**TRADE MARKS ACT 1994** **O/682/21**

**IN THE MATTER OF:**

**TRADE MARK APPLICATION No. 3361324**

**IN THE NAME OF TEFAL S.A.S.**

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**DECISION**

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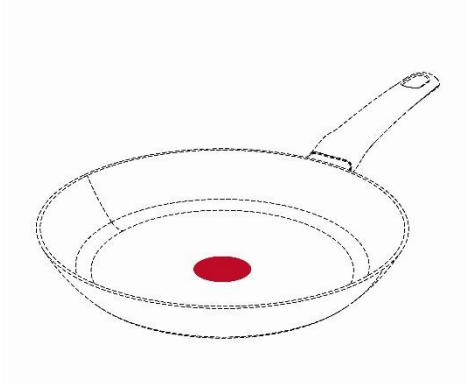
1. The Registrar of Trade Marks determined for the reasons given by Mr Edward Smith in his Decision issued on 23 November 2020 under reference BL O/587/20 that the following sign consisting of *"**a plain red dot affixed centrally to the bottom of a cooking receptacle**"* lacked distinctiveness (and was accordingly caught by the exclusion from registration contained in s. 3(1)(b) of the Trade Marks Act 1994) for *"Frying pans, saucepans, casseroles, stew-pans, cooking pots, crepe pans, grills, woks"* in Class 21:



2. The applicant for registration (Tefal S.A.S.) contends on appeal before me under s. 76 of the 1994 Act that the Hearing Officer erred by refusing to accept that the sign in question had acquired a distinctive character through use in the United Kingdom prior to the date of the relevant application for registration (application number 3361324 filed on 17 December 2018).

3. In paragraph 3 of its Grounds of Appeal it maintains that the Hearing Officer's Decision *"in so far as it finds that the Appellant has not sufficiently demonstrated that it has acquired distinctiveness for the mark in question in order to overcome the objection under Section 3(1)(b), was wrong"* for reasons which it expands upon in paragraphs 3.1 to 3.6.

4. I begin by observing that paragraphs 3.1 to 3.6 do not separately or together provide a sustainable basis for maintaining that the Hearing Officer's Decision was vitiated by error.

- **Paragraph 3.1 of the Grounds of Appeal**

5. The Appellant asserts that the Hearing Officer erred in principle by assessing its claim for acquired distinctiveness on the basis that the rationale of paragraphs [77] to [84] of the Judgment of the Court of Appeal in Societe des Produits Nestle S.A. v Cadbury UK Ltd [2017] EWCA Civ 358 *"unequivocally requires the applicant to have used the sign applied for as a trade mark"*.

6. At paragraph [80] of the Judgment of the Court of Appeal in Nestle v Cadbury, Kitchin LJ emphasised that *"there can be no dispute"* about the test for acquired distinctiveness envisaged by the Judgments of the CJEU in Case C-353/03 Societe des Produits Nestle S.A. v Mars UK Ltd EU:C:2005:432 and Case C-215/14 Societe des Produits Nestle S.A. v Cadbury UK Ltd EU:C:2015:604: *"The tribunal must consider whether the applicant has proved that a significant proportion of the relevant class of persons perceive the goods or services designated exclusively by the mark applied for, as opposed to any other mark which might also be present, as originating from a particular undertaking. In short, the mark itself must be seen as a badge of origin"*.

7. That, in substance, is the approach which the Hearing Officer said he was adopting and which he did indeed apply for the purposes of his assessment of the evidence before him. He cannot be criticised for proceeding on that basis.

- **Paragraph 3.2 of the Grounds of Appeal**

8. The Appellant maintains that in reaching a conclusion *"as to what measure, if any, of 'trust' or 'confidence' [the Applicant] has placed in its sign, such that it has educated the public to it being a guarantee of origin"* the Hearing Officer wrongly *"disregard[ed] the Appellant's survey evidence, which relates exclusively to the sign applied for alone, and makes no reference to the word mark 'TEFAL'"*.

9. However, it is not correct to say that the Hearing Officer disregarded the Appellant's survey evidence. He considered it in detail. Having done so, he found that it was not sufficient to establish what needed to be proved in accordance with paragraph [80] of the Judgment of the Court of Appeal in Nestle v Cadbury (see paragraph 6 above).

