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In the matter of IR Trade Mark Application No.1230792 and the request by Bed Bath 'N' Table Pty Ltd (the Applicant) to protect the figurative trade mark 'BED BATH 'N' TABLE', in classes 20, 24 & 35

and

Opposition No. 404587 by Liberty Procurement Co. Inc. (the Opponent)

and

In the matter of an Appeal to the Appointed Person by the Opponent against the Decision of the Hearing Officer O-443-16 for the Registrar, The Comptroller General dated 22 September 2016

DECISION

Procedural history

1. On 4 June 2014, the Applicant, on the basis of its international registration held in Australia, requested protection in the United Kingdom of the trade mark shown below:

BED BATH 'N' TABLE

2. As the Hearing Officer recorded, the United Kingdom Trade Marks Registry considered that the request satisfied the requirements for protection in accordance with Article 3 of the Trade Marks (International Registration) Order 1996 and particulars of the international registration were published in accordance with Article 10.

3. Protection was sought for the following goods and services:

In Class 20: Furniture.

In Class 24: Bath linen, bed clothes, bed covers, bed covers of paper, bedspreads; brocades; calico, calico cloth; canvas for tapestry or embroidery; cloth; cotton fabrics; coverlets (bedspreads); covers (loose) for furniture; crepe (fabric); curtain holders of textile material, curtains of textile or plastic; damask; dish towels for drying; door curtains; eiderdowns; fabric; face towels of textile; felt; flannel; furniture coverings of plastic; household linen; jersey (fabric); linen (bed), linen (household), linen cloth, material (textile); mattress covers; net curtains; non-woven textile fabrics; pillowcases; quilts; runners (table); serviettes of textile; sheets (textile); silk (cloth); table cloths (not of paper), table linen (textile), table mats (not of paper), table napkins

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of textile; taffeta (cloth); towels of textile; upholstery fabrics; woollen cloth, woollen fabric; textiles for blinds; embroidery fabric.

In Class 35: Retail services, wholesale and mail order services connected with the sale of textiles and textile goods, namely, bath linen, bed clothes, bed covers, bedspreads, brocades, calico, calico cloth, canvas for tapestry or embroidery, cloth, cotton fabrics, coverlets (bedspreads), covers (loose) for furniture, crepe (fabric), curtain holders of textile material, curtains of textile or plastic, damask, dish towels for drying, door curtains, eiderdowns, fabric, face towels of textile, towels, bathmats, felt, flannel, furniture coverings of plastic, household linen, jersey (fabric), linen (bed), linen (household), linen cloth, material (textile), mattress covers, net curtains, non-woven textile fabrics, pillowcases, quilts, runners (table), serviettes of textile, sheets (textile), silk (cloth), table cloths (not of paper), table linen (textile), table mats (not of paper), table napkins of textile, taffeta (cloth), towels of textile, upholstery fabrics, woollen cloth, woollen fabric, textiles for blinds, embroidery fabric, giftware, namely, candles and wicks for lighting, trinkets, ornamental statues, sculptures and statuettes, napkin holders and rings, nutcrackers, letter openers, ring holders, medals, candle extinguishers, flower vases, artistic prints, busts, bowls (basins), cutlery, jewellery cases, personal ornaments of precious metals, jewellery, horological and chronometric instruments, postcards, boxes and bins of paper and cardboard, gift bags, photographs, stationery, umbrellas, purses and bags, storage cases and containers, boxes, chests, glassware, porcelain and earthenware, games and playthings, bathroom products, namely, waste bins, mirrors, toilet roll holders, sponges, loofahs, soap dishes, shower curtains, soap, shampoo, laundry baskets, furniture, kitchen ware, including cutlery and crockery.

4. The list of retail services in class 35 is long, but, in my view, the list is easier to follow if it is divided up somewhat. There may be more divisions than I have set out below, but I have found it easier to consider these services if they are set out in the following way (I have inserted paragraph numbering to make this clear):

Class 35: Retail services, wholesale and mail order services connected with the sale of

(i) textiles and textile goods, namely, bath linen, bed clothes, bed covers, bedspreads, brocades, calico, calico cloth, canvas for tapestry or embroidery, cloth, cotton fabrics, coverlets (bedspreads), covers (loose) for furniture, crepe (fabric), curtain holders of textile material, curtains of textile or plastic, damask, dish towels for drying, door curtains, eiderdowns, fabric, face towels of textile, towels, bathmats, felt, flannel, furniture coverings of plastic, household linen, jersey (fabric), linen (bed), linen (household), linen cloth, material (textile), mattress covers, net curtains, non-woven textile fabrics, pillowcases, quilts, runners (table), serviettes of textile, sheets (textile), silk (cloth), table cloths (not of paper), table linen (textile), table mats (not of paper), table napkins of textile, taffeta (cloth), towels of textile, upholstery fabrics, woollen cloth, woollen fabric, textiles for blinds, embroidery fabric,

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(ii) giftware, namely, candles and wicks for lighting, trinkets, ornamental statues, sculptures and statuettes, napkin holders and rings, nutcrackers, letter openers, ring holders, medals, candle extinguishers, flower vases, artistic prints, busts, bowls (basins), cutlery, jewellery cases, personal ornaments of precious metals, jewellery, horological and chronometric instruments, postcards, boxes and bins of paper and cardboard, gift bags, photographs, stationery, umbrellas, purses and bags, storage cases and containers, boxes, chests, glassware, porcelain and earthenware, games and playthings,

(iii) bathroom products, namely, waste bins, mirrors, toilet roll holders, sponges, loofahs, soap dishes, shower curtains, soap, shampoo, laundry baskets,

(iv) furniture,

(v) kitchen ware, including cutlery and crockery.

