

**O-0475-25**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF REGISTRATION NOS. 917934186, 3372129 AND 3372116  
IN THE NAME OF ORANGE BRAND SERVICES LIMITED  
THE FIRST TWO IN RESPECT OF THE IDENTICAL TRADE MARK**



**AND THE THIRD IN RESPECT OF THE TRADE MARK**

**ORANGE**

**VARIOUSLY IN CLASSES 9, 11, 14, 35, 36, 37, 38, 39, 41, 42, 44 AND 45**

**AND**

**IN THE MATTER OF THREE APPLICATIONS FOR INVALIDATION THERETO  
UNDER NOS. 505927, 505928 AND 505929  
BY RAZVAN RADU**

## Background and pleadings

1. The following three trade marks are registered in the name of Orange Brand Services Limited (“the proprietor”):

**1) Mark No. 917934186**



Filing date: 24 July 2018

Registration date: 15 December 2018

The registration is a comparable trade mark based on an EU Trade Mark and was entered on the UK register on 31 December 2020.

Relevant goods:

**Class 9:** *Electrical and electronic communications and telecommunications apparatus and instruments; communications and telecommunications apparatus and instruments; electrical and electronic apparatus and instruments all for processing, logging, storing, transmission, retrieval or reception of data; apparatus and instruments for recording, transmission, amplifying or reproduction of sound, images, information or encoded data; electrical control, testing (other than in-vivo testing), signalling, checking (supervision) and teaching apparatus and instruments; optical and electro-optical apparatus and instruments; communications servers; computer servers; VPN [virtual private network] operating hardware; WAN [wide area network] operating hardware; LAN [local area network] operating hardware; computer hardware; computer network hardware; computer hardware for providing secure remote access to computer and communications networks; ethernet hardware; image processing apparatus, instruments and equipment; cameras; photographic apparatus, instruments and equipment; video projectors; multimedia projectors; bar code scanners and readers; television and radio apparatus and instruments; telecommunication, radio and television broadcasting transmitters and receivers; apparatus for access to broadcast or transmitted programmes; holograms; computers; peripheral*

*equipment for computers; programmed-data-carrying electronic circuits; discs, tapes and wires all being magnetic data carriers; printed circuit boards; blank and pre-recorded magnetic cards; data cards; memory cards; smart cards; cards containing microprocessors; integrated circuit cards; electronic identification cards; telephone cards; telephone credit cards; credit cards; debit cards; cards for electronic games designed for use with telephones; CD ROMS; magnetic, digital and optical data carriers; magnetic, digital and optical data recording and storage media (blank and pre-recorded); pre-recorded CDs; USB flash drives; devices for playing downloadable music files; portable media players; satellite transmitters and receivers; telecommunications and broadcasting satellites; radio telephone beacons and telephone masts; electric wires and cables; optical cables; fibre-optic cables; resistance wires; electrodes; telecommunications systems and installations; terminals for telephone networks; telephone switchboards; telecommunications signal input, storage, conversion and processing apparatus; telephone equipment; equipment for fixed, transportable, mobile, hands-free or voice-activated telephones; multimedia terminals; interactive terminals for displaying and ordering goods and services; secure terminals for electronic transactions including electronic payments; apparatus for processing of electronic payments; paging, radio paging and radio-telephone apparatus and instruments; telephones, mobile telephones and telephone handsets; facsimile machines; personal digital assistants (PDAs); electronic notepads; electronic notebooks; electronic tablets; electronic handheld units for the wireless receipt, storage and/or transmission of data messages and electronic payments; mobile electronic devices that enable the user to keep track of or manage personal information; apparatus for monitoring domestic or industrial consumption of electrical energy, gas, heat and water; electrical and electronic apparatus and instruments for use in or in relation to the generation or distribution of power, gas, water or electricity or telecommunications; apparatus for use in remote control of electricity, gas, heat, water and energy supplies; satellite navigational apparatus, instruments and systems; accessories for telephones and telephone handsets; adapters for use with telephones; battery chargers for use with telephones; desk or car mounted units incorporating a loudspeaker to allow a telephone handset to be used hands-free; in-car telephone handset cradles; headphones; hands free devices for telephone handsets and other mobile electronic devices; bags and cases specially adapted for holding or carrying portable telephones and telephone equipment and accessories; cell phone straps; computerised personal organisers; aerials; batteries; micro processors; key boards; modems; calculators; display screens; electronic global positioning systems; electronic navigational, tracking and positioning apparatus and instruments; monitoring (other than in-vivo monitoring) apparatus and instruments; radio apparatus and instruments; video films; audio-visual apparatus and equipment; electrical and electronic accessories and peripheral equipment designed and adapted for use with computers and audio-visual apparatus; computer games cartridges; parts and fittings for all the aforesaid goods; computer programs; computer software; VPN [virtual private network] operating software; WAN [wide area network] operating software; LAN [local area network] operating software; USB operating software; computer software supplied from the Internet; computer*

