

O/769/21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003480965

IN THE NAME OF WILD BOARDS LIMITED

FOR THE FOLLOWING TRADE MARK:

Speed Cube

IN CLASS 28

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY

UNDER NO. 503363 BY

GUANGZHOU GANYUAN INTELLIGENT

TECHNOLOGY CO., LTD.

BACKGROUND AND PLEADINGS

1. Wild Boards Limited (“the proprietor”) applied to register the trade mark shown on the front page of this decision (“the contested mark”) in the UK on 13 April 2020. It was registered on 10 August 2020 for the following goods:

Class 28: Puzzles; Cube puzzles; Cube-type puzzles; Manipulative logic puzzles; Manipulative puzzles; Toys in the form of puzzles.

2. On 29 September 2020, Guangzhou Ganyuan Intelligent Technology Co., Ltd (“the applicant”) applied to have the contested mark declared invalid under section 47 of the Trade Marks Act 1994 (“the Act”). The application is based upon sections 3(1)(b), 3(1)(c), 3(1)(d) and 3(6) of the Act.

3. In respect of its section 3(1)(b) ground, the applicant pleaded:

“The term "speed cube" refers to a three-dimensional puzzle with six faces, each divided into nine squares that can be rotated so that each side of the cube is the same colour. The trade mark consists of only the term "Speed Cube" without any design. The trade mark is therefore descriptive of all the goods in the registration and is devoid of any distinctive character in respect of all goods in the registration.”

4. Under its section 3(1)(c) and 3(1)(d) grounds, the applicant’s pleadings are identical to those reproduced above save for the last sentence, each of which respectively read:

“The trade mark therefore consists exclusively of signs which may serve in trade to designate the kind of all the goods in the registration”; and

“The trade mark therefore consists exclusively of signs which have become customary in the current language or in the bona fide and established practices of the trade in respect of all the goods in the registration.”

5. As for the section 3(6) ground of its application, the applicant claims that the proprietor knew at the time of filing the contested mark that 'Speed Cube' was a term used by other traders for three-dimensional puzzles and that it was a customary term in the trade of manipulative puzzles. As a result, the applicant claims that in filing the application for the contested mark, the proprietor sought, unethically, to stop other traders using the customary term in the course of trade meaning it was made in bad faith.
6. The proprietor filed a counterstatement denying the claims made.
7. The applicant is represented by Trademarkit LLP. The proprietor is unrepresented. Only the applicant filed evidence in chief. No hearing was requested and neither party filed any written submissions in lieu of a hearing. This decision is made following careful consideration of the papers.
8. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

PRELIMINARY ISSUE

9. In its counterstatement, the proprietor states that:

“The opponent has recently attempted to register the term Speed Cube in their trademark application. See trademark numbers UK00003537708, UK00003540685 and EU018318801. These are all owned by the opponent, but have been applied for after this trademark was registered. It appear[s] to be another typical attempt of a Chinese company to steal IP.”

10. While these comments are noted, the trade marks referred to by the proprietor are not subject to these proceedings. Further, the comments allude to the fact that the

applicant (incorrectly referred to as the opponent) has applied to register the term 'Speed Cube'. This is not the case as the referred to marks consist of additional words and/or device elements. As a result, the above comments are of no assistance to the proprietor.

EVIDENCE

11. As set out above, only the applicant filed evidence. This was in the form of the witness statement of Longju Luo dated 6 May 2021. Longju Luo is the CFO of the applicant, a position that they have held since 2018.
12. Longju Luo sets out that 'speedcubing' is a sport that involves solving a variety of combination or 'twisty' puzzles as quickly as possible. They state that speed cubing has increased in popularity in recent years and that since this rise in popularity, numerous businesses have begun specialising in making and/or selling speed cubes.
13. A wide range of online print-outs have been provided that discuss the history of 'speedcubing'.¹ While I do not intend to summarise each one, I do note that they are all taken from '.com' websites and there is no indication that they were aimed at or read by members of the relevant public in the UK. Further, all of the print-outs are dated after the relevant date, being the filing date of the contested mark (13 April 2020). However, I note that there are a number of articles that discuss the international history of 'speedcubing'. The evidence sets out that 'speedcubing' is a practice whereby users of the cube compete to solve the puzzles in the fastest time. Someone who participates in 'speedcubing' is known as a 'speedcuber'. This has stemmed a number of national and international tournaments since 1981, culminating in the Rubik's Cube World Championships which are held every two years with the most recent event taking place in Melbourne, Australia in 2019. While I note that the winner of the 2009 World Championship was a British national, there is no evidence of wider attendance of these events by the UK public, nor is there any evidence of coverage of these events in the UK. The evidence discusses