5. It may be noted that my paragraph (i) above reproduces the Class 24 goods (but has 'bed covers' generally as opposed to 'bed covers of paper' and adds 'towels' and 'bathmats') and my paragraph (iv) the Class 20 goods, whereas paragraphs (ii), (iii) and (v) are for retail services etc in connection with goods for which there is no corresponding specification of goods. I will return to this division later.

6. On 25 June 2015 the Opponent filed notice of opposition to the conferring of protection on this international registration, on the absolute grounds contained in ss.3(1)(b) & (c) of the Trade Marks Act 1994 ('the Act'). In response the Applicant denied these grounds, but did not allege that the mark had any distinctive character acquired through use in the UK. The Opponent's arguments for these grounds of opposition were summarised by the Hearing Officer in the following way:

6.1. The goods and services claimed relate to furniture, soft furnishings and bed, bath and table linen and to retail of these goods. The registration of the mark in suit would bestow upon the applicant an unfair monopoly which would prevent the legitimate and fair use by other traders to promote their goods and services in the normal course of their business using words which are of common English parlance. The element 'N' within the mark would merely be perceived by the average customer as "and". The term has no capabilities of acting as an indicator of origin because the words in this formation are wholly

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non-distinctive of all the goods and services claimed. The mark in suit therefore offends against section 3(1)(b) of the Act.

6.2. With the conceivable exception of “canvas for tapestry or embroidery” and “dish towels for drying” all of the goods and services claimed are goods or services for use in relation to beds, bath and tables, The Class 20 claim to “furniture” clearly includes all types of furniture including beds, baths and tables. Thus the sign applied has no function but to describe some of the goods covered by the Class 20 claim. Further, all of the goods in Class 24 are for use on, for, or in relation to, or may be used on, for, or in relation to beds, baths or tables, with the exception of “canvas for tapestry or embroidery” and “dish towels for drying”. The perception of the average consumer can be no other than that the goods for sale are beds, baths or tables or are otherwise goods adapted for use with beds, baths or tables. The letter ‘N’ is a common abbreviation for the word “and” and as such adds nothing to assist the distinctive character of the mark. The mark in suit consists of a sign which may serve in trade to designate the kind and intended purpose of goods and services and thus offends against Section 3(1)(c) of the Act.

7. Both sides filed evidence. A hearing was held on 13 September 2016 which the Applicant did not attend but written submissions were filed on its behalf. The Opponent was represented by Miss McFarland of Counsel instructed by Messrs Keltie LLP. The Hearing Officer issued his decision O-443-16 on 22 September 2016 in which he rejected both grounds of opposition and ordered the Opponent to pay the Applicant the sum of £700 by way of contribution towards its costs.

The Appeal

8. The Opponent filed an Appeal together with 12 pages of lengthy ‘Grounds of Appeal’, which did not so much as identify specific grounds of appeal but rather they appeared to contain all the submissions the Opponent wished to make in support of its Appeal. This impression was confirmed by what occurred at the Hearing of the Appeal before me on 9 March 2017. The Opponent/Appellant was not represented and filed no Skeleton Argument or written submissions beyond those in the ‘Grounds of Appeal’. The Applicant/Respondent was represented by Miss Charlotte Scott of Counsel, instructed by Walker Morris LLP.

9. In its Appeal, the Appellant/Opponent effectively invites me to uphold the grounds of opposition under ss.3(1)(b) & (c), alleging a whole host of errors committed by the Hearing Officer in his Decision. On behalf of the Respondent, Miss Scott provided me with a helpful Skeleton Argument, in which she identified and responded to the principal points which are made in a more diffuse way in the Appellant's 'Grounds of Appeal'. I will address these below.

Standard of Review

10. The Respondent reacted, understandably, to a submission made in the Appellant's Grounds of Appeal to the effect that '*we entirely accept that this appeal is not merely a 're-hearing''*'. As the Respondent submitted, this appeal is not a re-hearing at all. This appeal is by way of review such that the usual principles set out in *Reef Trade Mark* [2003] RPC 5 and other cases (including *BUD Trade Mark* [2003] RPC 25 and *Fage UK Ltd v Chobani UK Ltd* [2014] ETMR 26) apply. The same points are made at [5]-[6] of the judgment of Daniel Alexander Q.C. (sitting as a Deputy Judge of the High Court) in *Digipos Store Solutions Group Ltd v Digi International Inc.* [2008] RPC 24.
11. Miss Scott also reminded me of the more recent review of the case law on the appellate approach which Mr Alexander Q.C. carried out, this time as the Appointed Person, in *Talk for Writing Trade Marks* O-017-17. The points in issue on that appeal were very similar to the issues raised in the Appeal before me, and I propose to apply the principles he summarised as relevant to the case before him. Having reviewed the case law from [14] to [50] he summarised the principles as follows:

'52. Drawing these threads together, so far as relevant for the present case, the principles can therefore be summarized as follows.

