O/0915/24

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. UK00003655249
IN THE NAME OF MATCHITA LTD
FOR THE FOLLOWING TRADE MARK:

BRAINTEA

IN CLASSES 5 & 32

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY
UNDER NO. 504943 BY
DIGI ARTS LTD

BACKGROUND AND PLEADINGS

1. MATCHITA LTD ("the proprietor") applied to register the trade mark shown on the front page of this decision ("the contested mark") in the UK on 14 June 2021. It was registered on 29 October 2021 for the following goods:

   Class 5: Nutritional Supplements.

   Class 32: Soft drinks; powder for the preparation of beverages; fruit drinks.

2. By virtue of the contested mark being filed pursuant to Article 59 of the Withdrawal Agreement between the UK and the European Union, it is deemed to have the same filing date as the proprietor's identical EUTM, being 4 February 2019. This is, therefore, the relevant date for the purpose of these proceedings.

3. On 7 June 2022, DIGI ARTS LTD ("the applicant") applied to have the contested mark declared invalid under section 47 of the Trade Marks Act 1994 ("the Act"). The application is based upon sections 3(1)(b), 3(1)(c) and 3(1)(d) of the Act.

4. The applicant argues that, under sections 3(1)(b) and 3(1)(c), the contested mark, being 'BRAINTEA', is descriptive of products which have beneficial qualities to the functioning of the brain and mind.[1] It is claimed that this is a direct reference to the products having beneficial qualities or that this is their intended purpose. As for section 3(1)(d), the applicant argues that the contested mark is commonly used in the trade and is, therefore, objectional under this ground.[2] In respect of the section 3(1)(b) ground, the applicant offers a fall-back position that if the application fails in respect of section 3(1)(c) and (d), then it is in any event non-distinctive.

5. The proprietor filed a counterstatement wherein it made a series of denials of the claims made against it. In addition, the proprietor introduced arguments that have

[1] I note that the claim extends to say that the words 'BRAIN' and 'TEA' individually also describe the goods.
[2] The argument provided under section 3(1)(d) sets out that if it succeeds then the section 3(1)(b) ground will also apply.

no bearing on these proceedings. I will discuss these in further detail below (as well as points raised in its evidence).

6. The applicant is represented by Dynham Limited. The proprietor is represented by United Legal Experts. Both parties filed evidence in chief with the applicant electing to also file evidence in reply. No hearing was requested and only the applicant filed written submissions in lieu. This decision is made following careful consideration of the papers.

7. 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 decisions of the EU courts which predate the UK's withdrawal from the EU.

EVIDENCE

8. The applicant's evidence came in the form of two witness statements from Mr Damien Chin dated 18 January 2023 and 2 October 2023. The first statement is that which was filed as evidence in chief whereas the latter is that which was filed in reply. Mr Chin is the Director of the applicant's legal representative, a position he has held since 11 July 2022. His first statement is accompanied by five exhibits, being DC01 to DC05 and his second is accompanied by six annexes, being Annex 1 to 6.

9. The proprietor's evidence came in the form of the witness statement of Shahzaib Amin Malik dated 21 July 2023. Mr Malik is employed by the legal representative of the proprietor, though I note that he does not specify his role. His statement is accompanied by seven exhibits, being those labelled SAM1 to SAM7.

10. I do not intend to summarise the parties' evidence in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

PRELIMINARY ISSUE

11. As mentioned above, the proprietor has raised a number of points in its counterstatement (and throughout these proceedings, for that matter) that have no bearing on the present proceedings. The first is a claim that the applicant is taking undue advantage and is misleading the Tribunal and, therefore, filed the cancellation application in bad faith. It appears to me that this claim is made on the basis that the proprietor believes that the applicant is linked with a company called 'Brain Tea Inc' who it claims has intentionally copied the contested mark in other jurisdictions. There are several references to proceedings in the EUIPO and even in the UK between the proprietor and Braintea Inc. In respect of any connection between the applicant and Braintea, Inc., I note the following at paragraph three of Mr Chin's first witness statement:

> "The Proprietor has also filed cancellation against the Applicant's marks, UK00003445868 and UK00003484263 'BRAINTEA' (CA000504750 and CA000504786), both of which have been consolidated in current proceedings."

