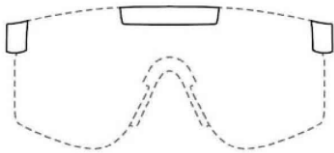


TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER UK00003951001

FILED BY PITT VIPER, LLC

TO REGISTER THE FOLLOWING MARK IN CLASS 9



**Mark Description:** The trade mark consists of a three-dimensional configuration of eyewear comprising a horizontal bar placed at the top mid-point of the front of the spectacle lens in combination with a pair of tabs at the top corners of the front of the spectacle lens. The dotted lines do not form part of the trade mark and are intended to show positioning of the mark on the goods.

**BACKGROUND**

1. On the 29 August 2023, Pit Viper, LLC (“the applicant”) applied to register the above 3D mark for the following goods in class:

*Class 9: Eyewear; eyeglasses and sunglasses; eyewear frames.*

2. On the 11 September 2023 the Intellectual Property Office (“IPO”) issued an examination report in response to the application. In the report, the following objection was raised under section 3(1)(b) of the Trade Marks Act 1994 (“the Act”):

**Section 3(1)(b)**

*The application is not acceptable in Class 9. There is an objection under Section 3(1)(b) of the Act as the mark is devoid of any distinctive character. This is because the mark consists of a non-distinctive horizontal rectangle in combination with two tabs applied to the front of the goods, which would merely be seen as a non-distinctive decorative feature on the goods. Therefore, without being educated as to the trade origin, the average UK consumer when seeing this mark, would not attribute any trade mark significance to it.*

*The mark is lacking the distinctive character required in order for it to function as a badge of origin for the goods. For an application to be considered distinctive and capable of indicating a single trade source it should have an element that is unique to the applicant and sets them aside in the market place. This mark does not appear to meet this criteria.*

3. In line with standard IPO procedure, a period of two months was allowed for the applicant to respond.
4. On the 13 October 2024, Bonham IP Limited (the attorney) , acting on behalf of the applicant requested a hearing in order to address the objection under 3(1)(b) of the Act.

5. A hearing was scheduled for 15 November 2023 and was attended myself on behalf of the IPO and Ms Jennifer Good who was acting on behalf of Bonham IP Limited.
6. Ms Good made the following aural submissions at the hearing in support of establishing that the mark was distinctive in the *prima facie*:
  - *The mark which consisted of a horizontal bar at the top, mid-point of the front of the glasses, in combination with a pair of tabs at the top corners would be perceived as unusual by the average consumer.*
  - *The average consumer would likely pay a medium to high degree of attention as they are intended to provide protection for the eyes.*
  - *The average consumer has become accustomed to view such signs as indications of commercial origin as in, for example, the red tag on Levi jeans.*
  - *That this unconventional sign should not be subject to any stricter test than other kinds of trade mark and that the mark in question departs significantly from the norms and customs of the sector.*
  - *As a consequence of the above factors, an average consumer would view the sign as a unique and unusual feature of the goods, rendering the sign capable of acting as an indication of commercial origin of the goods.*
7. At the hearing, I maintained the *prima facie* objection under 3(1)(b) and set out my reasons in the report dated 28 November 2023. Those reasons could be summarised as follows:
  - *Sunglasses take a wide variety of shapes and styles, with no unified characteristics save for having arms and lenses.*
  - *As a result of the breadth of differing appearances of sunglasses, the norms and customs of the sector are considered to encompass a wide gamut of styles and configurations.*
  - *Having established the 'norms and customs' of the trade, a sign consisting of a 'bar and tabs' on the goods (in the position shown in the mark representation) was not considered to have departed significantly from the norms and customs of the sector.*
  - *That the sign is rendered devoid of the requisite degree of distinctive character as a consequence of being perceived by the average consumer as a decorative or stylistic feature of the goods.*
8. On 25 January 2024, the attorney requested an extension of time in order to allow time to compile evidence in support of a plea of acquired distinctiveness. This request was accepted.
9. On the 27 February 2024, Ms Good provided a witness statement signed by Mr Christopher Garcin, the co-founder of Pit Viper LLC, along with supporting exhibits CG1 – CG9 in support of demonstrating that the sign had acquired a distinctive character as a result of its use as a trade mark in the UK.
10. Following a thorough examination of the evidence I did not consider it to be sufficient to prove that the sign in question had acquired a distinctive character for the purposes of functioning as a trade mark. The information provided lacked detail and as a result, did not support a finding that use of the sign was commensurate with use throughout the UK and to such a degree, that a significant proportion of the relevant public had been exposed to use of the sign as a trade mark. These shortcomings could be summarised as follows:
  - *The overwhelming majority of exhibits showing use of the 3D mark in advertising, on social media posts or on retail websites show the 3D mark used alongside other the distinctive matter, such as the words 'PIT VIPER'.*
  - *Whilst exhibits showing only use of the 3D mark in conjunction with other more traditional trade marks is not a determinative factor in its own right, no evidence was provided to*

*show that the relevant class of persons perceived the goods as originating from a particular undertaking as a result of use of the sign in question (and not other signs which may also be present).*

- *The kind of use shown in advertising materials and product listings in trade at best, demonstrate that some consumers may associate the 3D sign with the applicant, but falls short of demonstrating that consumers have come to rely on the 3D sign as a trade mark which guarantees the commercial origin of the goods.*
- *Sales figures provided were for totals of applicant's annual sales and did not appear to reflect only sales of goods bearing the sign applied for.*
- *Total sales figures of £470, 000 over a five-year period were not considered to be indicative of a significant market share in the UK.*
- *No figures for advertising spending specific to the UK were provided.*

11. On the 10 June 2024 I notified the attorney of the above assessment of the evidence and confirming that the application was refused. On 25 June 2024, the attorney submitted a form TM5.

12. Having received a request for statement of grounds of reasons for the registrar's decision, I set out my reasons below. It should be noted that the attorney did not concede the prima facie case and as such, I shall address both the prima facie case and the plea for acquired distinctiveness in this decision.

## **The Law**

13. The relevant parts of section 3 of the Act read 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 – 3(1)(b)**

14. 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 2018 (as amended by Schedule 2 of the Retained 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 some decisions of the EU courts which predate the UK's withdrawal from the EU.

15. The Court of Justice of the European Union ('CJEU') has repeatedly emphasised the need to interpret the grounds of refusal of registration listed in Article 3(1) and Article 7(1), the equivalent provision in Council Regulation 40/94 of 20 December 1993 on the Community Trade Mark, in the light of the general interest underlying each of them (*Bio ID v OHIM*, C-37/03P paragraph 59 and the case law cited there and, more recently, *Celltech R&D Ltd v OHIM*, C-273/05P).