(i) Appeals to the Appointed Person are limited to a review of the decision of Registrar (CPR 52.11). The Appointed Person will overturn a decision of the Registrar if, but only if, it is wrong (Patents Act 1977, CPR 52.11).

(ii) The approach required depends on the nature of decision in question (REEF). There is spectrum of appropriate respect for the Registrar's determination depending on the nature of the decision. At one end of the spectrum are decisions of primary fact reached after an evaluation of oral

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evidence where credibility is in issue and purely discretionary decisions. Further along the spectrum are multi-factorial decisions often dependent on inferences and an analysis of documentary material (REEF, DuPont).

(iii) In the case of conclusions on primary facts it is only in a rare case, such as where that conclusion was one for which there was no evidence in support, which was based on a misunderstanding of the evidence, or which no reasonable judge could have reached, that the Appointed Person should interfere with it (Re: B and others).

(iv) In the case of a multifactorial assessment or evaluation, the Appointed Person should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions. In particular, where an Appointed Person has doubts as to whether the Registrar was right, he or she should consider with particular care whether the decision really was wrong or whether it is just not one which the appellate court would have made in a situation where reasonable people may differ as to the outcome of such a multifactorial evaluation (REEF, BUD, Fine & Country and others).

(v) Situations where the Registrar's decision will be treated as wrong encompass those in which a decision is (a) unsupportable, (b) simply wrong (c) where the view expressed by the Registrar is one about which the Appointed Person is doubtful but, on balance, concludes was wrong. It is not necessary for the degree of error to be "clearly" or "plainly" wrong to warrant appellate interference but mere doubt about the decision will not suffice. However, in the case of a doubtful decision, if and only if, after anxious consideration, the Appointed Person adheres to his or her view that the Registrar's decision was wrong, should the appeal be allowed (Re: B).

(vi) The Appointed Person should not treat a decision as containing an error of principle simply because of a belief that the decision could have been better expressed. Appellate courts should not rush to find misdirections warranting reversal simply because they might have reached a different conclusion on the facts or expressed themselves differently. Moreover, in evaluating the evidence the Appointed Person is entitled to assume, absent good reason to the contrary, that the Registrar has taken all of the evidence into account. (REEF, Henderson and others).

Bearing in mind the repeated reminders that different points are likely to be particularly relevant in other cases, this is not intended to be a summary of universal application for other cases where particular aspects of the approach may require different emphasis.'

The Decision

12. Having set out the boundaries of the dispute, the Hearing Officer then summarised the evidence filed by the Opponent. In his review, he picked out the most pertinent points from the various materials exhibited. I have kept those points in mind in my analysis below. This was followed by a review of the Applicant's evidence, a review which was suitably short because both of the main points made were and are irrelevant: first, evidence that this mark has been registered in Australia since 1995 and second, evidence of a UK registration (the different mark BED BATH & BEYOND) held by the Opponent. The evidence did not disclose the circumstances in which each of those registrations was obtained. In particular, I have no idea whether the registration in Australia was only successful on proof of acquired distinctiveness or for how long the mark had been in use there before registration.
13. The Hearing Officer correctly addressed the s.3(1)(c) ground first. He directed himself by reference to:
- 13.1. the summary formulated by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 at [91]-[92] (citing from the CJEU in case C-51/10P *Agencja Wydawnicza Technopol sp. z o. o. v OHIM* [2011] ETMR 34 at [33]-[39] and [46]-[50]);
- 13.2. Case C-265/00 *Campina Melkunie BV v Benelux Merkenbureau* at [39]-[41];
- 13.3. Case C-421/04 *Matratzen Concord AG v Hukla Germany SA* at [24];
- 13.4. The observations of Mr Geoffrey Hobbs Q.C. as the Appointed Person in O-240-02 *Fourneaux De France Trade Mark* at p7 of the transcript of his decision, where Mr Hobbs said:
- 'Having listened with care to the arguments that have been addressed to me on this appeal, I have come to the conclusion that cooker hoods and extractors are closely connected items of commerce, and that they are both so closely connected with cookers that it would be unrealistic to treat the words FOURNEAUX DE FRANCE as descriptive of the character of the latter but not the former. The expression "cookers from France" is descriptive at a high level of generality. That makes it suitable, in my view, for descriptive use in the marketing of units of equipment of the kind found in modern cooker installations including not only grilling and roasting units, but also hood and extractor units.'*