12. It is noted that the proceedings referred to are aimed against marks owned by Braintea, Inc. and not the applicant. Clearly this is an incorrect statement by the applicant's witness as the marks in question are not marks of the applicant. This may suggest some sort of association between them but there is nothing actually before me in evidence to suggest what (if any) actual connection there is between them. As a result, I am not willing to infer that there is a connection between them. Even if there were evidence of such a connection between these companies, I see no reason why this would support the proprietor's claim. This is on the basis that ongoing proceedings in other jurisdictions (or this one, for that matter) between the same or connected parties is not something that would ordinarily be deemed as an attempt to mislead the Tribunal and neither is it something that would be deemed bad faith.[3]

[3] On this point, I will say that there are instances where this may be the case. However, any claims would need to be supported by the evidence that showed a party was clearly acting in a misleading way or in a vexatious manner. This is not the case here.

13. Another issue I consider necessary to discuss at this point is the evidence of the proprietor wherein it included printouts taken from the WIPO trade mark database resulting from a search of the register for the keyword 'BRAIN' in combination with different words.[4] This evidence shows 235 marks under classes 5, 32 and 32. Out of the 235 trade marks, 95 are registered with the UK IPO. As is often the case in proceedings before the Tribunal, reference to trade mark registers is, without anything further, of no consequence. I say this because assessments as to distinctiveness/descriptiveness of the mark at issue are to be considered on their own merits and in line with the relevant legislation and case law (that I will set out below), not the state of the register.

14. The proprietor also makes reference in its evidence to another 'BRAINTEA' mark registered in the EU under a different name.[5] The proprietor claims that the applicant did not feel threatened and did not even feel that this mark was descriptive because it is not involved in cancellation proceedings against the same. For the avoidance of doubt, this has no bearing on the present case. Whether the applicant chooses to oppose or apply to invalidate other marks or not (be that in the UK or other jurisdictions) is not a consideration that I must take into account. The decision to do so (or not, as the case may be) is solely for the applicant to make and it is not compelled to oppose or invalidate any and all marks that share the same elements as the mark at issue. Failure to do so does not mean that the applicant accepts that the mark is not objectionable under section 3(1) of the Act.

15. For the avoidance of doubt, the above arguments have no bearing on these proceedings and I will say no more about them.

DECISION

16. Section 3 of the Act has application in invalidation proceedings pursuant to section 47 of the Act, which reads as follows:

[4] SAM1
[5] SAM3

"47. –

(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

[…]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) […]

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that this shall not affect transactions past and closed."

Section 3(1) case law and legislation

17. Section 3(1) of the Act provides 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."

18. As above, the relevant date for determining whether the contested mark is objectionable under sections 3(1)(b), 3(1)(c) and 3(1)(d) is its deemed filing date, being 4 February 2019.

19. 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].

20. 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. I have no submissions or evidence from either party as to who the relevant public will be. Given that the contested mark's goods are nutritional supplements, beverages and those for the preparation of beverages, I consider that the relevant public will be members of the general public at large. In addition, I appreciate that there may be a sub-section of the consumer base that have a particular interest in health (namely

for the nutritional supplements). In my view, the relevant public will consider different factors such as taste/flavour, nutritional information and, for supplement goods, the benefits of the same. For the most part, the average consumer will pay a medium degree of attention when selecting the goods as they are all those that will be consumed. Having said that, some of the beverage goods may be more casual purchases that attract a lower degree of attention.

Section 3(1)(d)

21. I will first consider the application under section 3(1)(d) of the Act. It is the applicant's claim that 'BRAINTEA' has become customary in the current language or in the bona fide and established practices of the trade in respect of all goods.

22. In *Telefon & Buch Verlagsgesellschaft GmbH v OHIM,* Case T-322/03, the General Court summarised the case law of the Court of Justice of the European Union 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)."