*software for synchronizing data between computers, processors, recorders, monitors and electronic devices and host computers; cloud computing software; network operating systems programs; computer operating systems programs; computer software for providing secure remote access to computer and communications networks; computer security software; computer firewall software; software for ensuring the security of electronic mail; downloadable ringtones for mobile phones; electronic publications (downloadable) provided on-line from computer databases or the Internet; computer software and telecommunications apparatus (including modems) to enable connection to databases, local area networks and the Internet; computer software to enable teleconferencing, videoconferencing and videophone services; computer software to enable searching and retrieval of data; computer software for accessing databases, telecommunications services, computer networks and electronic bulletin boards; computer software for use in or in connection with generation of power or electricity, provision and distribution of gas and water; computer games software; interactive multimedia computer games programs; virtual reality games software; downloadable music files; photographs, pictures, graphics, image files, sound bites, films, videos and audio-visual programmes (downloadable) provided on-line or from computer databases or the Internet or Internet websites; computer software for use in remote monitoring; software for GPS navigation; smart watches; wearable mobile phone devices; wearable computers; wearable electronic transmitters and receivers of data; wristbands that communicate data to personal digital assistants, smart phones, tablet PCs, PDA, and personal computers through internet websites and other computer and electronic communication networks; telephones and smartphones in the shape of a watch; telephones and smartphones in the shape of a wristband; telephones and smartphones in the shape of a pendant, necklace, ring, earring and/or other item of jewelry; computers in the shape of a watch; computers in the shape of a wristband; computers in the shape of a pendant, necklace, ring, earring and/or other item of jewelry; personal fitness monitoring device in the shape of a watch or a wristband; personal fitness monitoring device in the shape of a pendant, necklace, ring, earring and/or or other item of jewelry; robots (other than cooking or culinary products) for personal, educational or entertainment use; equipment for the remote controlling of robots; software for the control and operation of robots; thermionic tubes and valves.*

**Class 11:** *Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes; apparatus for water supply and sanitary installations; apparatus for heating, steam generating and ventilating purposes; apparatus for heating, energy generation and collection from wind, wave and geothermal sources; apparatus for heating, energy generation and collection from renewable and sustainable sources; heating, refrigerating, air-conditioning, water heating and water supply apparatus; lighting apparatus and installations; light installations; lighting; light assemblies; light fixtures; light bulbs; solar collectors for heating; solar energy collectors for heating; solar energy powered heating installations; solar energy powered heating apparatus; solar heat collection panels; solar heating apparatus; solar heating installations; solar heating panels; solar panels for use in heating; solar thermal collectors*