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- 13.5. The observations of Mr Iain Purvis Q.C. sitting as a Deputy Judge of the High Court in *Canary Wharf Group Plc v The Comptroller General of Patents, Designs and Trade Marks* [2015] EWHC 1588 at [39]-[40].
14. The Hearing Officer then quoted some lengthy extracts from the Opponent's written submissions, which also reminded him of the decisions in *Corn Thins*, Cases C-191/00 *DOUBLEMINT*, T-19/04 *PAPERLAB* and T-610/13 *GREASECUTTER*.
15. The Hearing Officer's reasoning on the s.3(1)(c) ground was brief and was contained in the following two paragraphs (in which I have underlined some key passages to which I will refer later):

'19) The opponent contends that the mark in suit is simply a list or inventory and states that this is how it will be perceived and how the words are used by other companies. I accept that the individual words will be used to designate areas in a website or a retail outlet where items relating to e.g. beds/bedding can be found. I accept that it is possible to find the words "bed", "bath" and "table" listed on websites and probably on in-store guides, and in some instances they will be listed in the order that they are used in the mark. Indeed I accept that the opponent's evidence shows that on a number of websites the words are used in the same order as in the mark in suit to offer consumer a chance to more readily find what they are seeking. However, the evidence provided by the opponent simply does not show use of the words "bed bath 'N' Table" or even "Bed bath and table" without other components such as the descriptor "linen" being added. I accept that it is not unusual for bath towels, hand towels and tea towels to be in similar areas to bed linen as they are similar goods. Baths would not be regarded as furniture and so would be sold in a totally different area, such as sanitary ware or even plumbing. The opponent's evidence shows companies, unsurprisingly, using the individual words "bed", "bath" and "table" along with other descriptors such as linen, furniture etc. when identifying areas of their website for customers to search in order to find such goods.

*20) The authorities make it clear that I must regard the mark as a whole, and as such I do not believe that the mark in suit offends against Section 3(1)(c), as it does not describe a good or service but merely alludes to the fact that the goods are for use in the household. **The ground of opposition under Section 3(1)(c) therefore fails.'***

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16. The Hearing Officer then turned to the ground of opposition under s.3(1)(b). He directed himself by citing:

16.1. [29]-[33] of the CJEU judgment in Case C-265/09P *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG*; and

16.2. [116]-[117] of the judgment of Arnold J. in *Starbucks* (full reference above).

17. The Hearing Officer then quoted three paragraphs from the Opponent's written submissions in which the contentions may be summarised as (i) the mark is descriptive; (ii) it is not sufficiently different from ordinary descriptive words to create a distinctive trade mark (with the possible exception in relation to the class 35 designation of 'dish towels for drying' and/or 'canvas for tapestry or embroidery') and (iii) these three ordinary English words should remain free for other traders to use. He then gave his reasoning on the s.3(1)(b) ground as follows (my underling added, as before):

*'24) I do not accept the opponent's contentions. Whilst, as I have said earlier, individually each of the words is descriptive, collectively they merely allude to the fact that the goods are for use in the house. I accept that the mark in suit cannot benefit from any distinctiveness through use as this has not been shown. The average consumer cannot, therefore, be said to have been educated into viewing the mark in suit as an indicator of origin. To my mind, the average consumer will view the mark in suit not as a descriptor but as a mark of origin as, in its entirety, it is not descriptive of any of the goods and services applied for by the applicant and is not devoid of distinctive character. **The ground of opposition under Section 3(1)(b) therefore fails.'***

Discussion

18. There are three preliminary matters to mention:

18.1. First, although the mark is a figurative mark, the degree of stylization over the ordinary words 'BED BATH 'N' TABLE' is negligible.

18.2. Second, in the specification of goods and services, it is easy to identify goods and corresponding services which fall into the general category of goods for the bedroom, bathroom and for the table. I propose to consider the mark in relation to those goods and corresponding services first and then to consider goods and services which may fall outside that general category.

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- 18.3. Third, although the Hearing Officer did not expressly identify the characteristics and level of attention of the average consumer, I do not regard this as an error, let alone a material one. The goods (and the related retail services) are normal household items so the average consumer is an ordinary member of the public. The level of attention in purchasing is, in my view, above average because such items are selected and purchased on the basis they will be used and/or feature in the home for a reasonably significant length of time or selected and purchased as gifts for others.
19. From the paragraphs I have quoted above from the Hearing Officer's decision (§§19, 20 and 24), it can be seen that the Hearing Officer rejected both grounds for essentially the same reason: whilst each of the words is descriptive, collectively they merely allude to the fact that the goods are for use in the house/household. It was for this reason that the Hearing Officer concluded that the average consumer would view the mark not as a descriptor but as a mark of origin. His reason in turn seems to me to depend, in particular, on the sentence I underlined above when quoting from his §19 namely:
- However, the evidence provided by the opponent simply does not show use of the words "bed bath 'N' Table" or even "Bed bath and table" without other components such as the descriptor "linen" being added.*
20. It seems to me there are some related points wrapped up here. First, the source of the Hearing Officer's allusion appears to be the *absence* of the addition of a descriptor such as 'linen' (or, one might say, simply, 'goods'). Second and quite correctly, the Hearing Officer was considering the mark as a whole, which is why he used the word 'collectively'. That, however, itself raises two issues: first, the issue of whether the average consumer would perceive or categorise the goods in the way the Hearing Officer did to found his allusion; and second, whether the combination of the elements which make up the mark renders the mark as a whole free from objection. I will consider each of these three points in turn, but they are all interrelated.
21. As to the first point, I am reminded of the decision of Mr Geoffrey Hobbs Q.C. as the Appointed Person in O-561-01 *Cycling IS...* In that case, the application was for a series of two marks, each comprising the text 'Cycling IS...' in different

