

O-464-15

TRADE MARKS ACT 1994

IN THE MATTER OF THE FOLLOWING CONSOLIDATED ACTIONS:


**CANCELLATION 500096 BY ELGIN BEVERAGES
TRADE MARK REGISTRATION NO 2625960 IN THE NAME OF CHAR
(UK) LTD**

OXFORD TEA

**AND OPPOSITION 103965 BY CHAR (UK) LTD
APPLICATION NO 2628780 IN THE NAME OF ELGIN BEVERAGES**



Background and pleadings

1. These consolidated proceedings involve an opposition against a trade mark application for the mark  and invalidation against a trade mark registration for the mark OXFORD TEA.

The parties

2. Char (UK) Ltd, represented by Trade Mark Direct, is the opponent in the opposition proceedings (no. 103965) and the registered proprietor in the invalidation proceedings (no. 500096). It shall be referred to as “Char” in both proceedings.

3. Elgin Beverages Ltd, represented by London IP Ltd, is the applicant in the opposition proceedings (no. 103965) and the applicant in the invalidation proceedings no. (500096). It shall be referred to as “Elgin” in both proceedings.

Invalidation action (no.500096)

4. On 15 July 2013 Elgin filed a notice of invalidation against the following registration:

Mark: OXFORD TEA

Registration no: 2625960

Filing date: 26 June 2012

Publication date: 20 July 2012

Registration date: 28 September 2012

Owner: Char (UK) Ltd

Class 30 goods: Tea; beverages (tea-based); fruit tea, herb tea; iced tea

5. The invalidation is based on Section 3(1)(a), (b), (c) and (3)(3)(b) of the Trade Marks Act 1994 (“the Act”). This section of the Act is applicable by virtue of section 47(1). An application for invalidation under the aforementioned section is collectively referred to as “absolute grounds”.

Opposition action (no. 103965)

Opposed Mark: 

Application no: 2628780

Filing date: 17 July 2012

Publication date: 24 August 2012

Applicant: Elgin Beverages Limited

Class 30 goods: Iced Tea

6. The opposition is based on section 5(2)(b) of the Act. An opposition based on the aforementioned section is collectively referred to as “relative grounds”.

7. I shall begin with the invalidation absolute grounds challenge first since the outcome of this may have a fundamental impact on the relative grounds.

OXFORD TEA

INVALIDITY No. 500096

Pleadings

8. Elgin argues that their invalidation action should succeed for the following reasons:

3(1)(a) – since it does not satisfy the requirements of section 1(1) and, therefore, it is contrary to s.3(1)(a). Elgin claims that the mark is not a sign that is capable of distinguishing the proprietor’s goods from those of other undertakings.

3(1)(b) – the mark is devoid of distinctive character.

3(1)(c) – the mark consists exclusively of a sign which serves, in trade, to designate the kind, quality, intended purpose and/or geographical origin of the goods.

3(3)(b) – use of the mark, upon registration, will deceive or mislead the public into thinking that the tea and/or tea based beverage products which are manufactured in, originate from or are blended, sold, brewed, served or drunk in Oxford, or are otherwise associated with Oxford.

9. Char filed a counterstatement denying the claims made. The counterstatement included lengthy submissions on why the invalidation action should not succeed. These shall be referred to where necessary/appropriate.

10. Both sides filed evidence and numerous rounds of written submissions. I shall summarise the evidence and refer to the submissions where necessary. No hearing was requested and so this decision is taken following careful consideration of the papers.

Evidence

Char’s evidence (proprietor in the cancellation)

Witness statement of Kate McCormick dated 1 August 2014 (relating to 500096)

11. Ms McCormick is a trade mark attorney at Trade Mark Direct, Char's representatives. Attached to Ms McCormick's witness statement are three exhibits:

Exhibit CU1 is an extract from Collins' online English dictionary for the word "Oxford". It defines the place name Oxford as the following:

"1. a city in S England, administrative centre of Oxfordshire, at the confluence of the River Thames and Cherwell: Royalist headquarters during the Civil War; seat of Oxford University, consisting of 40 separate colleges, the oldest being University College (1249), and Oxford Brookes University (1993); motor-vehicle industry.

