

O-275-19

**TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION NO 3300129  
IN THE NAME OF TWG TEA COMPANY PTE LTD  
TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 30:**



**Background**

1. On 28 March 2018, the applicant, TWG TEA COMPANY PTE LTD, applied to register the above trade mark for the following goods:

*Class 30: Tea; black tea [English tea]; flavourings of tea; tea-based beverages; fruit flavoured tea; fruit tea; beverages with tea base; rooibos tea; herbal tea; chai tea; green tea; Japanese green tea; oolong tea (Chinese tea); aromatic teas; beverages made of tea; iced tea; tea bags; tea extracts; tea essence; tea for infusions; spices; sugar; chocolates; chocolate bars; pralines; edible ices; ice cream; sorbets (ices); ice desserts, confectionery; cakes, pastry; macaroons (pastry); pastries; biscuits; cookies, aromatic preparations for pastries.*

2. On 16 April 2018, the Intellectual Property Office ('IPO') issued an examination report in response to the application. The examination report contained an objection under Sections 3(1)(b) and (c) of the Trade Marks Act 1994 ('the Act').
3. The objection was raised on the basis that the mark consisted exclusively of a sign which may serve in trade to designate the kind of goods, i.e. goods being Golden Earl Grey tea or flavoured with Golden Earl Grey tea. The examination report stated that Golden Earl Grey is an Earl Grey tea blend, and the image (logo) contained within the mark merely reinforces the descriptiveness of the words. The examination report argued that the words permeate the mark to such a degree that the non-verbal elements are rendered incapable of enabling the whole sign to perform the function of a trade mark. The examination report included three exhibits, which were intended to demonstrate that Golden Earl Grey is, in fact, a kind of tea.
4. On 15 June 2018, the applicant responded, requesting a Hearing to discuss the objections raised. A Hearing was subsequently scheduled for 16 August 2018.
5. The Hearing was conducted on 16 August 2018 with myself, Mr Dafydd Collins. The applicant was represented by Mr Ian Bartlett of Beck Greener. At the Hearing, Mr

Bartlett referred me to the Office's decision in relation to the word only sign GOLDEN EARL GREY (UK TM 3228487), and explained that although the mark was ultimately withdrawn, this should not be interpreted as the applicant conceding the prima facie objection. At the Hearing I acknowledged Mr Bartlett's position, however, I supported the view of the Hearing Officer, Ms Bridget Rees, who concluded that the mark (consisting exclusively of the words Golden Earl Grey) would merely be perceived by consumers to designate that the goods are, or contain, Earl Grey which is golden in colour. The Hearing of 16 August 2018 then proceeded on the basis that the acceptability of the current application (3300129) rested only on the distinctiveness or otherwise, of the figurative elements contained within the sign.

6. Mr Bartlett argued that the sign applied for would cover the entire cannister/box the goods would be packaged in. The figurative element would therefore be sufficiently large in size to make a substantial impact on the consumer. Mr Bartlett submitted that the unique typeface (which is not readily available on Word), with "spike-like" elongations on the middle letters, as well as the shadowing and three-dimensionality of the words, are more than merely trivial elements, as they play their part in creating an exotic feel. Further, he submitted the pale, acid yellow colour of the background permeates through the perforated letters adding distinctive character. In addition, Mr Bartlett stated that the leaves themselves, which consist of four specific colours, are also intentionally perforated, allowing the pale, acid yellow colour to be further seen, and adding additional distinctive character to the mark.
7. During the Hearing, I referred Mr Bartlett to the decision of the Hearing Officer, Mr Edward Smith, in relation to UK TM 3288539:



8. The reason I identified it as being relevant to the Hearing was because the above mark was also a figurative application, made by the same applicant, containing words found to be descriptive and non-distinctive, whilst also containing figurative elements which had been argued to be insufficiently distinctive. Mr Smith had concluded in his case that the descriptive word elements contained within the sign "speak 'loud and clear' to drown out or permeate all other elements in the mark. Consequently, what is conveyed, as a totality, is an 'origin neutral' message, rather than an 'origin specific' one".
9. I deferred the decision of the Hearing of 16 August 2018 in order to revisit the findings of both Ms Rees in 3228487 and Mr Smith in 3288539, and to ensure my position was both consistent with theirs and more importantly, consistent with well established legal principles. I also wished to review the current application in light of *The Flying Scotsman* decision, BL O/313/11, which is a well-known expression of the relevant legal principles, as well as any other relevant cases which I shall mention below.
10. Having deferred the decision, the finalised Hearing Report concluded that the objection against the application should remain on the basis of Section 3(1)(b) only. The Section 3(1)(c) objection was waived following review of the judgment by Richard Arnold Q.C, sitting as deputy High Court Judge, in *SPAMBUSTER* (see [2005] EWHC 13 (Ch). This judgment found that although adding stylisation to the descriptive word *SPAMBUSTER* did not remove a potential descriptiveness objection under Section 3(1)(c), the addition of separate figurative elements would result in an objection under section 3(1)(b) only.

The hypothetical figurative elements suggested in the *SPAMBUSTER* judgment, which were deemed sufficient enough to reduce an objection from a 3(1)(c) and (b) to a 3(1)(b) only, were an exclamation mark and an oval surround. In the Hearing Report for 3300129 I identified that the figurative elements in the application consisted of more than an exclamation mark and oval surround, and that the sign was clearly more than a stylised word. With this in mind I identified that the Section 3(1)(c) objection was not appropriate, however, I nevertheless found the Section 3(1)(b) objection to stand.

11. The applicant was provided a period of two months in order to submit evidence of acquired distinctiveness with the purpose of overcoming the objection, as this opportunity had been afforded in the other two referred to decisions.
12. An extension of time to file evidence of acquired distinctiveness was requested and granted, until 22 November 2018. However, evidence was not received, and so the application was formally refused on 18 December 2018.
13. The applicant requested a statement of grounds on 18 January 2019.

## Decision

14. The relevant parts of section 3 of the Act read as follows:

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

*(a) ...*

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

### **The relevant legal principles - Section 3(1)(b)**

15. The Court of Justice of the European Union ('CJEU') has repeatedly emphasised the need to interpret the grounds of refusal of registration listed in Article 3(1) and Article 7(1), the equivalent provision in Council Regulation 40/94 of 20 December 1993 on the Community Trade Mark, in the light of the general interest underlying each of them (*Bio ID v OHIM*, C-37/03P paragraph 59 and the case law cited there and, more recently, *Celltech R&D Ltd v OHIM*, C-273/05P).
16. The general interest to be taken into account in each case must reflect different considerations according to the ground for refusal in question. In relation to section 3(1)(b) (and the equivalent provision referred to above) the Court has held that "...the public interest... is, manifestly, indissociable from the essential function of a trade mark", *SAT.1 SatellitenFernsehen GmbH v OHIM*, C-329/02P. The essential function thus referred to is that of guaranteeing the identity of the origin of the goods or services offered under the mark to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin (see paragraph 23 of the above-mentioned judgement). Marks which are devoid of distinctive character are incapable of fulfilling that essential function.
17. Section 3(1)(b) must include within its scope those marks which, whilst not designating a characteristic of the relevant goods and services (i.e. not being necessarily descriptive), will nonetheless fail to serve the essential function of a trade mark in that they will be incapable of designating origin. In terms of assessing distinctiveness under

section 3(1)(b), the ECJ provided guidance in *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (Postkantoor) C-363/99) where, at paragraph 34, it stated:

*A trade mark's distinctiveness within the meaning of Article 3(1)(b) of the Directive must be assessed, first, by reference to those goods or services and, second, by reference to the perception of the relevant public, which consists of average consumers of the goods or services in question, who are reasonably well informed and reasonably observant and circumspect (see inter alia Joined Cases C-53/01 to 55/01 Linde and Others [2003] ECR I- 3161, paragraph 41, and C-104/01 Libertel [2003] ECR I-3793, paragraphs 46 and 75).*