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orientations, applied for in respect of ‘*clothing, footwear and headgear*’ in class 25 and ‘*advertising, all relating to the cycling industry*’ in class 35. Mr Hobbs observed that the ellipsis in the mark visibly invites people to add meaning to the words. He held that the mark did not offend against s.3(1)(c) because it did not consist *exclusively* of matter that is descriptive of the kind or characteristics of the goods and services for which registration was requested. However, he upheld the ground of opposition based on s.3(1)(b) on the basis that the mark was devoid of distinctive character.

22. It is certainly the case that the CJEU jurisprudence relating to the directly equivalent provisions (in arts 3(1)(b)&(c) of the various Trade Marks Directives and arts.7(1)(b)&(c) of the Community Trade Mark Regulation and now the European Union Trade Mark Regulation) has developed considerably since Mr Hobbs’ decision in *Cycling Is...* back in November 2001. However, once the Tribunal has oriented itself correctly, the nature of the key questions have not changed. For example, when considering a s.3(1)(b) ground it remains legitimate to pose the key question thus: when used in relation to the goods or services in question, does the sign convey an origin specific or origin neutral message in the mind of the average consumer?
23. It is convenient to cite, as the Hearing Officer did, from Case C-265/09P *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG*, although I add paragraph 35 in particular:

“29 *However, 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*

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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 Proctor & 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).*

34 *In that regard, the Court has already stated that difficulties in establishing distinctiveness which may be associated with certain categories of marks because of their very nature – difficulties which it is legitimate to take into account – do not justify laying down specific criteria supplementing or derogating from application of the criterion of distinctiveness as interpreted in the case-law (see OHIM v Erpo Möbelwerk, paragraph 36, and Audi v OHIM, paragraph 38).*

35 *It is apparent from the case-law of the Court on Article 3 of Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), the wording of which is identical to that in Article 7 of Regulation No 40/94, that the distinctive character of a mark must always be assessed specifically by reference to the goods or services designated (see, to that effect, Libertel, paragraph 76, and Case C-363/99 Koninklijke KPN Nederland [2004] ECR I-1619, paragraphs 31 and 33)."*

24. The point made in Paragraph 35 of *Borco* could not be clearer (it is also mentioned in Paragraph 32, which the Hearing Officer cited). Furthermore, there can be no doubt that the same approach is required under section 3(1)(c). I note that amongst

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the goods in question in class 24 are: linen (bed), bath linen, table linen (textile), and the same terms feature in class 35 in the context of, for example, retail services connected with the sale of such goods. I do not ignore the point that the sign could be used in relation to just one or even a subset of those three types of goods, but equally, the sign could be used in relation to those three types of goods. Indeed, it might be said that a tribunal dealing with an issue of this sort should not ignore the most likely use, even if it may be obscured in the detail of a long specification of goods or services. So the average consumer has the sign ‘BED BATH ‘N’ TABLE’ used in relation to bed, bath and table linen and/or in relation to retail services connected with the sale of bed, bath and table linen. It is also possible to replace the word ‘linen’ in the previous sentence with, simply, ‘goods’ or ‘products’.

25. These are specific examples which, to my mind, illustrate that the Hearing Officer’s allusion rests on a false premise, for three related reasons:

25.1. First, it is true that the sign itself does not include a descriptor such as ‘linen’, but when the sign is assessed specifically by reference to goods or services designated, the goods or services themselves provide the supposedly absent element;

25.2. Second, and in any event, when the Hearing Officer held that the sign merely alludes to the fact that the goods are for use in the household, he seems to have been considering the goods *en bloc* and at a high level of generality. In my view this approach was contrary to the clear instruction given by the CJEU. If one considers specific goods (i.e. bed bath and table linen), then his point reduces to this: the sign ‘alludes’ to the fact that the goods (linen) are bed linen, bath linen and table linen. To my mind, this is not an allusion. To the contrary, if one considers this mark when used in relation to those goods, the characteristics of the goods in question are easily and immediately recognisable by the average consumer (cf the CJEU in case C-51/10P *Agencja Wydawnicza Technopol sp. z o. o. v OHIM* [2011] ETMR 34 at [50]).

25.3. Third, and considering the supposed ‘absence’, the sign itself BED BATH ‘N’ TABLE suggests that the goods are bed, bath and table goods and the services are the retail of bed, bath and table goods. Thus, in comparison to the situation under consideration in CYCLING IS...., the supposed ‘absence’

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from this mark is slender indeed and is not, in my view, sufficient to provide an allusive meaning.