16. 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

provision referred to above) the Court has held that "...the public interest... is, manifestly, indissociable from the essential function of a trade mark", SAT.1 SatellitenFernsehen GmbH v OHIM, C-329/02P. 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, without any possibility of confusion, to distinguish the product or service from others which have another origin (see paragraph 23 of the above-mentioned judgement). Marks which are devoid of distinctive character are incapable of fulfilling that essential function.

17. Section 3(1)(b) 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 ECJ provided guidance in *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (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).*

18. Of particular relevance to these proceedings, and as considered in joined cases C344/10 P and C-345/10 P *Freixenet SA*, is the fact that three dimensional marks which consist of the appearance of the goods are not subject to stricter criteria of assessment:

45. *It is also settled case-law that, the criteria for assessing the distinctive character of three-dimensional trade marks consisting of the appearance of the product itself are no different from those applicable to other categories of trade mark (see, in particular, Mag Instrument v OHIM, paragraph 30; Case C173/04 P Deutsche SiSi-Werke v OHIM [2006] ECR I-551, paragraph 27; Storck v OHIM, paragraph 26, and Case C-144/06 P Henkel v OHIM [2007] ECR I-8109, paragraph 36).*

46. *However, when those criteria are applied, account must be taken of the fact that the perception of the average consumer is not necessarily the same in relation to a three-dimensional mark consisting of the appearance of the product itself as it is in relation to a word or figurative mark consisting of a sign which is independent of the appearance of the products it designates. Average consumers are not in the habit of making assumptions about the origin of products on the basis of their shape or the shape of their packaging in the absence of any graphic or word element, and it could therefore prove more difficult to establish distinctive character in relation to such a three-dimensional mark than in relation to a word or figurative mark (see, in particular, Mag Instrument v OHIM, paragraph 30; Deutsche SiSi-Werke v OHIM, paragraph 28, and Storck v OHIM, paragraph 27).*

47. *In those circumstances, only a mark which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin is not devoid of any distinctive character for the purposes of Article 7(1)(b) of Regulation No 40/94 (see, in particular, Mag Instrument v OHIM, para 31; Deutsche SiSi-Werke v OHIM, para 31, and Storck v OHIM, para 28).*

19. Insofar as deciding whether a mark departs significantly from the norm, Lord Justice Kitchen identified three steps in [2017] EWCA Civ 1729, *London Taxi*,:

45. *The first step in the exercise is to determine what the sector is. Then it is necessary to identify common norms and customs, if any, of that sector. Thirdly it is necessary to decide whether the mark departs significantly from those norms and customs.*

20. In respect of the 'European test' or the 'norms and customs' test, this was commented on in the 16<sup>th</sup> Edition of Kerley's, at chapter 10, which states:

10-035. *The essential function of a trade mark is to distinguish the goods and/or services of one undertaking from those of other undertakings and the term "distinguish" must be understood in that way. The attribute of a trade mark which gives it the necessary ability to "distinguish" is its distinctive character, but the assessment of distinctive character is really an assessment of whether the sign/trade mark can distinguish in the sense just mentioned.*

10-036. *Problems arise if the term "distinguish" is used or understood more loosely. The examples given below demonstrate that "distinguish" can and has been used to mean different things. First, there is the correct meaning: see the citations from the Court of Justice judgments set out above<sup>1</sup>.*

10-037. *Secondly, the term "distinguish" can be used in the sense of "different". In the past, this meaning tended to be used (especially in CFI judgments) in cases involving the shapes of goods or their packaging, where the applicant frequently argues to this effect: "my mark has (the minimum degree of) distinctive character because it can clearly be distinguished from others in the market." This type of argument is utterly bogus. It amounts to nothing more than saying that "my mark is different". Deployment of this type of argument is a clear sign that the mark does not have distinctive character.*

10-038. *Thirdly, "distinguish" or "distinctive" is used in the sense of "standing out", likely to attract the attention of the consumer. This is a slight variation on "different", in that the mark is now adjudged to be sufficiently different such that it attracts the attention of the consumer. However, there are many things which will attract the attention of the consumer (bright or garish colours, snazzy graphics, bold claims) which have nothing to do with distinctive character. The usefulness of this concept depends entirely on whether the consumer's attention is attracted in the right "trade-origin message" manner.*

10-039. *Fourthly, the term "distinguish" is used in the "recognition" sense. Again, this may be only a slight variant on the above, but it has a greater aura of respectability because it involves the average consumer. Thus, the applicant argues to this effect: "my mark has distinctive character because the average consumer would recognise it, thereby enabling him or her to repeat the purchasing experience if positive or avoid it if negative." The CFI has correctly rejected recognition as being sufficient in some cases, e.g.:*

*49 The fact that consumers may get into the habit of recognising such a product from its get up is not enough to preclude the ground for refusal based on Article 7(1)(b) of the Regulation – Unilever v OHIM (T-194/01)*

21. As well as the commentary in Kerly's (above), the same submissions have been explored in previous decisions. In Bongrain ([2004] EWCA Vic 1690) it was stated that:

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<sup>1</sup> Those being cited being C-5301 *Linde*, C-104/01 *Libertel*, and C-64/02 *DAZ PRINZIP*

26 With that I can turn to Mr Malynicz's main point – that a very fancy shape is necessarily enough to confer an inherent distinctive character. I would reject it. **As a matter of principle I do not accept that just because a shape is unusual for the kind of goods concerned, the public will automatically take it as denoting trade origin, as being the badge of the maker.** at the heart of trade mark law is the function of a trade mark – expressed in Recital 10 of the Directive as an indication of origin. The perception of the public – of the average consumer is what matters. Mr Daniel Alexander QC, for the Registrar, helpfully pointed out that the kinds of sign which may be registered fall into a kind of spectrum as regards public perception. This starts with the most distinctive forms such as invented words and fancy devices. In the middle are things such as semi-descriptive words and devices. Towards the end are shapes of containers. The end would be the very shape of the goods. Signs at the beginning of the spectrum are of their very nature likely to be taken as put on the goods to tell you who made them. Even containers, such as the fancy Henkel container, may be perceived as chosen especially by the maker of the contents (e.g. shampoo) to say "look – here is the product of me, the maker of the contents". **But, at the very end of the spectrum, the shape of goods as such is unlikely to convey such a message.** The public is not used to mere shapes conveying trade mark significance, as the Court pointed out in Henkel (detergent tablets). The same point was made about slogans in Das Prinzip der Bequemlichkeit, para. 35: (my emphasis added)