¹ Exhibit LL1 of the Witness Statement of Longju Luo

that since 2000 (when the patent for the original Rubik's Cube expired), a wide range of third-party brands surfaced that have released their own versions of the cube that are of higher quality, twist more fluidly and are specifically engineered for speed. The evidence sets out that these have become known in the cubing community as 'speedcubes'.

14. Longju Luo has also provided a number of articles from UK-wide publications, being BBC News, The Observer (via The Guardian) and ITV News.² The BBC article is dated 30 October 2017 and refers to a three-day speedcubing event hosted by the UK Cube Association. The term 'speedcubers' is used to refer to the participants in the event. While the Observer article is dated 1 November 2020, being after the relevant date, it does refer to 'speedcubers' and a 2018 UK qualifier event that took place in London. The ITV article is dated 5 November 2016 and refers to the Rubik's UK Championships in Bristol wherein over 216 'speedcubers' from 18 countries will compete in a wide variety of Rubik's Cube solving events. While BBC and ITV News are UK publications, it appears that these articles have been published in the regional sections of their websites. Further, the Observer article is posted within the Guardian's website's 'Lifestyle' section.

15. Definitions of 'speedcubing' and 'speedcube' from the online dictionaries 'Macmillan Dictionary' and 'Wiktionary' have been provided.³ The first definition refers to 'speedcubing' as the activity of solving a Rubik's cube as quickly as possible. While dated after the relevant date, the print-outs refer to definitions of this term that were submitted in 2009. However, I note that those submissions were provided by sources from New Zealand and America. The second definition shows 'speed cube' as meaning "a puzzle identical in form and function to a Rubik's Cube but often having a different internal mechanism, and designed for optimal speed of use." This definition is also dated after the relevant date and does not contain any reference to use prior to the relevant date.

² Exhibit LL2 of the Witness Statement of Longjiu Luo

³ *ibid*

16. An article is provided from ruwix.com that discusses a wide range of third-party brands that sell their own speed cubes.⁴ While this is noted, the print-out is dated a year after the relevant date and does not indicate that any of these brands are sold in the UK.
17. A number of print-outs from YouTube are provided showing a wide range of videos regarding 'speedcubing'.⁵ As YouTube is a global platform, it is likely that UK users may have been able to access these videos. However, there is no evidence of this. Further, it is not clear that the videos shown were aimed at UK consumers nor is it clear when these videos were posted. As the print-outs are dated 22 April 2021, it is possible that these videos were uploaded after the relevant date.
18. A print-out of the Internet Movie Database ("IMDB") and a screenshot of Netflix's interface, both showing a 2020 documentary called 'The Speed Cubers', are provided. The IMDB print-out shows a release date of 29 July 2020 in the USA. Even if I were to conclude that the UK release was the same as the USA release, this is after the relevant date. Further, there is no evidence regarding any pre-release press coverage that would potentially give rise to knowledge of this documentary by the average consumers in the UK as at the relevant date.
19. Various print-outs are provided from a number of online stores that Longju Luo states to specialise in selling 'speed cubes'.⁶ Of these, I note they show the following:
- a. a UK-based website called britcubes.co.uk. However, this does not show any products referred to as 'speedcubes';
 - b. a website called kewbz.co.uk that claims to be a "Top Rated UK Based Online Speed Cube Shop" and also that it is the "#1 UK SPEED CUBE STORE". While this print-out shows a number of different cube puzzles, none are referred to as 'speed cubes'.

