

O-571-17

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK REGISTRATION 2608381

OWNED BY MATZA & CO LIMITED

OF THE FOLLOWING TRADE MARK IN CLASSES 17 & 20:

ZERO GRAVITY

AND

AN APPLICATION FOR INVALIDATION (NO. 501266) BY

PLATINUM ENTERPRISE (UK) LIMITED

Background and pleadings

1. The details of the trade mark registration the subject of these proceedings are:

Mark: **ZERO GRAVITY**

Goods: **Class 17** - Foam, polyurethane foam, semi-processed foamed plastics; foam, polyurethane foam, semi-processed foamed plastics, all for use in manufacture; foam, polyurethane foam and foamed plastics, all in the form of blocks, sheets and/or strips and all for use in manufacture; plastics foam materials for the manufacture of mattresses, pillows, settees, chairs and sofas.

Class 20: Articles made principally of foamed plastics materials; mattresses, pillows; parts made of foam, polyurethane foam and/or foamed plastics for mattresses, pillows, settees, chairs and sofas.

Proprietor: Matza & Co Ltd

Dates: Filed on 27 January 2012, published on 4 May 2012 and registered on 13 July 2012.

2. Platinum Enterprise (UK) Limited is the applicant for invalidation. Its grounds for invalidation are founded on sections 3(1)(b), (c) and (d) of the Trade Marks Act 1994 (“the Act”). The central theme of the grounds is that ZERO GRAVITY is a term which although derives from space exploration research (relating to compressional forces on the human body), it has found its way into everyday items where this “technology and concept” has been applied. In the furniture field, it is said to be descriptive of, and commonly used, in relation to goods which help to maintain the user in a zero gravity position. The proprietor filed a counterstatement denying this.

3. Both sides filed evidence. Both sides have been professionally represented throughout the proceedings, the proprietor by Novagraaf, the applicant by Appleyard Lees IP LLP. Neither side requested a hearing, but I have taken into account all the submissions which have been presented by the parties.

The relevant date

4. A claim to invalidation of a registered trade mark is akin to saying that it should never have been accepted and registered in the first place. Consequently, the grounds for invalidation must have been applicable at first filing, namely, 27 January 2012. This is the relevant date for the purpose of these proceedings.

Legislation

5. The provisions relied upon prevent, respectively, registration of trade marks which are “..devoid of any distinctive character”, “..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” or “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”. Even if a mark falls foul of these grounds, there is a proviso to section 3(1) which means that a registration shall not be refused if the trade mark has acquired a distinctive character through use and, a further proviso to section 47 of the Act, which means that a registration should not be invalidated if it has acquired a distinctive character since registration.

6. I bear in mind that these grounds are independent and have differing general interests. It is possible, for example, for a mark not to fall foul of section 3(1)(c), but still be objectionable under section 3(1)(d) and/or 3(1)(b) of the Act. In *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P, the Court of Justice of the European Union (“CJEU”) stated that:

“25. Thirdly, it is important to observe that each of the grounds for refusal to register listed in Article 7(1) of the regulation is independent of the others and

requires separate examination. Moreover, it is appropriate to interpret those grounds for refusal in the light of the general interest which underlies each of them. The general interest to be taken into consideration when examining each of those grounds for refusal may or even must reflect different considerations according to the ground for refusal in question (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-0000, paragraphs 45 and 46).”

7. In terms of section 3(1)(c), this is the equivalent of Article 7(1)(c) of the Community Trade Mark Regulation, the case-law of which was summarised by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch):

“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 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94, see *Office for Harmonisation in the Internal Market (Trade Marks and 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 for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkuniei*, 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] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR 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].”

8. In terms of section 3(1)(d), in *Telefon & Buch Verlagsgesellschaft GmbH v OHIM*, Case T-322/03, the General Court summarised the case-law of the CJEU under article 7(1)(d), the equivalent of section 3(1)(d) of the Act, as follows:

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

refer to those goods or services, and, secondly, on the basis of the target public's perception of the mark (*BSS*, paragraph 37).

50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (*BSS*, paragraph 38).

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

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

9. Finally, in terms of section 3(1)(b), this is the equivalent of article 7(1)(b) of the Regulation, the principles of which were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (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 *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)."

The evidence

Applicant's evidence

10. The applicant's primary evidence comes from Mr Christopher Hoole, a solicitor at Appleyard Leeds. Much of his evidence is taken from various Internet searches he has conducted (or were previously conducted as part of making the applicant's statement of case).

