

**O/673/21**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NOS. 3443204 and 3443198**

**IN THE NAME SOHO BREWING LTD  
IN RESPECT OF THE TRADE MARKS**



**And**





**IN CLASS 32**

**AND**

**CONSOLIDATED OPPOSITIONS THERETO UNDER NOS. 419741 & 419742  
BY WEST END DRINKS LTD**

## Background and pleadings

1. Soho Brewing Ltd (“the applicant”) applied to register the trade marks in the UK for the marks outlined in the table below:

Trade mark	Application no.	Territory	Application date/publication date	Goods filed
 (series of four)	3443204 (“the series mark”)	UK	11 November 2019 / 6 December 2019	Class 32: Beer; lager; pilsner; ale; porter, stout and preparations for making these different beers.
	3443198 (“the solo mark”)	UK	11 November 2019 / 6 December 2019	Class 32: Beer; lager; pilsner; ale; porter, stout and preparations for making these different beers.

2. West End Drinks Limited (“the opponent”) opposes both trade marks in respect of all of the goods on the basis of both section 3(1)(b) and (c) of the Trade Marks Act 1994 (“the Act”). The opponent argues that the mark consists exclusively of a sign that will serve in trade to designate the geographic origin of the goods applied for, and that the area of Soho in London is well known for

alcoholic drinks and as a centre for nightlife and entertainment. The opponent submits that for these reasons the marks are therefore also devoid of distinctive character under section 3(1)(b).


3. The applicant filed a counterstatement in respect of each opposition denying that the applications should be refused and putting the opponent to proof of the claims made.
4. Following the receipt of the TM8 and counterstatements from the applicant, both parties were informed by the Tribunal by way of a letter dated 13 May 2020 that the oppositions would be consolidated under Rule 62(G) of the Trade Mark Rules 2008.
5. Both parties filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary. Both sides filed written submissions. These will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.
6. Both parties are professionally represented in these proceedings. The opponent is represented by Stobbs IP Limited. The applicant is represented by Dolleymores LLP.
7. 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 Trade Marks Act relied on 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.

## Evidence

### Opponent's evidence in chief

8. The opponent filed its evidence in the form of three witness statements. The first witness statement is in the name of Claire Sugden, described as the Intangible Asset Manager and Chartered Trade Mark Attorney at Stobbs IP Limited. The statement introduces a total of seven exhibits, namely Exhibit CS1 to CS7.
9. Exhibits CS1 and CS2 comprise pages of two books providing a detailed history of the area of London named Soho. The books, namely 'Soho – A Street Guide to Soho's History, Architecture and People' by Dan Cruickshank, and 'Soho – a History of London's Most Colourful Neighbourhood' by Judith Summers both provide an extensive history of the area. The first is dated July 2020, and a date is not shown for the second. Both extracts provided are lengthy and whilst they have been considered they will not be summarised in detail at this stage.
10. Exhibit CS3 provided is undated and entitled 'I Never Knew That About London'. The author is named as Christopher Winn. The extract provides facts about the area of Soho, including that it houses (or housed at the time the book was written) "London's most famous jazz club".
11. Exhibit CS4 comprises the Wikipedia page for 'Soho' naming it as a part of the West End of London and one of London's main entertainment districts since the 19<sup>th</sup> century. The screenshots are dated 14 December 2020. Several pages outlining the history of the John Snow Pub are also provided under this exhibit.
12. Exhibit CS5 is the full UK IPO decision no. O/592/19 dated 3 October 2019. In her witness statement Ms Sugden directs me to paragraph 27 of this decision in particular, in which the hearing officer states that SOHO will be viewed as an area of London, and that the marks subject to that decision will reference types of beer produced in the Soho area, or of a brewery with the same location. Ms Sugden also directs me to paragraph 32 and 37 where it was found the wording

including SOHO would be viewed as descriptive of the goods provided and their geographical location, and that SOHO is more likely to be viewed as linking products to the location rather than linking the businesses in that instance. The decision also found at paragraph 32 that the marks, namely variations on the

mark , held between a low and medium degree of inherent distinctiveness as a whole for the goods including beer and larger.

