

**O/0685/23**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF UK REGISTRATION NO. 3631180**

**IN THE NAME OF AMY COYLE**

**IN RESPECT OF THE FOLLOWING TRADE MARK**

**TEXTURE TILE**

**AND**

**AN APPLICATION FOR A DECLARATION OF THE INVALIDITY**

**THEREOF UNDER NO 504627**

**BY**

**LISSIELOU LTD**

## BACKGROUND AND PLEADINGS

1. Trade mark No. 3631180 shown on the cover page of this decision stands registered in the name of Amy Coyle (“the proprietor”). It was applied for on 23 April 2021 and completed its registration procedure on 12 November 2021. The relevant goods for which it is registered are as follows:

### Class 16

*Letter embossers and stencils for cake decorating.*

### Class 20

*Non-edible decorations, of plastic, for cakes and baked goods.*

### Class 21

*Table ware, bakeware, cookware and containers; baking utensils; cookie cutters; cutters, templates, embossers application pads, and cookware for decorating cakes, baked goods and confectionery; hampers and gift sets containing the aforesaid.*

2. On 10 December 2021, LissieLou Ltd (“the applicant”) filed an application to have this trade mark declared invalid under the provisions of sections 3(1)(b), (c) and (d) of the Trade Marks Act 1994 (“the Act”) which are relevant in invalidation proceedings under section 47 of the Act. The application concerns all the goods for which the mark stands registered.

3. The applicant claims that the words “texture tile” would be understood to mean either a “*tile-shaped object bearing a texture*” or a “*tile-shaped object for embossing texture*” and that “*the term ‘texture tile’ is descriptive of any embosser consisting of a thin piece of durable material for the purpose of producing a surface pattern or design*”. It further claims that all the goods in Classes 16 and 21 are “*embossers or categories of goods that include embossers, or goods which may contain embossers and/or are very closely associated with embossers*”, so that the mark is descriptive of the kind, intended purpose or other characteristics of the goods. It continues:

“Furthermore, non-edible decorations, of plastic, for cakes and baked goods clearly include products which are thin pieces of durable material with a surface that is not smooth, or which bears a pattern, namely ‘texture tiles’, and the Mark is thus descriptive of the goods to which it relates in Class 20.”

4. Consequently, the applicant claims that the mark consists exclusively of a sign that may be used in trade to designate the kind, intended purpose or other characteristics of the goods to which the mark relates and that this was the case at the time of filing of the application for registration, and so the mark was registered in breach of section 3(1)(c) of the Act.

5. Under section 3(1)(b), the applicant claims that *“for at least the above reasons”*, the average consumer would perceive the mark not as a badge of origin uniquely identifying the goods of the proprietor and so it would be devoid of distinctive character.

6. Under section 3(1)(d), the applicant claims that the contested registration consists exclusively of a sign or indication which at the time of filing of the application for registration had become customary in the current language or in the *bona fide* and established practices of the trade, *“at least in respect of embossers for decorating cakes and goods that may be used as non-edible decorations, of plastic, for cakes and baked goods”*.

7. The applicant also claims that, following registration, the contested mark has not acquired distinctive character in relation to the goods for which it is registered.

8. The proprietor filed a defence and counterstatement denying the claims made and putting the applicant to proof of the descriptive use of the term “texture tile”. It accepts that “texture” and “tile” are standard English words with individual meanings, but denies that the term as a whole has an applicable meaning. It also denies the applicant’s claim that the mark has not, after registration, acquired distinctive character. It put the applicant to proof of the alleged widespread use of the term “texture tile”.

## **EVIDENCE AND SUBMISSIONS**

9. The applicant's evidence in chief comes from Henry Scott, who is co-founder and director of LissieLou Ltd. His witness statement is dated 5 August 2022 and is accompanied by four exhibits.

10. The proprietor's evidence comes from Amy Coyle, who is founder and owner of the brand SWEET STAMP by Amy Cakes. Her witness statement is dated 5 October 2022 and is accompanied by twelve exhibits. At the same time, the proprietor filed written submissions.

11. The applicant filed evidence in reply in the form of a second witness statement from Mr Scott dated 7 December 2022. This is accompanied by seven exhibits.

12. Neither side requested a hearing and both filed written submissions in lieu on 1 March 2023.

## **REPRESENTATION**

13. In these proceedings, the applicant was represented by Simon Coles of Graham Coles & Co and the proprietor by Tomkins & Co.