*"the authorities may take account of the fact that average consumers are not in the habit of making assumptions about the origin of products on the basis of such slogans."*

27 As regards the sentence from Henkel (detergent tablets) quoted above at para. 13, **I do not read the Court as saying – almost as an incidental matter – that a fancy shape is ipso facto enough for registration.** Mr Malynicz suggests we read "thereby" as "therefore". **I think the Court is saying no more than that fancy shapes – those which depart significantly from the norm – may fulfil the essential function, not that they must.** The approach in Mag Instrument is particularly instructive. What matters is: (my emphasis added)

*"the presumed expectations of an average consumer" (para.7) In that case the fact that the shapes of the torches had in fact become well-known after the date of application was not enough to prove they had inherent distinctiveness within the meaning of Art.7(1)(b) of the Community Trade Mark Regulation (equivalent to Art.3(1)(b) of the Directive) (judgment para. 64).*

28 So I think Mr Malynicz's principal contention is wrong. **Even if the shape of the goods themselves is indeed fancy, that is not enough to entitle a would-be trader in them to registration as a trade mark...** (my emphasis added)

### **Application of legal principles – Section 3(1)(b) – The case in the prima facie**

22. In applying the above principles to this case, I am obliged to first identify who would constitute the relevant consumer given the goods specified in this application. I must then seek to establish if this average consumer or the sales process, for example, would have any attributes or characteristics which might lead to the perception of such a mark which may be origin specific rather than origin neutral. To this end, the goods comprise of eyewear in the form of eyeglasses, sunglasses and eyewear frames and it is considered that such goods would be purchased by the general public, who would be paying a medium to high degree of attention when confronted by the sign. The attorney suggested at the hearing that the goods were not bought by the consumer based merely on their aesthetic appeal but also due to the protection the goods afforded to the eyes. This, the attorney argued, should lead to a finding that the goods are a more considered purchase and that the average consumer would be paying a higher degree of attention.

23. I am not convinced that whether the consumer pays a high level or medium level of attention in the purchase of these items makes any difference to the question whether such a mark is perceived as a trade mark in the prima facie. I will simply observe from my own experience that eyewear has a dual purpose, to technically correct eyesight or protect from the sun's glare but also as an obviously visible piece of fashion wear. I also appreciate that even if it is established that the degree of attention of the relevant consumer is higher than that of an average consumer, this does not, in and of itself, lead to a finding that a sign which is weaker in distinctive character is rendered sufficiently distinctive (see *CJEU C-311/11P Smart Technologies ULC v. OHIM* – [at para 48]).
24. Having established the sector in which the goods in question would be marketed and sold as well as the likely level of attention of the average consumer engaged in that sector, I move on to consider the distinctive character of the goods. The mark consists of a three-dimensional configuration of a bar positioned at the centre point of the top edge of the eyewear and two 'tabs' positioned in each of the top corners of the goods (as seen in the representation above). The attorney claimed at the hearing that these particular elements placed on the goods in the configuration specifically shown in the representation, would strike the average consumer as unusual. In the attorney's view, this is because it is more common for eyewear to have a complete frame, rather than just the sections of the frame shown in the mark representation. It was stated that the result of these factors must lead to a finding that the sign for which protection is sought departs significantly from the norms and customs of the eyewear sector with a result that the sign cannot be held to be devoid of any distinctive character.
25. As a result of this core argument from the applicant, it appears that these 'norms and customs' considerations represent a logical starting point in my assessment of the prima facie case. It is noted that in this regard, no evidence in support of the applicant's assertion that the sign departs significantly from the norms and customs of the trade was adduced at the hearing. I am mindful of the comments of Mr Geoffrey Hobbs KC in *Valrhona S.A.S (BL O/0638/24)* where he found that:

*22. On first principles, a shape must by nature and / or nurture possess a distinctive character when applied to goods of the kind specified in the request for protection by registration in order to be free of objection under s.3(1)(b) of the Act. Distinctiveness is a relative concept in the sense that it falls to be assessed with proper regard for the norms and variations of shape that are liable to be encountered in use in the market sector in which protection has been requested. It must be clear to the decision taker that the shape in question is or has become sufficiently arresting to overcome consumer inertia in the perception of shapes as indications of trade origin. And it cannot be assumed that an assessment made in the light of circumstances prevailing in the marketplace at one point in time will necessarily hold good in the light of circumstances prevailing in the marketplace at a substantially earlier or substantially later point in time.*

*23. All of which points to the desirability of the decision taker being provided with evidence demonstrative of the norms and variations of shape liable to be encountered in use in the relevant market sector. Nothing of substance was provided for consideration in the present case. The Applicant's General Director, Mr Jean-Luc Grisot, simply asserted in para. 32 of his Witness Statement dated 23 June 2023 that its chocolate bean shape "is a unique shape that is only used by VALRHONA". The Hearing Officer filled the gap by maintaining the position that "From my own knowledge of chocolate products on the market, I do not regard the features of the mark to be enough to conclude that the shape of the chocolate 'in its totality' departs significantly from the norms and customs of the trade" (para. [33]). The Applicant endeavoured to fill the gap with narrative statements from 6 witnesses maintaining the position that within their horizons the shape of the chocolate product was unique to Valrhona. In my view, it was open to the Hearing Officer to regard their evidence as*

*inconclusive in the absence of cogent supporting evidence sufficient to establish as an objective fact that the Applicant's chocolate bean shape constituted a significant departure from the norms and customs of the trade in the market for chocolate products.*