18. This establishes the principle that the question of a mark being devoid of any distinctive character is answered by reference firstly, to the goods and services applied for, and secondly, to the perception of the average consumer for those goods or services. In this regard, the relevant consumer must be identified as being the average consumer in general, as the goods applied for an inexpensive, every day, non-specialist items. The level of attention possessed by the purchasing public during the process of purchase will be moderate, and that of someone who is reasonably observant and circumspect, and nothing more.
19. One must also be aware that the test of distinctive character is one of immediacy or first impression, as confirmed by the European Court of First Instance (now the General Court) which, in its decision on *Sykes Enterprises v OHIM*, T-130/01 (Real People Real Solutions), stated the following:

*...a sign which fulfils functions other than that of a trade mark is only distinctive for the purposes of Article 7(1)(b) of Regulation No 40/94 if it may be perceived immediately as an indication of the commercial origin of the goods or services in question, so as to enable the relevant public to distinguish, without any possibility of confusion, the goods or services of the owner of the mark from those of a different commercial origin.*

### **Application of legal principles - Section 3(1)(b)**

#### **The Word Element 'GOLDEN EARL GREY'**

20. For the purposes of completeness and clarity, I confirm that the words contained within the mark do not, in themselves, possess any distinctive character. I am of the opinion that the words 'Golden Earl Grey' would merely be perceived by the consumer as designating that the goods are, or contain, Golden Earl Grey. This will apply to the tea products directly, and will also pertain to edible and potable goods containing or flavoured by a Golden Earl Grey tea. This is in line with the decision of 9 November 2017, by the Hearing Officer Ms Rees, in relation to the word mark GOLDEN EARL GREY (UK TM 3228487).
21. In confirming the decision of Ms Rees, I have also taken into account the finding of Mr Phillip Johnson, acting as the Appointed Person, in O/358/17. Mr Johnson oversaw an appeal of five decisions by the Registrar, including two in relation to the word marks 'PARIS BREAKFAST TEA', and 'RUSSIAN BREAKFAST TEA'. Mr Johnson said that the Hearing Officer's finding that the terms would be considered merely descriptive of a flavour of tea was coherent and logical. In coming to this conclusion, Mr Johnson referred to Wadlow, *The Law of Passing Off* (5<sup>th</sup> Ed, Sweet and Maxwell 2016):

*A trader who introduces goods or services which are novel enough for the English language not already to have a word to describe them does so at his own risk if he fails to provide the public with a suitable generic term for identifying the new goods or services without implicitly referring to their source.*

Mr Johnson applied this statement to a new blend of tea in paragraph 45 of O/358/17:

*These statements apply equally when somebody introduces a new blend of tea. If consumers consider the name of the blend to be PARIS (or Russian) BREAKFAST TEA then they are using those phrases descriptively and so cannot generate goodwill for [the applicant] TWG.*

In this paragraph, Mr Johnson is clearly explaining that ‘goodwill’ cannot arise from terms which are used and would appear to be used, in a plainly descriptive sense. The key question is one of interpretation. If the consumer considers a mark to be descriptive of a blend of tea, regardless of whether or not the applicant devised that term and irrespective of whether a descriptive impression was not their intention, then the name/mark cannot be considered distinctive.