*[heating]; solar water heaters; heating apparatus electric, fuel oil, gas or renewable energy; equipment, apparatus and installations for the production, recovery, separation, purification, liquefaction, processing and distribution of biofuel, fuel gas, biogas, bio methane, natural gas for vehicles, liquefied natural gas, liquefied bio methane, biogas from non-hazardous waste storage installation, renewable natural gas; equipment and installations composed thereof for utilising renewable energies to generate cold and heat; boilers; cooling installations and machines; apparatus and installations for hot-water heating; apparatus and installations for producing hot water; electric heating apparatus; heat accumulators; heat generating apparatus; industrial heating installations; installations for heating; domestic heating utensils; thermal storage apparatus [solar energy] for heating; thermal storage instruments [solar energy] for heating; water heaters; steam generating apparatus; steam generating installations; apparatus for supplying water; unit heaters; combustion installations and systems consisting thereof; thermal accumulators, thermostatic valves, distribution valves; radiators; installations and apparatus designed to regulate temperature; adjusting and safety installations and apparatus for gas pipes and for electric, gas or water apparatus in home automation installations; electric apparatus for domestic comfort, namely heat, steam accumulators, air-conditioning apparatus, air-conditioning installations, solar sensors and collectors for thermal conversion (heating); thermal solar panels (thermal solar sensors); thermal photovoltaic panels for heat generation; fuel economizers; heat regenerators; ventilation apparatus, heat pumps; stoves (heating apparatus); inserts (heating apparatus); regulating and safety accessories for water apparatus; water filtering apparatus; water softening apparatus and installations; air and water purifying apparatus and machines; installations for conducting, switching, purifying, for supplying, cooling water; nuclear reactors; installations for processing nuclear fuel and nuclear moderating material; solar furnaces; electric light bulbs; solar energy power heating apparatus; air treatment equipment; display lighting; solar energy powered heating installations for household use; solar energy powered heating apparatus for household use; control devices being parts of heating, lighting, steam generating, drying, ventilating, air conditioning, water supply and sanitary installations; apparatus for controlling temperature in heating installations, namely thermostatic valves [parts of heating installations]; automatic temperature regulators [thermostatic valves] for central heating systems, namely, thermostatic valves as part of heating installations; parts and fittings for the aforesaid goods.*

## 2) Mark No. 3372129



Filing date: 1 February 2019

Registration date: 7 June 2019

Relevant goods and services:

**Class 9:** *Electrical and electronic communications and telecommunications apparatus and instruments; communications and telecommunications apparatus and instruments; electrical and electronic apparatus and instruments all for processing, logging, storing, transmission, retrieval or reception of data; apparatus and instruments for recording, transmission, amplifying or reproduction of sound, images, information or encoded data; electrical control, testing (other than in-vivo testing), signalling, checking (supervision) and teaching apparatus and instruments; optical and electro-optical apparatus and instruments; communications servers; computer servers; VPN [virtual private network] operating hardware; WAN [wide area network] operating hardware; LAN [local area network] operating hardware; computer hardware; computer network hardware; computer hardware for providing secure remote access to computer and communications networks; ethernet hardware; image processing apparatus, instruments and equipment; cameras; photographic apparatus, instruments and equipment; video projectors; multimedia projectors; bar code scanners and readers; television and radio apparatus and instruments; telecommunication, radio and television broadcasting transmitters and receivers; apparatus for access to broadcast or transmitted programmes; holograms; computers; peripheral equipment for computers; programmed-data-carrying electronic circuits; discs, tapes and wires all being magnetic data carriers; printed circuit boards; blank and pre-recorded magnetic cards; data cards; memory cards; smart cards; cards containing microprocessors; integrated circuit cards; electronic identification cards; telephone cards; telephone credit cards; credit cards; debit cards; cards for electronic games designed for use with telephones; CD ROMS; magnetic, digital and optical data carriers; magnetic, digital and optical data recording and storage media (blank and pre-recorded); pre-recorded CDs; USB flash drives; devices for playing downloadable music files; portable media players; satellite transmitters and receivers; telecommunications and broadcasting satellites; radio telephone beacons and telephone masts;*