26. As no evidence was provided supporting the assertion that the sign significantly departs from the norms and customs of the trade, I will instead take judicial notice of the fact that in respect of the appearance of eyewear, there exists a very wide array of styles. Indeed, as I have suggested above, it is considered that the average consumer would place much significance on the aesthetic and stylistic aspects of the goods. As a result of the apparent value placed on the aesthetic appeal of such goods by the consumer, who I suggest, often views goods such as sunglasses as a fashion accessory, it appears that the trade places a great deal of effort into producing a vast range of styles of eyewear.
27. The eyewear can take the form of any number of different geometric shapes or they can take the form of established fashions such as 'aviator' style, 'cat-eye' style or 'wayfarer' style, for example. They can be slim-line or oversized, they can be clip-on, wrap around or can take the form of goggles for wearing when participating in sports. They can be simplistic or very ornate and they can be high end fashionwear or be more casual, even incorporating novelty shapes (*hearts, stars etc.*). In short, it is my view that it is normal and customary for the manufacturers of eyewear to be very creative in the design of their products and provide an almost immeasurable variety of aesthetic options for consumers to select from.
28. Having set out my view on the norms and customs of the sector above, I do not concur with the attorney's assertion that the lack of a complete frame around the lenses of the eyewear constitutes a significant departure from the norms and customs of the trade. Indeed, it is perhaps interesting to note that exhibit CG4 which was provided as part of the applicant's acquired distinctiveness evidence shows a large selection of sunglasses many of which feature examples with only partial frames surrounding the lenses.
29. Accordingly, it is considered that an average consumer of eyewear, even one who may be particularly attentive, would be unlikely to perceive the sign applied for as unusual in the context of the trade; they would instead view the sign as nothing more than an aesthetic or stylistic choice, selected by the manufacturer to appeal to the consumer.
30. Regardless, even if my above assessment in respect of what is customary in the sector is held to be erroneous, it should be appreciated that the position of the UK courts appears to be more cautious than that of the CJEU in regard to the relevance of the 'norms and customs test'. The approach broadly endorsed in the EU suggests that a sign is imbued with an inherent distinctive character should it be found to depart significantly from the norms and customs of the trade. However, the UK courts appear to acknowledge that whilst departing significantly is a necessary step in the assessment of a sign's capacity to function, this test alone is not necessarily sufficient. Instead, the UK courts appear to acknowledge that there is a distinction to be made between a sign being distinctive, insofar as it 'stands out', and a sign being rendered distinctive in a trade mark sense, that is to say, the sign is distinctive because it functions as a trade mark. In this regard, it is interesting to consider the comments in the 16<sup>th</sup> Edition of Kerley's, which can be seen in para 21 above.
31. In addition to the comments in Kerley's I would highlight the approach endorsed by Mr Thomas Mitcheson KC in his 'Shape of a Lawnmower' decision (O/555/22) where he stated that:

*66. Finally, I repeat my view that the issue is best determined in a case where it matters. One can easily think of aspects of the debate that might be argued but which it was not necessary to get into on the facts before me. For example, what happens when a shape is the first in a new field. Should that result in an automatic registration (because it is unique) or automatic refusal (because it is by definition, the norm)? The test needs to be flexible*

enough to deal with this scenario, and I am not convinced that the norm and customs test alone has this attribute. **That may be why, in the end, it is safest to return to the words of the statute, however useful/convenient the norm and customs approach might be in some cases** (my emphasis added).

32. In endorsing Mr Mitcheson's approach and in returning to the statute, it is useful to reflect on the objective of 3(1)(b) of the Act and acknowledge that "...the public interest... is, manifestly, indissociable from the essential function of a trade mark", (*SAT.1 SatellitenFernsehen GmbH v OHIM, C-329/02P*). 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, without any possibility of confusion, to distinguish the product or service from others which have another origin (see paragraph 23 of the above-mentioned judgement). Marks which are devoid of distinctive character are incapable of fulfilling that essential function.
33. In summary, the mark comprises a bar running across the top of the lens of the eyewear in combination with two tabs in the upper corner of the lens (as per the representation). The average consumer of these goods would be members of the general public paying a medium to high degree of attention in respect of the goods. When seeking out eyeglasses and sunglasses, the average consumer is confronted with a vast variety of choice in respect of the outward appearance of the goods. As a result, it is posited that an average consumer who is confronted by the sign in question would perceive it as nothing more than one aesthetic option amongst innumerable other options.

## Acquired Distinctiveness

### The Relevant Legal Principles

34. The proviso to section 3(1) of the Trade Marks Act 1994 is shown in paragraph 13 above. It states that a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) of the Trade Marks Act 1994 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.
35. The guiding principles when assessing evidence to demonstrate acquired distinctiveness are set out in *Windsurfing Chiemsee* (Joined cases C-108/97 and C109/97):

*51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: the market share held by the mark; how intensive, geographically widespread and longstanding use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from Chambers of Commerce and industry or other trade and professional associations.*

*52. If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied. However, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general abstract data such as predetermined percentages.*

*53. As regards the method to be used to assess the distinctive character of a mark in respect of which registration is applied for, Community law does not preclude the competent authority, where it has particular difficulty in that connection, from having recourse, under the conditions laid down by its own national law, to an opinion poll as guidance for its judgments (see, to that effect, Case C-210/96 Gut Springenheide and Tusky [1998] ECR I-4657, paragraph 37)"*

36. It is appreciated that the above principles set out in the Windsurfing Chiemsee decision are not representative of a criteria to be rigidly applied and that when assessing the evidence provided in support of a plea of acquired distinctiveness, it is essential that a rigorous and full evaluation of the totality of the evidence be undertaken.

37. The process by which inherently non-distinctive signs may acquire a distinctive character was elaborated on by the CJEU in case C-299/99 Koninklijke Philips Electronics NV v Remington Consumer Products Ltd [2002] ECR I-5475 at paragraph 64:

*“...the identification, by the relevant class of persons, of the product as originating from a given undertaking must be as a result of the **use of the mark as a trade mark** and thus as a result of the nature and effect of it, which make it capable of distinguishing the product concerned from those of other undertakings.” (my emphasis added)*

38. In other words, a non-distinctive sign may only acquire a distinctive character if the provider of the goods or services concerned has used the sign in a manner commensurate with trade mark use, and to such an extent that the average consumer has now come to rely on the sign as indicating the commercial origins of the products or services in question. Accordingly, I must assess the evidence and determine if a significant proportion of the relevant class of persons has been educated, through the use of the sign as a trademark, to perceive the sign as capable of distinguishing the goods and services of the applicant from those of their competitors.

39. I must also be mindful that it is settled in law that when assessing evidence which demonstrates the use made of the sign by the applicant, there is no requirement for the sign in question to have been used independently of any other indications of trade origin. This position was commented on in *Société des Produits Nestlé SA v Mars UK Ltd* [2005] ECR I6135 (Case C-353/03) where the CJEU held that a non-distinctive mark may have acquired distinctive character if it has been used as part of or in conjunction with a registered trade mark.