- **Paragraph 3.3 of the Grounds of Appeal**

10. The Appellant maintains that the Hearing Officer did not go as far as he should have gone to negate the approach of a previous Hearing Officer (Mr Mark Jefferiss, since retired) who had at an earlier stage of the present proceedings supposedly *"erred in disregarding the Appellant's evidence which demonstrates use of the sign but with a letter 'T' embossed over the top"*.

11. This fails to acknowledge the force of the Hearing Officer's express rejection of what the previous Hearing Officer had said on that subject: *"The [previous] hearing officer's views were at the least capable of being misconstrued in this respect and furthermore, the evidence does not only show use with the letter 'T', in any event, and so any suggestion that the only use relevant for the purposes of showing acquired distinctiveness would have been that showing only a red spot, without the letter 'T', is plainly, in law and based on the available evidence, unsustainable."*

12. I return below to the fact that the Hearing Officer does not appear to have taken account of the reasoning of the General Court (Ninth Chamber, Extended Composition) in Case T-307/17 adidas AG v EUIPO EU:T:2019:427 at paragraphs [50] to [63] (affirming that evidence for the purpose of substantiating a claim for distinctiveness acquired through use should show *"use of the mark in the form in which it was submitted for*

*registration and … in forms which differ from that form solely by insignificant variations … that are able, therefore, to be regarded as broadly equivalent to that form"*) and paragraphs [70] to [73] (affirming that *"where a trade mark is extremely simple, even minor alterations to that mark may constitute significant changes, so that the amended form may not be regarded as broadly equivalent to the mark as registered. Indeed, the simpler the mark, the less likely it is to have a distinctive character and the more likely it is for an alteration to that mark to affect one of its essential characteristics and the perception of that mark by the relevant public"*).

- **Paragraph 3.4 of the Grounds of Appeal**

13. The Appellant maintains that the Hearing Officer did not go as far as he should have gone to negate the approach of the previous Hearing Officer (Mr Mark Jefferiss, since retired) who had at an earlier stage of the present proceedings supposedly been *"overly harsh"* in his *"criticism of the Appellant's survey evidence"*.

14. However, the Hearing Officer did what he was required to do: he examined the evidence (including the survey evidence) before him with a view to deciding for himself whether it established what needed to be proved in accordance with paragraph [80] of the Judgment of the Court of Appeal in Nestle v Cadbury (see paragraph 6 above).

15. I return below to the fact that he did so without expressly referring to the 'Guidelines' for assessing the probative value of such evidence as set out in the Judgment of the Court of Appeal in Interflora Inc. v Marks & Spencer Plc [2012] EWCA Civ 1501 at paragraphs [61] (i) - (vii) per Lewison LJ.

- **Paragraph 3.5 of the Grounds of Appeal**

16. The Appellant maintains that *"… the survey evidence is very clearly part of a larger body of evidence. The Hearing Officer was clearly wrong to conduct an artificially separate assessment of the survey evidence without the context of the full body of evidence presented by the Appellant."*

17. There is no substance in this criticism. Early on in his Decision the Hearing Officer noted that: *"... the examiner or hearing officer is under an obligation to evaluate the evidence of acquired distinctiveness as a whole, as and when it is presented. Any survey will generally only be part of that corpus of evidence."* (paragraph [6]). He made the same point in paragraph [42]. It is apparent from the remainder of his Decision that he assessed the body of evidence before him from that perspective. The Appellant's suggestion to the contrary fails to recognise and properly allow for the fact that: *"... a judgment is, by its very nature, a linear structure; in common with every other linear structure, it has a beginning, a middle and an end."*: Re G (A Child) [2013] EWCA Civ 965 at paragraph [54] per McFarlane LJ.

