

O/0780/26

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

**IN THE MATTER OF
TRADE MARK APPLICATION NUMBERS**

**UK00004066057, UK00004070294,
UK00004070286 AND UK00004066046**

BY

SHISEIDO AMERICAS CORPORATION

TO REGISTER TRADE MARKS

IN CLASSES

3 AND 35

AND

OPPOSITIONS THERETO UNDER

OPPOSITION NUMBERS

**OP000450048, OP000450202,
OP000450201 AND OP000450483**

BY

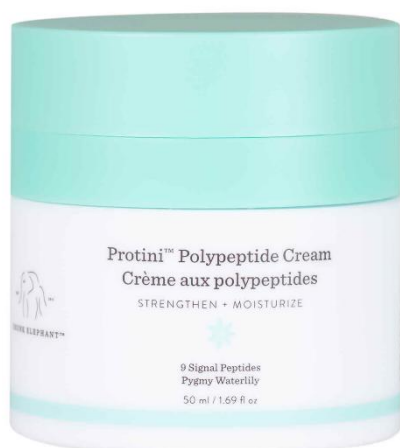
SOCIUM DISTRIBUTION LIMITED

BACKGROUND AND PLEADINGS

1. On 20 June 2024, Shiseido Americas Corporation (“the applicant”) filed an application under number UK00004066057 (“the first application”), the application being published for opposition purposes on 5 July 2024.
2. Registration for the first application is sought for the following goods and services:

Class 3	Face creams; skin moisturizer; non-medicated lotions for face; non-medicated skin care preparations; cosmetics; beauty preparations; beauty serums; moisturizing creams; facial cleansers.
Class 35	Retail services in relation to face creams, skin moisturizer, non-medicated lotions for face, non-medicated skin care preparations, cosmetics, beauty preparations, beauty serums, moisturizing creams and facial cleansers.
3. The first application is a three-dimensional (“3D”) mark, and I copy below the five representations of the mark that are on file.

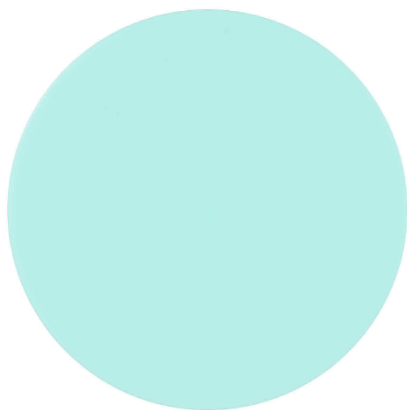
Representation 1



Representation 2



Representation 3



Representation 4



Representation 5



4. On 1 July 2024, the applicant filed an application under number UK00004070294 (“the second application”), the application being published for opposition purposes on 12 July 2024.
5. Registration for the second application is sought for the following goods and services:

Class 3	Moisturizing creams; non-medicated skin care preparations; cosmetics; beauty preparations; beauty serums; face creams; skin moisturizer; non-medicated lotions for the face; facial cleansers; face masks.
Class 35	Retail services in relation to moisturizing creams, non-medicated skin

care preparations, cosmetics, beauty preparations, beauty serums, face creams, skin moisturizer, non-medicated lotions for the face, facial cleansers and face masks.

6. The second application is a 3D mark, and I copy below the six representations of the mark that are on file.

Representation 1



Representation 2



Representation 3



Representation 4



Representation 5



Representation 6



7. On 1 July 2024, the applicant filed an application under number UK00004070286 (“the third application”), the application being published for opposition purposes on 12 July 2024.
8. Registration for the third application is sought for the following goods and services:

Class 3	Moisturizing creams; non-medicated skin care preparations; cosmetics; beauty preparations; beauty serums; face creams; skin moisturizer; non-medicated lotions for the face; facial cleansers.
Class 35	Retail services in relation to moisturizing creams, non-medicated skin care preparations, cosmetics, beauty preparations, beauty serums, face creams, skin moisturizer, non-medicated lotions for the face and facial cleansers.
9. The third application is a 3D mark, and I copy below the six representations of the mark that are on file.

Representation 1



Representation 2



Representation 3



Representation 4



Representation 5



Representation 6



10. On 20 June 2024, the applicant filed an application under number UK00004066046

("the fourth application"), the application being published for opposition purposes on 26 July 2024.