*electric wires and cables; optical cables; fibre-optic cables; resistance wires; electrodes; telecommunications systems and installations; terminals for telephone networks; telephone switchboards; telecommunications signal input, storage, conversion and processing apparatus; telephone equipment; equipment for fixed, transportable, mobile, hands-free or voice-activated telephones; multimedia terminals; interactive terminals for displaying and ordering goods and services; secure terminals for electronic transactions including electronic payments; apparatus for processing of electronic payments; paging, radio paging and radio-telephone apparatus and instruments; telephones, mobile telephones and telephone handsets; facsimile machines; personal digital assistants (PDAs); electronic notepads; electronic notebooks; electronic tablets; electronic handheld units for the wireless receipt, storage and/or transmission of data messages and electronic payments; mobile electronic devices that enable the user to keep track of or manage personal information; satellite navigational apparatus, instruments and systems; adapters for use with telephones; battery chargers for use with telephones; desk or car mounted units incorporating a loudspeaker to allow a telephone handset to be used hands-free; in-car telephone handset cradles; headphones; hands free devices for telephone handsets and other mobile electronic devices; bags and cases specially adapted for holding or carrying portable telephones and telephone equipment and accessories; cell phone straps; computerised personal organisers; aerials; batteries; micro processors; key boards; modems; calculators; display screens; electronic global positioning systems; electronic navigational, tracking and positioning apparatus and instruments; monitoring (other than in-vivo monitoring) apparatus and instruments; radio apparatus and instruments; video films; audio-visual apparatus and equipment; peripheral equipment designed and adapted for use with computers and audio-visual apparatus; computer games cartridges; parts and fittings for all the aforesaid goods; computer programs; computer software; VPN [virtual private network] operating software; WAN [wide area network] operating software; LAN [local area network] operating software; USB operating software; computer software supplied from the Internet; computer software for synchronizing data between computers, processors, recorders, monitors and electronic devices and host computers; cloud computing software; network operating systems programs; computer operating systems programs; computer software for providing secure remote access to computer and communications networks; computer security software; computer firewall software; software for ensuring the security of electronic mail; downloadable ringtones for mobile phones; electronic publications (downloadable) provided on-line from computer databases or the Internet; computer software and telecommunications apparatus (including modems) to enable connection to databases, local area networks and the Internet; computer software to enable teleconferencing, videoconferencing and videophone services; computer software to enable searching and retrieval of data; computer software for accessing databases, telecommunications services, computer networks and electronic bulletin boards; computer games software; interactive multimedia computer games programs; virtual reality games software; downloadable music files; photographs, pictures, graphics, image files, sound bites, films, videos and audio-visual programmes (downloadable) provided on-line or from computer*

*databases or the Internet or Internet websites; computer software for use in remote monitoring; software for GPS navigation; smart watches; wearable mobile phone devices; wearable computers; wearable electronic transmitters and receivers of data; wristbands that communicate data to personal digital assistants, smart phones, tablet PCs, PDA, and personal computers through internet websites and other computer and electronic communication networks; telephones and smartphones in the shape of a watch; telephones and smartphones in the shape of a wristband; telephones and smartphones in the shape of a pendant, necklace, ring, earring and/or other item of jewelry; computers in the shape of a watch; computers in the shape of a wristband; computers in the shape of a pendant, necklace, ring, earring and/or other item of jewelry; personal fitness monitoring device in the shape of a watch or a wristband; personal fitness monitoring device in the shape of a pendant, necklace, ring, earring and/or or other item of jewelry; robots (other than cooking or culinary products) for personal, educational or entertainment use; Equipment for the remote controlling of robots; Software for the control and operation of robots; parts and fittings for all the aforesaid goods.*

**Class 14:** *Jewellery; horological and chronometric instruments; clocks; watches; watches incorporating a pager; watches; Watches and/or wristbands incorporating sensors; watches, wristbands and bracelets that communicate data to personal digital assistants, smart phones, tablet PCs, PDA, and personal computers through internet websites and other computer and electronic communication networks; pendant, necklace, ring, earring and/or other item of jewelry that communicates data to personal digital assistants, smart phones, tablet PCs, PDA, and personal computers through internet websites and other computer and electronic communication networks; watches incorporating a smartphone; watches incorporating a telecommunication function; watches incorporating computing capabilities; pendant, necklace, ring, earring and/or other item of jewelry incorporating telecommunication and/or computing capabilities; parts and fittings for all the aforesaid goods.*

**Class 36:** *Financial services; banking services; insurance; financial affairs; monetary affairs; insurance and financing of telecommunications apparatus, systems and installations; provision of credit card facilities and services; provision of electronic funds transfer services and on-line transaction facilities; processing payments for the purchase of goods and services via an electronic communications network; automated payment services; electronic banking via a global computer network (Internet banking); electronic processing of payments via a global computer network; electronic transfer of funds by means of telecommunications networks; payment services provided via wireless telecommunications apparatus and devices; money order payment guarantee services; payment processing services; electronic currency transfer; contactless payment services; investment and fund management services; administration of funds and investments; computerised financial services; provision of on-line valuation services; real estate affairs; real estate property management and information and advice relating to the aforesaid; provision of financial information; stock exchange quotations; stocks and shares*