- **Paragraph 3.6 of the Grounds of Appeal**

18. This asserts that *"While the Hearing Officer alleges to have considered the 'totality of the evidence' ... the Appellant contends that the Hearing Officer's workings clearly demonstrate that he in fact incorrectly considered each individual piece of type of evidence separately, failing to consider it together as a complementary bundle. The Appellant contends that, when the evidence is properly assessed as a whole, it has met all requirements for the demonstration of acquired distinctiveness."*

19. There is, as I have noted in paragraph 17 above, no substance in the first limb of this criticism. The second limb of the criticism serves to confirm that the aim of paragraphs 3.1 to 3.6 in the context of the opening words of paragraph 3 of the Grounds of Appeal is basically to draw this Tribunal into re-taking the Decision on acquired distinctiveness in the guise of reviewing it for error.

20. At this point I must emphasise that it is necessary, in order to maintain the required distance and separation between the role of decision taker at first instance and the role of decision taker on appeal, for this Tribunal to proceed on the basis that the Decision below should stand unless the matters on which the Appellant relies are by force of what they reveal sufficient to establish that it was not open to the Hearing Officer, on the evidence and materials before him, to come to the conclusions he did for the reasons he gave.

21. I can see that the Hearing Officer correctly reminded himself of the well-established requirement for a full and stringent examination to be carried out for the purpose of determining whether the sign in question was eligible for registration under s.3 of the 1994 Act: paragraphs [15] to [20].

22. I note that in paragraphs [34] to [41] he summarised the evidence relied on by the Appellant in support of its claim for distinctiveness acquired through use. So far as I can see from the Grounds of Appeal and the Appellant's Skeleton Argument for the Appeal, there is no challenge to the accuracy of that summary.

23. In the course of his "Evaluation of the evidence of acquired distinctiveness" running from paragraph [42] through to paragraph [57], the Hearing Officer observed: *"... the mark may have been used, sometimes with the letter 'T' being prominent or visible, and on other occasions not. In principle and by reference to the actual evidence, this is not an issue for me"*. By that he meant that he accepted the Appellant's contention to the effect that its claim for distinctiveness of ***"a plain red dot affixed centrally to the bottom of a cooking receptacle"*** could be substantiated by evidence showing what seems from the papers on file to have been to a large extent use of a red dot with the letter 'T' superimposed upon it, as exemplified by this image taken from Exhibit NY 18 to the Witness Statement of Mr Nabil Yanar filed in support of the application for registration:

24. It does not appear from his Decision that the Hearing Officer directed himself to the question whether the sign and variant he was considering were *"broadly equivalent"* according to the *"insignificant variations"* test adopted by the General Court in Case T-307/17 adidas AG (see paragraph 12 above) and it is not self-evident that he proceeded in conformity with that test. However, for present purposes it suffices to say that the Appellant was not disadvantaged by the Hearing Officer's adoption of what I consider to be the somewhat more lenient *"permissible variations"* test that is applied for the purpose of determining whether there has been *"genuine use"* of a trade mark in proceedings for revocation on the ground of non-use: Case C-12/12 Colloseum Holding AG v. Levi Strauss & Co EU:C:2013:253 at paragraphs [25] to [36]; Case C-252/12 Specsavers International Healthcare Ltd v Asda Stores Ltd EU:C:2013:497 at paragraphs [17] to [31].

25. In real life, the 'spot' does not begin to glow red until the 'cooking receptacle' which incorporates it is heated to the temperature required to make that happen. In paragraph [44] the Hearing Officer expressed his *"grave concern that the applicant's exposure of its sign … is, and has been all along, an indicator of heat rather than an arbitrary or random red spot. If the sign has been used to achieve a technical effect, as an optimal heat indicator to show the consumer when the pan is hot enough to start frying or cooking, in my opinion this would militate, at the very least, against any perception that might have arisen that the use was as a trade mark and a guarantee of origin."*

26. In paragraphs [45] and [46] he cited examples from the evidence of the sign being presented and promoted as a THERMO-SPOT: *"This heat indicator changes its appearance depending on the temperature of the pan. With this new tool, cooks can now see when the pan has reached the right temperature."* and *"Tefal's unique heat indicator lets you know when your pan is perfectly pre-heated and ready to cook."* Having considered the material exhibited to Mr Yanar's Witness Statement, I think it is clear that the functionality of the sign as a temperature gauge has been an enduring theme of the Appellant's advertising and promotion of it over the period to which the evidence relates.