⁴ *ibid*

⁵ *ibid*

⁶ Exhibit LL3

- c. a number of listings from eBay.com that show 'speedcube' products being sold. While these listings are shown as being from China and are listed in Hong Kong Dollars, I note that they are available to ship internationally;
- d. search results on Amazon.co.uk for the term, 'speed cube' that show 18 results. Of these, I note that some products are directly referred to as 'Speed Cubes', however, some are not (Speed Magic Cube and Speed Puzzle Cube, for example); and
- e. a website called lightinthebox.com that shows a five-piece set of 'Speed Cubes' that is referred to as a 'speedcubing bundle'. While this is a '.com' website, the item is listed in pounds.

All of these print-outs are dated either 30 March 2021, 21 April 2021 or 8 May 2021, being some 11 to 13 months after the relevant date. Given the fact that these screenshots are dated a considerable amount of time after the relevant date, it is not possible for me to determine whether any of the goods shown were available at the relevant date.

20. A number of witness statements from various individuals attesting to the term of 'Speed Cube' being first used in the United Kingdom since either "at least Jan 2014" or "at least Jan 2017".⁷ This evidence is accompanied by screenshots of each witness's activities/'speedcubing' records via various website print-outs. There are 11 witnesses that are citizens of various countries such as China, Australia, Denmark, Philippines, Japan, the UK, Mexico and the USA. Of the witnesses, I note they are made up of a CEO of a company that make 'Speed Cubes', participants of 'speedcubing' competitions (including world champions) and a 'Cube Photographer'.

DECISION

Section 3(6) legislation and case law

21. Section 3 of the Act has application in invalidation proceedings pursuant to section 47 of the Act, which reads as follows:

⁷ Exhibit LL5

“47. –

(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

[...]

(4) In the case of bad faith in the registration of a trade mark, the registrar himself may apply to the court for a declaration of the invalidity of the registration.

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) [...]

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that this shall not affect transactions past and closed.”

22. Section 3(6) of the Act provides as follows:

“(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith”

23. The relevant case-law covering trade mark applications made in bad faith can be found in the following cases: *Chocoladefabriken Lindt & Sprüngli*, CJEU, Case C 529/07, *Malaysia Dairy Industries*, CJEU, Case C-320/12, *Koton*, CJEU, Case C-104/18P, *Sky v Skykick*, CJEU, Case C-371/18, *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited and others*, [2009] RPC 9 (approved by the Court of Appeal in England and Wales: [2010] RPC 16), *Trump International Limited v DDTM Operations LLC*, [2019] EWHC 769 (Ch), *Copernicus-Trademarks v EUIPO*, General Court of the EU, Case T-82/14, *Daawat Trade Mark*, The Appointed Person, [2003] RPC 11, *Saxon Trade Mark*, [2003] EWHC 295 (Ch), *Mouldpro ApS v EUIPO*, General Court of the EU, Case T-796/17, *Alexander Trade Mark*, The Appointed Person, BL O/036/18, *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch) and *Sky v Skykick* [2020] EWHC, 990 (Ch).

24. The law appears to be as follows:

- a. While in everyday language the concept of 'bad faith' involves a dishonest state of mind or intention, the concept of bad faith in trade mark law must be understood in the context of trade: *Sky* CJEU.
- b. A trade mark may be applied for in good faith in relation to some of the goods/services covered by the application, and in bad faith as regards others: *Sky* CJEU.

25. The following points are apparent from the pre-*Sky* case-law about registering trade marks in bad faith:

- a. Although it may be a relevant factor, the mere fact that the proprietor knew that another party was using the trade mark in another territory does not establish bad faith: *Malaysia Dairy Industries*.
- b. Similarly, the mere fact that the proprietor knew that another party used the trade mark in the UK does not establish bad faith: *Lindt, Koton* (paragraph 55). The proprietor may have reasonably believed that it was entitled to apply to

register the mark, e.g. where there had been honest concurrent use of the marks: *Hotel Cipriani*.

- c. However, an application to register a mark is likely to have been filed in bad faith where the proprietor knew that a third party used the mark in the UK, or had reason to believe that it may wish to do so in future, and intended to use the trade mark registration to extract payment/consideration from the third party, e.g. to lever a UK licence from an overseas trader: *Daawat*, or to gain an unfair advantage by exploiting the reputation of a well-known name: *Trump International Limited*.

