

O/1124/22

CONSOLIDATED PROCEEDINGS

TRADE MARKS ACT 1994

**IN THE MATTER OF UK REGISTRATIONS NOS. 3380303 & 3352739
IN THE NAME OF REDEMPTION CENTRES LTD**

AND

**APPLICATIONS FOR DECLARATION OF THE INVALIDITY THEREOF
UNDER NOS 503521 & 503701**

BY

TOMRA SYSTEMS ASA

BACKGROUND AND PLEADINGS

1. Redemption Centres Ltd (“the proprietor”) is the owner of two series of trade marks. The first series is registered as UK Trade Mark (“UKTM”) No. 3380303 and consists of the following two word marks: **REDEMPTION CENTRE** and **RedemptionCentre**. The series was applied for on 4 March 2019 and completed its registration procedure on 31 May 2019. The second series is registered as UKTM No. 3352739 and consists of the two figurative marks shown below. This series was applied for on 12 November 2018 and completed its registration procedure on 1 February 2019.



2. Both series are registered for the following goods and services:

Class 7

Recycling machines; bottle deposit machines; machines for depositing recyclable bottles and containers; automated machines for identifying, sorting, collecting and processing containers and plastic; part and fittings for all the aforesaid.

Class 36

Refund and money-back schemes relating to recycling of bottles and containers; refund and money-back schemes relating to recycling of goods; provision of information, consultancy and advice relating to the aforesaid.

Class 40

Recycling services; provision of facilities for recycling of bottles, containers and goods; provision of recycling centres; provision of facilities for the deposit of used or empty bottles and containers for the purpose of recycling and redemption; provision of information, consultancy and advice relating to the aforesaid.

3. On 31 December 2020, Tomra Systems ASA (“the applicant”) filed an application to have the series of word marks declared invalid under the provisions of sections 3(1)(b) and 3(1)(c) of the Trade Marks Act 1994 (“the Act”) which are relevant in invalidation proceedings under section 47(1) of the Act. The application concerns all the goods and services for which the series of word marks is registered.

4. The applicant claims that the marks are descriptive and devoid of distinctive character for the goods and services in respect of which they are protected and are therefore incapable of functioning as an indicator of trade origin. In particular, it asserts that “REDEMPTION CENTRE” is, and was at the date of filing, an expression used in the recycling trade *“to refer to a location or enterprise that receives empty containers from the public in exchange for a refund of a deposit paid in respect of those containers at the time of purchase”* and that such usage derives from the ordinary meanings of the words that make up the marks. It also claims that the marks could be used to describe the goods and services for which the marks are registered and would be perceived by consumers as a direct and specific reference to *“a place, building or business where items can be exchanged for (re)payment”*.

5. On 11 March 2021, the applicant filed an application to have the series of figurative marks declared invalid under the provisions of sections 3(1)(b) and 3(1)(c) of the Act. It makes the same claims as in its earlier application for a declaration of invalidity and in addition asserts that:

“The figurative components of the Registered Mark consist of commonplace representations of a bottle and the type of circular arrow frequently used in trade to signify recycling, so are in themselves descriptive and devoid of distinctive character for the goods and services under consideration, within the meaning of Sections 3(1)(c) and (b). They are insufficient to imbue the mark as a whole with any distinctive character.”

6. The proprietor filed defences and counterstatements denying the claims made. In its defence of the figurative marks, it contended that even if the words “REDEMPTION CENTRE” were held to be descriptive and non-distinctive, the device element, and the

marks as wholes, were distinctive of the goods and services covered by the registration.

HEARING

7. The matter came to be heard before me on 4 October 2022 by videolink. The applicant was represented by Michael Conway of Haseltine Lake Kempner LLP and the proprietor by Denise McFarland of Counsel, instructed by Keltie LLP.

EVIDENCE

8. The applicant's evidence in chief comes from Aleksander Mortensen, Head of Commercial of Tomra Systems ASA. His witness statement is dated 10 February 2022 and is accompanied by 6 exhibits. The evidence goes to the definition and use of the terms "redemption" and "redemption centres" in the US, UK and other English-speaking countries, and also contains the results of a Google Images search for "bottle recycling logo". Mr Mortensen's witness statement also refers to a list of new words added to the *Oxford English Dictionary* in 2009, which included "redemption centre". This was missing from the evidence that had been admitted to the proceedings. At the hearing, I asked Mr Conway about this exhibit. He said that he would not be referring to it and it was simply a list of words, without definitions and agreed with my view that it did not appear to be of material significance to the case.