## **DECISION**

14. The relevant provisions of section 47 of the Act are 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.

...

(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.”

15. 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 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.”

16. The relevant date is 23 April 2021.

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.<sup>1</sup> 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). I shall therefore begin by considering the section 3(1)(c) ground.

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

18. 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*

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<sup>1</sup> 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 refer to the trade mark case-law of EU courts, although the UK has left the EU.

*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].”

19. 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].”<sup>2</sup>

20. The proprietor submits that the relevant public consists of people who bake and decorate cakes as a hobby and also professionals. I agree.

21. It is not disputed that each of the two words that makes up the contested mark has a meaning in standard English. In her evidence, Ms Coyle has adduced definitions taken from the *Merriam-Webster Dictionary* and the *Cambridge Dictionary*.<sup>3</sup> The first of these is a US source, so I shall take account of the definitions from the latter. “Texture” is shown to mean “*the quality of something that can be decided by touch; the degree to which something is rough or smooth, or soft or hard*” while “tile” is “*a thin,*

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<sup>2</sup> Paragraph 21.

<sup>3</sup> Exhibit AC1.

*usually square or rectangular piece of baked clay, plastic, etc., used for covering roofs, floors, walls, etc.”.*

22. The proprietor submits that the evidence does not show that the average consumer would understand the combination of these words to be descriptive and that, if it did, one would expect to see greater use of the term in the marketplace in connection with the goods for which the contested mark is registered. However, the case law is clear that the mark does not need to have been used in a descriptive manner at the relevant date; rather, it is caught by section 3(1)(c) if it could be used descriptively: see paragraph 38 of *Agencia Wydawnicza Technopol sp. z o.o. v OHIM*, quoted by Arnold J. (as he then was) in *Starbucks*, reproduced in paragraph 18 above. The proprietor has also submitted that there are other terms that are more frequently used: for example, embossers, stamps, etc. Even if this is true, the CJEU stated in the same case that it is not relevant whether there are other, more usual, ways of describing the same characteristics of the goods: see paragraph 39.

23. The applicant has claimed that the meaning of the mark is either a *“tile-shaped object bearing a texture”* or a *“tile-shaped object for embossing texture”* and that *“the term ‘texture tile’ is descriptive of any embosser consisting of a thin piece of durable material for the purpose of producing a surface pattern or design”*. In its written submissions, it appears to accept the definitions adduced by the proprietor. I note that the definition of a tile refers to its usual shape, material and purpose. However, the applicant submits that:

“... notwithstanding the primary use of most tiles being for ‘covering roofs, floors, walls, etc.’ it is common for any thin piece of durable material (such as plastic) having the same shape as a tile to be referred to as a tile. Examples of this practice include the tiles used in popular games such as Scrabble and Rummikub”.<sup>4</sup>

24. I accept that the word “tile” is used in the context of board games, but there is no evidence to suggest that the average consumer would understand the word to denote

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<sup>4</sup> Written submissions in lieu of a hearing, section 3.2, page 3.

any “*thin piece of durable material*”, as claimed by the applicant. A kitchen chopping board, for example, may be a thin, square or rectangular piece of durable material, but I doubt whether the average consumer would use the word “tile” to describe any of its characteristics.

25. The applicant submits that Exhibit HS2 contains examples of the use in English of the term “texture tile” to refer to tile-shaped objects with non-smooth or patterned surfaces. The first of these is an image from Instagram dated 6 July 2018. It shows what appear to be thin squares with a raised flower design. It is not clear whether this post was made by a UK user and, in any case, at the date of printing it had received only three likes, indicating a low level of engagement. The second Instagram post comes from a user in Singapore. It is dated 1 February 2020 and shows what it describes as a “Texture Tiles Necklace”, made up of individual patterned round tiles. This evidence does not shed any light on how a UK consumer might understand the term “texture tile”. In my view, they would understand the phrase “TEXTURE TILE” to mean a square or rectangular piece of durable material, such as clay, porcelain or plastic, used with identical or similar pieces of the same material for covering a floor, wall or roof, with each of those pieces having a flat back and a non-smooth surface.

26. I will now go through the goods for which the contested mark is registered and consider whether the mark is descriptive for any of them. I bear in mind that the average consumer needs to be able to perceive immediately a description of one of the characteristics of the goods at issue.

