

**TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION NUMBER 3953833  
BY SUPERBUYS ONLINE LTD  
TO PROTECT THE FOLLOWING TRADE MARK IN CLASS 13:**

**THE ULTIMATE FIREWORKS SHOP**

**Background**

1. On the 6 September 2023, Superbuys Online Ltd ('the applicant') applied to register the above mark.
2. Registration was sought in Class 13 for the following goods:

**Class 13:**

*Fireworks;Sparklers [fireworks];Pyrotechnics;Sky rockets;Smoke detonators;Aerial bombs.*

3. On 19 September 2023, the Intellectual Property Office ('IPO') issued an examination report in response to the application. In that report, an objection was raised under section 3(1)(b) of the Trade Marks Act 1994 ('the Act'), which reads as follows:

*"Absolute grounds for refusal*

*Section 3(1)(b)*

*The application is not acceptable in Class 13. There is an objection under Section 3(1)(b) of the Act as the mark is devoid of any distinctive character. This is because the words 'THE ULTIMATE FIREWORKS SHOP', when used in relation to fireworks, will be viewed as a reference to a shop through which the specified goods can be obtained, rather than as a sign on which the average consumer can rely to guarantee the commercial source of the goods.*

*In order to function as a trade mark a sign must be capable of guaranteeing the source of the goods on which it is used in the mind of the average consumer so that they cannot be confused with the similar goods of another undertaking.*

*Based on their ordinary meanings, when used in relation to the specified goods the words 'THE ULTIMATE FIREWORKS SHOP' will be viewed merely as a reference to the type of establishment from which the goods may have been sourced, and as one which may be used by any undertaking supplying similar goods.*

*The inclusion of the words 'THE ULTIMATE' at the beginning of the mark do not imbue the mark with distinctive character. Instead, they merely serve a promotional function, indicating that the shop from which the goods can be obtained is the best or preeminent fireworks shop.*

*As such the mark is devoid of distinctive character and cannot perform the function of a trade mark in leaving the average customer in no doubt as to the commercial source of the goods on which it is intended to be used."*

4. The examination report of 19 September 2023 gave the applicant a period of two months from the date of the report in which to respond. This period expired on 20 November 2023. In the absence of any response at all, the report said the application would be refused under section 37(4) of the Act.

As no response to the examination report was made by the applicant, on 1 December 2023, the application was formally refused by letter of the same date. The letter allowed the applicant a period of one month (up to 1 January 2024) in which to request a statement of grounds which can then be used to appeal against the formal decision of refusal. The relevant Form TM5 and fee was filed on 4 December 2023. I should explain that Form TM5 is a formal request for a statement of grounds for the refusal of the application and does not of itself constitute an appeal. In this case, the primary reason for refusal of the application is, in fact, section 37(4) of the Act, whereby the applicant has failed to respond to the examination report of 19 September 2023 within the specified period.

Section 37 of the Act reads as follows:

### **37 Examination of application**

(1) The registrar shall examine whether an application for registration of a trade mark satisfies the requirement of this Act (including any requirements imposed by rules).

(2) For that purpose he shall carry out a search, to such extent as he considers necessary, of earlier trade marks.

(3) If it appears to the registrar that the requirements for registration are not met, he shall inform the applicant and give him an opportunity, within such period as the registrar may specify, to make representations or to amend the application.

(4) If the applicant fails to satisfy the registrar that those requirements are met, or to amend the application so as to meet them, or fails to respond before the end of the specified period, the registrar shall refuse to accept the application.

(5) If it appears to the registrar that the requirements for registration are met, he shall accept the application

5. The examination report of 19 September 2023 comprises the notice under section 37(3) and the mandatory refusal follows, in accordance with section 37(4). That said, it is customary in this type of case for the original and substantive objection under section 3(1)(b) to be reviewed also by the person authoring the statement of grounds, that is, me. In other words, I will not simply be relying on the fact there was no response by the applicant to the examination report, I will additionally be looking below at whether I think the examiner was right in their assessment of the application being ‘devoid of any distinctive character’, under section 3(1)(b) and for the reasons they gave<sup>1</sup>. There was no hearing on this application or submissions by the applicant to counter the examination report, so I only have the papers on file on which to base my substantive decision below.

