

O/1106/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 4024355
BY SIDEMEN PROJECT 1 LIMITED
TO REGISTER:



(SERIES OF TWO)

AS A TRADE MARK IN CLASSES 8, 21 AND 30

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NO 448176
BY WM MORRISON SUPERMARKETS LIMITED

BACKGROUND AND PLEADINGS

1. On 11 March 2024, Sidemen Project 1 Limited (“the applicant”) applied to register the series of trade marks shown on the cover of this decision (“the application”) in the UK for the following goods:

Class 8: Cutlery; spoons.

Class 21: Tableware; household or kitchen utensils and containers (none of precious metal or coated therewith); mugs; cups; glasses; bowls; plates; saucers; tea pots; dishes; kitchenware; kitchen storage containers; glassware; decorative household objects made from ceramic, earthenware, stoneware, china, porcelain or terra-cotta; lunch boxes; salt and pepper shakers; cookie jars; egg cups; plastic coasters and place mats; trays for household use; bottles; drinking bottles; bottle openers; corkscrews.

Class 30: Cereals and cereal snacks; breakfast cereals; cereal preparations, cereal bars; snack foods made of wheat, cereal or corn; flakes (corn); flakes (wheat); flakes (oat); flakes (maize); rolled oats and wheat; porridge; oat meal; cereal breakfast food; muesli; waffles; pancakes; pastries; croissants; coffee; tea; cocoa beverages and cocoa powder; hot chocolate; bakery goods; pastries; confectionary; chewing gum; bread and buns; energy bars; oat bars; muesli bars; rice; pasta; noodles; bagels; sandwiches; wraps; biscuits; tortilla chips; corn chips; pretzels; popcorn.

2. The application was published for opposition purposes in the Trade Mark Journal on 22 March 2024, and it was opposed by WM Morrison Supermarkets Limited (“the opponent”) on 21 June 2024. The opposition is based on sections 3(1)(b) and 3(1)(c) of the Trade Marks Act 1994 (“the Act”).

3. For its opposition based upon section 3(1)(b), the opponent states as follows:

“The mark of the Application consists of the ordinary English word BEST together with mundane, non-distinctive figurative elements. The word BEST is a laudatory term which traders and consumers use to refer to any goods claiming or having superlative qualities and is therefore prima facie devoid of any distinctive character. The figurative elements that are applied here to the word BEST are i) of a very ordinary and simple nature, ii) are of a kind commonly applied to signs used in relation to goods including those in respect of

which the application is made, and iii) may in fact reinforce the laudatory meaning of the word BEST. The figurative elements applied to the word BEST are not sufficient to imbue the mark of the Application with distinctive character and thus, in its totality, the mark of the Application is devoid of any distinctive character.”¹

4. In relation to section 3(1)(c) the opponent goes on to say:

“The mark of the Application consists of the ordinary English word BEST together with mundane, non-distinctive figurative elements. The word BEST is a clearly descriptive term which may serve in trade to designate characteristics of goods, for example to indicate that they are of the highest quality, most suitable or most effective. The figurative elements applied here to the word BEST are i) of a very ordinary and simple nature, ii) are of a kind commonly applied to signs used in relation to goods including those in respect of which the Application is made, and iii) may in fact reinforce the laudatory/descriptive meaning of the word BEST. The figurative elements contained in the mark of the Application are not sufficient to divert the customer’s attention away from or otherwise modified to any meaningful extent the entirely laudatory/descriptive word BEST. In its totality, the mark of the Application consists exclusively of laudatory and/or descriptive signs or indications of the kind barred from registration under section 3(1)(c).”²

5. The applicant filed a defence and counterstatement denying the claims made.

6. The opponent is represented by Wilson Gunn; the applicant is represented by Lincoln IP. Both parties filed evidence in chief. The applicant also filed written submissions dated 22 January 2025. The opponent did not file evidence in reply. No hearing was requested. Only the opponent filed submissions in lieu of a hearing. The decision is taken following a careful consideration of all 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 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

¹ Form TM7

² Form TM7

EVIDENCE AND SUBMISSIONS

8. The opponent's evidence in chief came in the form of the witness statement of Alexander Thompson dated 22 November 2024. Mr Thompson is a Chartered Trade Mark Attorney at the opponent's representative. Mr Thompson's evidence is accompanied by 5 exhibits, being Exhibits AT1-5.