*information services; stocks and bonds brokerage; fund raising activities; charitable collections, organising collections and organising fund raising activities; financial sponsorship; information and advisory services relating to insurance, financial affairs, monetary affairs, home and Internet banking, stocks and share information, stocks and bonds brokerage, provided on-line from a computer database or the Internet; brokerage of energy; issuing of vouchers; advisory, information and consultancy services relating to all the aforementioned.*

### **3) Mark No. 3372116**

ORANGE

Filing date: 1 February 2019

Registration date: 7 June 2019

Relevant goods and services:

**Class 9:** *Electrical and electronic communications and telecommunications apparatus and instruments; communications and telecommunications apparatus and instruments; electrical and electronic apparatus and instruments all for processing, logging, storing, transmission, retrieval or reception of data; apparatus and instruments for recording, transmission, amplifying or reproduction of sound, images, information or encoded data; electrical control, testing (other than in-vivo testing), signalling, checking (supervision) and teaching apparatus and instruments; optical and electro-optical apparatus and instruments; communications servers; computer servers; VPN [virtual private network] operating hardware; WAN [wide area network] operating hardware; LAN [local area network] operating hardware; computer hardware; computer network hardware; computer hardware for providing secure remote access to computer and communications networks; ethernet hardware; image processing apparatus, instruments and equipment; cameras; photographic apparatus, instruments and equipment; video projectors; multimedia projectors; bar code scanners and readers; television and radio apparatus and instruments; telecommunication, radio and television broadcasting transmitters and receivers; apparatus for access to broadcast or transmitted programmes; holograms; computers; peripheral equipment for computers; programmed-data-carrying electronic circuits; discs, tapes and wires all being magnetic data carriers; printed circuit boards; blank and pre-recorded magnetic cards; data cards; memory cards; smart cards; cards containing microprocessors; integrated circuit cards; electronic identification cards; telephone cards; telephone credit cards; credit cards; debit cards; cards for electronic games designed for use with telephones; CD ROMS; magnetic, digital and optical data carriers; magnetic, digital and optical data recording and storage media (blank and pre-recorded); pre-recorded CDs; USB flash drives; devices for playing downloadable music files; portable media players; satellite transmitters and receivers;*

*telecommunications and broadcasting satellites; radio telephone beacons and telephone masts; electric wires and cables; optical cables; fibre-optic cables; resistance wires; electrodes; telecommunications systems and installations; terminals for telephone networks; telephone switchboards; telecommunications signal input, storage, conversion and processing apparatus; telephone equipment; equipment for fixed, transportable, mobile, hands-free or voice-activated telephones; multimedia terminals; interactive terminals for displaying and ordering goods and services; secure terminals for electronic transactions including electronic payments; apparatus for processing of electronic payments; paging, radio paging and radio-telephone apparatus and instruments; telephones, mobile telephones and telephone handsets; facsimile machines; personal digital assistants (PDAs); electronic notepads; electronic notebooks; electronic tablets; electronic handheld units for the wireless receipt, storage and/or transmission of data messages and electronic payments; mobile electronic devices that enable the user to keep track of or manage personal information; satellite navigational apparatus, instruments and systems; adapters for use with telephones; battery chargers for use with telephones; desk or car mounted units incorporating a loudspeaker to allow a telephone handset to be used hands-free; in-car telephone handset cradles; headphones; hands free devices for telephone handsets and other mobile electronic devices; bags and cases specially adapted for holding or carrying portable telephones and telephone equipment and accessories; cell phone straps; computerised personal organisers; aerials; batteries; micro processors; key boards; modems; calculators; display screens; electronic global positioning systems; electronic navigational, tracking and positioning apparatus and instruments; monitoring (other than in-vivo monitoring) apparatus and instruments; radio apparatus and instruments; video films; audio-visual apparatus and equipment; peripheral equipment designed and adapted for use with computers and audio-visual apparatus; computer games cartridges; parts and fittings for all the aforesaid goods; computer programs; computer software; VPN [virtual private network] operating software; WAN [wide area network] operating software; LAN [local area network] operating software; USB operating software; computer software supplied from the Internet; computer software for synchronizing data between computers, processors, recorders, monitors and electronic devices and host computers; cloud computing software; network operating systems programs; computer operating systems programs; computer software for providing secure remote access to computer and communications networks; computer security software; computer firewall software; software for ensuring the security of electronic mail; downloadable ringtones for mobile phones; electronic publications (downloadable) provided on-line from computer databases or the Internet; computer software and telecommunications apparatus (including modems) to enable connection to databases, local area networks and the Internet; computer software to enable teleconferencing, videoconferencing and videophone services; computer software to enable searching and retrieval of data; computer software for accessing databases, telecommunications services, computer networks and electronic bulletin boards; computer games software; interactive multimedia computer games programs; virtual reality games software; downloadable music files; photographs, pictures, graphics, image files, sound bites,*