2. Also called: Oxford Down. a breed of sheep with middle-length wool and a dark brown face and legs.

3. a type of stout laced shoe with a low heel.

4. a lightweight fabric of plain or twill weave used esp for men's shirts."

Exhibit CU2 are "Examples showing use in business of the mark OXFORD for a variety of goods". These include undated web shot prints for the following companies:

- Oxford Essential Rider Equipment
- Oxford Solo Brake Bleeding Kit
- Oxfords Cashmere
- Oxford Brainfoods
- Various "Oxford" shirts advertised on Next's website
- Oxford Instruments
- Oxford Blue who are described as a lifestyle and country clothing company.
- Oxford Pharmascience (vitamin producers)
- Various "Oxford" bike products advertised on Chain Reaction Cycles website
- Oxford – paper manufacturers
- Oxford Audio
- Various "Oxford" branded glasses on Hilton eyewear website
- Various "Oxford" branded goods which appear to relate to the nursing industry
- The Oxford Bag Co
- A print from Farrow and Bell with the heading "Oxford Stone". It is not clear what goods or services these are.

Exhibit CU3 is an extract from Oxford City Council's website. It states that the city employs a large number of people in the university and public sector. Ms McCormick states that since there is no reference to agriculture or food/beverage production, it means that the city of Oxford is not well-known for these sectors.

Elgin Beverages (applicant in the cancellation)

Witness statement of Francesca Ifechukwunyem Maria Nwaegbe dated 1 May 2014

12. Ms Nwaegbe is the Head of Trade Marks at London IP, the professional representatives for Elgin. Ms Nwaegbe attaches a number of exhibits, namely:

Exhibit FIMN1 is an extract from The Chambers Dictionary (12th Edition). It is highlighted that Oxford, as an adjective, means “belonging to the city, county or university of Oxford”.

Exhibit FIMN2 is a print out from the Project Britain website entitled “What is England famous for?” Tea is listed as one of the answers. It also states that “England is famous for its educational institutes” listing Oxford, Cambridge and “London universities”.

Exhibit FIMN3 comprises of web screen prints from the website www.tea.co.uk Ms Nwaegbe highlights the banner “The UK Tea Council is an independent non-profit making body dedicated to promoting tea & its unique story for the benefit of those who produce, sell & enjoy tea”. The website also states that more tea is drank than coffee.

Exhibit FIMN4 consists of various print outs, many of which are for Oxford tea rooms. Other print outs refer to an Oxford Brea tea which is manufactured by Jeeves and Jericho and a reference to Oxford breakfast tea. The remaining print outs are for tea rooms in Oxford.

Exhibit FIMN5 are print outs from the website charteas.com which list teas named after various UK locations, these include Winchester, Yorkshire and Lancashire Tea.

Exhibit FIMN5 consists of website print outs from various websites. These include a print out from Char’s website which shows a range of tea called Winchester. Ms Nwaegbe argues that these print outs show “the geographical origin/significance of the ‘Winchester’ element of the name/trade mark”.

The exhibit also includes a print outs from Betty and Taylor and Lancashire tea Ltd websites. The print outs make reference to ‘Yorkshire Tea’ and Lancashire, both indicating geographical origin/connection.

CANARY WHARF

13. Prior to these proceedings being ready for a substantive decision, the High Court issued its decision¹ in relation to the trade mark application for CANARY WHARF in classes 16, 36, 37 and 39. The UK IPO refused registration of the mark CANARY WHARF² under sections 3(1)(b) and (c) of the Act. Following an application of the

¹ *Canary Wharf Group Ltd v Comptroller General of Patents, Designs and Trade Marks* [2015] EWHC 1588 (Ch)

² BL O-423-14

principles of the Windsurfing case (discussed below), the hearing officer found that the application should be refused on the grounds that it may serve in trade to designate the geographical origin of the applied for services. The application was also refused for the goods since they designate the subject matter. The decision was upheld on appeal before the High Court.

14. In light of the findings and comments made in the CANARY WHARF decision, particularly since it covers geographical indications, both parties were invited to file any submissions on how the decision impacts (if at all) the existing proceedings. Both parties filed submissions and I shall refer to these where necessary.