9. The proprietor's evidence comes from Niklas Engström, Director of Redemption Centres Ltd. His witness statement is dated 6 April 2022 and is accompanied by 5 exhibits. The exhibits contain company details for the proprietor and its parent and photographs showing the contested marks in use. Mr Engström also comments on the applicant's evidence.

10. The applicant filed evidence in reply in the form of a second witness statement from Mr Mortensen dated 9 July 2022. It is accompanied by 7 exhibits, which go to the use made of the phrase "redemption centers" and the approach taken by the US Patent and Trademark Office (USPTO) when examining applications to register trade marks containing the phrase. Ms McFarland submitted that the practice of the USPTO had

no relevance to the task facing me. I agree. I must view the contested marks from the perspective of the relevant public in the UK, either those in trade or the average consumer, who is deemed to be reasonably well-informed, observant and circumspect: see *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04, paragraph 24.¹

DECISION

11. Section 47(1) of the Act is as follows:

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

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

12. The relevant parts of section 3(1) of the Act are as follows:

“The following shall not be registered –

...

(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, intended purpose, value, geographical

¹ Section 6(3)(a) of the European (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.

origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

...

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 is 4 March 2019 for the contested word marks and 12 November 2018 for the contested figurative marks.

14. Ms McFarland submitted at the hearing that:

“It is important, we say, to recognise in the scheme of things that both of those marks went through without any objection being raised by the IPO at all, never mind anyone else objecting.”²

15. The fact that no objection was raised at examination stage has no bearing on my decision, as Mr Iain Purvis KC, sitting as the Appointed Person, clearly stated in *LSA Legal Steriod Alternative*, BL O/1020/22.³ Neither should I read anything into the lack of opposition to the contested marks. The invalidation process exists to enable marks to be challenged post-registration. I will therefore consider both series of marks afresh.

16. Ms McFarland submitted that the average consumer would be a member of the general public. On the other hand, Mr Conway considered that there were two groups that would be relevant: the user of a recycling service or the operator of that service. The general public would be unlikely to purchase the goods in question, but would make use of the services. I agree that the general public will not be purchasing goods such as *Recycling machines* or *Bottle deposit machines*. The consumers of the goods will be specialists, including local authorities and waste businesses, sports and

² Transcript, page 32.

³ Paragraph 12.

entertainment venues such as those shown in Exhibit 11 to Mr Mortensen's second witness statement, and other businesses, such as supermarkets. I take the view that the consumer of the Class 36 services will be a local authority or producer or retailer of the goods that are to be recycled. I agree with Mr Conway that both general and specialist consumers will be relevant for the Class 40 services.

17. The grounds are independent and have different general interests. It is possible for a mark not to fall foul of section 3(1)(c) but still be objectionable under section 3(1)(b): see *SAT.1 SatellitenFernsehen GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-392/02 P, paragraph 25. However, where a mark is descriptive of the goods or services for which it is registered, it necessarily lacks the required distinctiveness to avoid objection under section 3(1)(b).

18. Mr Conway accepted that, as regards the word marks, the section 3(1)(b) claim stood or fell with the claim under section 3(1)(c). In the case of the figurative marks, his primary position was that the marks in the series were descriptive and so fell foul of section 3(1)(c). In the event that I found against him on this point, his secondary position was that these marks were not capable of denoting trade origin and so should be declared invalid under section 3(1)(b). I shall therefore consider the section 3(1)(c) ground first, beginning with the series of word marks.

Section 3(1)(c)

19. 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 (as he then was) 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 L40, p. 1), see, by analogy, [2004] ECR I-1669, 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 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] E.C.R. I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] E.C.R. 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].”

20. More recently, Zacaroli J summarised the key question in *Puma SE v Nike Innovate C.V.*, [2021] EWHC 1438 (Ch):

“Ultimately, as Ms Himsworth QC submitted, the question is whether the mark applied for, when notionally and fairly used, is descriptive of the goods and services in question within the meaning of section 3(1)(c). A sign can be refused registration ‘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 [the characteristics in section 3(1)(c)]’: *Technopol* (above), at [50]. Moreover, a sign will be descriptive ‘if there is a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of one of the characteristics of the goods and services in question’: Case T-234/06 *Giampetro Torresan* (above) at [25].”⁴

⁴ Paragraph 21.

