

O/0277/25

TRADE MARK ACT 1994

IN THE MATTER OF APPLICATION 4117241

BY KOOBE Ltd

TO PROTECT THE FOLLOWING TRADE MARK IN CLASS 33

NORWICH CITY

Background

1. On 28 October 2024 Koobe Ltd applied to register the above mark in class 33 for 'Alcoholic Beverages, except beers, alcoholic preparations for making beverages.'
2. On 11 November 2024 the Intellectual Property Office ('IPO') issued an examination report in response to the application, in that report an objection was raised under section 3(1)(b) & (c) of the Trade Mark Act 1994 ('the Act') which read as follows:

"The application is not acceptable in Class 33. There is an objection under Section 3(1)(b) and (c) of the Act. This is because the mark consists exclusively of a sign which may serve in trade to designate the geographical location of the goods e.g., Alcoholic beverages and preparations for making beverages all produced in the city of Norwich.

Norwich is a historic and well-known city in England and research has demonstrated that there are other undertakings within this geographic area who produce alcoholic beverages i.e., distilleries, vineyards. As a result, it is considered that there is a need to keep the descriptive sign 'Norwich City' free for all producers of alcohol in the area to use.

Furthermore, it is considered that as a result of the sign merely serving a descriptive function, the average consumer would not perceive the sign as a trade mark, capable of distinguishing your goods from those of another commercial undertaking."

In line with standard IPO procedure a period of two months was allowed for the applicant to respond.

3. On 14 November 2024 the applicant responded stating that he understood our reservations about registering Norwich City in class 33 but Norwich City Football Club have registered Norwich City as a trade mark in other classes so the same thinking should be applied to them. The applicant understood that mark was made as a part of a wider EU application when we were members of the EU. The

applicant suggested that we allow this application to proceed and Norwich City Football Club could oppose and then the bigger picture of Norwich City trade marks could be discussed with a possible outcome that nobody can own Norwich City as a trademark.

4. On 15 November 2024 the examiner responded to the applicant stating that she had looked into the cases referred to by the applicant and is aware that football club marks can act as a trade marks, adding that the point of a trade mark is to denote single source origin and 'Norwich City FC/Football Club' would be seen as a single source of origin. She allowed until 15 January 2025 for the applicant to respond.

5. On 16 November 2024 the applicant replied stating that *“Norwich City has been accepted as a trade mark in other classes so precedent has been set. If we are not allowed to register Norwich City as a trademark in class 33 then Norwich City should not be allowed as a trademark in any other class and the existing trademarks should be removed”*. On 18 November 2024 the examiner gave the applicant details of the process of invalidating a trade mark.

6. As no further correspondence was received from the applicant a formal notice of refusal of the application was issued on 20 January 2025. On 3 February 2025 the applicant filed a form TM5 which is a request for a statement of reasons for the registrar's decision. The refusal was based on the failure by the applicant to respond within the time frame given, i.e. 15 January 2025. However, this decision will also consider the substantive objections under section 3(1)(b) & (c) for completeness. No formal evidence has been put before me for the purposes of demonstrating acquired distinctiveness in respect of the goods covered by this application, therefore I only have the prima facie case to consider.

The Law

7. Section 37 of the Act reads as follows:

37 Examination of application

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

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

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

(4) If the applicant fails to satisfy the registrar that those requirements are met, or to amend the application so as to meet them, or fails to respond

before the end of the specified period, the registrar shall refuse to accept the application. (5) If it appears to the registrar that the requirements for registration are met, he shall accept the application

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

3(1) The following shall not be registered –

(a) ...