DECISION

Section 72

15. The fact of registration is *prima facie* evidence of validity, as per section 72 of the Act, which states:

“In all legal proceedings relating to a registered trade mark (including proceedings for rectification of the register) the registration of a person as proprietor of a trade mark shall be *prima facie* evidence of the validity of the original registration and of any subsequent assignment or other transmission of it.”

16. Also relevant to these proceedings is the provision under section 47(1) of the Act which states:

“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)m (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.”

17. Char has not pleaded a case of acquired distinctiveness as a result of the use they have made of the mark. Therefore, I only have the inherent distinctiveness to consider.

18. The date of application for the trade mark was 26 June 2012. Under section 47(1), the question of whether the mark was registered in breach of section 3(1)(a), (b), (c) and (d) falls to be decided as of this date. Char has not relied upon the proviso to section 47(1) to show that the mark has acquired distinctiveness through the use which has been made of it, and has not filed any evidence of use of its mark. This means I can only consider the *prima facie* case, not whether the mark has acquired distinctiveness as a result of the use made of it.

Section 3(1)(a)

19. This section states:

“3.— (1) The following shall not be registered –
(a) signs which do not satisfy the requirements of section 1(1),”.

20. Section 1(1) states:

“1.—(1) In this Act a “trade mark” means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

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

21. There is no need to say much about this ground of invalidation. In *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418(Ch), Arnold J said:

“44. ... As I discussed in *JW Spear & Sons Ltd v Zynga Inc* [2012] EWHC 3345 (Ch) at [10]–[27], the case law of the Court of Justice of the European Union establishes that, in order to comply with art.4 , the subject matter of an application or registration must satisfy three conditions. First, it must be a sign. Secondly, that sign must be capable of being represented graphically. Thirdly, the sign must be capable of distinguishing the goods or services of one undertaking from those of other undertakings.

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

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

81. In view of that provision, there is no reason to find that a word like 'Postkantoor' is not, in respect of certain goods or services, capable of fulfilling the essential function of a trade mark, which is to guarantee the identity of the origin of the marked goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin (see, in particular, Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 28, *Merz & Krell*, paragraph 22, and *Libertel*,

paragraph 62). Accordingly, an interpretation of Article 2 of the Directive appears not to be useful for the purposes of deciding the present case."

46. The Court went on to say that the question whether POSTKANTOOR (Dutch for POST OFFICE) was precluded from registration in respect of particular goods and services (i.e. those provided by a post office) because it was devoid of distinctive character and/or descriptive in relation to those particular goods and services fell to be assessed under Article 3(1)(b) and (c) of the Directive (Article 7(1)(b) and (c) of the Regulation).

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

22. The upshot of this is that if I am satisfied that the mark complies with section 3(1)(b) and (c) of the Act, the section 3(1)(a) ground is bound to fail. Alternatively, if any of the grounds under section 3(1)(b),(c) or (d) succeed the outcome under section 3(1)(a) becomes moot. Either way, there will be no need for me to address the section 3(1)(a) ground separately to the other grounds of invalidation.

Section 3(1)(c)

23. The relevant section of the Act states:

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

(a)...

(b)...

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

(d)...

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

24. The leading authority relating to geographical names and section 3(1)(c) of the Act is the judgment of the CJEU in *Windsurfing Chiemsee Produktions-und Vertriebs GmbH (WSC) v Boots-und Segelzubehor Walter Huber and Franz Attenberger* (Joined cases C-108/97 and C-109/97) ("*Windsurfing*"). In paragraphs 24 to 35 it was stated:

"It should first of all be observed that Article 3(1)(c) of the Directive provides that registration is to be refused in respect of descriptive marks, that is to say

marks composed exclusively of signs or indications which may serve to designate the characteristics of the categories of goods or services in respect of which registration is applied for.

However, Article 3(1)(c) of the Directive pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the categories of goods or services in respect of which registration is applied for may be freely used by all, including as collective marks or as part of complex or graphic marks. Article 3(1)(c) therefore prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks.

As regards, more particularly, signs or indications which may serve to designate the geographical origin of the categories of goods in relation to which registration of the mark is applied for, especially geographical names, it is in the public interest that they remain available, not least because they may be an indication of the quality and other characteristics of the categories of goods concerned, and may also, in various ways, influence consumer tastes by, for instance, associating the goods with a place that may give rise to a favourable response.