21. Ms McFarland submitted that the evidence failed to show that the phrase “redemption centre” was used descriptively in the UK. She accepted that it did show use in the United States, Canada, Barbados and Jamaica in relation to deposit refund schemes where part of the purchase price of certain drinks includes a deposit that the consumer could collect when returning the empty container for recycling.⁵ Ms McFarland argued that use in these jurisdictions was not relevant. It is, however, settled case law that it is not necessary under section 3(1)(c) for the marks actually to be in use at the time of their applications in a way that is descriptive; it is sufficient that they could be descriptive. Furthermore, the lack of UK use is not surprising as there were no national or large-scale deposit refund schemes operating in the UK at the application date. According to a print out from the British Soft Drinks Association, Scotland plans to introduce a scheme in 2023, with England, Wales and Northern Ireland launching another in 2024.⁶ The applicant’s evidence shows some small-scale use in the UK with a press release dated 23 October 2019 listing Cheltenham Racecourse and Lord’s Cricket Ground as venues that have used “redemption kiosks” as part of their efforts to reduce plastic waste.⁷ I acknowledge that the phrase here is not identical to the mark, but the word “redemption” is shared.

22. The proprietor claimed in its counterstatement that it has created the term “Redemption Centre”. Mr Conway referred me to the Court of Appeal decision in *McCain International Limited v Country Fair Foods Limited & Anor*, [1981] RPC 69 where Templeton LJ said at [72]-[73]:

“Mr Harman, in a very forceful and if I may so, very attractive argument, submitted that ‘oven chips’ is a fancy name and not a phrase in common use in the English language, so that it will be associated with one particular manufacturer and not with a product. He said it is a novel phrase – and that is true; it has never been used before – that is also true. He castigated the phrase as an ungrammatical aggregate of two English nouns and said that it was nonsensical without an explanation. But in my judgment the words ‘oven chips’, grammatical or not, constitute an expression which is an

⁵ Exhibit AM4.

⁶ Exhibit NE5.

⁷ Exhibit AM11c.

ingenious and apt description of the contents, namely, potato chips prepared for cooking in the oven; and although the consumer may not have been aware, and could not have been aware of what the expression meant until oven chips came on to the market, once they had come on the market he could recognise a name which is apt and appropriate to describe a product rather than a manufacturer, the product being potato chips prepared for cooking in the oven. ...”

23. Whether the proprietor devised a completely new term is not the issue. In *Campina Melkunie BV v Benelux-Merkenbureau*, Case C-265/00, the Court of Justice of the European Union (“CJEU”) stated that:

“39. As a general rule, the mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics within the meaning of Article 3(1)(c) of the Directive even if the combination creates a neologism. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned.

40. However, such a combination may not be descriptive within the meaning of Art. 3(1)(c) of the Directive, provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements. In the case of a word mark, which is intended to be heard as much as to be read, that condition will have to be satisfied as regards both the aural and the visual impression produced by the mark.

41. Thus, a mark consisting of a neologism composed of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, is itself descriptive of those characteristics within the meaning of Art. 3(1)(c) of the Directive, unless there is a perceptible difference between the neologism and the mere sum of its parts,

that assumes that, because of the unusual nature of the combination in relation to the goods or services, the word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts.”

24. I consider that the overall impression of the word marks lies in the combination of the words “Redemption” and “Centre” as a unit. These are ordinary words that can be found in any standard English dictionary.

25. There was no dispute between the parties as to the meaning the consumer would find in the word “Centre”. It would be seen as a place or building which is the focus of a particular activity or group of activities. Ms McFarland referred to health centres and leisure centres as examples. She submitted that the “*ordinary English-speaking person in the UK*” would readily understand what was meant by those terms, but would, in her words, be “*completely baffled*” if someone told them they were going to the “redemption centre”.⁸

26. Both parties have offered dictionary definitions of the word “redemption” or the verb from which it is derived, i.e. “redeem”. The applicant’s statement of grounds quotes the following definitions from the *Cambridge Online Dictionary*:

- “to get something back”;
- “to exchange a piece of paper representing a particular amount of money for that amount of money or for goods to this value”; and
- “to buy back something, or to exchange something for money or for goods or services”.⁹

27. The proprietor denied that the word “redemption” is commonly used in relation to “getting something back”.¹⁰ In her skeleton, Ms McFarland offered the following definitions: “*the act of saving or state of being saved from the power of evil, the act of*

⁸ Transcript, page 25.