26. In these circumstances, the support for any allusion (and therefore escape from objection) rests on the way in which one categorises the goods or services in question. What this also means is that if you categorise the goods in one way (i.e. all for use in the household), one finds an allusion but that does not exclude a descriptive use if you categorise the goods in a different way. In my view, the Hearing Officer was wrong to find that this mark had an allusive meaning in relation to the general category of bed, bath and table goods.

27. I turn to the issue of how the average consumer would perceive the goods and services in question. My starting point is that the average consumer knows nothing about the particular specification of goods and services, whether individually or *en bloc*, and nothing about how goods and services may be grouped or summarised either in the Nice Classification or in individual specifications. When encountering a shop (whether physical or online) operating under the sign 'BED BATH N TABLE', the expectation of the average consumer would be that he or she was going to be offered bed, bath and table goods; linen, for example. The average consumer might have to visit different sections of the shop or website (e.g. Bed, Bath, Table) to find the bed linen, the bath linen and the table linen, but that would not render the sign any less descriptive. More specifically, the average consumer would perceive the relevant goods at the usual level of generality e.g. as bed sheets, duvet covers, towels, face flannels, tablecloths and so on, but finding those goods in the relevant department of the shop or section of the website would not be in any way surprising or unnatural, nor would it render the signposts used to get to the right destination anything less than descriptive and those signposts would, in my view, include the mark applied for.

28. I am satisfied that, on encountering products which fall into any of 'table linen' or 'bed linen' or 'bath linen', the average consumer would not think: 'Ah, these are all goods for the household or for the house'. To the contrary, the *prima facie* descriptive message in the mark applied for would be reinforced on encountering the goods on offer, and in turn, seeing the goods would reinforce that descriptive

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message. Even a consumer who was only interested in bed linen for example would expect (by reason of this sign) to find bath linen or textiles and table linen elsewhere in the physical shop or on the website. It follows that I consider the Hearing Officer committed a material error when he considered the goods and services *en bloc* and at the high level of generality of the household/goods for the house.

29. I turn then to the third point. The mark is a combination of the elements BED, BATH and TABLE. I am satisfied that each element if used on its own would be directly descriptive of corresponding (and easily identifiable) goods and services and I note that the Hearing Officer also proceeded on that basis. So, in my view, BED used in respect of beds, bedroom furniture, bed clothes, bed covers, bedspreads etc. would be a directly descriptive use. Likewise for BATH used in respect of bath linen, face towels of textile and the retail services connected with the sale of towels, bathmats, bathroom products etc. So too for TABLE in respect of tables, runners (table), table linen (textile), table mats, table napkins and the retail services connected with the sale of those goods plus cutlery and crockery.
30. The issue is whether the collection of descriptive elements in the mark is sufficient to render it free from objection.
31. In the context of art 3(1)(c)/7(1)(c), the CJEU has considered combinations of elements in three principal cases: Case C-363/99 POSTKANTOOR; Case C-265/00, BIOMILD and Case C-408/08 COLOR EDITION, and the effect of these cases is summarised in Kerly (16th Edition, 2018) at §10-101(9) as follows:

(9) As a general rule, a mere combination of elements, each of which is descriptive of characteristics of the goods or services, itself remains descriptive. However, the combination may not be descriptive if there is a perceptible difference between the resultant combination and the mere sum of its parts (POSTKANTOOR at [100]), where the unusual nature of the combination in relation to the goods or services 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 (POSTKANTOOR at [100]; BIOMILD at [41]; COLOR EDITION at [62]) or the combination has acquired its own meaning, with the result that it is now independent of its components (POSTKANTOOR at [104]).

32. It is sufficient to cite the relevant paragraphs from the most recent case *COLOR EDITION*:

61 *It is settled case-law that, 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 for the purposes of Article 7(1)(c) of the regulation. However, such a combination may not be descriptive for the purposes of that provision, provided that it creates an impression which is sufficiently far removed from that produced by the combination of those elements (see Case C-363/99 Koninklijke KPN Nederland [2004] ECR I-1619, paragraphs 98 and 99; Case C-265/00 CampinaMelkunie [2007] ECR I-1699, paragraphs 39 and 40; and Case C-273/05 P OHIM v Celltech [2007] ECR I-2883, paragraphs 77 and 78).*

62 *Thus, a mark consisting of a word 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, unless there is a perceptible difference between the word 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 (see Koninklijke KPN Nederland, paragraph 100, and Campina Melkunie, paragraph 41).*

63 *In the present case, after having found that the sign ‘COLOR EDITION’ was composed exclusively of indications which may serve to designate certain characteristics of the goods in question, the General Court held, in paragraph 49 of the judgment under appeal, that the association of the terms ‘color’ and ‘edition’ was not unusual but a normal construction in light of the lexical rules of the English language and that the mark in respect of which registration had been sought did not therefore create, for the target public, an impression sufficiently far removed from that produced by the simple juxtaposition of the verbal elements of which it was composed to alter its meaning or scope.*