The public interest underlying the provision which the national court has asked the Court to interpret is also evident in the fact that it is open to the Member States, under Article 15(2) of the Directive, to provide, by way of derogation from Article 3(1)(c), that signs or indications which may serve to designate the geographical origin of the goods may constitute collective marks.

In addition, Article 6(1)(b) of the Directive, to which the national court refers in its questions, does not run counter to what has been stated as to the objective of Article 3(1)(c), nor does it have a decisive bearing on the interpretation of that provision.

Indeed, Article 6(1)(b), which aims, *inter alia*, to resolve the problems posed by registration of a mark consisting wholly or partly of a geographical name, does not confer on third parties the right to use the name as a trade mark but merely guarantees their right to use it descriptively, that is to say, as an indication of geographical origin, provided that it is used in accordance with honest practices in industrial and commercial matters.

Article 3(1)(c) of the Directive is not confined to prohibiting the registration of geographical names as trade marks solely where they designate specified geographical locations which are already famous, or are known for the category of goods concerned, and which are therefore associated with those goods in the mind of the relevant class of persons, that is to say in the trade and amongst average consumers of that category of goods in the territory in respect of which registration is applied for.

Indeed, it is clear from the actual wording of Article 3(1)(c), which refers to '...indications which may serve... to designate... geographical origin', that

geographical names which are liable to be used by undertakings must remain available to such undertakings as indications of the geographical origin of the category of goods concerned.

Thus, under Article 3(1)(c) of the Directive, the competent authority must assess whether a geographical name in respect of which application for registration as a trade mark is made designates a place which is currently associated in the mind of the relevant class of persons with the category of goods concerned, or whether it is reasonable to assume that such an association may be established in the future.

In the latter case, when assessing whether the geographical name is capable, in the mind of the relevant class of persons, of designating the origin of the category of goods in question, regard must be had more particularly to the degree of familiarity amongst such persons with that name, with the characteristics of the place designated by the name, and with the category of goods concerned.

In that connection, Article 3(1)(c) of the Directive does not in principle preclude the registration of geographical names which are unknown to the relevant class of persons - or at least unknown as the designation of a geographical location or of names in respect of which, because of the type of place they designate (say, a mountain or lake), such persons are unlikely to believe that the category of goods concerned originates there.

Finally, it is important to note that, whilst an indication of the geographical origin of goods to which Article 3(1)(c) of the Directive applies usually indicates the place where the goods were or could be manufactured, the connection between a category of goods and a geographical location might depend on other ties, such as the fact that the goods were conceived and designed in the geographical location concerned.”

The CJEU subsequently summarised their findings at paragraph 37 as follows:

25. In view of the foregoing, the answer to the questions on Article 3(1)(c) of the Directive must be that Article 3(1)(c) is to be interpreted as meaning that:

- It does not prohibit the registration of geographical names as trade marks solely where the names designate places which are, in the mind of the relevant class of persons, currently associated with the contrary of goods in question; it also applies to geographical names which are liable to be used in future by the undertakings concerned as an indication of the geographical origin of that category of goods;
- where there is currently no association in the mind of the relevant class of persons between the geographical name and the category of goods in question, the competent authority must assess whether it is reasonable to assume that such a name is, in the mind of the relevant class of persons capable of designating the geographical origin of that category of goods;

- in making that assessment, particular consideration should be given to the degree of familiarity amongst the relevant class of persons with the geographical name in question, with the characteristics of the place designated by that name, and with the category of goods concerned;
- it is not necessary for the goods to be manufactured in the geographical location in order for them to be associated with it.

26. Applying the principles of *Windsurfing* the first question to address is whether OXFORD is associated in the mind of the general public with tea, beverages (tea-based-), fruit tea, herb tea and iced tea.

27. The evidence³ states that 165 million cups of tea are drunk in the UK per day. Accordingly, it is clear from the evidence, which is supported from my own knowledge, that tea is a hugely popular drink consumed by a significant proportion of the UK. Therefore, I consider the relevant class of persons to be the UK general public.