23. In light of the case law above, the relevant question is whether, on the relevant date (19 February 2019), the mark 'BRAINTEA' had become customary in the current language or in the bona fide and established practices of the trade to designate the goods for which the mark is registered. That question must be based on the perception of the average consumer of the goods in the UK, who I have identified at paragraph 20 above.

24. Firstly, I wish to discuss a point that the proprietor has raised in its defence, namely that the contested mark is 'BRAINTEA' and not 'BRAIN TEA'. It sought to provide evidence in support of this point by adducing the applicant's website, being 'braintea.com'.[6] Firstly, any use by the applicant of 'BRAINTEA' (or however it is phrased on the applicant's website) is not relevant to the present issue. The assessment is based on the contested mark which is owned by the proprietor so the applicant's use is not relevant. Secondly, I am of the view that the contested

[6] SAM5

mark will, clearly, be perceived and understood by consumers as the conjoining of two words, being 'BRAIN' and 'TEA'.[7]

25. My assessment of the present ground relies on the evidence before me. That evidence must be capable of supporting a finding that, as at the relevant date, 'BRAINTEA' had become customary in the trade. In order to determine this, I have examined the evidence before me. The most salient points are summarised below:

    a. Annex 1 consists of a number of printouts of articles from various publications regarding the benefits of vitamins, minerals and 'functional foods' that have been provided to demonstrate that consumers are accustomed to purchasing these types of supplements and to buying foods which are fortified with extra vitamins and minerals. This annex also provided shows examples of such products listed for sale via various retailers. I note that these include porridge, fruit and fibre cereal and peach and apricot yoghurt. While noted, all of these printouts are either undated or show dates after the relevant period. In addition, there are articles from US-based websites with nothing to suggest any readership in the UK.

    b. Annex 2 consists of a range of articles regarding the effects of a balanced diet and reference to so-called 'superfoods', being natural produce which have a particularly strong effects on the human body and human processes. I note that the first article provided is in relation to Ireland, not being a part of the UK so I fail to see how it is relevant. That being said, the second article is dated prior to the relevant date and is taken from the Belfast Telegraph. While this article is relevant to the assessment I must make, it is a localised publication and I have nothing to suggest the readership of the article amongst the wider UK consumer base. In addition to these articles, as was the case in the annex discussed above, a number of printouts showing products for sales via various online retailers are provided. The products shown include Yakult light milk drink, organic cúrcuma latte ginger, matcha green tea and a range of other

[7] I note that this was an argument raised by the applicant at paragraph 8 of its evidence in reply. As set out here, this is something that I agree with.

types of goods referred to as ‘superfoods’. All of these printouts are, again, undated.

c. Annex 3 consists of a number of articles that the applicant claims to demonstrate that there has been an increasing amount of interest in products which have an effect on the functioning of the human mind. This area is claimed to be called ‘nootropics’. While the articles are noted, only one (being an article from GQ dated 24 October 2018), is from prior to the relevant date. While the article is noted, it makes reference to Silicon Valley, being in the United States, and also the ‘FDA’, which is the US’s food and drug administration. Further, the article is taken from a ‘.com’ website so while I appreciate that GQ does offer a UK-based publication, it is not clear that this article is targeted at UK consumers.

d. Annex 4 consists of further printouts showing products listed for sale via various online retailers. I appreciate that the printouts show products that include the word ‘BRAIN’ which are listed for sale via large retailers such as Boots and Amazon, however, they are all either undated or appear to have been captured after the relevant date. In respect of this annex, I note that some printouts show the word ‘MIND’ which the applicant claims to be a synonym of ‘BRAIN’. Towards the end of this annex are four printouts wherein the word ‘BRAIN’ is used together with the word ‘TEA’. The products shown are not actually referred to as ‘BRAIN TEA’ but are, instead, listed as ‘Brain Tonic Organic Tea’, ‘Brain Boost Tea (Infusion)’ ‘Organic Brain Health Tea’ and ‘Ginkgo Biloba Tea 20 Bags | BteaCo Brain Memory Strength’. In any event, these printouts are all undated or are dated after the relevant date.