64 *In the light of the case-law cited in paragraphs 61 and 62 above, and as pointed out by the Advocate General in point 98 of his Opinion, that reasoning is not vitiated by any error of law.*

33. If I examine the three possible exceptions to the general rule (as identified in Kerly (16th Edition) at §10-101(9)), then in this case in my view:

- 33.1. there is no perceptible difference between the combination and the mere sum of its parts;

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33.2. the combination is not sufficiently unusual in relation to the goods or services to create 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; and

33.3. finally and for completeness, I find there is nothing to support the notion that the combination has acquired its own meaning, independent of its components (cf POSTKANTOOR at [104]).

33.4. I also note that the Hearing Officer did not find otherwise.

34. Having examined each of the three interrelated issues I identified in paragraph 20 above, each supports the view that the mark applied for is exclusively descriptive for the general category of bed, bath and table goods. This also renders the mark devoid of distinctive character.

35. Thus far, it will be noted that I have examined the two grounds together on the basis that the Hearing Officer gave essentially the same reason for rejecting both grounds. I have made specific findings in relation to s.3(1)(c) which, in the circumstances of this case, also translate over to the s.3(1)(b) ground.

36. In the light of my reasoning above, I am satisfied that the Hearing Officer's decision on both ss.3(1)(c) & (b) (i) involved material errors of law and (ii) was wrong. I have reached the conclusion that, in so far as the goods (and corresponding retail services) fall into the general category of bed, bath and table goods, the mark offends against both s.3(1)(c) as being exclusively descriptive of characteristics of the goods and services and against s.3(1)(b) as being devoid of distinctive character.

Consideration of specific goods and retail services

37. What remains is for me to decide whether there are goods and retail services which fall sufficiently outside that general category I have identified such that the use of this mark in relation to such goods/retail services would have an allusive and not directly descriptive meaning so as to confer distinctive character. I have worded my task in that way deliberately because, in view of my principal finding in the preceding paragraph, this mark suffers from a descriptive/non-distinctive disability.

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Since the allusion has to be caused by the combination of this mark used in relation to particular goods/retail services, it is effectively the distance between bed, bath and table goods/retail services (where the mark is descriptive and non-distinctive) and the particular goods/services in question which must found any allusion, if one is to be found.

38. In its Grounds of Appeal, one of the criticisms levelled at the Hearing Officer by the Appellant was that in his decision he did not condescend to work through [the] range of goods and services. Having made that criticism, the Appellant did not then ‘work through’ the range of goods and services or single out any particular goods or services for special consideration. Before the Hearing Officer, I note that the Opponent had indicated the specific goods “canvas for tapestry or embroidery” and “dish towels for drying” as being a *possible* exception to its overall submissions that, for all the goods and services applied for, the sign was devoid of any distinctive character and/or exclusively descriptive. I should point out that the Opponent then went on to submit that the average consumer would perceive the mark as descriptive even for those goods. Following the logic of this ‘possible exception’, it applies to other goods as well, namely: ‘embroidery fabric’.
39. In this appeal, neither side marked out any of the goods or services for special comment – the submissions made embraced all goods and services in the specification applied for. Notwithstanding that, I consider it would be wrong for me to ignore the ‘possible exception’ raised by the Opponent before the Hearing Officer and its logic.
40. In my view, if the mark applied for was used in relation to just “canvas for tapestry or embroidery” or just “dish towels for drying” or just ‘embroidery fabric’ it would not be exclusively descriptive and the same applies to the retail services connected with just those specific goods.
41. I must also consider the use of the mark applied for in relation to any of the retail services of the goods in my categories (ii), (iii) and (v) above. In relation to categories (iii) and (v), I conclude the mark is exclusively descriptive, since the goods in question are bath and table goods.

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42. That leaves my category (ii). Using the viewpoint of the average consumer I identified above, I have considered the mark being used in relation to the provision of retail services, wholesale and mail order services connected with the sale of each item of the named goods in this category. Some of these goods are for the bedroom (e.g. jewelry cases, ring holders, alarm clocks (i.e. horological and chronometric instruments) and some, in my view, could naturally be purchased for and found in the bedroom, although I recognise they could also be found elsewhere in the household (storage cases and containers, boxes, chests, boxes and bins of paper and cardboard) and many are for the (dining) table (e.g. candles and wicks for lighting, napkin holders and rings, nutcrackers, candle extinguishers, bowls (basins), cutlery, glassware, porcelain and earthenware).
43. Other goods are not directly referable to the bedroom, bathroom or dining table but are directly referable to other forms of table (writing, occasional, for example): stationery, postcards, flower vases, trinkets, personal ornaments of precious metals, letter openers.
44. That leaves the retail services connected with the sale of the following two categories of goods:
- 44.1. ornamental statues, sculptures and statuettes, artistic prints, photographs, busts (goods in this category could be for the dining room, as well as other rooms in the house and even outside (ornamental statues, sculptures)); and
- 44.2. medals, jewellery, gift bags, umbrellas, purses and bags, games and playthings.
45. It is not easy to draw a clear dividing line between those goods or retail services for which this mark is exclusively descriptive and those for which it is not *exclusively* descriptive, if one considers individual goods and the retail service connected with individual goods.
46. In my view, the assessment can be significantly affected by the context in which the average consumer considers particular goods. By way of example:

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46.1. If I (using the viewpoint of the average consumer) consider the mark BED BATH N TABLE used in relation to the retail services connected with the sale of just statuettes or just medals or just jewellery, there is much to be said for finding that this sign for those specific services is not exclusively descriptive;

46.2. By contrast, if I consider the mark BED BATH 'N' TABLE used in relation to a whole range of goods (and the related retail services) all of which fall into the general category of bed bath and table goods *plus* statuettes or medals or jewellery, the context is different because the range of the goods other than statuettes or medals or jewellery reinforces the descriptive meaning of the mark. The fact that the mark is also used in relation to statuettes, or medals or jewellery does not instill in the mind of the average consumer a different (and allusive) meaning. They are just other goods sold under a descriptive mark, even though the descriptive meaning may not be entirely apt or sufficiently direct for statuettes, medals or jewellery (considered on their own) so as to render the sign *exclusively* descriptive.

47. Although the CJEU guidance directs me that '*the distinctive character of a mark must always be assessed specifically by reference to the goods or services designated*', the fact that this assessment must also be undertaken using the viewpoint of the average consumer also signifies, to my mind, that the tribunal should take a commercially realistic approach and conversely need not and should not take a commercially unrealistic approach.

48. I can illustrate the distinction as follows:

48.1. To consider the mark BED BATH N TABLE used in relation to the retail services connected with the sale of just statuettes or just medals or just jewellery would be, in my view, commercially unrealistic;

48.2. By contrast, in my view, the far more commercially realistic approach in the context of the retail services in my category (ii), is to consider the mark BED BATH 'N' TABLE used in relation to a whole range of goods (and the related retail services) all of which fall into the general category of bed bath and table goods *plus* statuettes or medals or jewellery, indeed the entirety of category (ii).

49. In the context of this application, there are three particular reasons which in my view justify the commercially realistic approach I have just mentioned:

49.1. First, the mark itself tells the average consumer to expect a grouping of goods and retail services relating to those goods. The retail services may be (but need not be) provided in separate departments, as I indicated earlier.

49.2. Second, the average consumer expects a range of goods to be available and, if there are separate departments, in each of the three different departments.

49.3. Third, this expectation is the more pronounced in respect of the retail services of such goods.

50. I wish to point out that I am not rowing back on the criticism I made in paragraph 28 above. As I have explained, I do not consider the average consumer would think in terms of 'Ah, these are all household goods'. Instead, if the average consumer was to encounter BED BATH N TABLE being used in relation to the retail services of a department providing furniture and furnishings for a dining area, the mark does not suddenly cease to be exclusively descriptive if medals or statuettes are also on sale in that department. The same applies if 'canvas for tapestry or embroidery' or 'dish towels for drying' or 'embroidery fabric' are also on sale.

51. This analysis serves to confirm the utility and necessity of considering also the section 3(1)(b) ground. It may be noted that as I progressed through paragraphs 42-44 above, my reasoning reflected the descriptive meaning of this mark becoming slightly less easily recognizable to the average consumer, if one considers only retail services for the specific goods in question. One consequence of this may be that it will be easier to establish distinctive character through use of this mark if it is used in relation to those retail services for highly specific goods. Having said that, I have come to the conclusion that for the goods and retail services in the specification applied for, absent use in the UK, this mark is devoid of distinctive character. Before this mark can be said to be possessed of distinctive character for the goods and retail services in the specification and to be afforded the privilege of registration, I consider the average consumer needs to be educated to understand

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this sign as a mark of origin. This must occur through use since, absent use, I consider the mark does not signify origin and is devoid of distinctive character.

52. In these circumstances and for the reasons I have explained above, I allow the Appeal and uphold both the ss.3(1)(b) and (c) objections.

Costs.

53. As this Appeal has succeeded, I set aside the order for costs made by the Hearing Officer and, indeed, I will reverse it. In respect of the Opponent's costs of the proceedings before the UK IPO, I order the Applicant to pay to the Opponent the sum of £700.

54. As to the costs of the Appeal, the circumstances are unusual. Although the Appellant has been successful, I derived very little assistance from the Appellant's Notice. By contrast, although the Applicant has been unsuccessful, I found the Applicant's Skeleton Argument and oral submissions to be of assistance. I do not rule out the possibility that the Appellant incurred costs of its representatives considering the Skeleton Argument filed by the Applicant, but I consider it is a fair assumption that, in providing its assistance to me, the Applicant incurred considerably more costs on this Appeal overall than the Appellant. In these unusual circumstances, I make no order as to the costs of the Appeal.

JAMES MELLOR QC

The Appointed Person

2nd February 2018