28. In Char's counterstatement it argues that: [its mark] "contains the word Oxford, rather than Oxfordshire. The city of Oxfordshire is a heavily populated built up area and not agricultural land so is highly unlikely to become an area of tea growing or production. The city of Oxford in the UK has no particular reputation or significance in relation to iced tea, tea and tea based beverages. Tea is not grown in the city of Oxford or in any relevant scale in the UK due to it being a tropical plant. It is denied that tea and tea based beverages are blended, sold, brewed, provided, served, and drunk in Oxford in any wider scale or proportion than any other town or city in the UK."

29. In reply, Elgin states that⁴: "Whilst it may be true that tea is not grown in Oxford, of relevance is the fact that the average consumer of tea would understand that teas are carefully blended to provide a particular tasting tea, and it is highly plausible that the average consumer would understand OXFORD TEA to be either:

- tea blended by a company in Oxford; or,
- an indication of a particular blend of tea (as Earl Grey is a blend of black tea and bergamot oil and English breakfast is a blend of Assam, Ceylon and Keemun), likely to be in some way otherwise associated or connected with Oxford (e.g. sold in Oxford and/or sold by the well-known Oxford University establishment)"

30. Elgin goes on to argue that 1) teas are blended in Oxford (including its immediate surrounds), 2) "some blends (unrelated to Char), include 'Oxford' as part of their name describing the kind or type of (tea) products (e.g. 'OXFORD BREW'; Oxford Breakfast' and 'Oxford Blend'), clearly for the purposes of identifying or make reference e.g. to the Oxford based blending company's own blend, and/or Oxford establishment or geographical location where the blended tea products are to be sold", and 3) the 'Oxford' name is already associated with tea.

³ Exhibit FIMN3 to Ms Nwaegbe witness statement dated 1 May 2014

⁴ London IP written submissions of 1 May 2014

31. There is no evidence to support Elgin’s claim that tea is blended in Oxford, or its surrounding area. England (and the rest of the UK) is clearly associated with tea due to the amount consumed and possibly by some tea being blended in the UK. However, I think it is stretching the boundaries to suggest that because England is associated with tea then it naturally follows that consumers will believe that Oxford is also associated therewith. Accordingly, I find that in the mind of the relevant UK public, Oxford is not associated with tea.

32. In view of the above, it is necessary to consider whether it is reasonable to assume that Oxford may, in the future, have an association with tea.

33. The evidence shows that Oxford is probably most known for its highly regarded university. It is certainly a city that the general public will know and many will have visited. However, the evidence does not even suggest that it is a city likely to be associated with tea. Elgin filed evidence that refers to various tea blends and tea rooms which relate to Oxford. However, I do not consider a few references to tea rooms or blends as being evidence that Oxford is, or likely to be, associated with tea.

34. I am mindful of the comments in *Windsurfing* that it is not necessary for the goods to be manufactured in Oxford for there to be an association. It is clear that the goods are not manufactured in Oxford and there is no evidence to suggest that this may be the case in the future. Further, there is no evidence that shows that there is any form of association between Oxford and tea, or there is a likelihood of this. In view of the aforementioned, I conclude that even though the goods are not manufactured in Oxford, in the minds of the average consumer there is no association between Oxford and tea.

35. In view of the above, I dismiss the invalidation claim based on section 47(1) and section 3(1)(c) of the Act in relation to all of the registered goods.

Section 3(1)(b)

36. Section 3(1)(b) of the Act is 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.”

37. The relevant question under section 3(1)(b) of the Act (applicable by virtue of section 47(1) of the Act) is whether OXFORD TEA is capable of distinguishing tea,

beverages (tea-based-), fruit tea, herb tea and iced tea for which it is registered.⁵ The mere fact that OXFORD TEA is made up of words which individually describe characteristics of the goods does not necessarily mean that it is incapable of distinguishing the goods.

38. In *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P, the Court of Justice of the European Union stated at paragraph 25 that:

“Thirdly, it is important to observe that each of the grounds for refusal to register listed in Article 7(1) of the regulation is independent of the others and requires separate examination. Moreover, it is appropriate to interpret those grounds for refusal in the light of the general interest which underlies each of them. The general interest to be taken into consideration when examining each of those grounds for refusal may or even must reflect different considerations according to the ground for refusal in question (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-0000, paragraphs 45 and 46).”

39. The principles to be applied under article 7(1)(b) of the CTM Regulation (which 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 at paragraphs 29 to 33 in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

“..... 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).

