

O/0588/26

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. UK00901199876

IN THE NAME OF SCHYLLING INC.

FOR THE FOLLOWING TRADE MARK:

LAVA

IN CLASS 11

AND AN APPLICATION FOR A DECLARATION OF INVALIDITY

UNDER NO. 507597

BY THE GLOW COMPANY UK LTD

BACKGROUND AND PLEADINGS

1. Schylling Inc. (“the proprietor”) is the owner of the UK trade mark shown on the cover page of this decision. The contested mark was filed on 9 June 1999 and registered on 11 December 2000. It stands registered for the following goods:

Class 11 Ornamental novelty lamps; electrical novelty lighting fixtures.

2. On 26 July 2024, The Glow Company UK Limited (“the applicant”) applied to invalidate the contested mark based upon sections 47 and 3(1)(d) of the Trade Marks Act 1994 (“the Act”). The applicant claims that, at the time of filing the contested mark, the sign (LAVA) was commonly used in the trade in relation to the goods in issue. The applicant claims that the term was coined in the 1960s and since that time has been the name for a particular type of lamp. As such, the applicant claims that the relevant public would not attach any trade mark significance to the word LAVA and the contested mark should be invalidated.

3. The proprietor filed a counterstatement denying that the contested mark is invalid.

4. Neither party requested a hearing, but both filed written submissions in lieu. This decision is taken following a careful consideration of the papers filed.

REPRESENTATION

5. The proprietor is represented by Mathys & Squire LLP.

6. The applicant is represented by HGF Limited.

EVIDENCE AND SUBMISSIONS

7. The applicant filed evidence in chief in the form of the witness statement of Jim Cameron dated 6 December 2024, which is accompanied by 8 exhibits (JC1 to JC8). Mr Cameron is the Managing Director of the applicant, a position he has held for 22 years.

8. The proprietor filed evidence in the form of the witness statement of Paul Weingard dated 3 April 2025, which is accompanied by 19 exhibits (PW1 to PW19). Mr Weingard is the CEO of the proprietor, a position he has held since August 2014.

9. The applicant did not file evidence in reply.

10. Both parties filed written submissions in lieu on 16 June 2025.

RELEVANCE OF EU LAW

11. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

DECISION

Preliminary issues

Expert evidence

12. Exhibit JC9 is a witness statement by Dr Matt Hunt Gardener, a lecturer in sociolinguistics at Queen Mary University. He states that he has given the statement to “provide an expert’s analysis of the status of the word lava lamp”. As noted by the proprietor, if the applicant sought to adduce expert evidence, it should have sought permission of the Tribunal to do so. However, in any event, the assessment that I must undertake is from perspective of the average consumer and so the views of an expert in the field of sociolinguistics as to the meaning and relevance of the word LAVA are irrelevant.

Conduct of the applicant

13. The proprietor has filed evidence and submissions relating to the prior relationship between the applicant and the proprietor. In its written submissions, the proprietor states that the application “is being pursued in a manner which is inconsistent with honest business practices”. For the avoidance of doubt, the intentions of the parties in bringing/defending the proceedings are not relevant to my assessment, which is confined to the criteria set out in the relevant statutory provisions and case law. Consequently, I do not need to consider this line of argument any further.

Statutory provisions and case law

14. Section 3(1)(d) of the Act states as follows:

“(1) The following shall not be registered –

[...]

(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.”

15. Section 3(1) has application in invalidation proceedings by virtue of section 47 of the Act, which states:

“47(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.

[...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made.

Provided that this shall not affect transactions past and closed.”

16. In *Telefon & Buch Verlagsgesellschaft GmbH v OHIM*, Case T-322/03, the General Court summarised the case law of the Court of Justice under the equivalent of s.3(1)(d) of the Act, as follows:

“49. Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma* (BSS) [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public’s perception of the mark (BSS, paragraph 37).

50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably

observant and circumspect, is presumed to have in respect of the type of goods in question (*BSS*, paragraph 38).

51. Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and *BSS*, paragraph 39).

52. Finally, signs or indications constituting a trade mark which have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not therefore fulfil the essential function of a trade mark (see, by analogy, *Merz & Krell*, paragraph 37, and *BSS*, paragraph 40)."