(b) *trade marks which are devoid of distinctive character,*

(c) *trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,*

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

The relevant legal principles – section 3(1)(c)

9. There are a number of judgments from the CJEU which deal with the scope of Article 3(1)(c) of First Council Directive 89/104 (recoded and replaced by Directive 2008/95/EC on 22 October 2008) and Article 7(1)(c) of the Community Trade Mark Regulation (the 'CTMR'), whose provisions correspond to section 3(1)(c) of the UK Act. For the avoidance of doubt, it is noted that the Trade Marks Act 1994 is largely derived from EU law (Directive 2015/2436). In relation to the interpretation of such retained law, the case law of the Court of Justice of the European Union (CJEU) (including the General Court) issued before the end of the transition period continues to apply, and is binding, as retained EU case law under section 6 of the Withdrawal Act. I derive the following main guiding principles from the cases noted below:

- Subject to any claim in relation to acquired distinctive character, signs and indications which may serve in trade to designate the characteristics of goods or services are deemed incapable of fulfilling the indication of origin function of a trade mark (*Wm Wrigley Jr & Company v OHIM, C191/01P 'Doublemint', paragraph 30*);
- Article 7(1)(c) (section 3(1)(c)) pursues an aim which is in the public interest, namely that signs or indications relating to the categories of goods or services in respect of which registration is sought may be freely used by all. The provision therefore prevents such signs or indications from being reserved to one undertaking alone because they have been registered as trade marks (see judgment of 4 May 1999 in *Joined cases C-108/97 and C-109/97 Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) v Boots-und Segelzubehör Walter Huber and Franz Attenberger (Chiemsee)* [1999] ECR I2779, at paragraph 25).

- It is also a well-established principle that the Registrar's role is to engage in a full and stringent examination of the facts, underlying the Registrar's frontline role in preventing the granting of undue monopolies, see to that effect CJEU Case C-51/10 P, *Agencja Wydawnicza Technopol sp. z.o.o. v OHIM* [2011] ECR I-1541 (Technopol).
- It is not necessary that such a sign be in use at the time of application in a way that is descriptive of the goods and services in question; it is sufficient that it could be used for such purposes (*Doublemint*, paragraph 32);
- When determining whether a sign is devoid of distinctive character or is descriptive of the goods or services in respect of which registration is sought, it is necessary to take into account the perception of the relevant consumer who is reasonably well-informed and reasonably observant and circumspect (*Matratzen Concord AG v Hukla Germany SA*, C421/04);
- There must be a sufficiently direct and specific relationship between the sign and the goods in question to enable the relevant consumer immediately to perceive, without further thought, a description of the category of goods and services in question or one of their characteristics (*Ford Motor Co v OHIM*, T67/07);
- It is irrelevant whether there are other, more usual signs or indications designating the same characteristics of the goods and services. The word 'exclusively' in Paragraph (c) is not intended to be interpreted as meaning that the sign or indication should be the only way of designating the characteristic(s) in question (*Koninklijke KPN Nederland NV v Benelux Merkenbureau*, C-363/99 'Postkantoor', paragraph 57);
- However, section 3(1)(c) does not preclude the registration of geographical names which are unknown to the relevant class of persons (or at least unknown as the designation of a geographical location), or of names in respect of which, because of the type of place they designate, such persons are unlikely to believe that the category of services concerned originates there (see *Chiemsee* at paragraph 33).

10. The leading authority in relation to geographical names and section 3(1)(c) of the Act is the judgment of the Court of Justice of the European Union ("CJEU") in *Windsurfing Chiemsee Produktions-und Vertriebs GmbH (WSC) v Boots-und Segelzubehor Walter Huber and Franz Attenberger* (Joined cases C-108/97 and C109/97) ("Windsurfing"):

"24. It should first of all be observed that Article 3(1)(c) of the Directive provides that registration is to be refused in respect of descriptive marks, that is to say marks composed exclusively of signs or indications which may serve to designate the characteristics of the categories of goods or services in respect of which registration is applied for.

25. However, Article 3(1)(c) of the Directive pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the categories of goods or services in respect of which registration is applied for may be freely used by all, including as collective marks or as part of complex or

graphic marks. Article 3(1)(c) therefore prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks.