*films, videos and audio-visual programmes (downloadable) provided on-line or from computer databases or the Internet or Internet websites; computer software for use in remote monitoring; software for GPS navigation; smart watches; wearable mobile phone devices; wearable computers; wearable electronic transmitters and receivers of data; wristbands that communicate data to personal digital assistants, smart phones, tablet PCs, PDA, and personal computers through internet websites and other computer and electronic communication networks; telephones and smartphones in the shape of a watch; telephones and smartphones in the shape of a wristband; telephones and smartphones in the shape of a pendant, necklace, ring, earring and/or other item of jewelry; computers in the shape of a watch; computers in the shape of a wristband; computers in the shape of a pendant, necklace, ring, earring and/or other item of jewelry; personal fitness monitoring device in the shape of a watch or a wristband; personal fitness monitoring device in the shape of a pendant, necklace, ring, earring and/or other item of jewelry; robots (other than cooking or culinary products) for personal, educational or entertainment use; Equipment for the remote controlling of robots; Software for the control and operation of robots; parts and fittings for all the aforesaid goods.*

**Class 14:** *Jewellery; horological and chronometric instruments; clocks; watches; watches incorporating a pager; watches; Watches and/or wristbands incorporating sensors; watches, wristbands and bracelets that communicate data to personal digital assistants, smart phones, tablet PCs, PDA, and personal computers through internet websites and other computer and electronic communication networks; pendant, necklace, ring, earring and/or other item of jewelry that communicates data to personal digital assistants, smart phones, tablet PCs, PDA, and personal computers through internet websites and other computer and electronic communication networks; watches incorporating a smartphone; watches incorporating a telecommunication function; watches incorporating computing capabilities; pendant, necklace, ring, earring and/or other item of jewelry incorporating telecommunication and/or computing capabilities; parts and fittings for all the aforesaid goods.*

**Class 36:** *Financial services; banking services; insurance; financial affairs; monetary affairs; insurance and financing of telecommunications apparatus, systems and installations; provision of credit card facilities and services; provision of electronic funds transfer services and on-line transaction facilities; processing payments for the purchase of goods and services via an electronic communications network; automated payment services; electronic banking via a global computer network (Internet banking); electronic processing of payments via a global computer network; electronic transfer of funds by means of telecommunications networks; payment services provided via wireless telecommunications apparatus and devices; money order payment guarantee services; payment processing services; electronic currency transfer; contactless payment services; investment and fund management services; administration of funds and investments; computerised financial services; provision of on-line valuation services; real estate affairs; real estate property management and information and advice relating to the*

*aforesaid; provision of financial information; stock exchange quotations; stocks and shares information services; stocks and bonds brokerage; fund raising activities; charitable collections, organising collections and organising fund raising activities; financial sponsorship; information and advisory services relating to insurance, financial affairs, monetary affairs, home and Internet banking, stocks and share information, stocks and bonds brokerage, provided on-line from a computer database or the Internet; brokerage of energy; issuing of vouchers; advisory, information and consultancy services relating to all the aforementioned.*

2. On 16 March 2023 (the first invalidation) and 20 March 2023 (the second and third invalidations, Razvan Radu (“the applicant”) applied to partially invalidate the registrations (the full list of goods and services for which invalidation is sought is listed above). The invalidations are based upon section 3(1)(b) and section 3(1)(c) of the Trade Marks Act 1994 (“the Act”). In all three invalidations, the applicant’s assertions are the same, namely, the contested marks have a clear descriptive meaning in relation to the contested goods and that this descriptive meaning eclipses any impression that the mark could indicate trade origin. The marks immediately inform the consumer of the colour of the goods. He concludes that the contested marks are devoid of distinctive character and descriptive.