17. The enquiry under section 3(1)(d) is not whether the mark is descriptive of a characteristic of the goods, although that could also apply to a mark which falls foul of section 3(1)(d). It is whether the mark was customary in the current language or was customary in the bona fide and established practices of the trade in the UK (i.e. where the trade means the contested goods) at the date of application. Proving this requires the filing of evidence of fact supporting the claim that it was customary for traders to use the mark at the relevant date, but not in a trade mark sense.¹ There is a relatively high evidential burden: in *Affinity Leasing Limited v Total Motion Limited*, Mr Daniel Alexander QC, sitting as the Appointed Person reviewed the authorities and concluded that the overall message was that section 3(1)(d) "requires specific evidence that it is specifically customary."²

18. I need to make the assessment taking into account the expectations of the relevant public in deciding whether, at the date of the application, the mark had become

¹ *Nude Brands Ltd v Stella McCartney Ltd* [2009] EWHC 2154 Ch.

² BL O/522/20

“customary in the current language or in the bona fide and established practices of the trade”. Although where intermediaries influence decisions to purchase goods their views should be taken into account, in the present case, the average consumer for the contested goods is largely the general public, and it is their views which are likely to be of decisive importance.³

19. In *Stash Ltd v Samurai Sportswear Ltd*, Professor Annand, sitting as the Appointed Person, stated that it was sufficient if a mark offended either limb of section 3(1)(d).⁴ That is to say, that (at the relevant date) the mark had become customary (a) “in the current language”, or (b) “in the bona fide and established practices of the trade”. The words ‘of the trade’ should not be construed as applying to both limbs. Basing herself on the Oxford English Reference Dictionary, 1995, Professor Annand took “customary” (in the language) to mean “usual; in accordance with custom”.

The relevant date

20. The relevant date for the purposes of my assessment is the filing date of the contested mark, i.e. 9 June 1999.

The evidence

21. The parties agree that the product sold by the proprietor and its predecessors (an ornamental lamp with colourful wax inside which moves up and down) was created in the 1960s. I do not understand it to be in dispute that the creator of the product was an individual called Edward Craven Walker. Mr Cameron explains this as follows:

“The concept of a lava lamp was invented in 1960s by a man named Edward Craven Walker. The first lava lamp was branded Astro Lamp and originally sold by Crestworth, then changed to Mathmos, a company founded by Edward Craven.”

³ CJEU, Case C-371/02 *Björnekulla Fruktindustrier AB v Procordia Food AB*, paragraphs 24 and 25.

⁴ BL O/281/04

22. The applicant has filed evidence of dictionary definitions of “lava lamp” as follows:⁵

“a decorative type of lamp in which a luminous viscous material moves in constantly changing shapes.”

Collins Dictionary

“a decorative electric lamp in which a brightly coloured amount of wax moves up and down a container full of transparent liquid, forming new shapes as it does so.”

Cambridge Dictionary

“(A proprietary name for) an ornamental electric lamp which consists of a transparent (esp. conical or cylindrical) chamber containing a viscous liquid in which a brightly coloured substance is suspended, rising and sinking in irregular and constantly changing shapes as a result of the heat emitted from the bulb below.”

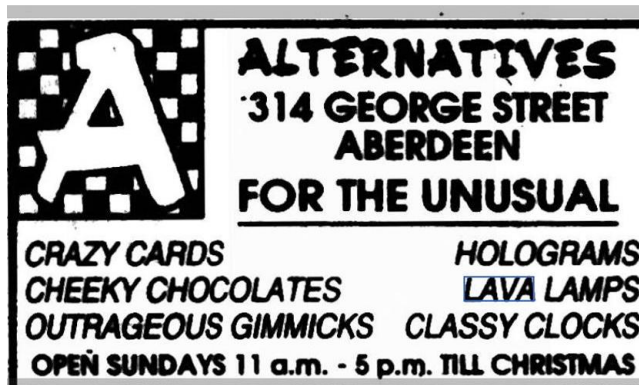
Oxford English Dictionary

23. The first two of these definitions assist the applicant, as they confirm that a “lava lamp” is a type of lamp. However, the third of these states that it is a proprietary reference, which supports the proprietor. In any event, it is important to bear in mind that these definitions deal with the current position (they are contemporaneous with the witness statement); however, the assessment that I must undertake relates to the position as at the relevant date (9 June 1999). I, therefore, find that these definitions are of limited assistance, as the position may have been entirely different some 20 years earlier.