11. Registration for the fourth application is sought for the following goods and services:

Class 3 Moisturizing creams; non-medicated skin care preparations; cosmetics; beauty preparations; beauty serums; face creams; skin moisturizer; non-medicated lotions for the face; facial cleansers.

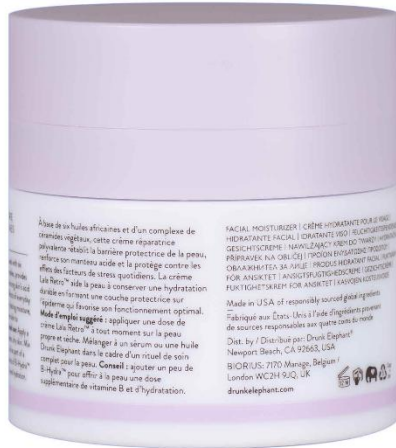
Class 35 Retail services in relation to moisturizing creams, non-medicated skin care preparations, cosmetics, beauty preparations, beauty serums, face creams, skin moisturizer, non-medicated lotions for the face and facial cleansers.

12. The fourth application is a 3D mark, and I copy below the five representations of the mark that are on file.

Representation 1



Representation 2



Representation 3



Representation 4



Representation 5



13. The opposition cases - OP000450048, OP000450202, OP000450201 and OP000450483 – were filed against the first, second, third and fourth applications respectively on Form TM7s dated 7 October 2024, 14 October 2024, 14 October 2024 and 28 October 2024 by Socium Distribution Limited (“the opponent”), together with statements of grounds. Each of the cases is based upon sections 3(1)(a), (b), (c) and (d) of the Trade Marks Act 1994 (“the Act”).
14. The applicant filed Form TM8s and counterstatements denying the claims made.
15. The proceedings were consolidated on 3 April 2025.

16. Both sides filed evidence which is summarised below. Neither party requested a hearing, but both parties filed written submissions in lieu.

17. The applicant is represented by Stobbs whereas the opponent is represented by Clarion Solicitors Limited.

Evidence

18. The opponent filed evidence in the form of the witness statement from Donna Burton, a director of the opponent, signed and dated 17 June 2025, together with Exhibit DB1 which is referred to later in this decision.

19. The applicant filed evidence in the form of a witness statement from Hannah Cramp of the applicant's representatives, signed and dated 18 August 2025, together with Exhibits HC1 to HC5.

20. Exhibit HC1 shows that the applicant owns two UK registered 3D marks which could be said to be similar in their characteristics to the applications before me.

21. Exhibit HC5 shows that the applicant owns the following UK registered marks:

- UK00917450297 and UK00003283929 (the word marks "DRUNK ELEPHANT") which correspond to the words "DRUNK ELEPHANT" in the applications.
- UK00917450388 and UK00003283939 (both figurative marks)



which correspond to the picture of an elephant in the applications.

- UK00003336012 and UK00917949144 (the word marks "PROTINI") which correspond to the word "Protini" in the first application.

- WO0000001705700 (the word mark “BRIGHTFACIAL”) which corresponds to the word “Brightfacial” in the second application.
- UK00917999906 and UK00003359575 (the word marks “A-PASSIONI”) which correspond to the word “A-Passioni” in the third application.
- UK00004046262 (the word mark “DRUNK ELEPHANT LALA RETRO”) which corresponds to the words “Lala Retro” in the fourth application.

22. The opponent filed evidence in reply in the form of a witness statement from Ashton Craven-Lockwood, an associate at the opponent’s representatives, signed and dated 20 October 2025, together with Exhibit ACL1.

23. The exhibit is a letter from the opponent which concerns negotiations between the parties. The opponent declared this letter to be “open” and not to be “without prejudice” correspondence and the evidence was admitted into the proceedings. For its part, the applicant considers the correspondence to be without prejudice material.

24. Ashton Craven-Lockwood, at paragraph 4 of their witness statement says the following:

“... Party A has made an offer to settle this matter on terms set out in Exhibit ACL1. Insofar as Party B rejects Party A’s offer of settlement contained in the letter in Exhibit ACL1, it is evident that Party B views the protection sought by the Applications as being for the generic shape and common colours of products of the nature of those pictured in the Applications.”

25. I can find no basis for Ashton Craven-Lockwood’s claim. Exhibit ACL1 is a letter from the opponent to the applicant. It contains no details as to what the applicant’s response to this letter was and so there is nothing in this evidence to show that the applicant views its applications as seeking protection for generic shapes and common colours. This evidence is therefore of no assistance to the opponent.