22. This clearly puts the onus of the perception of trade origin in the hands of the consumer, regardless of the intention of the applicant: if the consumer assumes a term is describing a new product, then the mark cannot function as a badge of origin.
23. Whilst I acknowledge that Mr Bartlett wished to place on record the fact that the applicant did not concede the Section 3(1)(c) objection in relation to GOLDEN EARL GREY (UK TM 3228487), which was nonetheless ultimately withdrawn following a failure to provide evidence of acquired distinctiveness, I conclude the correct decision was made in that instance. The same conclusion in relation to that wording takes effect on this case in so far as they share the same words.
24. Considering the fact that the relevant consumer *could* consider the wording to be descriptive at this moment, or *may* consider the wording to be descriptive in the future, an objection would be required for the words themselves under Section 3(1)(c) of the Act, which stipulates a sign shall not be registered if it *may* serve in trade to designate a characteristic. With this in mind, I conclude that the term ‘Golden Earl Grey’ is purely descriptive of a characteristic of the goods from the perspective of the relevant consumer. I wish to point out that I do not think it is necessary to visit again the exhibits relied upon by the examiner in the original examination report to demonstrate that ‘Golden Earl Grey’ is a descriptive term.

### **The Effect of the Figurative Elements**

25. Although I have found the words contained within the mark to be descriptive, I have previously referred to the *SPAMBUSTER* judgment, and found a Section 3(1)(c) objection to be inappropriate. It is quite evident, therefore, that the acceptability of the sign applied for will rely on the impact the sign’s figurative elements may or may not have in creating an overall distinctive impression as a whole in relation to otherwise non-distinctive terms.
26. At the Hearing of 16 August 2018, Mr Bartlett described in detail the figurative elements of the sign. Mr Bartlett explained that the font used was not a standard version and was unique to the applicant. Mr Bartlett went on to describe the uniqueness of the stylized lettering, arguing that the letters extend upwards, with “spike-like” additions to the middle of each letter. In addition, the letters contain both shadowing and three-

dimensionality. Overall, the formation of the letters is curved, which gives the presentation of the words an “exotic feel”, and which cannot be considered to be merely trivial. Mr Bartlett also explained that the letters and leaves were intentionally and deliberately perforated in order to allow the pale, “acid yellow” background to show through. Finally, Mr Bartlett argued that the leaves containing four different colours makes them unique and ultimately distinctive.

27. It may well be true that the applicant designed the perforated leaves to allow the “acid yellow” background to shine through, and it may also be likely that the font used is unique and specifically created by the applicant. However, the decision on whether or not such details create distinctiveness lies not in the efforts of the applicant, but in the recognition of the consumer. It is well established in case-law that distinctiveness of a sign must be assessed, first, by reference to the goods or services in respect of which registration is sought and, second, by reference to the perception of the relevant public (see C-53/01 P, *Linde*, para 41, C-363/99, *Koninklijke KPN Nederland NV*, para 34, Joined Cases C-468/01 P to C-472/01 P, *Proctor & Gamble*, para 33). As detailed as Mr Bartlett’s analysis of the figurative elements is, the question is whether or not the purchaser of everyday inexpensive items, such as tea and confectionary, who is considered to be reasonably observant and circumspect and nothing more, will notice such minute details and will consider them to be sufficiently distinctive to the point of functioning as indicators of trade origin.
28. It is also well established in case-law that the test of distinctive character is one of immediacy or first impression, as confirmed in *Sykes Enterprises v OHIM*, T-130/01 (Real People Real Solutions). As I have explained so far in the decision, I find the verbal elements contained within the mark to contain descriptive information about the kind of goods. I will go further and say that despite the figurativeness of the lettering, the relevant public will perceive, first and foremost, purely descriptive information about the goods, rather than receive any indication as to the commercial origin of the goods
29. In addition, I am not convinced that during the purchasing process of such inexpensive everyday goods as those applied for, the level of attention of the average consumer will be so attuned to the minor details of the perforated leaves etc., that upon first impression they will notice those minor details within the mark as a whole. I do not believe the minor details will contribute to the overall impression of the mark to the extent that it will unequivocally be viewed as an identifier of trade origin.
30. As I have previously explained, I do not imagine the consumer will dissect the figurative intricacies of the mark to the extent that Mr Bartlett did at the Hearing. I am of the opinion that when faced with the mark applied for, the perceptions and recollections of the average consumer in relation to the mark as a whole, and absent education, will be origin neutral as opposed to origin specific.
31. Whilst making my decision, I have considered the analysis of Mr Geoffrey Hobbs, acting as Appointed Person in the BL O-205/04, *Quick Wash Action*. I consider it to apply the current application, in so far as the verbal elements of the mark speak loud and clear, and convey an origin neutral message. Whilst I acknowledge the addition of the figurative elements, notably a figurative tea-leaf, I believe Mr Hobbs’ wording in the ‘Quick Wash Action’ case perfectly aligns to the tea-leaf in the current application, in so far as the “artistic impression [of the tea-leaf] neatly and skilfully builds upon and reinforces the origin neutral message in a way that makes it even more effective than the words alone might. I think that the net result is a well-executed, artistically pleasing, origin neutral device”.