9. The applicant filed evidence in chief in the form of the witness statement of Ms Karen Veitch dated 14 March 2025. Ms Veitch is a Chartered Trade Mark Attorney at the applicant's representative. Ms Veitch's evidence is accompanied by 3 exhibits, being KV1-3. As mentioned above, the applicant also filed submissions dated 22 January 2025.

10. The opponent filed written submissions in lieu of a hearing dated 16 June 2025.

11. Whilst I do not propose to summarise the evidence and submissions any further at this point, I have taken them all into consideration in reaching my decision and will refer to them below, as and where necessary.

DECISION

12. Section 3(1)(b) and 3(1)(c) read as follows:

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

(a) [...]

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

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

(d) [...]

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

13. The relevant date under sections 3(1)(b) and (c) is the date of filing of the contested mark i.e. 11 March 2024.

14. 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*.³ The average consumer will vary depending on the particular goods concerned. In this case, the average consumer is likely to include both members of the general public and business users (such as hotels or other hospitality establishments). On balance, I consider that at least a medium degree of attention is likely to be paid during the purchasing process for the goods given that factors such as calorific and nutritional contents and durability will be taken into consideration.

15. 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 Satelliten Fernsehen GmbH v OHIM*.⁴ I will, give consideration to the 3(1)(c) ground first and will then move onto the 3(1)(b) ground.

Section 3(1)(c)

16. I will begin with the application under section 3(1)(c). Section 3(1)(c) prevents the registration of marks which are descriptive of the goods, or a characteristic of them.

17. 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:

³ Case C-421/04

⁴ Case C-329/02 P at [25].

“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. I1461 , 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]."

18. The application consists of a series of 2 marks. The first mark in the series is in black and white, and the second is in colour. Given that marks registered in black and white can be used in any colour, nothing will turn on the different presentation of the marks within the series. Consequently, for ease of reference, I will refer to the applicant's series of marks as the applicant's 'mark', unless it becomes necessary to differentiate between them.

19. As mentioned above, the opponent submits that the word 'BEST' is a descriptive term which will communicate to consumers that the goods sold under the applicant's mark are of the highest quality, most suitable or most effective. As such, it is the opponent's contention that the word is clearly descriptive of the characteristics of the applied-for goods. Further, the opponent submits that the figurative elements are insufficient to divert the customer's attention away from or otherwise modify, to any meaningful extent, the laudatory/descriptive word 'BEST'. In contrast, the applicant submits that the term 'BEST' is not descriptive; as 'BEST' is not a natural expression for the goods in question and is highly subjective, it would not be immediately clear to the consumer what it means. It is submitted that the sign would catch the consumer's attention and be recognised as playful rather than descriptive, with an element of

humorous grandstanding or boasting,⁵ and providing information on the origin of the goods. Further, the applicant denies that the additional elements are mundane and non-distinctive, and it argues that there is sufficient visual stylisation to prevent it from being examined as consisting of merely the word 'BEST'.

20. In my view, it is clear that the word 'BEST' will be immediately understood by the average consumer as a descriptive claim as to the quality of the applicant's goods, i.e. the cereals offered under the applicant's mark are the best on the market. The descriptive message is clear and direct; the average consumer would certainly understand the nature of the claim that is being made. The word 'BEST' in the applicant's mark contains a statement about the goods which requires no form of mental processing or analysis. Contrary to the applicant's submissions, I do not consider that the word 'BEST' possesses even a degree of tension or originality in the way that its sentiment is expressed, as was held in *Audi v OHIM*.⁶

21. Nevertheless, the applicant's mark does not consist exclusively of the word elements: it also contains stylistic elements. I must now consider the impact of these figurative elements and what overall impression the mark will have upon the average consumer in relation to the goods. In its counterstatement, the applicant argued that the stylisation prevents the mark as a whole from being viewed as merely the word 'BEST'. As mentioned above, in the case of *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc*,⁷ Arnold J. held that a descriptive word with a minor figurative embellishment was, as a whole, devoid of any distinctive character. The mark under consideration was:



22. It is my view that the stylistic elements are insufficient to diminish the descriptive content of the words. Furthermore, although often registered in black and white, consumers are used to trade marks being used in colour. In respect of the second mark in the series, the colours applied to the word 'BEST' would be considered typical. Therefore, when standing back and considering how the average consumer would understand the mark as a whole,⁸ I

⁵ Counterstatement, paragraphs 10-12

⁶ Case C-398/08

⁷ [2013] F.S.R 29

⁸ *Putterscope* BL O/096/11

find that neither the stylisation nor the use of colour does anything to modify the laudatory or descriptive message conveyed by the word 'BEST'.