24. There are examples of businesses other than the proprietor using the word LAVA prior to the relevant date. I note that some of these are from businesses which appear to have been using it with the proprietor’s consent. For example, there are references in exhibit JC5 to The Gadget Shop selling lava lamps, but an article from *The Independent* dated 10 April 1999 confirms that the proprietor supplied these goods to

⁵ Exhibits JC3 and JC4

The Gadget Shop. That is not necessarily problematic for the applicant because if the use by those authorised retailers was also generic then that could still support the applicant's case. That being said, there are plenty of examples of businesses that there is no suggestion have any connection to the proprietor using the term "lava lamp" to describe their products:⁶



Date: 12 December 1999

Aberdeen Press and Journal



Date: 5 February 1994

Wolverhampton Express and Star



Date: 15 November 1995

Huddersfield Daily Examiner



Date: 10 October 1997

Western Daily Press

⁶ Exhibit JC5

THE NORTH'S BIGGEST RANGE OF

LIGHTING

at LOWEST PRICES!



**EMPIRE-STYLE
CHANDELIER
PENDANT**
£19.99

**Just Arrived!
1960'S STYLE
LAVA LAMP
Special
Purchase!**
£34.99



**WOODEN
CANDLESTICK
TABLE LAMP
& Co-ordinating
Fabric Shade**
£19.99



**3-LIGHT FLUSH
CEILING FITTING
inc. Glass Shades**
£14.99

**Italia
LIGHTING**
Lime St, Lpool 051-709 4323



**5 LT. MARIE THERERE
CRYSTAL CHANDELIER**
£39.99



**3-LT. WOOD/BRASS
CEILING FITTING
inc. Glass Shades**
£19.99

Date: 19 August 1993

Liverpool Echo

STACKS

For that Unique Gift

Lava Lamps

Coloured Glass

Metalwork

Candles + Oils

Jewellery

Collectables

10 The Strand Arcade 01332 344242



Date: 22 November 1996

Evening Telegraph



Date: 3 July 1998

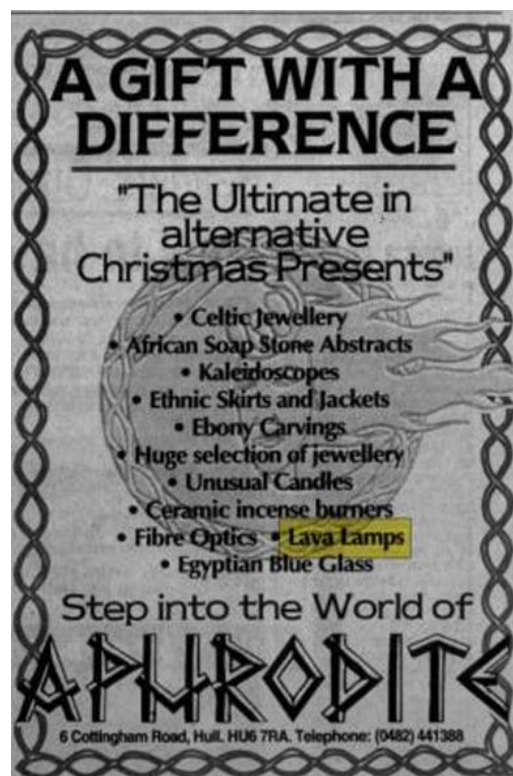
Hammersmith and Shepherds

Bush Gazette



Date: 28 October 1999

Staffordshire Newsletter



Date: 23 November 1993

Hull Daily Mail

25. In all of these examples, the term "lava lamp(s)" can be seen being used along side other descriptors of goods (such as fibre optics or disco lamps). Further, there

are multiple examples of the term LAVA being used by national publications (which are likely to have come to the attention of a significant proportion of the relevant public) in relation to lamps, but not in a trade mark sense. I have listed some examples below:⁷

“We’re not talking Camden market kitsch: lava oil lamps, garish glass ashtrays and floor cushions...”

The Independent, 1 September 1996

“By the time she was allowed into the building weeks after the bomb, her stock of lava lamps and antique clothing had been ruined by debris and rain.”

The Guardian, 13 June 1997

“But its devotees are beginning to grow up, settle down, buy a flat, and naturally they want their homes to look the part – maybe something a bit ironic such as a lava lamp or corduroy bean-bag.”

The Daily Telegraph, 12 September 1998

“Whilst you’re ransacking the very deepest recesses of your closet in search of once-again-trendy nylon shirts, lava lamps and velvet hipsters...”

The Daily Telegraph, 16 September 1997

“And we’re not talking lava lamps and decorative cheese boards.”