27. The Class 16 goods are *Letter embossers and stencils for cake decorating*. The *Cambridge Dictionary* defines the verb “emboss” as follows: “*to decorate an object, especially with letters, using special tools that make a raised mark on its surface*”.<sup>5</sup> This definition is not disputed by the proprietor. I understand that a stencil is a tool containing cut-out sections, enabling the user to produce a coloured design on, in this case, the icing of a cake. In my view, in neither of these cases will the average consumer immediately perceive that “texture tile” describes one of the characteristics of the goods. Understanding the term descriptively would require a degree of mental

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<sup>5</sup> Exhibit HS5, page 2.

effort on the part of the average consumer that is not consistent with an immediate perception. I find that the contested mark is not descriptive of a characteristic of the Class 16 goods for which it is registered.

28. The Class 20 goods are *Non-edible decorations of plastic, for cakes and baked goods*. Such decorations could include square or rectangular pieces of thin plastic. However, I have already found that the evidence does not show that the average consumer in the UK would use the word “tile” to describe any thin piece of plastic. I find that the contested mark is not descriptive of a characteristic of these goods.

29. The remaining goods are in Class 21 and are as follows: *Table ware, bakeware, cookware and containers; baking utensils; cookie cutters; cutters, templates, embossers, application pads, and cookware for decorating cakes, baked goods and confectionary; hampers and gift sets containing the aforesaid*. Given my findings on how the average consumer would perceive the phrase “texture tile”, it is my view that the contested mark is not descriptive of a characteristic of these goods for the reasons set out in paragraph 27 above.

30. The section 3(1)(c) ground fails.

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

31. The principles to be applied under Article 7(1)(b) of the CTM Regulation (which is now Article 7(1)(b) of the EUTM Regulation, and is identical to Article 3(1)(b) of the Trade Marks Directive and section 3(1)(b) of the Act) were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG*, Case C-265/09 P, as follows:

“29. ... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

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

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Procter & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37)."

32. A trade mark may therefore fall foul of section 3(1)(b) of the Act for reasons other than its descriptive qualities. However, the applicant's case under this section also relies on the alleged descriptiveness of the contested mark and it presents no other reasons why it claims the mark is devoid of any distinctive character. Therefore, the section 3(1)(b) ground also fails.

### **Section 3(1)(d)**

33. In *Telefon & Buch Verlagsgesellschaft GmbH v OHIM*, Case T-322/03, the General Court ("GC") summarised the case law of the CJEU under the equivalent of this section 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 v 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. 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).”

34. It seems to me that the word “customary” sets a relatively high bar to overcome. In *Stash Trade Mark*, BL O/281/04, Professor Ruth Annand, sitting as the Appointed Person, referred to the definition of the word in the *Oxford English Reference Dictionary*: “usual; in accordance with custom”.<sup>6</sup>

35. The applicant submits that at the time of the filing of the application for the contested mark, the term “texture tile” had been “*in widespread use*” to describe the registered goods by a number of parties other than the proprietor.<sup>7</sup> I summarise the evidence below.

36. Exhibit HS3 contains the following:

- i) A printout from Amazon which shows a product titled “Fondant Impression Texture Tile with Floral and Dots Design, Silver” with the brand listed as “Duff Goldman by Gartner Studios”. It was first available on 25 January 2014, was unavailable at the date of printing, and there are no reviews shown to indicate when any sales might have occurred. The product description states: “*Add unexpected dimension to your fondant with these easy texture tiles.*”<sup>8</sup>
- ii) A printout from the website of a retailer called Cherish3Dprints showing 9 results from a search for “texture tile”. The phrase is used in the title of the products. There is no date on this printout apart from a copyright date of 2022;<sup>9</sup>
- iii) A printout from the Etsy page of Cherish3DprintsUK showing a “Yom Kippur background texture tile”.<sup>10</sup> The currency shown is sterling. A review of this

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<sup>6</sup> Paragraph 33.

<sup>7</sup> Written submissions in lieu of a hearing, section 3.7, page 10.

<sup>8</sup> Exhibit HS3, pages 1-2.

<sup>9</sup> Exhibit HS3, pages 3-7.