e. Annex 5 shows another set of printouts that are either undated or from after the relevant date that the applicant claims to show the word ‘TEA’ being used across a wide range of therapeutic products.

f. Annex 6 is, again, a range of printouts showing products for sale. The products shown this time are all purported to be use of ‘BRAIN TEA’ by third parties. As has been an issue consistent throughout the applicant’s evidence, none of the

printouts are from prior to the relevant date. The closest the applicant has come here to proving its point is a printout taken from Amazon in the USA that shows a product called “SOLLO Brain Power Organic Green Tea Pods with MCT, Acai & Vitamins B1, B5, B6, B9, B12, D3 Nootropic Brain Booster- Improves Memory & Focus Compatible with 2.0 K-Cup Keurig Brewers” being first available on its website on 5 August 2021, being over two years after the relevant date.

g. While not included in an annex, the applicant has, in the body of the first witness statement of Mr Chin, provided a printout taken from ‘walmart.com’ that shows goods under the category of ‘Brain Teas’. Firstly, it is my understanding that Walmart is a popular US-based supermarket chain that does not operate in the UK. On this point, it is noted that the goods shown are in US dollars. It is clear to me that this evidence is aimed at the US market, not the UK consumer. Further, the printout is not dated so even if it could be said that UK consumers were able to buy and ship goods from the US-based Walmart website to the UK, this would be of no assistance here because it does not reflect the position as at the relevant date.

h. In filing its evidence in reply, the applicant also included further printouts, at Exhibit 3, of an explanatory post dated 27 September 2021 taken from Holland & Barrett’s website regarding superfoods, superfood recipes from a website called ‘womansday.com’ dated 21 July 2020 and an article from the NHS website regarding superfoods with a printout date of 2 October 2023. In addition, there are printouts of articles at Exhibit 4 relating to nootropics. Two of these are from Holland & Barrett and I note that one is dated 10 June 2022 and the other shows a printout date of 2 October 2023, WebMD (which I understand is a US-based website) that is dated 18 July 2022 and an undated Wikipedia article. Lastly, Exhibit 5 includes further product listings showing goods called ‘Brain Tea’. Unsurprisingly, none of the products shown appear to be from prior to the relevant date (they all show printout dates of 2 October 2023) and some are even shown on printouts from US-based websites with products shown in US dollars.

26. In considering the evidence generally, I note that some of the printouts showing product listings show prices in euros. I see no merit in mentioning this in any great detail as the printouts are all from after the relevant date so are of no assistance in any event. However for the avoidance of doubt, the assessment here is based on the understanding in the UK so any use targeted at the EU (and the USA, for that matter) is irrelevant.

27. In assessing the present ground, I am of the view that I can dispense of it very briefly. I say this because, as mentioned several times in my summary above, the evidence overwhelmingly includes that which has either been taken from after the relevant date or is undated. The only evidence I have from prior to the relevant date comes in the form of two articles. The first is from a localised Belfast publication with no indication as to its readership across the UK consumer base. The second is a GQ article that is aimed at the US consumer, not the UK. Even if these articles were of assistance, they are informative articles regarding superfoods and nootropics, generally. There is nothing in them that suggests any use of 'BRAINTEA' to the point that it would have become customary in the trade by the relevant date. To summarise, there is absolutely nothing filed by the applicant that can support a claim that, by the relevant date, 'BRAINTEA' became customary in the language or in the bona fide and established practices of the trade. As a result, I find that the applicant has failed to prove its claim and, therefore, the contested mark is not objectionable under section 3(1)(d).

Section 3(1)(c)

28. I will now move on to the application based on section 3(1)(c) of the Act. I will consider this before the section 3(1)(b) ground because the primary argument under section 3(1)(b) is that the mark is descriptive. If this turns out to be the case then the outcome of the section 3(1)(b) ground will follow this one. If it is not, then I will proceed to assess the applicant's fall-back position.

29. Section 3(1)(c) prevents the registration of marks which are descriptive of the goods, or a characteristic of them. 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. 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]."