DECISION

Relevance of EU law

26. 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. This is why this decision continues to make reference to the trade mark case law of EU courts.

Section 3(1)(a)

27. Section 3(1)(a) reads as follows:

“(1) The following shall not be registered –

(a) signs which do not satisfy the requirements of section 1(1).

[...]”

28. Section 1(1) 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.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals, colours, sounds or the shape of goods or their

packaging.”

29. Strictly speaking, there is no need for me to decide whether this ground succeeds or fails in the context of section 1(1)(b). As Mr Geoffrey Hobbs QC, as the Appointed Person in *AD2000 Trade Mark*,¹ pointed out, section 3(1)(a) permits registration provided that the mark is “capable” to the limited extent of “not being incapable” of distinguishing. Consequently, if I am satisfied that the mark complies with section 3(1)(b) of the Act, the “incapable of distinguishing” objection under section 3(1)(a) is bound to fail. Alternatively, if the ground under section 3(1)(b) succeeds, the outcome under section 3(1)(a) becomes moot. However, as I will be addressing the opponent’s objection in the context of section 1(1)(a), I will also address section 1(1)(b) for the sake of completeness.

The opponent’s evidence and submissions

30. Donna Burton’s witness statement says that:

“4 The basis of the Company’s opposition to the Trade Mark Applications includes the assertion that the marks applied for consist of shapes and design elements which are commonplace in the beauty and cosmetic industry. In particular, the shape and configuration of the containers fall within the norms and customs of the sector and are not distinctive. I am concerned that, through the Trade Mark Applications, the Applicant is seeking to gain a monopoly right over the non-distinctive shapes and colours of its products’ designs.”

31. Ms Burton then proceeds to comment on Exhibit DB1 which consists of a list of images of moisturising creams with product name, brand, and the date from which they have been on sale:

“9 Given the importance of shape and colour in the beauty industry,

¹ [1997] RPC 168.

particularly skincare and moisturisers, it is no surprise that such shaped containers with brightly coloured lids are widespread in the industry, and there are clearly numerate [*sic* – I take the intended word here to be “numerous”] examples that pre-date the Trade Mark Applications. It is not possible for the Applicant to show that its 3D shape marks are distinguishable from those designs and containers that existed long before the Trade Mark Applications given that they are so commonplace and do not depart significantly from the norms and customs of the beauty industry.

- 10 It is obvious, from a review of the Trade Mark Applications, given the inclusion of the relevant products list of ingredients, size and manufacturer details, all of which are incidental to the design, the marks are intended to be for moisturising creams as products, in a white container and brightly coloured lid, rather than for a mark capable of clearly distinguishing the goods and services and being clearly represented graphically on the trade mark register.”

32. Further, at paragraph 5.1 of its submissions in lieu, the opponent says the following:

“The Applicant made the Applications as 3D shape marks. A 3D shape mark should allow the registrar, other competent authorities and the public to determine the clear and precise subject matter of the protection afforded to the Applicant and distinguishing the Applicant's goods and services from those of other undertakings ... The Opponent submits that it is not possible for the Applicant to show that its 3D shape marks, being cylinder or rectangle containers, are distinguishable from those containers that pre-date the Applications given that they are so commonplace ... The Opponent submits that this is a clear attempt by the Applicant to register and monopolise an infinite number of signs. In *Dyson* (Case C-321/03), the applicant sought to register two

trade marks for a transparent bin (or collection chamber) on vacuum cleaners. The European Court of Justice (the "**ECJ**") found that the marks were intended to protect the idea of a transparent bin or collecting chamber, which could take many forms. Consequently, the marks were deemed to represent mere properties of the goods and services and did not constitute signs. The ECJ noted that registering such marks could give their holders an unfair advantage over their competitors, and as such, did not meet the requirements for registration."

The applicant's submissions

33. At paragraph 8 of its submissions in lieu, the applicant says the following:

"It is plain from a simple view of the Applications that what Party B [the applicant] is attempting to protect is a 3D trade mark, including the specific placement of certain elements such as colour and wording on the shapes. If Party B had attempted to protect the shape per se, then it would have done so via 3D applications without these additional elements (and, in any event, there is no requirement in the Act that a mark protecting shape must only protect shape alone; indeed, the UK IPO's Manual of Trade Marks Practice states that a 3D mark includes representations of containers and packaging). Likewise, if the Applicant had attempted to protect colour alone, then it would have filed applications to protect colour(s) per se."