11. Exhibit 1 contains (and introduces into evidence) the applicant's statement of case, to which was attached various Internet extracts. Ten sources are specifically referred to, as follows:

- i) An article entitled ZERO GRAVITY POSITION EXPLAINED from relaxtheback.com. From various pieces of information such as the use of \$s and US spelling, this appears to be a US website. It describes a particular posture, developed by NASA, which may help alleviate spinal problems and back pain.
- ii) An article headed "What's a zero-gravity massage chair" from the website electronics.howstuffworks.com. Again, there is use of \$s in the text. The article is about the use of the zero gravity position and its incorporation into massage chairs. The writer acknowledges, for obvious reasons, that the chair does not actually defy gravity. There is a garden chair depicted as an example of another chair which utilises the position.
- iii) An article from What's the Best Bed, about adjustable beds. Again, the article has prices in \$s. Within the quite lengthy text, there is a reference to the zero gravity position.
- iv) An extract from The Mattress Department (based in Utah) about the Zero gravity position and its use in adjustable beds.

- v) A print from the website of LargsMobilityCentre which lists a “Zero Gravity Adjustable Bed” costing £820 with a description reading “Mattress has a layer of zero-gravity foam for extra comfort”. It has a copyright date of 2015.
- vi) A print from the website of Comfort Plus Products (which sells mobility products for the elderly and disabled). A recliner chair is depicted, with one of its features identified as having a “zero gravity position”. The company describes itself as a UK company.
- vii) Prints from the website “pic’n’pay furniture” which depicts a number of beds which incorporate mattresses with “zero gravity foam”. They are priced in £s.
- viii) Prints from the website “@Sussex” showing beds with mattresses, one of which has “Advanced Zero Gravity Fillings” and is priced in £s. There is a copyright notice of 2013.
- ix) An extract from the website Tesco Direct showing Palm Springs Zero Gravity Garden Chairs. Some accompanying text reads: “Zero gravity chairs need to be a part of your life for the simple reason that they ease muscular tension and relieve the pressure on your spine”.
- x) A print from amazon.co.uk for a “Zara” Zero Gravity Leisure Lounger”. Accompanying text reads “The Zara Lounger is zero gravity adjustable.”. There is an indication that the product was first available on amazon.co.uk on November 2015. There are, though, reviews from earlier than that, the earliest being from June 2013.

12. The same exhibit also includes the examination report for the subject registration. Furthermore, beyond the 10 specifically commented upon sources, the following also appears:

- xi) A print from the website of a company called Mattress Firm which is priced in \$s (although possibly not US\$s given other content) showing an

adjustable bed which is equipped with “zero gravity, lounge and TV viewing positions”.

- xii) A website of unknown origin depicting various adjustable beds, one of which, The Serta Motion, can adopt the “zero gravity position”.
- xiii) A website from another unknown source depicting what is described as a Zero Gravity Lawn Chair.
- xiv) A website of unknown origin providing a review, from January 2013, of adjustable beds. The first contains the text “The ergonomic hand control offers massage, zero gravity and convenient back lighting”. A table at the end of the reviews lists prices in \$s.
- xv) A print from the website Relax in Comfort with a category headed “Zero Gravity & Massage Chairs” with a specific product listed as PC500 Silhouette Zero-Gravity Recliner. It is listed in \$s.
- xvi) A print from the website “What’s the Best Bed” dated from May 2013 about adjustable beds. As part of the explanation of their therapeutic benefits, reference is made to the Zero gravity position. This, again, appears to be a US website.

13. In addition to all of the above contained in the statement of case, a further search has been conducted with more hits provided, as follows:

- Exhibit 2 consists of a print from goodbed.com in which a question has been asked reading “what is zero gravity foam?”. Three answers are provided, one relates to foam used in mattresses as a marketing term for foam which relieves back pressure by giving the allusion of weightlessness. Another answer relates to the position adopted by adjustable beds and is described as a buzzword. Another refers to a state of relaxation to aid sleep. This is all dated 2013. There is nothing to suggest that this is UK use.

- Exhibit 3 - A print from Amazon.co.uk dated 5 October 2015 showing a Comfort Dreams Zero Gravity Adjustable 3 piece wedge system. The wedges put the user in bed into what looks like the zero gravity position as described earlier.
- Exhibit 4 – A print from LivingSocial.co.uk for an “Extra deep Zero Gravity Memory Foam Mattress” priced in £s. There is a reference to the voucher used to obtain the product as expiring in January 2017.
- Exhibit 5 – A print from the website “The Happy People” which uses the words ZERO GRAVITY CHAIRS which then depicts something similar to the wedge system placed on top of a bed.
- Various extracts from myzerogravitychair.com. Products are listed, but the earliest date I can find is from 2015. There is reference in the material to zero gravity chairs being easier to find in the US, where they are more popular than the UK.