27. The Hearing Officer returned to this point in paragraph [54] of his Decision in the context of his assessment of the survey evidence:

> 54. I have already mentioned above at paras 44-47 my concerns that the applicant's use as a trade mark had been tainted by the fact that it was, in reality, a sign which resulted from, and was intended to fulfil, a technical effect. These concerns are actually reinforced by the survey results which can be found at Exhibit SJ1 to the Witness Statement of James Hickson. In response to Question 2, no less that 65 of the 400 responders indicated that the sign showed a 'heat spot', or an alternative term such as 'hot spot', or even 'when the pan is hot enough', that is 16.75%. In the Midlands, the proportion is significantly higher, 36 out of 105 (34.2%), referenced the technical nature of the sign. I regard these figures as critically undermining the applicant's claim that the sign is simply a 'Famous Red Spot', suggesting a wholly random or arbitrary sign. In other words, this is a sign which, in the eyes of many of the relevant consumers, cannot, in fact, be divorced from its technical function. I would also note in passing that I have no difficulty in looking critically at the survey results rather than simply accepting Mr Hickson's account of the results. This was, after all, exactly what was done in the *Land Rover* case above and approved of on appeal.

28. The survey respondents were asked to answer the following questions with reference to a showcard which reproduced the sign graphically represented in paragraph 1 above:

> 1) We are conducting a survey and would like to speak to people who buy cookware products. Do you buy cookware products?
>
> Response:
> NO – Take no further
> YES – Continue to question (2)
>
> 2) In the context of cookware products, when you see this [show card displaying trade mark] what, if anything, comes to mind?
>
> Response:
> If Tefal is mentioned then conclude here.
> If Tefal is not mentioned, then move on to question 3)
> If the response is unclear, ask if they are able to expand further and clarify what they mean,
>
> 3) In your opinion, would a product showing this [show card displaying trade mark] come from any particular company?

Response:
NO – Take no further
YES – Continue to question 4)

4) Which company would you understand the product comes from?

29. The instruction *"If Tefal is mentioned then conclude here"* assumed that mentions of *Tefal* in response to Question 2 could, without any further probing, be treated as instances of recognition of the sign as a trade mark. And that is indeed the way in which such mentions were counted for the purposes of the Appellant's submissions.

30. However, the mentions of *Tefal* were, in and of themselves, inconclusive with regard to the claim for acquired distinctiveness. That is because it was not possible to say where they sat in relation to the important distinction between *"on the one hand, an applicant proving that as a result of the use he has made of the mark, the relevant class of persons perceive the goods designated exclusively by that mark, as opposed to any other mark which might also be present, as originating from a particular source and, on the other hand, an applicant proving only that a significant proportion of the relevant class of persons recognise the mark and associate it with the applicant's goods"*: see Nestle v Cadbury (above) at paragraphs [44] and [77] per Kitchin LJ.

31. Questions 3 and 4 were designed to steer survey respondents who had not mentioned *Tefal* in response to Question 2 into identifying *Tefal* as the "*particular company"* which *"a product showing this [show card displaying trade mark]"* would come from. As the Hearing Officer pointedly observed in paragraph [55] of his Decision: *"That 58% chose to reject the 'yes' answer or their answer simply isn't recorded, or worse for the applicant, for them to give the opposite answer to the one intended, is interesting to say the least"*.

32. The Hearing Officer was entitled to find that the survey evidence provided support for his view that the sign *"was, in reality, a sign which resulted from, and was intended to fulfil, a technical effect"* (paragraphs [44] and [54]) and also that it *"only goes to the question of 'association' with the applicant, and not, as required by the case law ('Kit Kat' and the cases that preceded and foreshadowed it) use as a trade mark"* (paragraphs [47] and [53]).

33. He did not expressly assess the probative value of the survey evidence by reference to the Interflora 'Guidelines'. In support of its contention that the survey evidence was sufficient to substantiate its claim for distinctiveness acquired through use, the Appellant maintained before me that the requirements of those 'Guidelines' were satisfied in the present case.

