority* [2018] UKSC 25.

27. But even if EUIPO practice were relevant, it is difficult to see what exercising "especial care" in relation to a trade mark application means. Each and every application should

be considered by examiners very carefully. And as for explicit reasons it is difficult to see what a Hearing Officer can say after taking account of the comments of James Mellor QC, sitting as the Appointed Person, in *BREXIT* (O/262/18) at [11]:

> …Frequently, the mark identified on the Register are different in some respect. (Indeed, an identical earlier mark for identical goods or services would pose a different (relative grounds) obstacle). The mark itself may be different or the goods or services for which it is registered may be different or the applicant may have been able to rely on evidence of distinctiveness acquired through use. 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.

28. It is because bare "state of the register" evidence is so rarely helpful to a tribunal that it is often said to be "irrelevant" (*BREXIT* (O/262/18), [10]; *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281 at 305) or even "worthless": *Lifestyle Equities CV v Royal County of Berkshire Polo Club Ltd* [2022] EWHC 1244 (Ch). In short, the assessment under section 3(1)(b) is not about assessing the sign against other marks on the register, but against the statutory standard. Accordingly, this aspect of Ms Jones' submission is rejected.

29. Ms Jones also criticises the Hearing Officer for not taking into account evidence submitted by the Applicant as to the current trend for minimalist stylisation of logos in greeting cards. I am not sure how such evidence would assist the Appellant. The evidence would need to be coming from the other perspective, namely that consumers see the existence of stylisation as an indicator of trade origin. It cannot be assumed that because stylisation is uncommon it would be given sufficient trade mark significance by the relevant public thereby overcoming the fact the sign is otherwise devoid of distinctive character.

30. Finally, the fact the sign might be used on the back of the card does not automatically mean the stylisation becomes more important. In light of the Hearing Officer's other findings such positioning would make no difference.

31. Accordingly, I reject this ground of appeal as well.

**Conclusion**

32. For these reasons, I reject the appeal in its entirety and uphold the Hearing Officer's decision. The application is rejected in relation to "Greeting cards" in Class 16.

PHILLIP JOHNSON
THE APPOINTED PERSON
10 May 2024

Representation: Ms Victoria Jones (instructed by Taylor Wessing)