*26. In regard to acquisition of distinctive character through use, the identification, by the relevant class of persons, of the product or service as originating from a given undertaking must be as a result of the use of the mark as a trade mark (judgment in Philips, paragraph 64).*

*27. In order for the latter condition, which is at issue in the dispute in the main proceedings, to be satisfied, the mark in respect of which registration is sought need not necessarily have been used independently.*

*28. In fact Article 3(3) of the directive contains no restriction in that regard, referring solely to the ‘use which has been made’ of the mark.*

*29. The expression ‘use of the mark as a trade mark’ must therefore be understood as referring solely to use of the mark for the purposes of the identification, by the relevant class of persons, of the product or service as originating from a given undertaking.*

*30. Yet, such identification, and thus acquisition of distinctive character, may be as a result both of the use, as part of a registered trade mark, of a component thereof and of the use of a separate mark in conjunction with a registered trade mark. In both cases it is sufficient that, in consequence of such use, the relevant class of persons actually perceive the product or service, designated exclusively by the mark applied for, as originating from a given undertaking.”*

40. I refer also to the comment in *Bach and Bach Flower Remedies Trade Marks* [2000] RPC 513 at paragraph [49] (*per Morrirt LJ with whom Thorpe and Chadwick L.JJ agreed*):

*“... use of a mark does not prove that the mark is distinctive. Increased use does not do so either. The use and increased use must be in a distinctive sense to have any materiality.”*

### **Summary of the witness statement and exhibits**

41. The evidence consisted of a witness statement signed on 25 February 2024 by Mr Christopher Garcin, co-founder of Pit Viper, LLC., along with nine exhibits.
42. The witness statement signed by Mr Garcin set out the content of each of the accompanying exhibits numbered CG1 through CG9 and also included annual turnover figures in the UK for the period of 2018 to 2022 which were as follows:
  - 2018 – £24, 600
  - 2019 - £41, 100
  - 2020 - £60, 200
  - 2021 - £174, 300
  - 2022 - £160, 600

The witness statement also lists six outdoor and sporting events held throughout the UK where the applicant has sold their goods.

43. Exhibit CG1 consisted of screenshots taken from the applicant’s website and social media pages. The screenshots showed the applicant’s goods presented in a retail listing manner, showing images of the goods alongside information such as price etc. The exhibit also included a wide variety of photographs on social media showing the goods being worn by what appear to be consumers wearing the applicant’s goods.
44. Exhibit CG2 consists of a list of approximately 40 physical stores in the UK who stock the applicant’s goods. It is noteworthy in my view, that the stores listed do not appear to be mainstream consumer stores and are instead, stores specific to outdoor pursuits such as surfing, cycling, mountain biking, snowboarding and skiing, for example.
45. Exhibit CG3 consists of screenshots taken from the Instagram accounts of various UK based sports and extreme sports athletes and influencers who are sponsored by the applicant. In the photographs posted their Instagram accounts, the athletes and influencers are seen participating in a variety of sporting or social activities. The applicant’s goods are shown intermittently amongst the ‘posts’ of these individuals.
46. Exhibit CG4 consists of screenshots taken from the website of a UK retailer of sunglasses called Zoe’s Favourite. The exhibit shows a wide range of sunglasses originating from a variety of competing providers (as well as the applicant’s own goods) displayed in a retail listing format, showing images of the goods alongside information such as the brand of the product, pricing information and descriptions of the goods. The applicant states that this exhibit demonstrates how their mark is ‘unique’ in comparison to their competitors and as a result, distinguishes their goods from those of their competitors.
47. The applicant states in their witness statement that through extensive UK and global sales they have become known for their iconic eyewear including their ‘Originals’ range which features the mark applied for. Exhibit CG5 consists of a small selection of media articles which the applicant suggests are indicative of the success and profile of their company. The articles show use of the applicant’s brand ‘Pit Viper’ as well as individuals wearing goods which feature the mark applied for.
48. The applicant submits in their witness statement that as a result of their popularity they have encountered a significant amount of counterfeit and copy-cat products. Exhibit CG6 shows a copy of an online guide produced by the applicant to inform their customers on how to identify

the goods as genuine. One of the steps included in the guide shows the same image as that included in the application at hand and encourages its customers to 'Look at the glasses' stating that "...your glasses are fake if they don't look like ours."

49. Exhibit CG7 consists of a report that identifies instances of potential infringement of the applicant's goods, again demonstrating the difficulties faced by the applicant in regard to counterfeit. The exhibit also the 3D mark in use on potentially infringing products alongside the brand name of the applicant.
50. The applicant stresses in the witness statement that it is in the interest of the public that the applicant can successfully address the counterfeiting of their goods and that trade mark protection in the US and UK is essential in this endeavour. Exhibit CG8 consists of a print out from the USPTO demonstrating that the applicant has been successful in gaining registration in the US for the mark which forms the basis of this application.
51. As part of their application to the USPTO, the applicant adduced a witness statement for the USPTO containing the details of the company's global sales and marketing spend. This witness statement is shown in exhibit CG9. The elements contained in this document which speak to global sales and marketing spend consists of the following statements:

**7. The commercial success of Pit Viper sunglasses bearing the Trade Dress sought to be registered is undeniable. From sales in 2012 topping just over \$10,000, sales during 2021 is expected to exceed \$9 million dollars. Pit Viper, known for its iconic sunglasses featuring the Trade Dress, is among the fastest growing eyewear brands in the U.S.**

**9. Pit Viper's advertising budget is used in various ways to reach its significant consumer base. Each year Pit Viper expends a large amount on advertising expenditures in order to ensure that consumers can recognize legitimate Pit Viper products in the face of increasing numbers of fakes and knock off products that mimic the Trade Dress, the PIT VIPER trademark, or both. In 2021, Pit Viper spent more than \$2 million dollars in advertising promoting its products that feature the Trade Dress.**

## **Assessment of the evidence**

52. In assessing a plea of acquired distinctiveness I am seeking to establish if the evidence provided serves to demonstrate that a significant proportion of the relevant class of persons has come to see the sign applied for as a trade mark, because of the use made of it. In paragraph 51 of *Windsurfing* (joined cases *C-108/97 and C109/97*) the courts also stated that the kinds of information which may assist in establishing the extent and to which an applicant has used the sign may take the form of "*...market share held by the mark; how intensive, geographically widespread and longstanding use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from Chambers of Commerce and industry or other trade and professional associations*". Of course, it is also settled that the list provided in para 51 of the *Windsurfing* decision should not be considered as constituting an exhaustive criterion which must be met in order to establish that the case for acquired distinctiveness has been proven. Instead, I must be careful to undertake a multifactorial assessment of any exhibits provided and arrive at a conclusion based on a global appreciation of the suite of evidence before me.
53. Whilst bearing in mind that the *Windsurfing* considerations do not represent a 'tick box exercise' it is nonetheless appreciated that annual turnover figures are usually very useful. This is because they can often assist in establishing the potential number of consumers who have been

exposed to the mark. However, in respect of the annual turnover figures provided in the witness statement, it is unclear if these figures represent turnover only in respect of goods featuring the mark or are instead representative of the total turnover across the applicant's various product lines.