My analysis

34. I consider these marks, which combine more than one instance of what a trade mark can consist of, to be a long way from the circumstances of the *Dyson* case cited by the opponent. In that case it was held:

"35. In the present case, it is common ground that the subject matter of the

application in the main proceedings is not a particular type of transparent collecting bin forming part of the external surface of a vacuum cleaner, but rather, in a general and abstract manner, all the conceivable shapes of such a collecting bin.

36. In that regard, Dyson cannot maintain that the subject matter of its application in the main proceedings is capable of being perceived visually. What consumers can identify visually is not so much the subject matter of the application as two of Dyson's graphic representations as contained in the application. Those representations cannot be assimilated to the subject matter of the application because, as pointed out by Dyson on a number of occasions, they are merely examples of it.”

35. In this case, the applications consist of specific 3D shapes which include specific words, a specific figurative element, and specific colours. Each of the marks has been filed as five or six photographic representations which show different perspectives on the 3D object.

36. I note the opponent's submissions in lieu at paragraph 2.7 where it asserts that “the Drunk Elephant logo and name [is] only partially visible in the case of UK App Nos. 4066057 and 4066046” and the applicant's statement at paragraph 20 of its submissions in lieu that the logo “is wholly visible in all of the Applications (albeit from more of a side-on view in Application Nos. UK00004066057 and UK00004066046).” Having assessed the marks, I find that although the words “DRUNK ELEPHANT” in the first and fourth applications are slightly compressed by the curvature of the container, this does not preclude these marks from satisfying section 1(1)(a) of the Act. I consider all four marks to be visually represented in a manner which is sufficiently clear and precise as to the protection afforded to the applicant and consequently, they comply with section 1(1)(a).

37. I turn now to section 1(1)(b) and the contested mark's capability of distinguishing. In *Stichting BDO v BDO Unibank, Inc* [2013] F.S.R. 35 (HC) Arnold J (as he then was) said:

“44. [...] As I discussed in *JW Spear & Sons Ltd v Zynga Inc* [2012] EWHC

3345 (Ch) at [10]-[27], the case law of the Court of Justice of the European Union establishes that, in order to comply with art.4, the subject matter of an application or registration must satisfy three conditions. First, it must be a sign. Secondly, that sign must be capable of being represented graphically. Thirdly, the sign must be capable of distinguishing the goods or services of one undertaking from those of other undertakings.

45. The CJEU explained the third condition in Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* [2004] ECR I-1619 as follows:

“80. As a preliminary point, it is appropriate to observe, first, that the purpose of Article 2 of the Directive is to define the types of signs of which a trade mark may consist (Case C-273/00 *Sieckmann* [2002] ECR I-11737, paragraph 43), irrespective of the goods or services for which protection might be sought (see to that effect *Sieckmann*, paragraphs 43 to 55, *Libertel*, paragraphs 22 to 42, and Case C-283/01 *Shield Mark* [2003] ECR I-0000, paragraphs 34 to 41). It provides that a trade mark may consist inter alia of ‘words’ and ‘letters’, provided that they are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

81. In view of that provision, there is no reason to find that a word like ‘Postkantoor’ is not, in respect of certain goods or services, capable of fulfilling the essential function of a trade mark, which is to guarantee the identity of the origin of the marked goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin (see, in particular, Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 28, *Merz & Krell*, paragraph 22, and *Libertel*, paragraph 62). Accordingly, an interpretation of Article 2 of the Directive appears not to be useful for the purposes of deciding the present case.”

46. The Court went on to say that the question whether POSTKANTOOR (Dutch for POST OFFICE) was precluded from registration in respect of

particular goods and services (i.e. those provided by a post office) because it was devoid of distinctive character and/or descriptive in relation to those particular goods and services fell to be assessed under Article 3(1)(b) and (c) of the Directive (Article 7(1)(b) and (c) of the Regulation).

47. It follows that “the goods or services” referred to in Article 4 are not the particular goods or services listed in the specification, as counsel for the defendants argues. Rather, the question under Article 4 is whether the sign is capable of distinguishing any goods or services.”

38. Article 4 of Regulation 207/2009 of 26 February 2009 on the Community trade mark (codified version) is the equivalent to section 1(1) of the Act, set out above. The contested marks in these proceedings are not incapable of distinguishing any goods or services. It follows that the contested marks satisfy section 1(1)(b) of the Act.