30. In considering the section 3(1)(d) ground above, I found that none of the evidence filed by the applicant was of any assessment to that ground given that it does not reflect the position as at the relevant date. As I already mentioned above, the relevant date for this ground is the same as it was for the section 3(1)(d) ground. Therefore, the evidence filed is of no assistance here. However, unlike the section 3(1)(d) ground, applications for invalidity under section 3(1)(c) may succeed without evidence.[8]

31. In its submissions, the applicant's position in respect of the present ground is as follows:

"In the context of supplements and beverages, the term "brain tea" may be deemed descriptive as it conveys directly the intended benefit or purpose of the product. The term "brain" implies cognitive enhancement or mental clarity, while "tea" suggests a beverage form. The combination "brain tea" thus indicates a beverage or supplement formulated to support cognitive function or brain health. This direct correlation between the product's name and its intended benefit renders it descriptive. Moreover, it facilitates consumers' comprehension of the product's potential purpose without the need for further elucidation."

[8] On this point, I appreciate that evidence is often of assistance, especially in circumstances where the mark and goods at issue are technical in nature. However, I do not consider that to be the case here.

32. I have already set out above that 'BRAINTEA' will be viewed as two conjoined words, being 'BRAIN' and 'TEA'. These words, when considered individually, will have clear and obvious meanings to the majority of average consumers. First, 'BRAIN' will be understood as a reference to the organ inside the head that controls the body's activity and thoughts. Further, it will be understood as the organ that enables and regulates feelings and emotions. The word 'TEA' will be understood as a reference to a beverage that is made by steeping tea leaves in water. That being said, the assessment I must make here is based on the mark as a whole meaning that the relevant assessment is what consumers will understand from the combination of the words. However before considering the meaning of the contested mark as a whole, I wish to point out that, in my view, average consumers will be aware of many foods/drinks on the market that offer benefits to the health of those that consume it. For example, I consider that consumers will be aware of the fact that high fibre foods will help maintain bowel health, that certain probiotic yoghurts assist in regulating the digestive system and that a variety of nutritional supplements exist on the market that are taken for a wide range of health benefits. I appreciate that this is not supported by evidence aimed at the relevant date, however, I am of the view that it is something I am entitled to take judicial notice of on the basis that it would not be the subject of any serious dispute.[9]

33. Following what I have said in the preceding paragraph, I am of the view that because average consumers are accustomed to the fact that there are many foods/drinks on the market that benefit different parts of the body, they will, when confronted with the contested mark construe it as a reference to a tea which, when consumed, provides some undetermined benefit to the user's brain. For example, I consider that consumers will believe that the tea is something that consists of nutritional ingredients that release chemicals in the brain that provide the user with increased focus or clarity. Further, it may also be the case that the tea is considered a herbal remedy for various ailments such as headaches.

34. All of the above being said, the actual question as to whether the contested mark is objectionable or not is based on the actual goods for which it stands registered.

[9] On this point I refer to the case of *Chorkee Ltd v Cherokee Inc.,* Case BL O/048/08

In the present case, the relevant goods are “nutritional supplements” in class 5 and “soft drinks”, “powder for the preparation of beverages” and “fruit drinks” in class 32. I will begin my assessment with the class 32 goods.

Class 32

Soft drinks.

35. On the basis that soft drinks are commonly defined as being beverages that are non-alcoholic, I am of the view that “soft drinks” covers teas. Therefore, ‘BRAINTEA’ can be said to be descriptive of these goods. Even where the goods are not a type of tea (on the basis that “soft drinks” is such a broad term), I am of the view that the message created by ‘BRAINTEA’ is so direct that consumers will believe that the ingredients of the product will include tea.[10] Whether this is correct or not, I do not consider that it prevents ‘BRAINTEA’ from being descriptive of the kind or intended purpose of the goods. On this point, I do not consider that the consumer would pay enough attention in selecting these goods that they would examine the ingredients to the point that it became apparent to them that the ingredients did not include tea (if that was the case, of course).[11] The contested mark is, therefore, objectionable for “soft drinks” under section 3(1)(c) of the Act.

Powder for the preparation of beverages.