Evening Standard, 9 August 1999

“Some of the items remain unclaimed, and I have a choice of a “wine rack” (contains 24 bottles), matching his-and-hers car coats, an infra-red massage wand, a lava lamp, a machine for converting unwanted newspapers into environmentally friendly fuel-briquettes, a pair of secateurs, and three terracotta window-boxes...”

Evening Standard, 11 December 1997

⁷ Exhibit JC5

“Children also need plenty of room to store their collections of CDs, games, books or trophies. For a Seventies touch that will still appeal to the kids, a volcano lava lamp is perfect.”

Sunday Mirror, 3 October 1999

“A fibre optic lamp and two lava lamps add to the psychedelic mood.”

Daily Mirror, 13 March 1999

“There’s something rather touching about the image of the optimistic young baby-boomers of the mid-1960s swanning around the boutiques of London, stocking up on their youthquaking bean bags, space-age coffee tables and hippermost lava lamps.”⁸

The Observer, 5 May 1996

26. I also note that there are multiple examples in the evidence of the term LAVA being used by reference to the proprietor itself. For example:⁹

“The last few years have seen a revival in the fashion for the purely decorative, brightly coloured and futuristic lava lamp. Produced exclusively by British company Mathmos since 1963...”

The Guardian, 10 April 1999

“Along with white lipstick and pea coats, the current Sixties revival has resurrected the “It Girl’s” favourite accessory, the Lava Lamp. If you got rid of your original Astro in an Eighties boot sale, Mathmos has a range of space lamps from the rocket-shaped Lunar to 2ft long sections of Astro Wall. Cool.”

The Guardian, 28 October 1995

“Astro Lava Lamp by Mathmos, a surrealistic snip at only £49.95.”

The Daily Telegraph, 7 June 1997

⁸ This is also supported by an article which refers to LAVA as a “brand”, although this is current and not applicable to the relevant date.

⁹ Exhibit JC5

“REMEMBER Astro lava lamps? New space-age lights from the same manufacturer include: Glitter, £39.95, a colour-changing light filled with moving metal crystals; and Fibre Space, £79.95, a new version of the classic Seventies lamp.

*Mathmos, 179 Drury Lane...”

Evening Standard, 24 September 1996

“We’ve got five ultra-cool *Rat Attack* games and five Mathmos lava lamps to giveaway...”

Daily Mirror, 2 October 1999

27. In my view, the evidence indicates that the word LAVA is being used as a reference to a type of lamp (even if one sold/invented by the proprietor), and not as a trade mark. Whilst I appreciate that in some cases a capital letter is used for the word LAVA (which might be taken to indicate a name), I do not consider that the context in which these words are used are typically proprietary indications. This is particularly the case given that throughout the evidence, references are to LAVA LAMPS, rather than the LAVA LAMP, which suggests that it is a name for a particular type of lamp which falls within that classification, rather than a particular brand attributable to one undertaking. This is reinforced by the examples of advertisements, shown above, which list lava lamps alongside other terms which are customarily used to describe types of lamps (aquarium lamp, disco lamps etc.).

28. I bear in mind that an objection under this ground requires a high bar be met; as the proprietor indicates in its submissions, it is not sufficient to show that the average consumer understands the term in a descriptive sense, it must have become customary.¹⁰ I also bear in mind the proprietor’s submission that the contested mark is the word LAVA (solus) and not LAVA LAMP. The proprietor refers me to a previous decision of this Tribunal in which the hearing officer noted that there was no evidence of the sign “PowerScrub” being used, even though evidence had been filed to show use of terms such as “powered scrubber” and “power scrubbers”.¹¹ That case can be

¹⁰ BL O/522/20

¹¹ BL O/897/21

distinguished from the present case because the evidence of use related to different terms from the contested marks. In the present case, the only point of difference is the addition of the word LAMP which is plainly descriptive/non-distinctive and does not alter the meaning of the word LAVA. To conclude that the use of the word LAVA in combination with the word LAMP could not be relied upon to show customary use of the word LAVA would be akin to finding that use of the term LAPTOP COMPUTER could not be relied upon to show customary use of the term LAPTOP. In my view, nothing turns on this distinction.

29. In my view, taking into account the evidence as a whole, I am satisfied that the word LAVA had become customary in the current language or bona fide and established practices of the trade to designate the relevant goods, as at the relevant date.