13. Exhibit CS6 comprises pages from a second UK IPO decision no. O/196/19 dated 11 April 2019. In her witness statement, Ms Sugden directs me to paragraphs 47, 50, 54, 61 and 69, in which the Hearing Officer found less weight would be given to the element SOHO in the marks subject to this decision, due to its meaning as a well known entertainment district in London.
14. Exhibit CS7 is an article from The Guardian dated 3 March 2008. The article reports the death of a man named Paul Raymond. The article describes him as the “self-styled king of Soho” and states he was one of the richest men in the country, and that he “made his name” by opening the UK’s first strip club in Soho in 1958, and that he owned the freehold of large areas of Soho.
15. The second witness statement provided by the opponent is in the name of Mr Howard Raymond, described as the Director and co-founder of the opponent. In the statement, Mr Raymond explains that the ‘King of Soho’ as described in the article provided at Exhibit CS7 was his father, and that his father was consistently described in the media in this way.
16. Mr Raymond submits in his witness statement that in his experience in the “entertainment and real estate industry”, the use of the word SOHO in respect of the goods would not indicate brand origin.
17. The final witness statement from the opponent is provided in the name of Mr Mark Phillip Quinn, the Director of Raymond Estates Ltd. The statement submits that to Mr Quinn, the mark SOHO indicates a district of London well known for its entertainment and nightlife.

## Applicant's evidence in chief

18. The applicant has provided a witness statement in the name of Ms Victoria Bennett, described as a Chartered Trade Mark Attorney at Dolleymores LLP, the applicant's representative. The applicant submits a copy of the marks that are the subject of this opposition at Exhibit VB1. Exhibit VB2 comprises a copy of the registration details for what is described by Ms Bennett as "their Device mark, without wording". This shows the background element of the marks subject to this opposition registered under UK registration no. 3393419.
19. Exhibit VB3 is a copy of the provisions under the Act. At paragraph 7 Ms Bennett states that no objection under Sections 3(1)(b) or 3(1)(c) were raised against the application no. 3393419, and Exhibit VB4 comprises the acceptance letter from the UK IPO in respect of the application.
20. At paragraph 9, Ms Bennett states that during the examination of both applications which are the subject of this opposition, the examiner did not raise an objection under either section 3(1)(b) or section 3(1)(c). The acceptance letters for the marks from the UK IPO are provided as Exhibit VB5.

## Opponent's evidence in reply

21. The opponent filed evidence in reply in the form of a further witness statement in the name of Clare Sugden. This did not produce any further exhibits and provided comments in response to Ms Bennett's evidence only. This will not be summarised at this time but it has been fully considered and will be referenced where appropriate within this decision.

## Preliminary issues

22. The opponent's second and third witness statement comprise statements that appear to be submissions from individuals on what SOHO means to them, and whether it would be viewed as an indication of brand origin. I find this evidence of little assistance. I do not find that the fact that Mr Raymond's father was the

self-proclaimed 'King of Soho' gives him authority to determine what will and will not be viewed by the average consumer as an indication of origin, a decision that is to be determined by the Tribunal. Further, Mr Quinn's own understanding of what Soho means is of no assistance to this matter, not least because Mr Quinn does not appear to represent the average consumer, being the Director of a company named Raymond Estates Ltd, which appears likely to be associated with Paul Raymond, the 'King of Soho'. It seems both of these individuals will have a more substantial knowledge of the area of Soho than the average consumer of the goods, and regardless, they are not in a position to comment objectively on the views of the average consumer in this regard. For completeness, even if it is not the case that Raymond Estates Ltd is associated with Paul Raymond, I do not find the knowledge held by an individual, namely Mr Quinn, to be of assistance to my assessment of the knowledge held by the average consumer.

23. Further, I note reference to other decisions issued by the other Hearing Officers in the Tribunal. Whilst these are noted, any findings made by other Hearing Officers in previous decisions are not binding on me.