36. The above term covers a wide range of powders used to prepare beverages and I see no reason why this would not include tea in the form of a powder (be that instant tea, for example). As a result, I am of the view that, in this context, ‘BRAINTEA’ is descriptive of the kind and intended purpose of the above goods. Even where the powders do not cover tea, following what I have said in the preceding paragraph, I find that consumers are still likely to believe the ingredients include tea. Again, whether this is correct or not does not prevent ‘BRAINTEA’

[10] I say this because, as far as I am aware, it is common in the trade for beverages (such as smoothies, for example) to include a blend of different ingredients. While this may include fruits or vegetables, it can also include a wide range of goods such as teas, hibiscus or peanut butter, for example. In my view, the word ‘TEA’ on such goods will be understood as a clear reference to an ingredient.
[11] I consider this to be the case regardless of whether the consumer pays a medium or lower degree of attention when selecting these goods.

being descriptive of the goods' kind or intended purpose. The contested mark is, therefore, objectionable for "powder for the preparation of beverages" under section 3(1)(c) of the Act.

Fruit drinks.

37. Following what I have said in the preceding two assessments, I am of the view that consumers will believe that the above goods consist of tea as an ingredient. Again, whether this is correct or not does not prevent 'BRAINTEA' being descriptive of the goods' kind or intended purpose. Following the same reasons to those discussed under my previous assessments, I find that the contested mark is objectionable for "fruit drinks" under section 3(1)(c) of the Act.

Class 5

Nutritional supplements.

38. I will begin my assessment here by stating that "nutritional supplements", as a term, is broad enough to cover those that come in liquid form. As a result, and following everything I have said above under my consideration of beverage goods, I am of the view that 'BRAINTEA', in this context, will describe a nutritional supplement that consists of tea that supplies nutrition to the brain for the benefit of cognitive function. Further, I consider that this will apply even in the event that the supplement is in the form of a capsule or pill. To repeat a similar point to what I have said above, the reference to 'TEA' is such that consumers will believe that the capsule/pill being consumed consists of tea as an ingredient, regardless of whether that is actually the case or not. As a result, I find that the contested mark describes the kind and intended purpose of the above goods. The contested mark is, therefore, objectionable for "nutritional supplements" under section 3(1)(c) of the Act.

39. The application for invalidity reliant upon section 3(1)(c) succeeds in full. I will now proceed to discuss the section 3(1)(b) ground.

Section 3(1)(b)

40. The applicant pleads that if either of its section 3(1)(c) or (d) grounds succeed then the contested mark is objectionable under section 3(1)(b). As I have found the section 3(1)(c) ground to be successful, it follows that the section 3(1)(b) ground also succeeds on the basis that the contested mark is descriptive and, therefore, devoid of any distinctive character. In light of this, I see no reason to consider the applicant's fall-back position in respect of this ground.

41. As a result of the above, I find that the contested mark is objectionable under section 3(1)(b) of the Act.

CONCLUSION

42. While the invalidation application based on section 3(1)(d) has failed, the applicant has succeeded in full in respect of its invalidation application under sections 3(1)(b) and 3(1)(c). The contested mark is hereby, subject to any successful appeal against my decision, declared invalid in respect of all goods for which it is registered and deemed never to have been made and is cancelled *ab initio* i.e. from its filing date of 4 February 2019.

COSTS

43. As the applicant has been successful, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. While I note that the applicant did file evidence during these proceedings, it was of no value to the outcome reached. That being said, costs for the evidence rounds will still be attributed (albeit to a lesser degree) on the basis that the applicant was required to consider the proprietor's evidence.

44. In the circumstances, I award the applicant the sum of **£1,100** as a contribution towards its costs. The sum is calculated as follows:

Filing an application for invalidation and considering the counterstatement:	£300
Considering the proprietor's evidence:	£300
Written submissions:	£300
Official fees:	£200
Total	**£1,100**

45. I therefore order MATCHITA LTD to pay DIGI ARTS LTD the sum of £1,100. 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 conclusion of the appeal proceedings.

Dated this 18th day of September 2024

A COOPER
For the Registrar