26. The correct approach to the assessment of bad faith claims is as follows. According to *Alexander Trade Mark*, the key questions for determination in such a case are:

- a. What, in concrete terms, was the objective that the proprietor has been accused of pursuing?
- b. Was that an objective for the purposes of which the contested application could not be properly filed? and
- c. Was it established that the contested application was filed in pursuit of that objective?

27. The proprietor's intention (i.e. objective) is a subjective factor which must be determined objectively by the competent authority. An overall assessment is required, which must take account of all the factual circumstances relevant to the particular case: *Lindt*.

28. The matter must be judged at the relevant date, which is the date of the application for registration: *Lindt*.

29. It is necessary to ascertain what the proprietor knew at the relevant date: *Red Bull*. Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: *Hotel Cipriani*.

30. An allegation of bad faith is a serious allegation which must be distinctly proved, but in deciding whether it has been proved, the usual civil evidence standard applies (i.e. balance of probability). This means that it is not enough to establish facts which are as consistent with good faith as bad faith: *Red Bull*.

31. While a claim under section 3(6) of the Act has been pleaded, the case law above sets out that an allegation of bad faith must be distinctly proven and an assessment of such a claim must take into account all of the factual circumstances relevant to the case. In this case, the applicant has failed to file any evidence that points towards the proprietor acting in bad faith in making the application for the contested mark. The applicant has not, therefore, made out a prima facie case of bad faith in relation to the application for the contested mark. As a result, the application based upon section 3(6) fails.

Section 3(1) case law and legislation

32. As per paragraph 21 above, section 3 of the Act has application in invalidation proceedings pursuant to section 47 of the Act.

33. Section 3(1) of the Act provides 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) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

34. The relevant date for determining whether the contested mark is objectionable under sections 3(1)(b), 3(1)(c) and 3(1)(d) is its filing date, being 13 April 2020.

35. I bear in mind that the above 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)(b): *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P at [25].

36. The position under the above grounds must be assessed from the perspective of the average consumer, who is deemed to be reasonably observant and circumspect: *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04. I have no submissions or evidence from either party as to who the relevant public will be. Given that the contested mark’s goods are puzzles, I consider that the relevant public will be members of the general public at large. I consider that the degree of attention being paid for the goods for which the contested mark is registered will be medium. In my view, the relevant public will consider different factors such as the suitability of the goods, the materials and the complexity of the puzzle.

Section 3(1)(d)

37. I will now consider the application under section 3(1)(d) of the Act. It is the applicant’s claim that ‘Speed Cube’ consists exclusively of signs which have become customary in the current language of in the bona fide and established practices of the trade in respect of all goods.

38. In *Telefon & Buch Verlagsgesellschaft GmbH v OHIM*, Case T-322/03, the General Court summarised the case law of the Court of Justice under the equivalent of s.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).”

39. In light of the case law above, the relevant question is whether, on the relevant date (13 April 2020), the mark ‘Speed Cube’ had become customary in the current language or in the bona fide and established practices of the trade to designate the goods for which the mark is registered. That question must be based on the perception of the average consumer of the goods in the UK, who I have identified at paragraph 36 above.

40. While I accept, from the evidence, that the terms ‘speedcubing’ and ‘speed cube’ are known within the competitive ‘speedcubing’ industry/community, my assessment must be made in relation to the UK average consumers. On this point, I have no evidence to suggest that members of the ‘speedcubing’ community make up a significant proportion of average consumers for the goods at issue in the UK.

41. In my assessment of ‘Speed Cube’ from the point of view of the relevant public in the UK, I do not consider that the evidence points to ‘Speed Cube’ being customary in the current language or in the bona fide and established practices of the trade. Even the evidence that is specifically aimed at the UK public is not particularly helpful to the applicant. For example, I note that while there is evidence of press coverage of ‘speedcubing’ events in the UK via national news publications, the reach of these articles is limited due to the fact they were posted in the regional or lifestyle sections of their respective websites. Further, the evidence of the term ‘Speed Cube’ being used on goods in the UK is far from sufficient to warrant a finding that it has become customary in the current language of the trade. This is particularly the case given that the evidence showing ‘Speed Cube’ on goods for sale is dated approximately one year after the relevant date and, therefore, does not point towards the situation at the relevant date.