26. As regards, more particularly, signs or indications which may serve to designate the geographical origin of the categories of goods in relation to which registration of the mark is applied for, especially geographical names, it is in the public interest that they remain available, not least because they may be an indication of the quality and other characteristics of the categories of goods concerned, and may also, in various ways, influence consumer tastes by, for instance, associating the goods with a place that may give rise to a favourable response.

27. The public interest underlying the provision which the national court has asked the Court to interpret is also evident in the fact that it is open to the Member States, under Article 15(2) of the Directive, to provide, by way of derogation from Article 3(1)(c), that signs or indications which may serve to designate the geographical origin of the goods may constitute collective marks.

28. In addition, Article 6(1)(b) of the Directive, to which the national court refers in its questions, does not run counter to what has been stated as to the objective of Article 3(1)(c), nor does it have a decisive bearing on the interpretation of that provision. Indeed, Article 6(1)(b), which aims, inter alia, to resolve the problems posed by registration of a mark consisting wholly or partly of a geographical name, does not confer on third parties the right to use the name as a trade mark but merely guarantees their right to use it descriptively, that is to say, as an indication of geographical origin, provided that it is used in accordance with honest practices in industrial and commercial matters.

29. Article 3(1)(c) of the Directive is not confined to prohibiting the registration of geographical names as trade marks solely where they designate specified geographical locations which are already famous, or are known for the category of goods concerned, and which are therefore associated with those goods in the mind of the relevant class of persons, that is to say in the trade and amongst average consumers of that category of goods in the territory in respect of which registration is applied for.

30. Indeed, it is clear from the actual wording of Article 3(1)(c), which refers to '...indications which may serve ... to designate ... geographical origin, that geographical names which are liable to be used by undertakings must remain available to such undertakings as indications of the geographical origin of the category of goods concerned.

31. Thus, under Article 3(1)(c) of the Directive, the competent authority must assess whether a geographical name in respect of which application for registration as a trade mark is made designates a place which is currently associated in the mind of the relevant class of persons with the category of goods concerned, or whether it is reasonable to assume that such an association may be established in the future.

32. In the latter case, when assessing whether the geographical name is capable, in the mind of the relevant class of persons, of designating the origin of the category of goods in question, regard must be had more particularly to the degree of familiarity amongst such persons with that name, with the characteristics of the place designated by the name, and with the category of goods concerned.

33. In that connection, Article 3(1)(c) of the Directive does not in principle preclude the registration of geographical names which are unknown to the relevant class of persons — or at least unknown as the designation of a geographical location or of names in respect of which, because of the type of place they designate (say, a mountain or lake), such persons are unlikely to believe that the category of goods concerned originates there.

...

36. Finally, it is important to note that, whilst an indication of the geographical origin of goods to which Article 3(1)(c) of the Directive applies usually indicates the place where the goods were or could be manufactured, the connection between a category of goods and a geographical location might depend on other ties, such as the fact that the goods were conceived and designed in the geographical location concerned.”

11. I have also taken into account the consequences for third parties of granting the applicant a monopoly. In *Linde A.G. v Rado Uhren A.G.* Case C-53/01 the following guidance was given at paragraphs 73 – 74:

“73. According to the Court’s case-law “Article 3(1)(c) of the Directive pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is applied for may be freely used by all, including as collective marks or as part of complex or graphic marks. Article 3(1)(c) therefore prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (see to that effect, *Windsurfing Chiemsee*, paragraph 25).

74. The public interest underlying Article 3(1)(c) of the Directive implies that, subject to Article 3(3) any trade mark which consists exclusively of a sign or indication which may serve to designate the characteristics of goods or a service within the meaning of that provision must be freely available to all and not be registrable.

