

O/0647/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER UK00004012741

BY RTC DIRECT LTD

TO REGISTER THE FOLLOWING MARK IN CLASSES 03, 04, 05, 11 AND 21:

FLORAL

Background

1. On 08 February 2024, RTC Direct Ltd ('the applicant') applied to register the mark shown above, for the following goods:

Class 03: Cleaning and polishing preparations, laundry preparations; soaps; detergents; non-medicated toilet preparations, cosmetics, perfumes, pot pourri, deodorants, perfuming preparations for the atmosphere, essential oils.

Class 04: Candles; fragranced or scented candles, candles for scenting or perfuming the atmosphere; illuminants, tapers, nightlights and wicks.

Class 05: Disinfectants (other than for laying or absorbing dust); sanitary preparations; antiseptics; preparations for repelling and/or destroying insects; germicides; deodorants (not for personal use); air freshening preparations, air purifying preparations, room air fresheners, preparations for perfuming or fragrancing the air, preparations for neutralising odours.

Class 11: Apparatus and instruments, all for scenting, purifying, freshening or humidifying the atmosphere; parts and fittings for all the aforesaid goods.

Class 21: Household or kitchen utensils and containers (not of precious metal or coated therewith); oil burners, perfume burners, fragrant oil burners, essential oils burners; apparatus for heating oils for perfumes and releasing fragrance into the ambient atmosphere; deodorising apparatus; apparatus for dispensing perfumes, air freshening or air purifying preparations into the ambient atmosphere; glassware, porcelain and earthenware.

2. On 14 February 2024, the Intellectual Property Office ('IPO') issued an examination report in response to the application. The examination report contained objections under Sections 3(1)(b) and (c) of the Trade Marks Act 1994 ('the Act') against all goods and a classification error, namely, the term 'deodorising apparatus' would be transferred from Class 21 to the correct Class 11.
3. The Section 3(1)(c) objection was raised on the basis the mark consists exclusively of a sign which may serve in trade to designate a characteristic of the goods, e.g., those that have a floral fragrance, a component with a floral fragrance, or a floral design.
4. The Section 3(1)(b) objection is not independent of the objection under Section 3(1)(c), and the finding of non-distinctiveness was an automatic consequence of the sign being considered as designating a characteristic of the goods. This is the approach I shall adopt throughout this statement of grounds.
5. In line with standard IPO procedure, the applicant was allowed a period of two months to respond.
6. On 14 February 2024, the applicant responded, stating they were aware of a prior registration for the word FLORAL for Class 05 goods, the applicant did not provide a case number. It was also submitted the applicant would consider an application for only Classes 03 and 04 as *"all our products will have an aroma of flowers"*.

7. In response, on 16 February 2024, the examiner issued a letter which confirmed they were unable to comment on the circumstances regarding acceptance of the earlier registration but out of courtesy had performed a search of the register and investigated a prior registration for the word FLORAL (I believe this case to be UK00909292582). The application covers 'Sanitary preparations for medical purposes; Disposable materials for dressing (bandaging)' in Class 05 and 'Disposable medical and veterinary materials for dressings and surgical interventions' in Class 10. The examiner felt the goods in the earlier registration were different to those in the current application and were therefore not persuaded by this submission. They also confirmed that the objection could not be overcome by deleting certain classes as suggested by the applicant. The applicant was permitted a further two months to request a hearing with a senior officer of the IPO to discuss the matter further.
8. No further response was received to the previous correspondence and on 25 April 2024, the examiner confirmed the objections taken under Section 3(1)(b) and (c) remained and as such the application was being refused under Section 37(4) of the Act. In this case the primary reason for refusal of the application is that the applicant failed to satisfy the registrar that the requirements were met.
9. On 26 April 2024, following formal refusal, the applicant responded stating they did not understand why the application was to be refused when a third party has a registration in Classes 05 and 10 and a further in Class 33 for the word FLORAL. The applicant also provided a screen shot showing the cases referred to, namely, UK00909292582 (FLORAL) and UK00916363541 (FLORAL). The examiner responded within the same day stating the application had been refused and reaffirming the option of filing a Form TM5, a written statement of reasons for the Registrar's decision to refuse the application. The applicant responded filing the Form TM5 the same day.
10. The applicant does not rely on any formal submissions in favour of acceptance beyond the contention that the registry has behaved unfairly in registering similar marks. There is also no reliance upon acquired distinctiveness through use and thus, I will firstly consider the formal grounds of refusal under Section 37(4)

following no response to the examiner's letter of 16 February 2024, but for completeness I will also consider the substantive grounds of objection under Sections 3(1)(b) and (c).