34. I take as my starting point the observations of Arnold LJ in Glaxo Wellcome UK Ltd v Sandoz Ltd [2019] EWHC 2545 (Ch) at paragraphs [218], [219]:

> 218. It is well known that, in any form of survey or opinion polling, the wording of the questions has a very significant influence on the responses. In the context of surveys for the purposes of trade mark and passing off proceedings, this problem is compounded by the fact that trade mark and passing off law is concerned with people's unconscious assumptions. As soon as you start asking people questions designed to ascertain those unconscious assumptions, you risk the process distorting what you are trying to test. One of the well-known phenomena this gives rise to is respondents treating the questionnaire like a quiz, and searching for the answers they should give in the questions. These problems are rendered even more severe if the questionnaire seeks responses to an artificial stimulus (such as a colour sample rather than actual packaging). It is for these reasons that the courts of England and Wales have for a long time laid down guidelines which need to be followed by those carrying out such surveys if the evidence is to be relied upon. It does not matter for present purposes whether compliance with these guidelines is a requirement for admissibility or goes to weight, and I will assume the latter
>
> 219. The basic guidelines, often referred to as "the Whitford Guidelines", were formulated by Whitford J as long ago as 1984 in *Imperial Group plc v Philip Morris Ltd* [1984] RPC 293 (an unsuccessful passing off claim concerning the use of the colours black and gold on cigarette packaging) at 302-303. More recently, these guidelines were endorsed by the Court of Appeal in *Interflora Inc v Marks & Spencer plc* [2012] EWCA Civ 1501, [2013] FSR 21. In that case Lewison LJ summarised the guidelines at [61] as follows:
>
> i) if a survey is to have any validity at all, the way in which the interviewees are selected

must be established as being done by a method such that a relevant cross-section of the public is interviewed;

ii) any survey must be of a size which is sufficient to produce some relevant result viewed on a statistical basis;

iii) the party relying on the survey must give the fullest possible disclosure of exactly how many surveys they have carried out, exactly how those surveys were conducted and the totality of the number of persons involved, because otherwise it is impossible to draw any reliable inference from answers given by a few respondents;

iv) the questions asked must not be leading; and must not direct the person answering the question into a field of speculation upon which that person would never have embarked had the question not been put;

v) exact answers and not some sort of abbreviation or digest of the exact answer must be recorded;

vi) the totality of all answers given to all surveys should be disclosed; and

vii) the instructions given to interviewers must also be disclosed.

- **Guideline 1**

35. The Appellant commissioned an external agency to conduct the survey. The survey was *"designed to achieve a statistically significant representative cross-section of the general population within the UK."* (Hickson, para.5)

36. The survey interviews were conducted between 7 and 11 May 2019. Results were provided for a total of 400 respondents who had been questioned in unspecified circumstances at unidentified locations in "the Midlands" (105 respondents), "the North of England" (91 respondents), "the South of England" (156 respondents) and "Scotland" (48 respondents).

37. In written submissions dated 17 May 2021, the Appellant confirmed that the respondents were randomly selected and filtered only to the extent of the first question within the survey.

38. The respondents had by answering Question 1 in the affirmative identified themselves as people who *"buy cookware products"*. That was enough to make them eligible for inclusion in the survey regardless of whether they were previously aware of any use in the market place of **"a plain red dot affixed centrally to the bottom of a cooking utensil"** as graphically represented on the showcard. They were not directly asked for any information about their involvement in buying *"cookware products"* or their awareness or otherwise of the sign in question. No information was provided with regard to any aspects of their personal attributes or individual characteristics. The evidence on file is notably silent as to whether any such information was or was not obtained from them in connection with the survey.

39. The information deficit in relation to the matters I have noted in paras 36 and 38 above increased the difficulty of determining how far the randomly selected survey respondents represented a cross-section of people whose responses could be treated as relevant for the purposes of the task in hand.

40. The nature of that task was clear from the Judgment of the CJEU in Joined Cases C-217/13 and C-218/13 Oberbank AG v. Deutsche Sparkassen-und Giroverband eV EU:C:2014:2012:

> "It is … settled case-law that, whether inherent or acquired through use, the distinctive character of a mark must be assessed in relation, on the one hand, to the goods or services covered by that mark **and, on the other, to the presumed expectations within the trade circles concerned, that is to say, an average consumer of the category of goods or services in question who is reasonably well-informed and reasonably observant and circumspect**" (para. [39]);
>
> "As regards the question how to determine whether a mark has acquired a distinctive character through use, it is settled case-law that the competent authority for registering trade marks must …make an overall assessment of the evidence that the mark has come to identify the goods or services concerned as originating from a particular undertaking … **Moreover, that evidence must**

**relate to the use of the mark as a trade mark, that is to say for the purposes of such identification by the relevant class of persons** …" (para. [40]).