14. Mr Hoole states that zero gravity, therefore, describes a position in which a person’s weight is evenly spread and is used in the ergonomic design of beds, chairs, mattresses and pillows. He then refers to the proprietor’s own use as supporting the objection. The material is included in Exhibit 8. The prints provided include the words ZERO GRAVITY (inside an apple) with text reading:

“Zero Gravity is a unique new sleeping surface that harnesses the very best of foam technology. Sink-in support provides a responsive yet weightless sleeping experience.”

15. Reference is made to Zero Gravity Foam being developed by Matza. Exhibit 9 is said to be use by the proprietor’s licensee, Highgate Beds, which also uses the words ZERO GRAVITY and which includes reference to “The Zero Gravity technology has the combined feel of memory and latex”. It also includes the text “Zero Gravity TM Technology is an advance development and really innovative in the way it works”.

16. Mr Hoole completes his evidence by providing submissions outlining why the application to invalidate the registration should succeed.

The proprietor's evidence

17. The proprietor's evidence comes from Mr Sam Panasuik, its account manager. His evidence is about the use made by the proprietor and its licensee, Highgate Beds. The number of ZERO GRAVITY mattresses sold has ranged from 18k in 2012 to 21k in 2016. Its promotional spend (I list the provided advertising costs) has ranged from £250 in 2012 to £18k in 2016. Sales by Highgate Beds have ranged from 1263 mattresses in 2012 to 4000 in 2016. Various exhibits are provided showing use of its ZERO GRAVITY mark. For reasons that will become apparent, I do not consider it necessary to detail all of this here, but note, for example, that the use is not inconsistent with the use shown in the applicant's evidence, including use within the apple logo. Use includes prominent use on labels, brochures etc, and, also, being sewn into the mattress itself.

The applicant's reply evidence

18. This comes, again, from Mr Hoole. Much of what he says consists of a critique of the proprietor's evidence. I note the following:

- A discussion about when the applicant became a member of the National Bed Federation and doubts raised as to the accuracy of certain information given by Mr Panasuik, such as his claim that he has been accounts manager for more than 10 years, yet the company had only been incorporated for 6.
- It is noted by Mr Hoole that Mr Panasuik acknowledges that ZERO GRAVITY was a perfect name for the goods as it suggests a feeling of great comfort.
- That nothing is provided to support the sales/advertising figures.
- That the number of sales is nominal and would represent only a very small market share.

- That certain photographs of vans are computer generated not actual photographs.
- That nothing is provided setting out the relationship between the proprietor and Highgate beds and questions raised about whether the sales are under the mark.
- That many of the supporting exhibits refer to weightlessness and cross reference NASA and that the term is sometimes used in non-capitalised form.

Section 3(1)(d) of the Act

19. Under section 3(1)(d), I must be satisfied that the sign ZERO GRAVITY is “...customary in the current language or in the *bona fide* and established practices of the trade”. Further guidance on how to apply this provision can be seen in *Merz & Krell GmbH & Co* [2002] ETMR 21, where the (“CJEU”) stated:

“24 Accordingly, signs or indications that are not capable of fulfilling the essential function of a trade mark cannot enjoy the protection conferred by registration. As is made clear by the tenth recital in the preamble to the Directive, the purpose of the protection afforded by the registered trade mark is in particular to guarantee that trade mark’s function as an indication of origin.

25 Article 3(1)(d) of the Directive must be interpreted in the light of those considerations.

26 Under Article 3(1)(d) of the Directive, trade marks which consist exclusively of signs or indications which have become customary in the current language or trade practices are to be refused registration.

27 It is true that, unlike Paragraph 8(2)(3) of the Markengesetz, which refers to trade marks that consist exclusively of signs or indications which have become customary in the current language or trade practices “to designate the goods or services”, Article 3(1)(d) of the Directive contains no such qualification. It

cannot, however, be concluded from that that, in order to assess the merits of an application for registration of a trade mark, account should not be taken of the connection between the signs or indications constituting the trade mark and the goods or services covered by that mark.

28 The purpose of Article 3(1)(d) of the Directive is to prevent the registration of signs or indications that are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and so do not satisfy the criterion laid down in Article 2 of the Directive.