54. Regardless, whilst it is noted that the applicant's turnover figures for the UK have generally been steadily increasing, I am not convinced that this information is indicative of a 'significant proportion' of the relevant class of persons being exposed to the sign during the purchasing act. It is noted that in exhibits CG2 and CG4, the applicant currently lists their goods for as much as £139 per unit, which would suggest that even in respect of the applicant's most 'successful' annual period of 2021, approximately 1255 units were sold in the UK. Of course, I should allow for the possibility that some (or even most) of their sales during the periods shown in the witness statement may have been at lower prices than those indicated in exhibits CG2 and CG4. However, even with an adjustment of very generous margin of variation in the retail price of the goods, I do not believe that the turnover shown could be considered as reflecting significant sales numbers in the UK. Additionally, given that market analysis values the UK sunglasses sector at over £450 million in 2024<sup>2</sup>, it is considered that the kind of annual turnover shown by the applicant would be unlikely to support a finding that they enjoy a prominent position in the UK which equates to a significant market share of the sunglasses market.
55. Clearly, the applicant has a presence in the UK with over 40 stores selling their goods throughout the UK (Exhibit CG2). The applicant also operates their own website selling their goods directly to UK consumers (Exhibit CG1). It is challenging to determine precisely whether the selling of the applicant's goods through 40 stores is representative of a sizeable footprint in the UK. Given the nature of the stores the applicant lists in exhibit CG2, it appears they are targeting a specific kind of consumer, namely those engaged in outdoor pursuits such as surfing, mountain biking and cycling, skiing and snowboarding etc. In this regard, I believe that whilst not inconsequential, the number of stores listed is not indicative of intensive use throughout the UK. There are thousands of stores in the UK who cater to outdoor activities, for example, just in respect of cycling stores, there were over 2200 in the UK as of 2023<sup>3</sup>. The witness statement also refers to 6 sporting events which are attended by the applicant. Again, considering the number of sporting/extreme sporting events that occur in the UK annually, this information does not in my view, suggest a particularly intensive degree of exposure of the sign.
56. In addition to the UK annual turnover figures, the applicant also provided very limited information on their marketing spent in exhibit CG9. This information originated from a witness statement which had been produced in support of a plea of acquired distinctiveness at the USPTO, for the same mark. As a result, the details of marketing spent appear to be very US centric and lack any details which pertain specifically to the UK. Accordingly, it is impossible for me to know how much of the \$2 million spent by the applicant on promotion, was spent specifically on marketing the mark in the UK.
57. From the exhibits produced I can see that marketing has been undertaken by the applicant through social media channels, specifically through Instagram where the applicant confirms that they sponsor 10 athletes and influencers (CG3). The applicant also provided evidence of their exposure (in a marketing sense) via three articles published online (CG5). The first article included under exhibit CG5 is a feature about the applicant and their goods and includes many references to the 'Pit Viper' brand. However, no references to the 3D mark are specifically made in the article, with the appearance of the applicant's goods only highlighted as being

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<sup>2</sup> Global business data platform Statista.com <https://www.statista.com/outlook/cmo/eyewear/sunglasses/united-kingdom#revenue>

<sup>3</sup> Global industry research company, IBIS World - <https://www.ibisworld.com/united-kingdom/number-of-businesses/bicycle-retailing/14632/#:~:text=Questions%20Clients%20Ask%20About%20This,over%20the%20past%205%20years%3F>

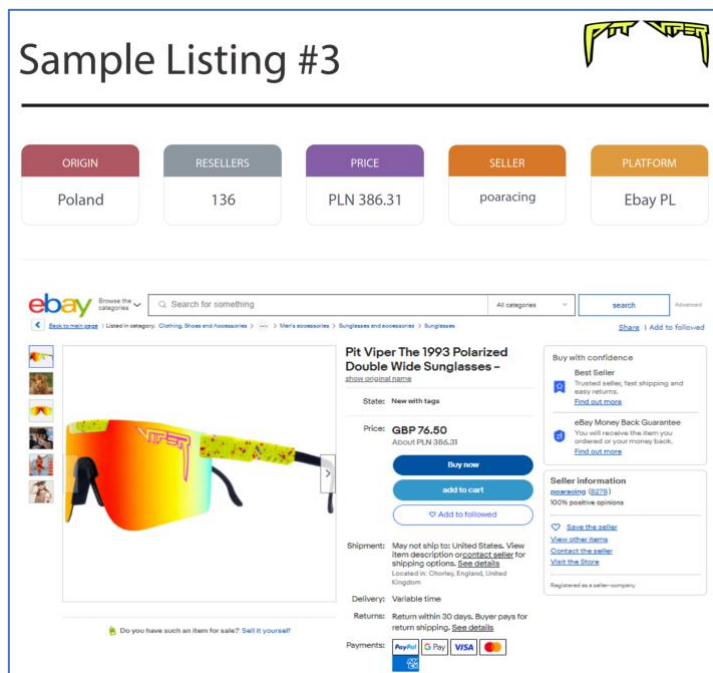
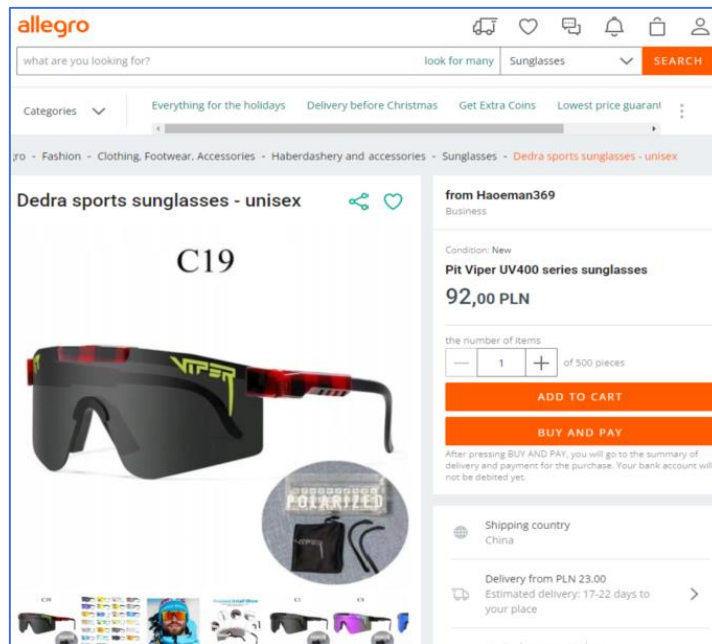
“...wildly colourful wraparound sunglasses”. It is also noteworthy that the individuals in the two prominent photographs in the article are not wearing sunglasses which feature the 3D mark, in fact, the glasses worn are very different in appearance to the mark in question. The second and third articles included under exhibit CG5 could not be described as marketing undertaken by the applicants themselves. Instead, the second article features a story on a distributor no longer distributing the goods of a company called ‘Bern’ with only an incidental reference to Pit Viper, contrasting their success against Bern’s decline. The third article again includes only incidental use of the Pit Viper name and goods. The article consists of a feature published online by VICE Media about an extreme offroad motorsport event called ‘Mudbillys Festival’. The article includes only a passing reference to the applicant, where VICE describe the appearance of ‘Hillbilly Nation megafans’ as sporting “...a mullet, pair of reflective Pit Viper sport sunglasses and green farmer jackets.”. This same article does include various photographs from the event with two of the photographs showing individuals wearing sunglasses which feature the 3D mark.