39. The oppositions under section 3(1)(a) fail.

Sections 3(1)(b), 3(1)(c) and 3(1)(d)

40. Sections 3(1)(b), (c) and (d) read as follows:

“3(1) The following shall not be registered –

(a) [...]

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

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) 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.”

41. The relevant dates under sections 3(1)(b), 3(1)(c) and 3(1)(d) are the dates of filing of the contested marks i.e. 20 June 2024, 1 July 2024, 1 July 2024, and 20 June 2024 respectively.

42. I bear in mind that the above grounds are independent and have differing general interests. It is possible, for example, for a mark not to fall foul of section 3(1)(c) but still be objectionable under section 3(1)(b): *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P at [25].

43. The position under the above grounds must be assessed from the perspective of the average consumer, who is deemed to be reasonably observant and circumspect: *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04. The average consumer varies depending on the particular goods and services concerned. In this case, the average consumer is likely to be a member of the general public who purchases face creams and related goods and who utilises the retail services thereof. The cost of the goods will not generally be excessive. The average consumer will give some consideration to the ingredients and properties of the face creams and related goods. Overall, I consider that a medium level of attention is likely to be paid during the purchasing process.

Section 3(1)(b)

44. The principles to be applied under article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation, and is identical to article 3(1)(b) of the Trade Marks Directive and section 3(1)(b) of the Act) were conveniently summarised by the Court of Justice of the European Union (“CJEU”) in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

“29. [...] the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and

C-474/01 P *Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37).”

45. The opponent, in its submissions in lieu says the following:

“5.2 ... [T]he Tribunal must find that the Applications are devoid of any distinctive character ... The Opponent submits that it is not possible for the Applicant to show that its 3D shape marks, being cylindrical or rectangular containers, are distinguishable from those containers that existed long before the Applications given that they are so commonplace and do not depart significantly from the norms and customs of the beauty industry (*Jaguar Land Rover Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2016] ETMR 12 and *Freixenet v OHIM*, C-344/10). In the case of colour, distinctiveness without prior use is inconceivable save in exceptional circumstances, and particularly where the number of goods and services for which the mark is claimed is very restricted and the relevant market very specific (*Libertel*, C-104/01). The remaining Application Features are wholly descriptive, referencing the properties of the goods (to which the mark is applied) as a moisturising cream containing certain ingredients, the size of the container, the ingredients contained in the goods, and the contact details of the Applicant. The Opponent again submits that the partially visible elements of the mark should not be considered as forming part of the Applications as they do not enable the registrar, other competent authorities and the public to determine the clear and precise subject matter of the protection afforded to the Applicant.”

46. The applicant has chosen to address both section 3(1)(b) and section 3(1)(c) in its submissions in lieu:

“20. It is appropriate to deal with Sections 3(1)(b) and (c) of the Act together. Party B's case is simple: the Applications are clearly inherently

distinctive and non-descriptive. As has been discussed above, the Applications seek to protect the specific subject matter as presented in the images therein. While this includes the shapes of the respective products, the Applications also include:

- The placement of colours on the tops of the containers,
- The distinctive names PROTINI™ Polypeptide Cream, LALA RETRO™ Whipped Cream, A-PASSIONI™ Retinol Cream, and BOUNCY BRIGHTFACIAL™,
- The distinctive trade mark "DRUNK ELEPHANT", and
- The distinctive logo, (the "Drunk Elephant Logo")



which is wholly visible in all of the Applications (albeit from more of a side-on view in Application Nos. UK00004066057 and UK00004066046).

...

22. The Applicant submits that the Applications are inherently distinctive and non-descriptive as their complete wholes. In other words, the combination of all of the elements/features of the Applications render them inherently distinctive and non-descriptive. Moreover, the inclusion of the distinctive elements PROTINI, LALA RETRO, A-PASSIONI, BOUNCY BRIGHTFACIAL, and DRUNK ELEPHANT, and the Drunk Elephant Logo, mean that the Applications cannot be said to consist exclusively of a sign which may serve in trade to designate the kind of goods, nor can they be said to be devoid of any distinctive character."

47. Each of the marks displays the words "DRUNK ELEPHANT" below a picture of an elephant. Given that the words and the picture of an elephant are not descriptive of the goods and services, the contested marks cannot be said to be devoid of any distinctive character. Moreover, while they are secondary to the principal distinctive

elements in the applications – the words “DRUNK ELEPHANT” and the picture of an elephant – I also consider the words “Protini” in the first application, “A-Passioni” in the third application, and “Lala Retro” in the fourth application to be non-descriptive. The oppositions under section 3(1)(b) fail.