24. In the evidence provided by the applicant, Ms Bennett notes that objections under the grounds raised in this opposition were not raised during the examination of the applications to the logo only or current marks. There is some dispute between the parties on the relevance of this to the current matter. Whilst this is noted, this will not have any bearing on the outcome of this decision, which is to be determined objectively based on the evidence I have before me. I am not bound by any decision made during the examination of the marks before me, or the examination of any similar marks.

## DECISION

### Section 3(1)(b) and 3(1)(c)

25. Before I begin my decision, I note 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) of the Act: *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P at [25].

### Legislation

26. Section 3(1) reads as follows:

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

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



## **Average consumer**

27. The position under 3(1)(b) and 3(1)(c) must be assessed from the perspective of the average consumer, who is deemed to be reasonably observant and circumspect: *Matratzen Concord AG v HuklaGermany SA*, Case C-421/04.

28. In this instance, the goods covered by the marks are all alcoholic beverages in class 32. The average consumer of the goods will be the general public over the age of 18. These goods will be purchased fairly frequently at a relatively low price point, but considerations will be made in respect of the flavour and level of alcohol content. I find the consumer will pay an average degree of attention to the goods. There will also be a portion of professional consumers, buying the goods to sell on to others, and these consumers, and these consumers will likely pay a higher level of attention to the goods than the general public.

## **3(1)(c)**

29. I will begin with the examination of the trade mark under section 3(1)(c) of the Act.

## **General principles of section 3(1)(c)**

30. 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).

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].”

31. In assessing the mark under section 3(1)(c), I keep in mind that the objective of this section of the Act is to ensure that signs designating a characteristic of the goods remain free for use by traders of those goods. The goods applied for under all of the earlier marks are as follows:

*Class 32: Beer; lager; pilsner; ale; porter, stout and preparations for making these different beers.*

32. In respect of the opposition under section 3(1)(c), the opponent argues:

“...the Applications are not capable of distinguishing beers and the remaining goods applied for because the place name for ‘SOHO’ has a reputation for alcoholic drinks amongst the general public in the UK. We submit that the Opponent has shown that the public in the UK views the area in London known as SOHO as an alcoholic drink making centre, in particular by way of the Witness Statements of Mark Quinn and that of Howard Raymond.”

33. I find there is little evidence that the area of Soho has a reputation amongst the average consumer for alcoholic drinks per se. I am not convinced by the pages from books provided detailing the history of the area, as the history books focused on the area of Soho do not represent the average consumers knowledge of the same. Further, I note the third book is named "I never knew that about London", and is clearly for the purpose of sharing lesser known facts about the area. Although I note the reference to London's most famous Jazz club being located in the area, as well as references to a historic association with the sex trade, I do not find this to be evidence that the area as a whole is known for its alcoholic beverages. I note the references to Soho being one of London's main entertainment districts, although I note that evidence provided on this is dated after the date that the applications were filed. As I have mentioned in the preliminary issues, I do not find Mr Raymond's or Mr Quinn's witness statement to be of any assistance, and I do not find the article provided detailing the life of the 'King of Soho' to be informative of the average consumers understanding of the area and its relationship to alcoholic beverages.

34. However, notwithstanding the above, I am willing to accept, partly from the evidence filed but also I am willing to take judicial notice on the fact that Soho is geographical location, namely an area of London, and that it is well known to the UK consumer, and that it is a popular destination for nightlife. On this basis, I accept that the average consumer will understand it to be a place where alcohol is served more frequently than in some other areas of the UK. I do not accept that it has been shown to be a place particularly well known for brewing beer or producing alcohol.

35. Whilst it is the focus of the evidence filed, the word SOHO is not the only element of the earlier marks. In respect of the series marks, these also consist of the words Larger, Pale Ale, Porter and Pilsner, all of which are clearly descriptive of respect of the goods covered. The solo mark also includes the word Brewing, which indicates that the type of goods offered will be made in a brewery, something that is directly associated with the making of beer. I accept,

therefore, that the wording of all of the earlier marks will indicate to the consumer a geographic location in addition to a type or method of making the alcoholic beverages covered by the applications. Whilst the evidence has not shown that the area of Soho is known by the consumer for making beer, this does not prevent the wording of the marks from indicating to the average consumer that the goods offered under the sign are alcoholic beverages that derive from the area of Soho. I note the applicant's submission that the landscape of Soho is not one suitable for beer production, but I find it entirely plausible it could be home to many micro-breweries, and this is a view I believe the average consumer would share. I find the wording of the contested marks alone will indicate the type and location of product offered under the same.