58. The applicant has stressed that they have faced substantial issues with copycat and counterfeit goods and have produced guidance to the consumer by way of a guide on their own website (Exhibit CG6). Within this guide, shown below, the applicant advises that consumers undertake a visual assessment of the goods to ensure that the goods ‘look like theirs’. They also provide a representation of the 3D mark to aid the consumer which could be argued to demonstrate that the applicant is attempting to draw attention to the 3D mark and how it is associated with Pit Viper.



59. The applicant also provided a prepared report produced by Vantage BP, which identifies 4267 potential infringements. Of these, it appears that 72 instances of potential infringement were attributed to the UK on Amazon.co.uk, with the other entries pertaining to other non-UK websites.

60. It is not clear to me what the submissions under Exhibit 6 and Exhibit 7 contribute in support of demonstrating that the mark in question has in fact acquired a distinctive character. If the inference is that the mark must be distinctive because it is being reproduced by counterfeiters in the counterfeit goods, then I consider this to be a flawed proposition. The images below show two of the examples of potential counterfeit goods highlighted in Exhibit CG7:



61. I accept that the above counterfeit goods do incorporate the 3D mark applied for however, in my view, this does not necessarily inform me of whether the 3D shape itself is regarded by an average consumer as a distinctive element, capable of functioning as a badge of origin. I am mindful of Mr James Mellor's QC comments in *Birkenstock v Eurogloria s.l.* (O-072-18) where he stated:

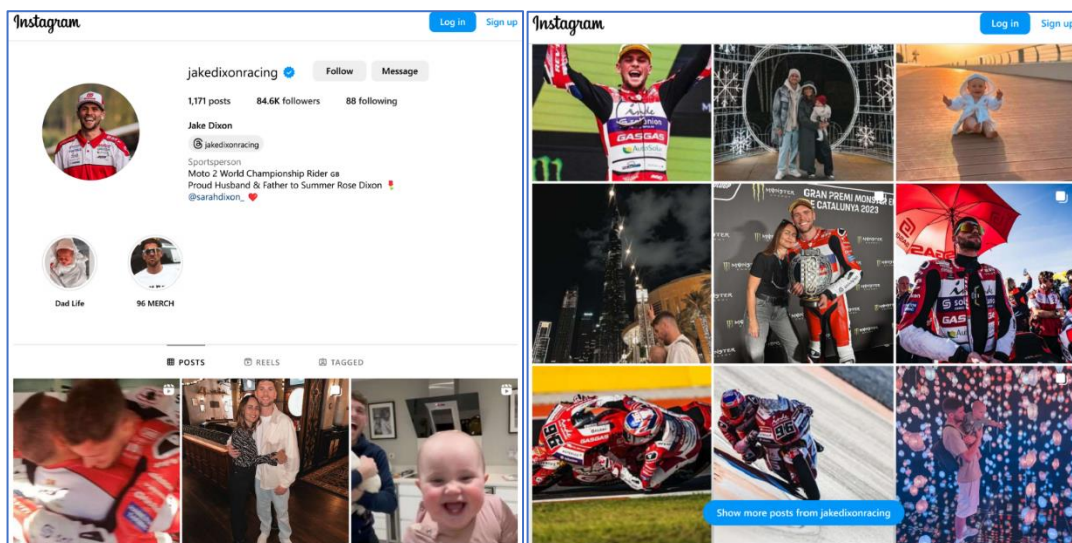
*29. The most specific alleged error is the second and it concerns the extract from the blog about counterfeit Birkenstock sandals in AW9. The Hearing Officer is accused of ignoring the evidence in AW9 that counterfeiters regarded the inclusion of the sole device as necessary to indicate that the goods originated from the Registered Proprietor. In my view, this evidence does not establish this proposition. (My emphasis)*

*Counterfeiters attempt to reproduce the genuine goods. The three images posted by 'Emma73' in AW9 showed, first, side views of fake and real sandals showing the appearance of the wording BIRKENSTOCK on the side of the leather upper, second, the wrongly aligned sole pattern on the counterfeits and third, the correct alignment on the soles*

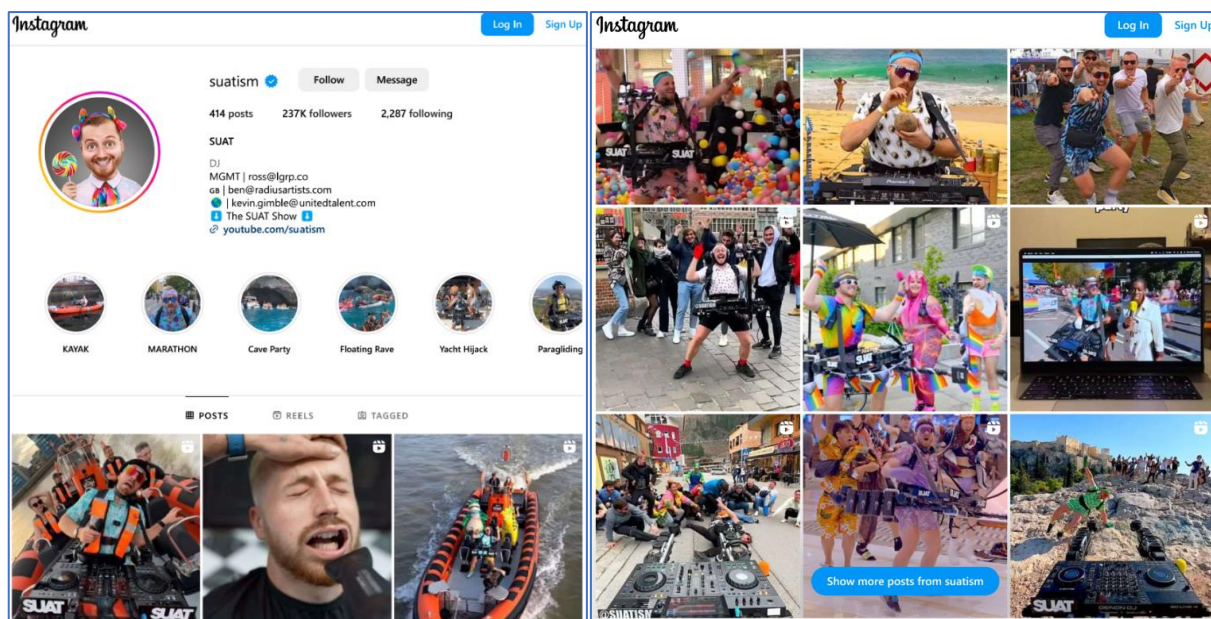
*of a pair of genuine Birkenstock sandals. These images tell one nothing about whether the sole pattern is or is not regarded as a badge of origin, whether by counterfeiters or the general public. (My emphasis).*