41. Relevance is for the purposes of such assessment inseparable from the question whether the sample set for the survey was populated with respondents whose attributes and characteristics indicated that their responses could collectively (for statistical analysis) be taken to shed light on the way the sign in question was liable to be perceived and remembered by a reasonably well-informed and reasonably observant and circumspect average consumer of *"frying pans, saucepans, casseroles, stew-pans, cooking pots, crepe pans, grills, woks"*.

42. The evidence and materials on file do not establish that the survey was designed and implemented with an effective procedure for identifying and systematically selecting such respondents for inclusion in the sample set. I do not consider that Question 1 was sufficient, in and of itself, to achieve that. The procedural deficit went hand in hand with the information deficit.

43. I am not satisfied that the survey method can be taken to have fulfilled the requirements of Guideline 1.

- **Guideline 2**

44. *"It was determined that a survey of 250 people across the UK would be an appropriate cross-section in this project."* (Hickson, para. 5). The evidence on file is silent as to when, why and how it was subsequently decided to increase the number of randomly selected respondents to 400.

45. I do not rule out the possibility that a survey of 400 respondents might be numerically sufficient in other circumstances to produce some relevant result on a statistical basis. However, I do not consider that it can be taken to have been numerically sufficient for that purpose in the context of survey results affected by the procedural deficit and information deficit referred to above.

- **Guideline 3**

46. Compliance with the requirements of Guideline 3 is not addressed in or affirmatively proven by the evidence on file. There is, in particular, a large hole in the evidence with regard to *"exactly how those surveys were conducted"*.

- **Guideline 4**

47. Question 2 is apt to be perceived by the person answering it as a test of his or her capacity to come up with an answer. Question 3 takes that a stage further by attempting to steer people who 'failed' to link the sign on the showcard to *"a product ... from any particular company"* into coming up with an answer to that effect. Question 4 then asks the respondent to come up with the name of a particular company which they would *"understand the product comes from"*. I consider that Question 3 (and Question 4 in combination with Question 3) interacts with Question 2 in a way which fails to comply with the requirements of Guideline 4.

- **Guideline 5**

48. Exhibit SJ1 contains what the Appellant has referred to as *"the raw data of the survey"*. The information it provides was organised and laid out in tabular form in 7 columns under the headings: **Resp.ID**; **Q1**; **Location**; **Q2**; **Is Tefal mentioned**; **Q3**; **Q4**.

49. The evidence on file is notably silent as to whether the snippets of text set out in the columns under the headings **Q1**, **Q2**, **Q3** and **Q4** completely and accurately transcribe what originally were *"exact answers and not some sort of abbreviation or digest of the exact answer"* given by the individual survey respondents. There is, as I have said, a large hole in the evidence with regard to *"exactly how those surveys were conducted."*

50. Experience has shown as Jacob J observed at first instance in Neutrogena Corporation v. Golden Ltd [1996] RPC 473 at 486 that: *"[P]ure questionnaire evidence is seldom helpful – there are almost inevitable faults with the questions or the records of the answers as well as in the later stages of the processing."* It is not apparent from Exhibit 1 whether or to what extent there was any probing as required by the Questionnaire in relation to responses to Question 2 which were *"unclear"*. If the survey respondents did nothing other than utter the words specifically ascribed to them in 'Exhibit SJ1',

they would in substantially more than a few instances have been communicating quite unnaturally with the people interviewing them. In my view, these are more likely to have been instances of interviewers recording the gist or thrust of the answers they received than instances of respondents speaking tersely in limited terms as recorded in that Exhibit. I consider that compliance with the requirements of Guideline 5 is neither self-evident nor proven in the present case.

- **Guideline 6**

51. Compliance with the requirements of Guideline 6 is not addressed in or self-evident from the evidence on file. There is, in particular, no evidence to the effect that the survey work which yielded the survey results reported in 'Exhibit SJ1' was the only survey work undertaken in connection with the present claim for acquired distinctiveness of the sign in question.