12. It is clear from the aforementioned case law that I must determine whether or not the mark applied for will be perceived by the relevant consumer as a means of directly designating the characteristic of the goods being provided. In this case, the characteristic being the geographical origin of the goods. In order to do this, I must assess who I consider the relevant consumer to be. The goods covered by the application are alcoholic beverages and alcoholic preparations for making beverages. The sale of alcoholic products is restricted by law to consumers over the age of 18 and whilst these products are likely to be available through a number of

retail and wholesale outlets such as supermarkets, off-licenses, general stores, pubs, social clubs, wholesalers and on-line outlets, all sellers are required to be licensed and must ensure that the purchaser is over 18 years old by checking identity, if necessary, before the sale is completed. This level of confirmation of the consumer's age ensures that the relevant consumer of these products would be over the age of 18, reasonably well-informed and reasonably observant and circumspect.

13. In taking into account the average consumer's perception of the mark I must consider the geographical reference 'Norwich City' and whether this name is likely to be associated in the mind of the average consumer with the goods covered by the application, or whether it is reasonable to assume that such an association may be established in the future. In doing so I must ascertain the average consumer's familiarity with the geographical name in question, the characteristics of the place designated by that name and with the goods concerned. As stated in the Chiemsee decision (Joined Cases C-108/97 and (C-109/97)

"where there is currently no association in the mind of the relevant class of persons between the geographical name and the category of goods in question, the competent authority must assess whether it is reasonable to assume that such a name is, in the mind of the relevant class of persons, capable of designating the geographical origin of that category of goods: in making that assessment, particular consideration should be given to the degree of familiarity amongst the relevant class of persons with the geographical name in question, with the characteristics of the place designated by that name, and with the category of goods concerned".

14. I believe consumers will be aware that Norwich City is a geographical location as Norwich a county town in Norfolk with a population of 144,000 in 2019 and 'Norwich City' is the name of a well-known football club. I consider that consumers will only identify the name as being that of a geographical location. In this respect I refer to decision of the High Court in Canary Wharf (Case CH/2014/0564) in particular paragraph 29:

29. ...But the 'need to keep free' principle is not limited to use of a geographical name in respect of which the goods or services for which a particular area is already famous. On the contrary it can cover the use of the name in respect of services for which it has never been used before. The question is simply whether it is reasonable to assume that the name is capable of indicating geographical origin.

15. I find that, on seeing the mark, consumers will perceive immediately a descriptive message indicating that the goods are from Norwich city. In my opinion others should be free to use the words Norwich city in the course of trade. As stated above, the Windsurfing decision at Paragraph 32 states that, in assessing whether the name is capable of designating the origin of the goods, regard must be given to the fame of the geographical name, familiarity with the characteristics of the place, and familiarity with the goods or services.

16. The goods covered by the application are not specialist goods but everyday goods that consumers will be aware of. According to Wikipedia the city of Norwich has had a long tradition of brewing with several large breweries continuing into the second half of the 20th century. However, our research shows there are still a number of microbreweries, vineyards and distilleries in the area of Norwich and Annex A gives details of some of these. Regardless of this our opinion of the mark would be the same, as most large towns and cities are likely to have companies producing alcohol. The specification covers alcohol at large and I am aware that the distilling of goods such as gin in particular has assumed some at least of the characteristics of a cottage industry, such as being on a small scale and without geographical constraint. The decision in Canary Wharf therefore confirms the consideration of public interest in marks incorporating a geographical location, whether or not there currently exists, or in the future is likely to exist, an association between that location and the goods or services on offer. I find that, on seeing the mark, consumers will perceive immediately a descriptive message indicating that the goods are produced in or provided from Norwich City and other providers of alcoholic beverages and preparations made from alcoholic beverages should be free to use those words in the course of trade.

17. Having maintained the objection under Section 3(1)(c) this effectively ends the matter. However, in case I am found to be wrong in this regard, I will go on to determine the matter under section 3(1)(b) of the Act. I should at this point stress that since an objection has been made under section 3(1)(c), this automatically engages section 3(1)(b). However, it can be useful to also consider section 3(1)(b) in its own right - the scope of the two provisions is not identical, and marks which are not descriptive under section 3(1)(c) can nonetheless be devoid of any distinctive character.