Section 3(1)(c)

48. The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was set out by Arnold J. (as he then was) in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (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 (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94, see *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; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461, paragraph 24).[...]

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 (see, inter alia , *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44, paragraph 45, and *Lego Juris v OHIM* (C-48/09 P), paragraph 43).

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 (see, to that effect, *OHIM v Wrigley* , paragraph 31 and the case-law cited).

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 (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie*, paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

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 (*Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and *Case C-363/99 Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). 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 (*Koninklijke KPN Nederland*, paragraph 57).

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 (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

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 (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), 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 (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56).”

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: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97].”

49. The opponent, in its submissions in lieu says the following:

“5.4 ... the Tribunal must find that the Applications consist exclusively of signs that may serve, in trade, to designate the characteristics of the goods and services for which registration is sought ... Moisturising creams and other beauty products and cosmetics are often sold in cylindrical or rectangular bottles or containers.”

50. I remind myself that the marks must be considered in their totality. As previously stated, each of the marks displays the words “DRUNK ELEPHANT” below a picture of an elephant. Given that the words and the picture of an elephant do not designate any characteristics of the goods and services at issue, the contested marks cannot be said to be exclusively so designating and are compliant with section 3(1)(c). Moreover,

while they are secondary to the principal distinctive elements in the applications – the words “DRUNK ELEPHANT” and the picture of an elephant – I also consider the words “Protini” in the first application, “A-Passioni” in the third application, and “Lala Retro” in the fourth application not to designate any characteristics of the goods and services. The oppositions under this ground fail.

Section 3(1)(d)

51. 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)."

See also: *Merz & Krell GmbH & Co* [2002] ETMR 21 (CJEU) and *Stash Trade Mark* – BL O/281/04 (AP)

52. In light of the above case law, the pertinent question is whether, on the relevant dates, the marks had, based on the perception of the average consumer of the goods and services in the UK, "become customary in the current language or in the bona fide and established practices of the trade" to designate the goods and services covered by the mark.

The parties' submissions

53. The opponent, in its submissions in lieu, says the following:

"5.4 ... the Tribunal must find that the Applications consist exclusively of signs that ... are shapes which are customary in the established and bona fide practices of the trade. Moisturising creams and other beauty products and cosmetics are often sold in cylindrical or rectangular bottles or containers."

54. The applicant, in its submissions in lieu, says the following:

"30. To attempt to support its case under Section 3(1)(d), Party A has

submitted evidence via a witness statement signed by Donna Burton. The witness statement introduces some marketplace material which attempts to demonstrate the norms and customs of the relevant beauty and cosmetic industry. It is submitted that Party A has simply not proved in evidence that the Applications do not significantly depart from the norms and customs of the sector - in fact, Party A has failed entirely at demonstrating what the norms and customs of the sector are.

31. The Opponent's evidence does not give an overview or even a representative sample of the relevant sector of the products in question, which can be broadly categorised as skin care products. Without any picture of what the sector is, or is comprised of, it is impossible to decide what norms and customs there may - or may not - be.

...

51. The Opponent has not proved that the Applications 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. In the witness statements of Donna Burton (both original and as amended), this is the primary case put forward by the Opponent, and yet the sector and the norms and customs of it have not been established."

My analysis

55. Whether or not the opponent's evidence provides a sufficiently full picture of established practices in the relevant trade and whether or not the containers that constitute the 3D objects in the applications can be said to be typical of that trade, the applications do not consist exclusively of signs which have become customary in the trade. As previously stated, the applications also include specific words, a specific figurative element, and specific colours. I have found some of those words and the figurative element to be distinctive and where I have made that finding, the words in question have not become customary in the current language of the trade.

56. The oppositions under section 3(1)(d) fail.

CONCLUSION

57. The oppositions fail in their entirety, and the applications will proceed to registration.

COSTS

58. The applicant has been successful and is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1 of 2023. I assess these as follows:

Preparing statements and considering the other side's statements: £500

Preparing evidence and considering the other side's evidence: £1000

Preparation of submissions in lieu: £500

Total: £2000

59. I therefore order Socium Distribution Limited to pay Shiseido Americas Corporation the sum of £2000. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the final determination of the appeal proceedings.

Dated this 27th day of August 2026

John Williams

For the Registrar