- **Guideline 7**

52. The Appellant maintains that *"full details of the instructions issued to the interviewers"* are set out in the Witness Statement of Mr Hickson (the survey co-ordinator).

53. Mr Hickson simply says that the respondents were selected at random (para.12), that the surveys were conducted using hand held tablets and a separate colour stimulus show card (para.13) and that the responses were obtained without the interviewers mentioning any brands or companies to any of the respondents (para.15). He says nothing about the instructions issued to the interviewers. The details of the instructions they were given are conspicuous by their absence from his Witness Statement. I consider that the evidence on file fails to comply with the requirements of Guideline 7.

54. My overall conclusion in relation to the survey evidence is that it cannot bear the weight that the Appellant seeks to place upon it for the purposes of its Appeal against the Hearing Officer's Decision.

55. The Appellant filed evidence at first instance in the form of a Witness Statement from Mr William Jones, the Chief Operating Officer at BHETA (the British Home

Enhancement Trading Association) in which he stated: *"A round red spot at the centre of a frying pan is known in the industry and understood as an indication that the product originated from Tefal. I am not familiar with other producers and suppliers using a round red spot in the centre of a frying pan."* (para. 2).

56. The Hearing Officer referred to this Witness Statement narratively in paragraph [37] of his Decision, but said no more about it in his assessment of the evidence. Mr Jones' observations were not conclusive as to the way in which the sign in question was liable to be perceived and remembered by a reasonably well-informed and reasonably observant and circumspect average consumer of goods of the kind to which the claim for acquired distinctiveness related. More specifically, his evidence did not preclude the Hearing Officer from deciding the case as he did on the basis of the need to recognise that perceptions and recollections of 'association' do not always or necessarily connote 'distinctiveness'.

57. In the final analysis, the Decision under appeal proceeded without material error to give effect to the well-established proposition that: *"... use of a mark does not prove that the mark is distinctive. Increased use does not do so either. The use and increased use must be in a distinctive sense to have any materiality."* Bach and Bach Flower Remedies Trade Marks [2000] RPC 513 at paragraph [49] (per Morritt LJ with whom Thorpe and Chadwick L.JJ agreed).

**Decision**

58. The Appeal is dismissed for the reasons I have given above. In accordance with the usual practice in this Tribunal on appeals against the refusal of registration, it is dismissed with no order for costs.

**Registry practice and procedure: survey evidence**

59. I note with regard to the procedure followed in the present case that on 4 April 2019 the Appellant's professional representatives wrote to the Registry requesting permission to proceed with the survey discussed above with a view to tendering the

results of it in evidence. The letter stated: *"Of course, if you have any concerns or comments with the proposal, please do let us know."*

60. Permission was requested in line with the practice indicated in Tribunal Practice Notice (2/2012) : Survey Evidence and Expert Witness Evidence and the 'gatekeeping' requirements established for case management purposes by the Judgments of the Court of Appeal in Interflora Inc v. Marks & Spencer Plc [2012] EWCA Civ 1501 at paragraphs [149] to [153] and Interflora Inc v. Marks & Spencer Plc [2013] EWCA Civ 319 at paragraphs [4], [5], [26] and [30].

61. The Registry replied the same day stating: *"... the applicant must decide for themselves what type of evidence they file in an attempt to display acquired distinctiveness and once received all evidence will be considered on its merits."* The Appellant's representatives responded on 8 April 2019 observing that *"it was our understanding that the Applicant cannot proceed with the survey until the Office confirms that it may do so"* and requesting *"confirmation that we may proceed to instruct the proposed survey"*. I gather that the Appellant heard nothing further from the Registry on that point and so went ahead with the survey of its own motion.

62. At the hearing of the Appeal I asked the Registrar's representative for a note summarising the Registrar's approach to the filing of survey evidence by an applicant for registration in the light of TPN (2/2012) in the circumstances of a case such as the present.