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

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).

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,

⁵ *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* Case C-265/09 P

three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

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)."

40. It is well established in law that the absolute grounds for refusing registration must be examined separately, although there is a degree of overlap between sections 3(1)(b) and (c) of the Act: see *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* [2004] E.T.M.R. 57, the Court of Justice of the European Union ("CJEU"), paragraphs 67 to 70. That degree of overlap is reflected in the applicant's pleadings in which, effectively, descriptiveness (i.e. section 3(1)(c)) is given as a reason for lack of distinctive character under section 3(1)(b).

41. In my view, Elgin's claim for invalidation is no stronger under this ground of attack than section 3(1)(c). The lack of distinctive character is argued mainly on the basis that the mark designates origin and would therefore lack distinctive character. I have already found that OXFORD TEA is not descriptive of the geographical origin of the goods and no alternative argument why section 3(1)(b) applies have been submitted. Therefore, Elgin has not shown that OXFORD TEA is incapable of distinguishing the registered goods and is therefore devoid of any distinctive character.

Outcome

42. I dismiss the invalidation claim based on section 47(1) and 3(1)(b) of the Act for all of the goods for which OXFORD TEA is registered.

Section 3(3)(b)

43. Section 3(3)(b) reads:

"3. – (3) A trade mark shall not be registered if it is –

(a).....

(b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service)."

44. Section 3(3)(b) of the Act derives directly from article 3(1)(g) of Directive 008/95/EC of the European Parliament and of the Council of 22 October 2008 ("the Directive").

45. Elgin’s statement of case argues “that if the registered mark is not in fact used upon such goods, it will deceive or mislead the public into thinking that the tea and/or tea based beverage products are manufactured in, originate from or are blended, sold, brewed, served or drunk in Oxford, or are otherwise associated with Oxford.”

46. In *Elizabeth Florence Emanuel v Continental Shelf 128 Ltd* Case C-259/04 the Court of Justice of the European Union (“CJEU”) stated at paragraph 47:

“Nevertheless, the circumstances for refusing registration referred to in Article 3(1)(g) of Directive 89/104 presuppose the existence of actual deceit or a sufficiently serious risk that the consumer will be deceived (Case C-87/97 *Consorzio per la tutela del formaggio Gorgonzola* [1999] ECR I-1301, paragraph 41).

47. Elgin has not provided evidence of actual deceit taking place. Consequently, there is no evidence of the existence of actual deceit.

48. It must follow that if the objection under section 3(1)(c) fails then the mark is free from objection under section 3(3)(b). If the mark will not be perceived as indicating geographical origin then it cannot be deceptive. Therefore, I find that there is not a ‘sufficiently serious risk that the consumer will be deceived’.

49. The section 3(3)(b) claim fails.

OVERALL SECTION 3 OUTCOME

50. In view of the above the section 3(1)(a), (b), (c) and 3(3)(b) claims are dismissed.

OPPOSITION No. 103965 – RELATIVE GROUNDS

51. Since the invalidation claim against trade mark registration no. 2625960 has not succeeded, I shall now consider the opposition.



Background and pleadings

52. On 17 July 2012 Elgin applied to register the following mark. It was accepted and published on 24 August 2012 for class 30 “Iced Tea”.



53. On 17 October 2012, Char filed a notice of opposition against the application. The opposition is based on Section 5(2)(b) of the Act. This is on the basis of its earlier UK trade mark registration which Char argues is confusingly similar to their existing registration. The earlier registration was the subject of the invalidation action number 500096, which was dismissed. Pertinent details of the registration are as follows:

Mark: OXFORD TEA

Registration no: 2625960

Filing date: 26 June 2012

Publication date: 20 July 2012

Registration date: 28 September 2012

Owner: Char (UK) Ltd

Class 30 goods: Tea; beverages (tea-based); fruit tea, herb tea; iced tea

54. Elgin filed a counterstatement denying the claims made by the opponent. Since the above mentioned registration has been registered for less than five years prior to the date of publication of Char's mark, it is not subject to the proof of use provisions.

55. Only the applicant filed evidence which shall be summarised below. Both parties provided written submissions which shall be referred to when necessary to do so. No hearing was requested and so this decision is taken following careful consideration of the papers.