<sup>10</sup> Exhibit HS3, pages 8-12.

product was left on 8 September 2021, which is after the date of application for the contested mark;

- iv) An Instagram post from cherish3dprints dated 18 April 2021, five days before the application date.<sup>11</sup> It appears to be from the UK and the text reads as follows:

“Showing you an example of how to use our:

- love you x emboss stamp
- hearts texture tile

#positive #gift #nicegesture #welldone #congrats #fondantpopstamp #fondantdecoration #fondanttoppers #fondant #embossedcookies #embosser #stamps #custom #customstamp #customisable #baking #bakinglove #letters #holder #supportsmallbusiness #supportlocal #sweettooth #3dprinter #3dprinting #3dprintinglife #etsyseller #etsy #etsysellerofinstagram”

- v) Facebook posts from My Little Cakepop dated 5 March 2021 and 31 July 2021 referring to “*a hand knit texture tile*” and “*basket weave texture tile*” respectively.<sup>12</sup> The prices and spelling suggest a seller from the US;
- vi) A printout from the Etsy page of NKLDNItd showing a “Heart Print Pattern Texture Tile PLA Fondant Stamp Fondant Embosser Cookie Stamp Cookie Embosser”.<sup>13</sup> The price is in sterling and the listing is undated;
- vii) A Facebook post from NKLDNItd headed “TEXTURE TILES”, followed by the text “Add some fun texture to your creations with our pattern stamps! Now available on Etsy”.<sup>14</sup> However, the post is dated 26 June 2021, i.e. after the relevant date;
- viii) Another Etsy printout, this time from House of Toot Sweet.<sup>15</sup> The first two items use the phrase “texture tile”. The page states it was last updated on 7 June 2022;

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<sup>11</sup> Exhibit HS3, page 13.

<sup>12</sup> Exhibit HS3, page 14.

<sup>13</sup> Exhibit HS3, pages 15-16.

<sup>14</sup> Exhibit HS3, page 17.

<sup>15</sup> Exhibit HS3, page 18.

- ix) A printout from the website of Nightingale Cake Artistry showing a “Woodgrain texture tile embosser”.<sup>16</sup> The website is directed towards the UK but the item is undated;
- x) An Instagram post from Nightingale Cake Artistry showing texture tiles, dated 23 August 2021.<sup>17</sup>

37. Exhibit HS4 contains examples of use of the phrase “texture tiles” in sectors other than baking and cake decorating. However, these examples are either undated or not clearly targeted towards the UK consumer with the exception of the metalclay.co.uk website which shows what it describes as “Texture Tile – Feathered”, with a review dated 17 January 2018.<sup>18</sup> The printout shows that other texture tiles were available at the date of printing, which was 2 August 2022. The issue with this piece of evidence is that it is not entirely clear which sector the trader is operating in, although it appears to be ceramics, as the recent blog posts include “The cost of running a kiln” and “Art Clay is 100% recycled eco-silver”.

38. The applicant’s evidence in reply also includes undated printouts from its own website, Etsy, and the websites of Sugar Stamp and My Little Cakepop showing use of the term “texture tile”.<sup>19</sup> The evidence from My Little Cakepop has been adduced to rebut the proprietor’s criticisms of the earlier evidence listed at paragraph 36(v) above, namely that it showed use within the US. Exhibit HS9 does show two products, each described as a “texture tile” priced at £7.00. As these are undated, I cannot tell whether My Little Cakepop targeted towards UK customers at the relevant date or not.

39. In summary, then, there are two pieces of evidence showing use by third parties in the baking and cake decorating trade in the UK of the term “texture tile” before the relevant date of 23 April 2021. These are the items listed at paragraph 36(i) and (iv). The evidence falls short of what would be required to show that the term had, by the relevant date, become customary in the current language or in the *bona fide* and

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<sup>16</sup> Exhibit HS3, page 19.

<sup>17</sup> Exhibit HS3, page 20.

<sup>18</sup> Exhibit HS4, pages 6-7.

<sup>19</sup> Exhibits HS6, HS8, HS9 and HS10.

established practices of the trade to designate the goods in respect of which the contested mark was registered. Therefore, the section 3(1)(d) ground also fails.

## **OUTCOME**

40. The application for a declaration of invalidity has failed and UKTM No. 3631180 will remain registered.

## **COSTS**

41. The proprietor has been successful and is entitled to a contribution towards the costs it has incurred during these proceedings, according to the scale set out in Tribunal practice Notice No. 2/2016. In the circumstances, I award the proprietor the sum of £1550 which has been calculated as follows:

*Preparing a statement and considering the other side's statement: £300*

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

*Preparing written submissions in lieu of a hearing: £450*

***TOTAL: £1550***

42. I therefore order LissieLou Ltd to pay Amy Coyle the sum of £1550, 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 19 day of July 2023**

**Clare Boucher**

**For the Registrar,**

**Comptroller-General**