63. I propose to consider the implications of the Registrar's position in that regard:

> It is unusual for survey evidence to be filed before an application has had a hearing with an ex-parte officer. However, either at the point of hearing, or in post hearing correspondence the hearing officer is able to offer advice about whether filing survey evidence would be a way forward and they would also be able to comment on any proposed survey questions. Nevertheless, the registrar does not believe it is right for applicants to seek permission (from the IPO) before entering such evidence into ex-parte proceedings. The above TPN is a Tribunal notice and makes it clear that the production of survey evidence increases costs for both parties; as the party not producing the survey has the costs of considering the survey evidence. This does not apply in ex-parte proceedings,

> where the costs of another party are not a factor. Furthermore, the role of the registrar in ex-parte proceedings is more akin to a dispute between the applicant and the IPO as to registrability, so to act as a formal gate keeper in the sense of having to seek permission (and otherwise keeping the gate shut) might not be wholly appropriate in such circumstances.

64. Rule 62(2) of the Trade Marks Rules 2008 (as amended) permits the Registrar to control the evidence in Registry proceedings "by giving directions as to: (a) the issues on which evidence is required; and (b) the way in which the evidence is to be placed before the registrar". That, together with the general power in Rule 62(1) to "give such directions as to the management of any proceedings as the registrar thinks fit", enables the Registrar to act as a 'gatekeeper' with regard to the filing of survey evidence in *ex parte* proceedings no less than in *inter partes* proceedings.

65. The exercise of those powers for that purpose does not, in itself, involve or require a departure from the Registrar's role of non-advisory decision taker. The basic aim of the exercise is the same in both contexts: to proceed in a way which can realistically be regarded as conducive to a due and proper application of the law to the facts of the case at hand. And the Registrar's decision as to that will, at least in principle, be amenable to appeal under Section 76 of the 1994 Act.

66. At this point I shall assume (without deciding) that the Registrar is free to proceed in accordance with the approach indicated in paragraphs 61 to 63 above. That is to say, by requiring permission for the filing of survey evidence in *inter partes* proceedings without also requiring it in *ex parte* proceedings and declining to determine formal applications either for permission or directions with respect to the filing of such evidence in *ex parte* proceedings.

67. That approach is, as it seems to me, apt to result in the Registrar departing from the role of non-advisory decision taker and doing so informally in a way which is not directly amenable to appeal if and when it involves *"offer[ing] advice about whether filing survey evidence would be a way forward"* and *"comment[ing] on any proposed survey questions"* for the assistance of a particular party in a particular case. The more specific the advice and comments, the greater the likelihood of such departure.

68. I think the better course would be for the Registrar to publish an updated statement of Registry practice with regard to: the assessment of survey evidence for probative value; the extent of the requirement to obtain permission for the filing of such evidence in pre- and post-registration proceedings; and the procedure for seeking and obtaining such permission. Doing so would provide an opportunity not only to address the situation which arose in the present case, but also to take stock of the considerations and concerns which have been identified in the case law on survey evidence in England, including those discussed by Arnold LJ in Glaxo Wellcome UK Ltd v. Sandoz Ltd (above) at paragraphs [200] to [246].

69. Prominent among the shortcomings identified in the Glaxo Wellcome case was that surveys admitted into opposition proceedings in the Registry in 2015 had been devised and conducted by an expert who *"was not aware of the requirements of the English courts with regard to the documentation of surveys"* (paragraph [206]) using a methodology for investigating acquired distinctiveness known as the 'three-step test' (paragraph [200]) with respect to which Arnold LJ observed: *"I acknowledge that the courts in other countries regard these questions as acceptable, but in my judgment they do not comply with the standards required in this country"* (paragraph [235]).

70. The 'three-step' methodology has recently been endorsed and recommended for use in the EUIPO and EU Member States in EUIPN Common Practice Communication (CP12) Evidence in Trade Mark Appeal Proceedings (March 2021) at section 3.3.3 'Structure of market surveys'. So the need to be clear that it generally does not measure up to the requirements of the Interflora 'Guidelines' may, if anything, have increased since Glaxo Wellcome was decided.

Geoffrey Hobbs QC
20 September 2021

Ms Rachel Wilkinson-Duffy and Mr Daniel Joy of Baker & McKenzie LLP appeared on behalf of the Appellant.

Mr Lee Scott of the UKIPO appeared on behalf of the Registrar.