⁹ Paragraph 5.

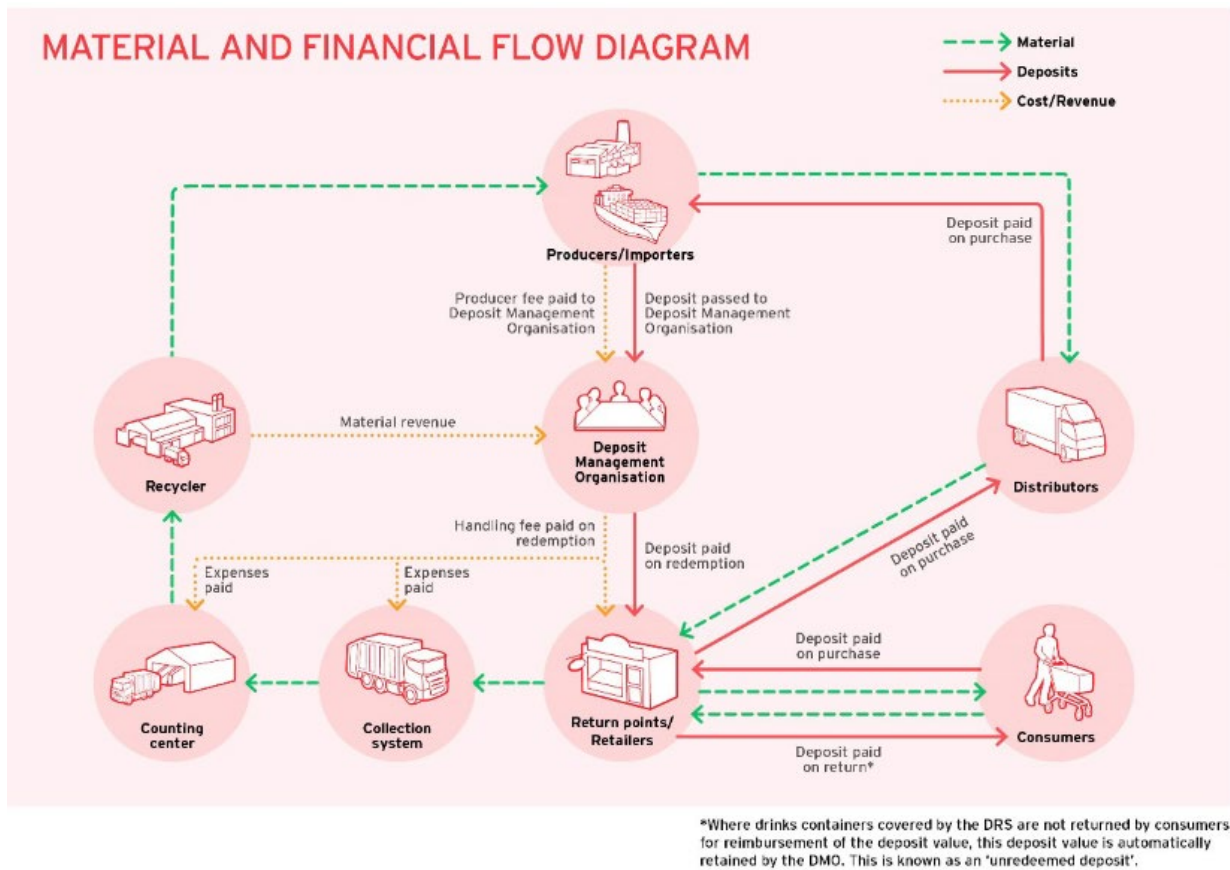
¹⁰ Counterstatement, paragraph 5.

redeeming”, “an act of redeeming or atoning for a fault or mistake or the state of being redeemed, deliverance from evil; or sin; salvation” and, from the *Cambridge Online Dictionary*, “redeem – improve – to make someone or something seem less bad for example a ‘poor game was redeemed in the second half by superb performance from Anthony Edwards’.”¹¹ She criticised the applicant for submitting a US definition from the *Merriam Webster Dictionary* during the evidence rounds. As will have been seen, the proprietor included definitions from a UK dictionary in its statement of grounds.