The Law – Sections 3(1)(b) and (c)

11. Section 37 of the Act reads as follows:

37 Examination of application

(1) The registrar shall examine whether an application for registration of a trade mark satisfies the requirement of this Act (including any requirements imposed by rules).

(2) For that purpose he shall carry out a search, to such extent as he considers necessary, of earlier trade marks.

(3) If it appears to the registrar that the requirements for registration are not met, he shall inform the applicant and give him an opportunity, within such period as the registrar may specify, to make representations or to amend the application.

(4) If the applicant fails to satisfy the registrar that those requirements are met, or to amend the application so as to meet them, or fails to respond before the end of the specified period, the registrar shall refuse to accept the application.

(5) If it appears to the registrar that the requirements for registration are met, he shall accept the application

12. 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 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

The relevant legal principles – Section 3(1)(c)

13. There are a number of judgements of the Court of Justice of the European Union ('CJEU') which deal with the scope of Article 3(1)(c) of the First Council Directive 89/104 (recoded and replaced by Directive 2008/95/EC on 22 October 2008) and Article 7(1)(c) of the Community Trade Mark Regulation (the 'CTMR'), whose provisions correspond to section 3(1)(c) of the UK Act. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2011 (as amended by Schedule 2 of the Registered EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

14. The main guiding principles are shown below:

- Subject to any claim in relation to acquired distinctive character, signs and indications which may serve in trade to designate the characteristics of goods or services are deemed incapable of fulfilling the indication of origin function of a trade mark (Wm Wrigley Jr & Company v OHIM, C-191/01P 'Doublemint', paragraph 30);
- Article 7(1)(c) (section 3(1)(c)) pursues an aim which is in the public interest that descriptive signs or indications may be freely used by all (Doublemint, paragraph 31);
- When determining whether a sign is devoid of distinctive character or is descriptive of the goods or services in respect of which registration is sought, it is necessary to take into account the perception of the relevant consumer who is reasonably well-informed and reasonably observant and circumspect (Matratzen Concord AG v Hukla Germany SA, C-421/04);
- I have also taken into account the consequences for third parties of granting the applicant a monopoly. In Linde A.G. v Rado Uhren A.G. Case C-53/01 the following guidance was given at paragraphs 73 – 74:

“73. According to the Court’s case-law “Article 3(1)(c) of the Directive pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is applied for may be freely used by all, including as collective marks or as part of complex or graphic marks. Article 3(1)(c) therefore prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (see to that effect, Windsurfing Chiemsee, paragraph 25).

74. The public interest underlying Article 3(1)(c) of the Directive implies that, subject to Article 3(3) any trade mark which consists exclusively of a sign or indication which may serve to designate the characteristics of goods or a service within the meaning of that provision must be freely available to all and not be registrable”

- I have also considered what may constitute a characteristic of the goods claimed and in doing so take guidance from Geoffrey Hobbs KC in O/313/11 FLYING SCOTSMAN paragraph 15¹.

Application of the legal principles

15. From the aforementioned case law, it is clear I must determine whether or not the mark applied for will be perceived by the relevant consumer as a means of directly designating characteristics of the goods being provided. In this case the characteristic being a floral fragrance, or a floral design, applied to the goods. In order to do this, I must assess who I consider the relevant consumer to be.
16. The goods at issue are Class, 03, 04, 05, 11 and 21 products offering, by example but not limited to cleaning goods, candles, sanitary preparations, atmosphere purifying apparatus and household and kitchen utensils. These are everyday goods to which the consumer would pay a low to moderate level of attention when purchasing.
17. Having established the relevant consumer, I must assess how they would perceive the word ‘FLORAL’ presented in a black stylised font on a white background in relation to the goods claimed in normal and fair use. In my view the word ‘FLORAL’ when viewed by the consumer is unlikely to be analysed in detail but rather taken at face value and perceived as an indication that the goods either have a floral scent or are covered by a floral print. I have taken the following definitions for the word ‘FLORAL’ from the Collins English Dictionary:

¹ See [Trademark Appointed Person decision \(0/313/11\) \(ipo.gov.uk\)](https://ipo.gov.uk/031311/)

1. A perfume with a floral aroma
2. A pattern or design incorporating representations of flowers

18. The dictionary definitions shown define the term 'FLORAL' as being both a perfumed or floral scent, or a pattern incorporating flowers. It is clear from the aforementioned case law that I must determine, assuming notional and fair use in trade, whether the mark in suit would be viewed by the average consumer as designating a characteristic of the goods for which registration is sought.