Evidence

Applicant's evidence

Witness statement of Ms Nwaegbe and exhibits FIMN1 – FIMN3

56. This is the same Ms Nwaegbe who submitted a witness statement in relation to the invalidation action.

- Exhibit FIMN1 consists of print outs from the UK IPO website. They include a number of existing trade mark registrations which have the prefix OXFORD. The print outs include the marks OXFORD BIERFEST (plus device), OXFORD STREET and UNIVERSITY OF OXFORD (plus device).
- Exhibit FIMN2 consists of various print outs. These are: an extract from The Chambers Dictionary 12th Edition which defines 'iced tea' as 'chilled sweetened tea flavoured e.g. with lemon'. The exhibit also contains a print out from Whittard of Chelsea's website. It is dated 26 April 2013 and headed "Iced Tea". A further web print out is from Twinings' website. It is dated 10 August 2012 and headed "HOW TO MAKE ICED TEA – EARL GREY TEA".

Ms Nwaegbe states that references to iced tea in the dictionary and the websites prove that the term 'iced tea' has become generic and a common expression.

- Exhibit FIMN3 are print outs from a Google search for the term 'dry iced tea'. There was only one hit for the term 'dry iced tea' which is the name used for a cocktail which was formulated in Manchester. The search was confined to the UK. The search was conducted on 29 April 2013. Ms Nwaegbe submits that "contrary to the Opponent's implication/indication, 'dry' is not a recognised term or commonly used expression in the UK and/or English language to describe the level of sweetness of tea. As is demonstrated/evidence/confirmed by the two (www.meriam-webster.com and www.collinsdictionary.com) dictionary references".

57. Ms Nwaegbe argues that 'dry' is neither 1) a recognised term, nor 2) a commonly used expression, which describes the level of sweetness of tea. She states that it is a term frequently used in relation to alcohol but not tea.

58. Ms Nwaegbe also claims that the "dominant element of the Applicant mark is 'OXFORD DRY', and the relevant trade and public, and the average consumer (tea suppliers, purchasers and drinkers) will readily view and/or consider the 'brand identifier' as being 'OXFORD DRY' and not 'OXFORD' as the opponent submits". Accordingly the comparison which should take place is between "OXFORD DRY and OXFORD TEA".

Decision

Section 5(2)(b)

59. Sections 5(2)(b) of the Act is as follows:

"5(2) A trade mark shall not be registered if because-

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark".

Relevant case law

60. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

AVERAGE CONSUMER AND THE PURCHASING ACT

61. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

62. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), at paragraph 60 Birss J. described the average consumer in these terms:

“The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

63. The goods in question are “iced tea”, which would be purchased and consumed by the general public. It is an inexpensive drink which is likely to be ordered at a cafe or bar. Further, the drink may be purchased following a visual inspection of them on supermarket and shop shelves, or aurally ordered in a cafe or restaurant. Therefore, I consider the purchasing process to be aural and visual to an equivalent extent.

64. Generally the cost of iced tea is low, and the level of care and attention paid when purchasing the goods will be low.

COMPARISON OF GOODS

65. The respective marks cover the following goods:

Elgin’s goods (the applicant)	Char’s goods (the opponent)
Iced Tea	Tea; beverages (tea-based-); fruit tea, herb tea; iced tea.

66. Both parties goods cover “iced tea”. Therefore, they are identical.


COMPARISON OF MARKS

67. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

68. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

69. The respective trade marks are shown below:

Elgin's mark	Char's mark
 The logo for Elgin's mark features the words "OXFORD DRY" in a bold, sans-serif font. "OXFORD" is in orange with a yellow outline, and "DRY" is in yellow with an orange outline. Below this, the words "ICED TEA" are written in white on a green banner with a blue border.	OXFORD TEA

70. Elgin's mark consists of the words OXFORD DRY with the outer edges in orange and the inner part in yellow. The stylisation is not particularly distinctive and is not dominant. Below OXFORD DRY are the words ICED TEA which is on a green banner. Whilst the banner and the stylisation of the words do contribute to the overall distinctiveness of the mark they do not alter the initial impression of the mark which, in my view, mainly resides with OXFORD. The words "DRY ICED TEA" in Elgin's mark and "TEA" in Char's merely describe the goods offered.