29 The question whether particular signs or indications possess distinctive character cannot, however, be considered in the abstract and separately from the goods or services those signs or indications are intended to distinguish.

30 That finding is corroborated by Article 3(3) of the Directive. As the Court held at paragraph 44 of the judgment in *Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee [1999] E.C.R. I-2779*, it is through the use made of it that such a sign acquires the distinctive character which is a prerequisite for its registration under that provision. However, whether a sign does have the capacity to distinguish as a result of the use made of it can only be assessed in relation to the goods or services covered by it.

31 It follows that Article 3(1)(d) of the Directive must be interpreted as only precluding registration of a trade mark 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.”

.....

41 It follows that Article 3(1)(d) of the Directive must be interpreted as meaning that it subjects refusal to register a trade mark to the sole condition that the signs or indications of which the trade 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. It is immaterial, when that provision is applied, whether the signs or indications in question describe the properties or characteristics of those goods or services.”

20. In *Stash Trade Mark* BL O/281/04, Prof Annand (sitting as the Appointed Person) provided further guidance, stating:

33. In the event, I do not believe this issue of the interpretation of section 3(1)(d) is central to the outcome of the appeal. “Customary” is defined in the Oxford English Reference Dictionary, 1995 as: “usual; in accordance with custom”. In my judgment, the Opponent has failed on the evidence to prove that at the relevant date STASH contravened section 3(1)(d) as consisting exclusively of signs or indications which have become customary either in the current language or in trade practices for the goods concerned.”

21. The evidence relied upon by the applicant is set out above. Much (although not all) represents use that has been made in the US as opposed to the UK. I have serious reservations that even taking all of the UK use into account that there is sufficient evidence to show customary use in the UK (either in the current language or in trade practice), even now. However, the position is significantly worse when one bears in mind the relevant date in January 2012. There is no evidence at all (certainly not from a UK perspective) to show that there has been any use prior to the relevant date. Whilst later evidence can sometimes cast light backwards, this is not the sort of case where any reliable indications can be taken. These issues were highlighted by the proprietor in the submissions attached to its evidence. I agree with it that the evidence is wholly insufficient to support a ground under section 3(1)(d) of the Act. The ground fails.

Section 3(1)(c) of the Act

22. The question here is whether the words ZERO GRAVITY comprise a direct description of the goods or some characteristic(s) of them. The perception of the

relevant public (which can include consumers and those in trade) is an important factor. Again, the position must be judged at the relevant date in January 2012.

23. I accept that the term ZERO GRAVITY has some suggestive qualities, alluding to a feeling of weightlessness and, in turn, comfort. This is what the proprietor's witness also appears to accept when it refers to the mark as being a good name. I do not accept, though, that this is an acceptance of descriptiveness. In terms of whether the mark will be perceived as more than a mere allusion, and cross the border into descriptiveness, is another matter. Whilst it may have been the case that a zero gravity position is known in certain quarters (those familiar with space exploration; though the evidence on this is not particularly strong), I am doubtful whether the consumer of the relevant goods, or those in the trade, will be particularly familiar with the term as indicating a particular position, let alone whether they would regard it as a term that has applicability to describe a position that can be adopted for certain furniture items. There is greater use of the phrase in the US, but, there is no real reason to suppose that those in the UK trade will be particularly familiar with that, nor is the evidence focussed enough on the relevant date to show that it was even a recognised term in the US before the making of the application.

24. Based on the above, I am left with the view that the mark is merely suggestive/allusive and is not one which provides a description of the relevant goods. Nor do I think that in January 2012, there was any particular need to keep the mark free for the legitimate future use by other traders. The ground fails.

Section 3(1)(b) of the Act

25. Whilst this ground of objection is independent of the other grounds, I see no material difference in how it is pleaded. The claim is that the mark is devoid of distinctiveness because it is descriptive/generic. Given my findings under sections 3(1)(b) and (d), this ground also fails.

Distinctiveness acquired through use

26. Given my findings, it is not necessary to consider whether the mark has acquired distinctiveness through use.

Costs

27. The proprietor has been successful and is, therefore, entitled to a contribution towards its costs. My assessment, based upon the published scale, is set out below:

Preparing a statement of case and considering the counterstatement - £400

Filing and considering evidence and accompanying submissions - £1000

Total - £1400

28. I order Platinum Enterprise (UK) Limited to pay Matza & Co Limited, the sum of £1400 within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 15th day of November 2017

Oliver Morris

For the Registrar,

The Comptroller-General