18. I have fully considered in this case whether there is a separate or independent objection under section 3(1)(b). In the circumstances I do not consider that there is; the objection under 3(1)(b) co-exists and is co-extensive with the objection under section 3(1)(c). In other words, the mark is devoid of all distinctive character by virtue only of it designating a characteristic under section 3(1)(c).

19. Regarding the applicant's reference to earlier acceptances of Norwich City marks, other than the NORWICH CITY mark 918110176, which was accepted at the EUIPO and came over on to the UK register at the time of the UK's exit from the EU, those marks include the words 'football club' or 'FC' which give an indication of trade origin and are not on a par with the name 'Norwich City' alone.

20. I have concluded that the mark applied for will not be identified as a trade mark without first educating the public that it is an indication of trade origin. In this decision I have considered all the documents filed by the applicant, and all the arguments submitted to me in relation to this application. Having done so, and for the reasons given above, the application is refused under sections 3(1)(b) and 3(1)(c) of the Act

Dated this 24th day of March 2025

Linda Smith

**For the Registrar
The Comptroller-General**

Annex A

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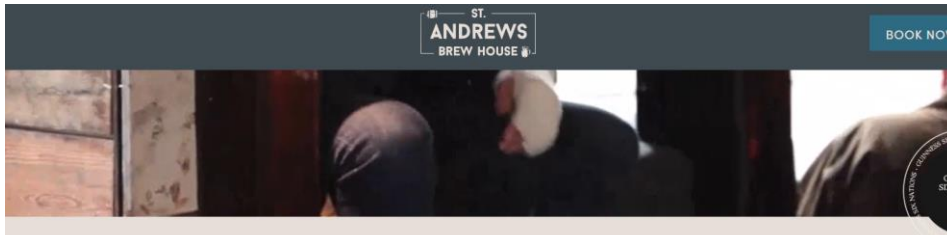
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Description

Chalk Hill began production in 1993 on a 15-barrel plant. It supplies local pubs and festivals. A small plant is used to brew experimental beers, which if popular become part of the regular range.

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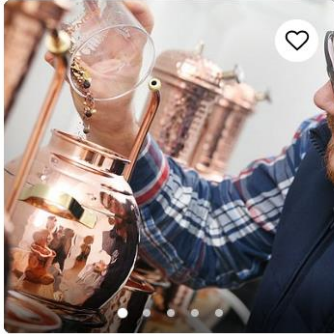


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Winter's Brewing Company Ltd
8 Keelan Close, Norwich, NR6 6Q

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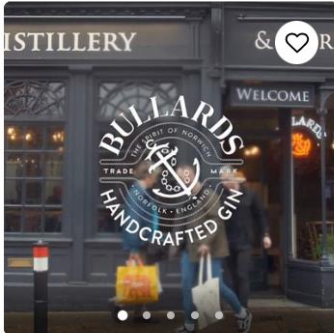
1. Adnams 'Make Your Own Gin' Experience - Norwich

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Distillery Tours • Beer Tastings & Tours

By suelewing

Plenty of gin to taste and very friendly staff. The goodie bag was excellent and taking away your own crafted gin was...



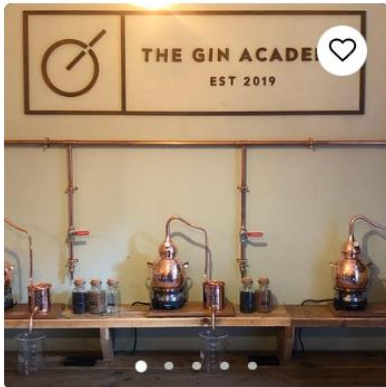
2. Bullards Gin

●●●●● 23

Distillery Tours

By fightingtorque

Technical, historical and business discussion about everything to do with gin from two experts in a great setting..



3. Gin Academy

●●●●○ 15

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By amberfQ3211UV

Got to try all of the home distilled gins and make our own which was a fab experience.

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