32. In coming to my decision, I have also considered another of Mr Hobbs' decisions acting as Appointed Person, this time in *The Flying Scotsman* BL O/313/11. In that decision, Mr Hobbs was of the opinion that the figurative representation of the locomotive possessed enough artistry and creative impression that it would be seen as alluding emblematically to the content and character of the goods concerned. He continued that the words did not speak louder than the non-verbal element. I do not consider the same to apply in relation to the current application. Rather, I am of the opinion that the figurative element is non-distinctive, and is insufficient to create a distinctive totality.
33. Whilst conducting my assessment, it is of course essential to ensure that the trade mark is not divided into its constituent parts of verbal and figurative elements, but rather an assessment of the mark's capacity to function as an indicator of trade origin is made of the sign as a whole. Although I have evaluated both the verbal and figurative elements separately, I have also assessed the mark as a whole. In doing so I have come to the conclusion that the combination of non-distinctive words and non-distinctive figurative elements does not create an impression which is sufficiently far removed from that produced by the combination of those elements, and does not create a result which is more than the sum of its parts (see judgment C-265/00 *Biomild*, para 40).
34. In addition, whilst not referred to at the hearing, I believe that my finding is also in accordance with the 'Common Communication on the Common Practice of Distinctiveness – Figurative Marks Containing Descriptive/Non-Distinctive Words, of 2 October 2015' (please see the UKIPO website at <https://www.gov.uk/government/publications/common-practice-on-distinctiveness-figurative-marks-containing-descriptive-non-distinctive-words>). In this Common Practice notice, a subject was covered which is directly relevant to the current application. The subject I refer to is that which explains that a figurative mark which contains both descriptive words and figurative elements, which are themselves either a direct representation or have a direct link to the goods applied for, are ultimately objectionable. Such a judgement applies directly to the current application as the words are descriptive and the figurative element is a tea-leaf, and therefore a direct link to the goods applied for. Regardless of the delicacy of the artistic details, the figurative element will be considered, first and foremost, as a representation of the content of the goods.
35. In coming to my conclusion, I have assessed the meaning of the words, as well as the consumer's perception of the figurative elements, and I have analysed the overall impression of the mark as a whole. Whilst I have dissected the mark to discuss its constituent parts, my assessment of its ability to function as an indicator of origin has focused, in its ultimate conclusion, on the complete representation. In doing so I have waived the Section 3(1)(c) objection. However, I find the Section 3(1)(b) objection to remain relevant.
36. Despite Mr Bartlett's submissions as to the distinctiveness of the figurative elements, I have found that in the majority of instances the intricacies will be overlooked by the relevant consumer, and the immediate impression of the sign is that of indicating the products are either flavoured with or are themselves Golden Earl Grey tea.

## **Conclusion**

37. Having given due care and attention to all arguments put forward in the proceedings, the application is rejected for all the goods applied for because it fails to qualify under section 3(1)(b) of the Act.

Dated this 21<sup>st</sup> day of May 2019

Dafydd Collins  
Acting for the Registrar, the Comptroller General