## **The Law**

6. *Section 3(1) of the Act reads as follows:*

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

*(a) ...*

*(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, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,*

*(d) ...*

*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.*

## **The relevant legal principles – section 3(1)(b)**

7. There are a number of judgments of the Court of Justice of the European Union (“CJEU”) which deal with the scope of article 3(1)(b) of the Directive and Article 7(1)(b) of the Regulation, whose provisions correspond to Section 3(1)(b) of the UK Act. For the avoidance of doubt, it is noted that the Trade Marks Act 1994

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<sup>1</sup> I should explain that I act independently from the examiner and on behalf of the registrar. In that regard I am at liberty to form my own conclusions based on the material before me and am expressly not bound to support the examiner’s view.

is largely derived from EU law (Directive 2015/2436). In relation to the interpretation of such 'retained' or 'assimilated' law, the case law of the Court of Justice of the European Union (CJEU) (including the General Court) issued before the end of the transition period continues to apply, and is binding, as 'retained or 'assimilated' EU case law<sup>2</sup> under section 6 of the Withdrawal Act. I derive the following main guiding principles from the cases noted below:

- The European Court of Justice (ECJ) has repeatedly emphasised the need to interpret the grounds of refusal of registration listed in Article 3(1) and Article 7(1), the equivalent provision in Council Regulation 40/94 of 20 December 1993 on the Community Trade Mark, in the light of the general interest underlying each of them (*Bio ID v OHIM*, C-37/03P paragraph 59 and the case law cited there and, more recently, *Celltech R&D Ltd v OHIM*, C-273/05P).
- The general interest to be taken into account in each case must reflect different considerations according to the ground for refusal in question. In relation to section 3(1)(b) (and the equivalent provision referred to above) the Court has held that "...the public interest... is, manifestly, indissociable from the essential function of a trade mark", *SAT.1 SatellitenFernsehen GmbH v OHIM*, C-329/02P. The essential function thus referred to is that of guaranteeing the identity of the origin of the goods or services offered under the mark to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin (see paragraph 23 of the abovementioned judgement). Marks which are devoid of distinctive character are incapable of fulfilling that essential function.
- An objection under Section 3(1)(b) operates independently of objections under section 3(1)(c) – (*Linde AG (and others) v Deutsches Patent-und Markenamt*, Joined Cases C-53/01 to C-55/01, paragraphs 67 to 68);
- For a mark to possess a distinctive character it must identify the product (or service) in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product (or service) from the products (or services) of other undertakings (*Linde* paragraphs 40-41 and 47);
- A mark may be devoid of distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive (*Postkantoor* paragraph 86);

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<sup>2</sup> In the event this decision issues after 1 January 2024, by virtue of The Retained EU Law (Revocation and Reform) Act 2023, what was previously known as 'retained EU law' will instead be known as 'assimilated EU law'. This is, for the purposes of this decision, a purely technical change and does not alter the decision or the legal principles relied upon in any way.

- A trade mark's distinctiveness is not to be considered in the abstract but rather by reference to the goods or services in respect of which registration is sought and by reference to the relevant public's perception of that mark (Libertel Group BV v Benelux Merkenbureau, Case C-104/01 paragraphs 72-77);
  - The relevant public must be deemed to be composed of the average consumer who is reasonably well-informed and reasonably observant and circumspect (Libertel paragraph 46 referring to Case C-342/97 Lloyd Schuhfabrik Meyer).
8. It is clear from the aforementioned case law that, assuming what is called 'notional and fair use', I must determine whether or not the mark applied for will be viewed by the relevant consumer as a mark capable of denoting a single source of trade origin when used in relation to the goods included in the application. In other words, can the words operate as a unique and individual 'fingerprint', saying to the consumer that the goods bearing or promoted under this term are the goods of a single undertaking. In order to do this, I must first identify who I consider the relevant consumer to be.
  9. As mentioned above, the objection has been maintained against all the goods of Class 13.
  10. When considering these goods, it is my view that the relevant consumer will be the general public; this would include also those organising specific fireworks events. The goods in question are fireworks, including I assume, specific types of fireworks. In making the purchase of such fireworks I would anticipate that a moderate degree of attention would be paid to the purchase which could be online or in person. From my own personal knowledge I would say that, whereas in the past fireworks were purchased largely around specific events such as bonfire night or New Years Eve, these days, fireworks are often purchased all year round for private parties or even, e.g. memorials. However, this fact does not affect my overall findings in this case.