30. I am fortified in this finding by an extract from Wikipedia which has been filed by the proprietor. I approach this evidence with due caution given the nature of Wikipedia as an online encyclopedia that can be amended by anyone. However, the accuracy of the statement recorded therein does not appear to be disputed by the proprietor, given that they have themselves relied upon it as evidence. The extract records the owner of the proprietor's predecessor in title as saying:¹²

“When we re-launched the lamps we retained the name “Astro Lamp” but as just the name for the original model. We used the name “Lava Lamp” for the range as it seemed to us that this was the generic name for the products.” (my emphasis)

This statement, therefore, appears to support my finding.

Acquired distinctiveness

31. The Court of Justice of the European Union provided guidance in *Windsurfing Chiemsee*, Joined cases C-108 & C-109/97, about the correct approach with regard

¹² Exhibit PW4

to the assessment of the acquisition of distinctive character through use. The guidance is as follows:

“51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.

52. If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied. However, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data such as predetermined percentages.

53. As regards the method to be used to assess the distinctive character of a mark in respect of which registration is applied for, Community law does not preclude the competent authority, where it has particular difficulty in that connection, from having recourse, under the conditions laid down by its own national law, to an opinion poll as guidance for its judgment (see, to that effect, Case C-210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 37).”

32. In his evidence, Mr Weingard states that:

“I am not aware, nor have I found anything to suggest, that Crestworth Trading Limited or Mathmos Limited [the proprietor’s predecessors in title] ever used the term “LAVA” in relation to their products to any significant degree.”

33. There does not, therefore, appear to be any claim that the contested mark had acquired enhanced distinctiveness by the relevant date. However, if I am satisfied that the contested mark had acquired enhanced distinctiveness by the date of the application for invalidation then this is sufficient to avoid the mark falling foul of section 3(1). It is also important to bear in mind that the relevant market for assessing acquired distinctiveness is the UK market; evidence of use in other jurisdictions is, therefore, irrelevant.

34. Examples of lamps which Mr Weingard states were sold in collaboration with the proprietor have been provided.¹³ There are examples of products sold by the proprietor through retailer Argos, but Mr Weingard expressly states that:¹⁴

“the term ‘LAVA’ or ‘Lava Lamp’ are never used to describe the Products. The Products were called “Wax Movement Lamps”, “Volcano Lamps”, “Motion Lamps”, “Crystal Lamp”, but never “LAVA Lamps”.

Contrary to this, there are, in fact, examples of products being described as “Giant lava glitter lamp – silver” and “Tiffany style giant lava lamp” within that exhibit. However, other than those examples, the word LAVA does not appear at all (as a brand or descriptor). Consequently, whilst sales may have been on a sizeable (and national) scale given the relationship with national retailer Argos, this cannot prove acquired distinctiveness for the contested mark given that it does not appear to have been used in relation to the proprietor’s products in most cases. Similar evidence is given in respect of another retailer, Index.

35. There are some limited examples of the word LAVA appearing in a stylised form on product packaging.¹⁵ The high point of the evidence of use appears to relate to sales made by the proprietor to the applicant. For example, there is evidence that over 31,000 products were sold by the proprietor to the applicant in 2021 alone. There is evidence of the applicant selling products (presumably, some of which are those sourced from the proprietor) where the term ‘lava lamp’ is plainly used as a descriptor

¹³ Exhibit PW12

¹⁴ Exhibit PW13

¹⁵ Exhibit PW17

(such as the Nova lava lamp) but also examples of the term ‘lava’ being used to identify origin (such as LAVA brand lava lamp).¹⁶ No figures are provided which distinguish between the two. I have no evidence as to the amount invested in advertising and promotion in the UK or market share information. Whilst I have no doubt that the term “lava” or, indeed “lava lamp” are likely to be recognised by the relevant public, I do not consider that they would be perceived as indicating origin. Having viewed the proprietor’s evidence as a whole, I find that it is insufficient to establish acquired distinctiveness. I am fortified in this finding by the fact that there is significant doubt regarding whether the proprietor was itself using the mark to indicate origin or descriptively.

CONCLUSION

36. The application for invalidation is successful and, subject to appeal, the application is deemed never to have been made.

COSTS

37. As the applicant has been successful it is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the applicant the sum of **£1,500**, calculated as follows:

Preparing a Notice of invalidation and considering the counterstatement	£300
Preparing evidence and considering the other side’s evidence	£650
Written submissions in lieu	£350
Official fee	£200

¹⁶ Exhibit PW9

Total

£1,500

38. I therefore order Schylling Inc. to pay The Glow Company UK Limited the sum of **£1,500**. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 7th day of July 2026

S WILSON

For the Registrar