28. I agree that the words “redeem” and “redemption” have multiple meanings. Indeed, they may have all the meanings cited in the two paragraphs above. In the context of the goods and services at issue, I find that “redemption” would be understood to refer to the exchange of goods to be recycled for something of value, such as a deposit where that has been paid, and that a “redemption centre” would be a place or facility where this exchange occurs. I have made this finding on the basis of the dictionary definitions and how “redemption” and “redeem” are used in the evidence which is directed towards the relevant industry sector. As an example, the consultation paper produced by the relevant government departments for England, Wales and Northern Ireland uses the verb “redeem” (in its various forms) to refer to the process of getting back the deposit the customer has paid when purchasing a drink covered by a deposit refund scheme, as shown in the centre of the diagram below:¹²

¹¹ Registered proprietor’s skeleton argument, paragraph 29.

¹² Exhibit AM5, page 86.



29. Mr Engström also uses the word in this context in his witness statement (the emphasis is mine):

“The main products [of my company] are reverse vending machines (or RVMs) – a critical infrastructure and machine that automatically recognizes, sorts and compacts redeemed beverage containers in a deposit return scheme (DRS).”¹³

30. I bear in mind that “redemption centre” is a term used in other English-speaking jurisdictions and take note of Ms McFarland’s submissions that such use was not relevant when considering how the UK public would view the marks. While I accept that there are differences between British English and American English, it seems to me that, particularly where a concept does not exist in the UK on any substantial scale, that an American English term may well be one that is used to describe it. As with

¹³ Paragraph 7.

“oven chips”, I believe that in the context the relevant public would understand what the term means.

31. I shall now consider whether the mark “redemption centre” is descriptive of the goods and services for which the marks are registered. The Class 7 goods are *Recycling machines; bottle deposit machines; machines for depositing recyclable bottles and containers; automated machines for identifying, sorting, collecting and processing containers and plastic; part and fittings for all the aforesaid*. All these terms would include the reverse vending machines that are used in deposit refund schemes and would allow a member of the public to redeem the deposit paid on a bottle or other container and would constitute, or be found in, a centre that enabled this activity to take place. Consequently, I find that the mark is descriptive of the Class 7 goods.

32. The services in Class 36 are *Refund and money-back schemes relating to recycling of bottles and containers; refund and money-back schemes relating to recycling of goods; provision of information, consultancy and advice relating to the aforesaid*. I have already noted that the possible meanings of “redemption” include the getting back of money. It is settled case law that it is irrelevant whether there are more usual ways of describing the services (such as “money back scheme”). In my view, “redemption centre” could be used to describe the place where the consumer takes advantage of such schemes, and so I find that the mark is descriptive of the Class 36 services.

33. The services in Class 40 are *Recycling services; provision of facilities for recycling of bottles, containers and goods; provision of recycling centres; provision of facilities for the deposit of used or empty bottles and containers for the purpose of recycling and redemption; provision of information, consultancy and advice relating to the aforesaid*. Mr Conway considered that it was significant that the Class 40 specification actually includes the word “redemption”. I agree. “Redemption centres” would, in my view, describe the facilities that have been provided for the purposes of recycling and, in particular, redemption. The terms *Recycling services; provision of facilities for recycling of bottles, containers and goods; provision of recycling centres* are broader terms that would include the provision of facilities that could be described as

“redemption centres”. I find that the word marks are descriptive of the Class 40 services.

34. The word marks are *prima facie* excluded from registration by section 3(1)(c) of the Act.

35. I shall now move on to consider the series of figurative marks. While I have found that the verbal element of the mark is descriptive, that does not automatically mean that I must find that the whole mark offends against section 3(1)(c). Mr Conway submitted that the device is a pictogram showing a bottle with a circular arrow commonly used to symbolise recycling and hence descriptive. He quoted from the Practice Guidelines of the European Union Intellectual Property Office:

“Pictograms are basic and unornamented signs and symbols that will be interpreted as having purely informational or instructional value in relation to the goods or services concerned. Examples would be signs that indicate mode of use (like a picture of a telephone in relation to pizza delivery services) or that convey a universally understandable message (like a knife and fork in relation to the provision of food). Commonly used pictograms, for example, a white ‘P’ on a blue background to designate a parking place ... or the design of an ice cream to designate that ice cream is sold in the vicinity, are not distinctive in relation to the goods or services in respect of which they are used. Moreover, if the pictogram immediately conveys information about the kind, quality, intended purpose or other characteristics of the goods or services, it will also be objectionable.”¹⁴

36. Ms McFarland submitted that the device would not necessarily be seen as a bottle and the public might think it was, for example, a skittle. I disagree. The bottle shares several features with examples adduced by the applicant in Exhibit AM6. There is a rectangular block on top of a narrowing neck. I believe the public will see this as depicting a bottle top. The slightly scalloped base also appears in a number of

¹⁴ Applicant’s skeleton argument, paragraph 19.

examples in this exhibit. In the context of the goods and services, I consider that the circular arrow will be interpreted as a reference to recycling.

37. In her skeleton argument, Ms McFarland said that she would invite me to be mindful of what the evidence shows, and what it fails to show. She reminded me of *“the pitfalls which occur when evaluative assessment is to be undertaken fairly and objectively, without the guiding assistance of relevant and supportive evidence”*¹⁵ and referred me to the decisions of the Appointed Persons in *O2 Holdings Limited Trade Mark Application*, BL O-078-11, and *ELVIS JUICE*, BL O-048-18. As the latter case had been considered recently by Mr Iain Purvis QC, sitting as the Appointed Person, in *HARLEY Trade Marks*, BL O/168/22, I informed the parties before the hearing that I would be interested in their views in the light of this later decision.

38. In *HARLEY*, Mr Purvis had drawn a distinction between facts and legal evaluation based on the facts and made several comments on the use of judicial notice. Mr Conway distinguished these cases from the present proceedings, which concerned words that could be found in the dictionary, and in such circumstances, he submitted, it was a legal evaluation, or, as he put it, *“a judicial conclusion”*, that the average consumer would ascribe a particular meaning to those words, taking into account the context in which they were used.¹⁶ Ms McFarland considered that *HARLEY* fortified the thrust of the *ELVIS JUICE* case, that there needs to be rigour and the decision taker should not jump to conclusions that are not supported by the evidence. Her submission was, in short, that:

“... one has to be cautious and approach matters with a rigour and in relation to each element of the statutory framework ask the question, ‘Have I been given enough information upon which to make this finding?’”¹⁷

39. I accept that the images in Exhibit AM6 are undated. However, I note that bottles and arrows may be used to indicate bottle recycling. As I have already noted, what is important is not whether the mark has been used descriptively, but whether it could

¹⁵ Paragraph 42.

¹⁶ Transcript, pages 4-5.

¹⁷ Transcript, page 27.

be. I agree with Ms McFarland that the bottles have different shapes and that they are in different positions. However, I consider that they are still all identifiable as bottles, as is the central element of the figurative marks. The tribunal routinely comes to a judicial conclusion on how devices will be interpreted by the relevant public. In the context of the goods and services at issue, it is my view that the public will believe that the device denotes that the goods and services are to be used for recycling bottles and hence would be descriptive.

40. The figurative marks are *prima facie* excluded from registration by section 3(1)(c) of the Act.

41. The proprietor has not claimed that the contested marks have acquired distinctive character and so the applications for invalidity succeed under section 3(1)(c) of the Act.

Section 3(1)(b)

42. As I have found that the marks are descriptive under section 3(1)(c), they lack distinctive character under section 3(1)(b).

OUTCOME

43. The applications for invalidity have succeeded and UKTM registrations nos. 33803030 and 3352739 will, subject to any successful appeal, be declared invalid.

COSTS

44. The applicant has been successful in these proceedings and is entitled to a contribution towards its costs in line with the scale set out in Tribunal Practice Notice 2/2016. The award is calculated as follows:

Preparing statements and considering the other side's statements: £400

Preparing evidence and considering the other side's evidence: £800

Preparing for and attending the hearing: £1000

Official fees: £400

TOTAL: £2600

45. I therefore order Redemption Centres Ltd to pay Tomra Systems ASA the sum of £2600, which 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 20th day of December 2022

**Clare Boucher,
For the Registrar,
Comptroller-General**