23. As such, I find that the applicant's mark as a whole consists exclusively of signs which may serve, in trade, to designate the kind and quality of the goods in classes 8, 21 and 30.

Section 3(1)(b)

24. Section 3(1)(b) of the Act prevents registration of marks which are devoid of distinctive character. The principles to be applied under article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation, and is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act) were conveniently summarised by the CJEU in OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG (C-265/09 P) as follows

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

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

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

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (Storck v OHIM, paragraph 25; Henkel v OHIM, paragraph 35; and Eurohypo v OHIM, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C447/02 P KWS Saat v OHIM [2004] ECR I-10107,

paragraph 78; Storck v OHIM, paragraph 26; and Audi v OHIM, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P Proctor & Gamble v OHIM [2004] ECR I-5173, paragraph 36; Case C-64/02 P OHIM v Erpo Möbelwerk [2004] ECR I-10031, paragraph 34; Henkel v OHIM, paragraphs 36 and 38; and Audi v OHIM, paragraph 37)."

25. Even if I am wrong in my finding under section 3(1)(c), I am of the view that the applicant's mark would also be excluded from registration in respect of the goods in classes 8, 21 and 30 under section 3(1)(b). I acknowledge, that a minimum degree of distinctiveness is sufficient to avoid an objection under this ground.⁹ Nevertheless, I am of the view that the applicant's mark as a whole would not serve to identify the applied-for goods as originating from a particular undertaking and to distinguish those goods from those of other undertakings.¹⁰ The stylisation used is minimal and does not, in my view, result in the mark having the minimum degree of distinctiveness required for registration. The applicant's mark is devoid of distinctive character for the goods and would not be perceived as an indicator of trade origin. Rather, the average consumer would perceive the applicant's mark (whether or not in colour) as an origin neutral claim that the goods offered under it are the 'BEST'.

Acquired distinctiveness

26. I now turn to consider whether, by the relevant date of 11 March 2024, the applicant had established acquired distinctiveness for its goods in classes 8, 21 and 30.

27. In *Windsurfing Chiemsee*,¹¹ the Court of Justice of the European Union provided the following guidance about the correct approach with regard to the assessment of the acquisition of distinctive character through use:

⁹ *Putterscope*, BL O/096/11, paragraph 8

¹⁰ Case T-34/00 *Eurocool Logistik GmbH v OHIM*

¹¹ Joined Cases C-108 & C-109/97

“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 long-standing 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 judgment (see, to that effect, Case C-210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 37).”

28. I note that no details have been provided by the applicant to indicate the size of the relevant market or its share of that market. Neither are there any sales figures in evidence. There is also a distinct lack of evidence as to any amount spent by the applicant in promoting its mark. The opponent has provided an undated snapshot from the applicant’s Instagram page,¹² which suggests to me that there may be some promotion. In addition, the applicant has stated that they are well known youtubers with a combined total of over 138 million subscribers as of October 2022.¹³ However, the evidence does not demonstrate advertisement of the mark, as it does not demonstrate, for example, the extent to which the mark has been promoted on YouTube. Further, I note that the Wikipedia evidence in Exhibit AT4, by virtue of it being a Wikipedia article, must be treated with caution. This is on the basis that, as far as I understand it, Wikipedia is a community-based encyclopaedia that any user can contribute to, meaning that the content may be unverified. Both parties have filed evidence

¹² Exhibit AT3

¹³ Witness statement of Ms Veitch

of use of the applicant's mark, in physical retail premises or online from the website of the applicant or third parties.¹⁴ However, the evidence of use as a whole is simply not sufficient for me to determine how intensive, geographically widespread or long-standing the use of the mark has been. Overall, the evidence before me falls a long way short of establishing that the applicant's mark has acquired distinctiveness.

29. The opposition under sections 3(1)(b) and (c) succeeds in its entirety.

CONCLUSION

30. The opposition has succeeded and, subject to any appeal against my decision, the application will be refused.

COSTS

31. The opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. The sum awarded to the opponent is calculated as follows:

Preparing a statement and considering the other side's statement	£300
Preparing evidence and considering the other side's evidence	£600
Preparation of submissions and considering the other's side's submissions	£450
Total	£1350

32. I therefore order Sidemen Project 1 Limited to pay WM Morrison Supermarkets Limited the sum of £1350. This sum is to 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 25th day of November 2025

A KLASS

For the Registrar

¹⁴ Exhibits KV3 and AT1 and AT2.