19. I will first address the goods which the examiner deemed to contain a floral scent, namely, Classes 03, 04, 05 and 11. Whilst a floral perfume may not be a specifically defined scent, similar to that of say roses or lavender, I do not believe this undermines the objection. The consumer, whom I have established as being the general public, is in my opinion accustomed to making purchases of the goods claimed based on a number of factors including the aroma of that product. The fact the goods contain a floral aroma which may consist of a combination of flowers giving a fragrant scent is sufficient in my opinion to conclude the sign may serve in trade to designate a characteristic of the goods. Furthermore, the applicant confirmed as much in correspondence dated 14 February 2024, "*all our products will have an aroma of flowers*".

20. I now turn to the goods claimed in Class 21. It was the examiner's opinion that the use of the word 'FLORAL' in relation to goods such as household and kitchen utensils describes a characteristic of the goods, namely, they will possess an applied floral pattern. Such goods are often purchased for their aesthetic qualities, I believe the general consumer would indeed perceive the mark as a clear indication the goods are enveloped in a floral pattern.

21. Although I have found the term 'FLORAL' to be descriptive, I will for clarity comment on the stylisation of the mark. The mark consists of a normal stylised font, on a white background. The stylisation within the mark does not, in my view, affect its identity and therefore my assessment is the same. It is well established in case-law that the distinctiveness of a sign must be assessed, first, by reference

to the goods in respect of which registration is sought and, second, by reference to the perception of the relevant public. It is important for me to consider the impact of the mark as a whole, that being the word 'FLORAL' presented in a stylised, yet 'normal' font. My view would be that the word 'FLORAL' as a descriptive term would overwhelm any stylised elements and the overall impact would be that the mark designates a characteristic of the goods. The mark, therefore, to my mind, is nothing more than descriptive in relation to the goods upon which it is to be used. As a result, the objection under section 3(1)(c) of the Act is therefore maintained.

22. There has been no attempt by the applicant to challenge the objection set out under Sections 3(1)(b) and (c) of the Act, other than to refer to prior 'floral' registrations. From the limited materials available to me, including the dictionary definition of the word 'FLORAL', I find that the objection under section 3(1)(c) to be validly made at the outset in the sense that 'FLORAL' would or could designate the scent or pattern of the goods being sold. As a consequence of that the objection under section 3(1)(b) is also and inevitably made out.

23. In correspondence dated 14 February 2024 and 26 April 2024, the applicant made reference to marks accepted for registration. These are EU marks granted UK protection following the UK's exit from the European Union, the precedents referred to include the following registrations:

UK00909292582 (FLORAL)

Class 05 – Sanitary preparations for medical purposes; Disposable materials for dressings (bandaging)

Class 10 – Disposable medical and veterinary materials for dressings and surgical interventions.

UK00916363541 (FLORAL)

Class 33 – Alcoholic beverages (except beer); Wine; Liqueurs; Sparkling wines.

24. It is a well established principle that such prior acceptances create no binding precedent on the IPO, this principle has been expressly made in decision BL O262/18 BREXIT, see paras 09 and following, and more recently decision BL O431/24 THINKING OF YOU, para 28, whilst this decision was in respect of Section 3(1)(b), I believe its guiding principles to be relevant:

“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.”

25. To summarise, an absolute grounds objection was raised. The final deadline of 16 April 2024 was not adhered to, subsequently resulting in a mandatory refusal under section 37(4) of the Trade Marks Act 1994.

Conclusion

26. It is found for the reasons given above, the application is refused under section 37(4), for all goods claimed. Furthermore, the objections under section 3(1)(b) and (c) were justified in the circumstances.

Dated this 9th day of July 2024

Jon Hayward
For the Registrar
The Comptroller-General