36. However, the contested marks are not filed as word marks. In the applicant's submissions, it raises that the second witness statement filed in the name of Clare Sugden for the opponent states *"In reply to paragraph 7 of Victoria Bennett's statement, it is stated that it is irrelevant to these proceedings as to the status of the examination of the Applicant's UK Trade Mark Registration No 3393419, which is for the device element only of the subject applications, as it is to the word SOHO, and that element alone, that the opposition on Absolute Grounds has been directed"*. The applicant states that this assessment is incorrect and requests that I conduct the analysis based on the marks as a whole. Whilst I have already agreed that the examination of previous marks will have no bearing on this decision, I agree that the assessment on this ground must be conducted in respect of the mark as a whole, and that it is not correct to make my decision based on the inclusion of the word SOHO in the mark only.

37. In addition to the wording, the marks filed include a circular device behind the text which is separated in half and which a square sitting in the middle and overlapping the two halves of the same. Whilst I note the background image appears to make reference to a Union Jack, this is heavily stylised. The text itself is also stylised, particularly the word 'SOHO', in a manner that I consider to be fairly unusual in that it is not a standard font. Whilst I note therefore that the wording itself may describe the location and type of product, I find the combination of all of the elements of the marks, including the device element

sitting behind the wording and the presentation of the same means that to my mind none of the contested marks consist *exclusively* of signs which are descriptive of the goods. Whilst I note the applicant has filed evidence that the device element of the mark is already registered on its own, for clarity I note here that I have made my considerations independently and within the context of this case.

38. For the avoidance of doubt, I have considered the opponent's arguments that the word SOHO must remain available on the basis that it may elicit a favourable response from the consumer due to the area's reputation, but I do not find this furthers the opponent's position under this ground, not least due to the reasons previously outlined, namely that these are not applications for the word SOHO.

39. As it is required that the marks consist exclusively of signs that serve to designate a characteristic of the goods for an opposition to succeed under section 3(1)(c), and whilst keeping in mind the objective of this ground to keep signs that are descriptive free for use by other traders, I find the opposition under this ground fails.

### **3(1)(b)**

40. I will now consider the opponent's case under section 3(1)(b) of the mark.

41. Within its pleadings, the opponent makes no independent claim as to why the marks are non-distinctive other than because they are claimed to be descriptive of an area of London. This points to there being no need to consider the section 3(1)(b) ground separately to the section 3(1)(c) ground (see the comments of Anna Carboni, sitting as the Appointed Person in O-363-09 *COMBI STEAM Trade Mark*).

42. Therefore, whilst recognising that section 3(1)(b) and section 3(1)(c) are independent of each other, the circumstances in this case are such that it is



not necessary for me to consider separately the ground based upon section 3(1)(b).

43. As it was not established that the contested applications consist solely of descriptive elements under section 3(1)(c), and as no further argument has been advanced as to why I should find the marks do not hold *any* distinctive character under section 3(1)(b), I do not find that this has been established. I conclude that the opposition based upon section 3(1)(b) fails.

### **Final Remarks**

44. The opposition fails. Subject to a successful appeal, the applications will proceed to registration in their entirety.

### **COSTS**

45. The applicant has been successful and is entitled to a contribution towards its costs. In the circumstances I award the applicant the sum of £1400 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

#### **Prior to consolidation**

Considering the statement of grounds and filing the counterstatements	£300 x 2 = £600
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#### **Post consolidation**

Preparing evidence and considering and commenting on the other side's evidence	£500
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Preparing and filing the written submissions in lieu	£300
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**Total**

**£1400**

46. I therefore West End Drinks Limited order to pay Soho Brewing Ltd the sum of £1400. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

**Dated this 15th day of September 2021**

**Rosie Le Breton  
For the Registrar**