### **The mark applied for**

11. The mark comprises the words 'The Ultimate Fireworks Shop'. I do not believe any of the words will need defining from the perspective of the relevant consumer. They are all well-known words with an obvious and grammatically correct meaning.
12. Had the application been in relation to the retail services of selling fireworks, as distinct from the fireworks themselves then the outcome would be very clear cut in my opinion. In other words, the words 'The Ultimate Firework Shop' would both designate a characteristic of the services (the 'type', 'quality' or 'kind' of service), as well as being also simply 'devoid of any distinctive character' at the

same time and as a consequence of designating a characteristic of the service. This would have given rise to an objection under section 3(1)(c) of the Act ('designates a characteristic') as well as section 3(1)(b) ('devoid of distinctive character'). I should perhaps add that the laudatory words 'The Ultimate.....' are just that, purely laudatory and not adding anything by way of uniquely identifying the undertaking responsible for offering such a service.

13. In this case, there is no objection under section 3(1)(c) of the Act raised by the examiner; the only objection is under section 3(1)(b), being that the application is, simply, devoid of any distinctive character. I need to explain why, in my opinion the application is 'devoid of distinctive character', as the examiner has said, in relation to fireworks themselves, rather than the retail of fireworks. After all, the word 'shop' in the mark does not, on the face of it, 'designate a characteristic' of a firework as such.
14. The reason is that the fireworks themselves and retail of the same are too closely related in my opinion to make any meaningful, legal, distinction. Fireworks are typically sold in shops; they may be larger supermarkets or shops specialising in the sale of fireworks. Such shops may be online or in the context of a physical environment, or both.
15. In this context, and in my opinion a relevant consumer will not make a ready or easy distinction between the products being sold and the means by which they are sold – through a shop. It is rather similar to the situation prevalent in fast food retail – the words, 'The Ultimate Pizza Shop', whether used in relation to the pizza itself or the retail of pizzas would be similarly devoid of distinctive character, in either or both cases. This is because a shop selling food such as a pizza is also likely in the consumer's mind to also be responsible for the production of pizzas and usually on the same site. Can the same be said, though, for fireworks? Even if the fireworks are not made on the same site as the shop selling them I think it quite feasible for a retail outlet, particularly if it is online, to also engage in the manufacture or production of fireworks themselves. A firework is not necessarily a sophisticated item of manufacture; its construction, subject to health and safety measures, would be quite a simple affair. Furthermore, there are as I have said, outlets specifically dedicated to selling fireworks, such is the demand these days, outside the obvious times of popularity such as bonfire night or New Years Eve.<sup>3</sup> In my opinion the examiner was, on the face of it correct then and in the absence of counter argument, to take the view that the term, 'The Ultimate Firework Shop', when used in relation to fireworks would not serve to guarantee the origin of such a product. The term could be used by a number of different undertakings, all of

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<sup>3</sup> There is a useful prior case of the registry BL O/266/02 COMPUTER BOOKSHOPS which explores the question of a retail name being also devoid for associated and closely related products - see paras 19-25.

whom could call themselves 'The Ultimate Fireworks Shop'. At this point I would like to clarify what exactly trade mark distinctiveness means, particularly in contradistinction to what may be considered to be generally 'distinctive' in a broader sense.

**What does devoid of any distinctive character actually mean ?**

15. I have determined I cannot draw any meaningful distinction between the fireworks themselves and the retail or selling of the same. Given however the applicant is unrepresented, I thought I would try to explain the phrase 'devoid of any distinctive character' under section 3(1)(b). This can be a confusing provision.
  
16. By being 'devoid of any distinctive character' under the Act, the examiner says that the words 'The Ultimate Fireworks Shop' will not function as a trade mark to guarantee the origin of the goods of one undertaking from those of another. It is important to recognise then that the word 'distinctive' is being used to indicate capacity to function in a trade mark sense, rather than being simply distinctive in a general sense. The point being made here by the examiner is that the term 'The Ultimate Fireworks Shop' is a term that could, theoretically at least, be used by a number of different undertakings in relation to these goods to indicate the means by which the products are sold, and for that reason alone the term could not serve the function of a trade mark.

**Conclusion**

17. Having considered the relevant case law, I have concluded that the examiner was correct, on the face of it in their original assessment, and for that reason the application is refused in relation to all goods specified.
  
18. The application is refused under section 3(1)(b) of the Act.

Dated this 20<sup>th</sup> day of December 2023

Edward Smith

Hearing Officer, acting for the registrar.