42. Additionally, while the various witness statements attesting to ‘Speed Cube’ being used in the UK are noted, I have two issues with this evidence. Firstly, only one of these statements is given by a member of the UK public and none of the statements

provide any explanation as to the basis for their understanding that ‘Speed Cube’ is used in the UK. Secondly, the statements were made by individuals from within the ‘speedcubing’ community so I am not convinced that their perception of ‘speed cube’ is reflective of the understanding of the broader UK based public. Taking all of this into account, I am not prepared to accept that the evidence points to an ‘Speed Cube’ being customary in the current language or in the bona fide and established practices of the trade. As a result, the application based on section 3(1)(d) fails in its entirety.

Section 3(1)(c)

43. I will now move on to the application based on section 3(1)(c). Section 3(1)(c) prevents the registration of marks which are descriptive of the goods, or a characteristic of them. The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was set out by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the Court of Justice of the European Union (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 Melkunie* , paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] 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]."

44. The applicant has claimed that 'Speed Cube' refers to a three-dimensional puzzle with six faces, each divided into nine squares that can be rotated so that each side of the cube is the same colour and, therefore, consists exclusively of signs which may serve in trade to designate the kind of all goods registered. In its counterstatement, the proprietor stated:

“It is unclear to Wild Boards Limited on what grounds the trademark is being opposed. The term “speed” is an adjective and therefore, cannot be descriptive for Class 28 as the definition “the rate at which someone or something moves or operates or is able to move or operate” cannot be used to infer whether there is high or low kinetic involvement.”

45. While I accept the definition of ‘Speed’ provided by the proprietor, it is the purpose of this assessment to consider how the average consumer would view the word in relation to the goods at issue which, in this case, are various types of puzzles. I am of the view that on the goods at issue, the word ‘Speed’ will be understood by the average consumer as a reference to the aim of the puzzle, in that the user is challenged to solve it as quickly as possible. As for the term ‘Cube’, this will be known to the average consumer as a 3D shape that, in the context of the proprietor’s goods, will be understood as a cube-shaped puzzle.

46. When taken as a whole and viewed on the goods at issue, the phrase ‘Speed Cube’ will, in my view, be seen as a unit and understood by the average consumer as being a cube-shaped puzzle of which the aim is to solve it as quickly as possible. I, therefore, consider that ‘Speed Cube’ consists exclusively of indications which may serve to designate the kind of goods for which the contested mark is registered in that it is a cube-shaped puzzle that is to be solved as fast as possible. Therefore, the contested mark is objectionable under section 3(1)(c) of the Act for all of the goods for which it is registered.

47. The application for invalidity reliant upon section 3(1)(c) succeeds in full. For completeness, I will continue to consider the application for invalidity under section 3(1)(b) of the Act.

Section 3(1)(b)

48. Section 3(1)(b) prevents registration of marks which are devoid of distinctive character. The principles to be applied under article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation, and is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act) 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).”

49. The applicant has pleaded that the phrase ‘Speed Cube’ is “descriptive of all of the goods in the registration and is devoid of any distinctive character in respect of all the goods in the registration.” Given that the applicant also pleaded descriptiveness under its section 3(1)(c) grounds, my assessment under this ground will not result in a different outcome from the one I have made above. Therefore, for the same reasons set out at paragraphs 45 and 46 above, I consider that the contested mark is descriptive for all of the goods for which it is registered. The contested mark is, therefore, objectionable under section 3(1)(b) of the Act.

50. The application for invalidity reliant upon section 3(1)(b) succeeds in full.

CONCLUSION

51. While the invalidation applications based on sections 3(6) and 3(1)(d) have failed, the applicant has succeeded in full in respect of its invalidation applications under sections 3(1)(b) and 3(1)(c). The contested mark is, therefore, invalid in respect of all goods for which it is registered and deemed never to have been made and is cancelled *ab initio* i.e. from its filing date of 13 April 2020.

COSTS

52. As the applicant has been successful, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of **£900** as a contribution towards its costs. The sum is calculated as follows:

Filing an application for invalidation and considering the counterstatement:	£200
Preparing evidence:	£500
Official fees:	£200
Total	£900

53.I therefore order Wild Boards Limited to pay Guangzhou Ganyuan Intelligent Technology Co., Ltd the sum of £900. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 14th day of October 2021

A COOPER
For the Registrar