62. Accordingly, I do not consider exhibits CG6 and CG7 to contribute in any meaningful way to the multifactorial assessment before me in respect of establishing whether the sign has acquired a distinctive character through use.
63. Again, whilst recognizing that the 'Windsurfing' factors do not constitute a tick-box list of requirements, it is nonetheless apparent that the body of evidence presented in this case fails to provide much of the information and detail that may have assisted in satisfying a plea of distinctive character. When seeking to establish the extent to which the applicant has exposed consumers to the sign, the evidence provided amounted to UK turnover figures, an estimated figure for their global marketing spend (no UK related figures were given), a list of 40 or so stores which stock their goods and details of 6 events they attended.
64. In respect of the evidence demonstrating the marketing efforts of the applicant, the exhibits were again, less than compelling. The applicant provided information pertaining to their sponsorship of ten athletes and influencers on social media and details of three articles published online. In respect of the Instagram accounts, some of these individuals do enjoy a successful social media profile. The account of the most prominent individual has 237,000 followers, however, the relevance of the numbers of followers for these ten Instagram accounts is difficult for me to quantify. This is because given the global reach of social media, it is impossible for me to identify how many of the individuals 'following' these influencers are based in the UK.
65. Regardless, when viewing the exhibits showing the Instagram influencers, I do not believe they offer compelling evidence that the sign is being used in a manner commensurate with trade mark use. The exhibit features the photograph galleries of ten athletes or influencers, but it appears that the applicant's goods do not feature in the galleries in a manner that would 'resonate' with a viewer. As can be seen from the images below, the galleries feature a range of photographs of the athlete however, images featuring the mark appear only intermittently:

#### *Account of Jake Dixon*



## Account of DJ Suat



66. In my view, even if it was established that significant numbers of followers of these Instagram accounts did originate from the UK, this exhibit would still be unlikely to indicate that an average consumer would perceive the shape applied for as a distinctive trade mark. Since it is settled law that average consumers are not in the habit of making assumptions about the origin of products on the basis of their shape<sup>4</sup>, it is doubtful that social media photographs showing individuals wearing glasses featuring the 3D shape would lead to an average consumer perceiving that they are being presented with a trade mark.

67. The evidence provided in the exhibits does not show that the applicant has used the three-dimensional shape in a manner which corresponds with trade mark use, such that an average consumer has come to understand the shape as indicating the commercial source of the goods. It is noteworthy that in many of the exhibits that include representations of the goods, the distinctive words 'Pit Viper' also appear on the product. It is considered that it is this primary indicator which is relied on by the average consumer. Of course, I realise that it is well established that a three-dimensional mark may in certain circumstances, acquire a distinctive character even if it is used in conjunction with a more traditional primary trade mark. However, as was laid out in KitKat<sup>5</sup>, I must consider whether the applicant has proven that the relevant class of persons perceive the goods as originating from a particular undertaking because of use of the sign in question, as opposed to any other mark which might also be present. Paragraph 80 states:

*80. I now turn to the various issues to which the contentions of the parties give rise and begin with the test to be applied in assessing whether a mark which is inherently non-distinctive has acquired distinctive character. As I have said, this has been explained by the CJEU in its judgment in this case at para 67 in a manner which is foreshadowed by and entirely consistent with the guidance given by the Court in Société des Produits Nestlé SA v Mars UK Ltd [2006] All ER (EC) 348 and there can be no dispute about it. The tribunal must consider whether the applicant has proved that a significant proportion of the relevant class of persons perceive the goods or services designated exclusively by the mark applied*

<sup>4</sup> joined cases C344/10 P and C-345/10 P Freixenet SA

<sup>5</sup> Société des Produits Nestlé SA v Cadbury UK Ltd (No 2) [2017] EWCA Civ 358

*for, as opposed to any other mark which might also be present, as originating from a particular undertaking. In short, the mark itself must be seen as a badge of origin.*

68. In the conclusion of the KitKat case at para 103, it was also stated that:

*103 Where the mark has been used in combination with other marks, the task inevitably becomes more difficult, because it is the perception of the mark applied for, and not other marks used in combination with it, which it is necessary to isolate and establish.*

69. It is considered that in respect of the exhibits provided, none demonstrate that the applicant has successfully educated consumers to view the three-dimensional shape as a trade mark. Absent of such evidence, it remains unclear to me whether the average consumer is perceiving the shape alone as an indication of the origin of the goods, or whether they are instead relying on the words 'Pit Viper'.

70. When considered as a whole, the evidence provided fails to demonstrate that the three-dimensional mark applied for has in fact, acquired a distinctive character as a result of the use made of the sign as a trade mark. The exhibits are very limited in respect of their detail with the result that they fail to demonstrate any kind of intensive or trade mark relevant exposure of the sign to a significant proportion of the relevant class of persons. Similarly, the exhibits fail to set out compelling evidence that the applicant's own use of the sign has been of the kind which would be capable of successfully educating the relevant class of persons to view the three-dimensional shape as a trade mark and not a simple aesthetic property of the goods.

## **Conclusion**

71. Having carefully considered all of the documents filed by the applicant as well as all of the submissions made to me in relation to this application, for the reasons set out above, the application is refused because it fails to satisfy the requirements set out under Section 3(1)(b) of the Trade Marks Act 1994.

**Dated this 12<sup>th</sup> day of September 2024**

**Oliver Rose'Meyer  
For the Registrar  
The Comptroller-General**