71. The applicant argues that the comparison should be between OXFORD DRY and OXFORD TEA, whereas the opponent is of the view that the comparison is between OXFORD TEA and OXFORD DRY ICED TEA.

72. The opponent argues that the word DRY is commonly used in relation to alcohol but not tea. The applicant denies this claim stating that DRY is used in relation to soft drinks, for example DRY would be used in relation to Ginger Ale and tonic water. In my view, the word dry for tea and iced tea is not distinctive. Whilst it may be the case that "dry" tea does not exist, it would still not be distinctive for the subject goods. I suspect that many would assume it as being descriptive of the type of tea

along the same lines as a dry white wine but, at least, it would not denote trade origin. Further, I do not believe that the average consumer for tea would give it a great deal of thought and would give its ordinary meaning.

Aural

73. Elgin's mark will be pronounced as OXFORD DRY ICED TEA. No other element will be pronounced. Char's mark will be pronounced as OXFORD TEA. With the exception of the words DRY ICED at the end of Elgin's mark, they will be pronounced in the same way. Overall, I find that the respective marks are aurally similar to a high degree.

Visual

74. Whilst Elgin's mark does consist of some stylisation, it is not particularly striking. Therefore, given that both marks contain OXFORD and TEA, I find that the marks are visually highly similar.

Conceptual

75. Conceptually, since I have already found that OXFORD is distinctive (albeit to a low degree) for tea products, this is the conceptual hook for each mark. Accordingly, both marks will be remembered as either tea or dry iced tea but essentially the same type of goods under the mark Oxford. I have already found that consumers will not believe that the goods themselves originate from Oxford but they will nevertheless remember Oxford and little else. Accordingly, I am of the opinion that conceptually the respective marks are identical.

DISTINCTIVE CHARACTER OF THE EARLIER TRADE MARK

76. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated at paragraphs 22 and 23 that:

"In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; 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 section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from

chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

77. No evidence of use of the mark OXFORD TEA has been filed. Therefore, it has not claimed an enhanced level of distinctiveness due to the use made of the mark.

78. With regard to the inherent distinctiveness, I have already found that it is a degree of distinctive character, but I must decide the extent of distinctiveness. Clearly the word TEA is entirely descriptive of the goods in question and is, therefore, non-distinctive. In view of this, the degree of distinctiveness resides solely in OXFORD. This is a city that will be known to all of the consumers of the goods and a place that many people will have visited. Accordingly, I find that the level of inherent distinctive character in the mark OXFORD TEA to be very low.

LIKELIHOOD OF CONFUSION

79. I must now determine whether there is a likelihood of confusion. This is not a scientific process and it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*). This is known as the interdependency principle.

80. In view of the above, I remind myself of the various findings I have reached:

- The respective goods are identical;
- The respective marks are conceptually identical, and from a visual and aural perspective highly similar;
- The mark has a low degree of inherent distinctive character;
- The average consumers of the goods are the general public, who will pay a low degree of care and attention;
- The goods are purchased following a visual inspection and ordering aurally.

81. Whilst the earlier mark has a very low degree of distinctive character, the dominant and only distinctive element of each is the place OXFORD. The combination of the high degree of overall similarity between the marks and the identical goods leaves me in no doubt that there is a likelihood of direct confusion between the respective marks.

OUTCOME

82. The opposition against section 5(2)(b) of the Act succeeds. The application, subject to appeal, shall be refused in its entirety.

COSTS

83. Char has been successful in defending their trade mark registration and opposing Elgin's application. They are entitled to a contribution towards its costs. In the circumstances, I award Char the sum of £2300 as a contribution towards their costs of these consolidated proceedings. The sum is calculated as follows:

Invalidation action

Considering the other side's statement of case and filing a counterstatement	£400
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Preparing and considering evidence and commenting on other side's evidence	£500
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Opposition action

Official fee	£200
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Preparing a statement of case, considering the other side's statement	£400
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Preparing and considering evidence and commenting on other side's evidence	£800
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Total	£2300
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84. I therefore order Elgin Beverages Limited to pay Char (UK) Ltd the sum of £2300. The above sum should be paid within fourteen days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 6th day of October 2015

MARK KING
For the Registrar,
The Comptroller-General