3. The proprietor filed counterstatements denying the assertions made and puts the applicant to strict proof of its claims. It also claims that the marks’ non-descriptiveness and inherent distinctiveness is self-evidence in respect of the contested goods and services. The proprietor points out that the marks are not colour marks and do not consist of the colour orange. Finally, it claims that, in the alternative and in the event that its marks are held to be descriptive or devoid of inherent distinctive character, its marks have acquired distinctive character as a result of the extensive use made of them in respect of the contested goods and services.

4. The three applications for invalidation were subsequently consolidated prior to the evidence rounds.

5. The parties both filed evidence in these proceedings, and this will be summarised to the extent that it is considered necessary. The parties also filed written submissions that I keep in mind, and I will refer to as and where appropriate during this decision.

6. Neither party requested a hearing and I, therefore, make my decision after careful consideration of the papers on file.

7. Throughout the proceedings, the applicant represented himself and the proprietor was represented by Taylor Wessing LLP.

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 upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

## **Evidence**

9. The applicant's evidence takes the form of the witness statement of the applicant, Mr Razvan Radu together with exhibits 1 – 14.

10. The proprietor's evidence consists of the witness statement of Mr Alessandro Cimaschi, Senior Legal Counsel for the proprietor together with exhibits AC1 – AC15.

11. The applicant filed evidence in reply in the form of a second witness statement from Mr Radu with exhibits 1 – 10. This evidence consists of criticism of the proprietor's tactics and actions around the world and its motives for filing "Orange" trade marks around the world. This evidence adds nothing to the claims based upon section 3(1) of the Act, and I need say no more about this evidence.

## **Legislation**

12. Section 3(1) reads:

“3.— Absolute grounds for refusal of registration

(1) The following shall not be registered—

(a) ...

(b) trade marks which are devoid of any distinctive character.

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

(d) ...

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

13. Section 3(1) is relevant in invalidation proceedings because of section 47 of the Act, the relevant part of which states:

“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.

[...]

(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.

[...]

(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.”

### **Section 3(1)(c)**

14. I find it convenient to begin by considering the ground based upon section 3(1)(c). 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. (as he then was) 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 CJEU [Court of Justice of the EU] 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].”

15. The applicant asserts that the colour and “generic term” orange are frequently used for goods in classes 9, 11 and 14. In support of these claims, evidence has been adduced showing these goods coloured orange. The evidence consists almost entirely of screenshots of webpages from websites of online retailers such as amazon.co.uk, apple.com, ao.com, currys.co.uk and tradeinn.com and were all obtained between “21/09/2023” and “24/09/2023”. Where prices are shown, they are always in pound sterling (£). The goods shown in the evidence are:

- Smart phones and tablets. The phone descriptions shown alongside the image of each of the phones includes an indication of their colour e.g. “orange” or “sunset orange”;<sup>1</sup>
- Computer cases and PC gaming cases coloured orange or with orange highlighting;<sup>2</sup>
- a “GeoPad” and several Lenovo branded laptops coloured orange;<sup>3</sup>
- Apple’s iMac computer available in orange;<sup>4</sup>
- a “GeoPad” laptop coloured orange;<sup>5</sup>
- various brands of smartwatches with orange straps and sometimes orange features on the watches themselves;<sup>6</sup>
- orange coloured or partially orange coloured items (many described as being “orange”), namely, speakers, amplifiers, MP3 music player, distortion and acoustic pedals, headphones, portable radios, USB flash drives/memory sticks, external hard drives, keyboards, computer mice, RAM memory, mini sports video camera, digital camera, batteries, universal output, portable satellite signal finder, USB cables, games controller, decibel meter, calculators, mobile phone case, landline phones, weighing scales;<sup>7</sup>
- orange coloured domestic lights and light fittings, a cooker, air fryers, fridge freezer, a fridge, electric clothes dryers, a hair dryer, desk fans and axial fans, light bulbs, towel warmers/radiators, battery bank/power stations, generators, a compressor, electric switches and extension cables and an air filtration system;<sup>8</sup>
- jewellery incorporating “orange sapphires”;<sup>9</sup>
- an orange heart necklace, an orange amber necklace, orange glass/ceramic bead necklace/earring/bracelet set, earrings made from orange agate and from orange faceted resin, hoops and earrings of orange enamel, an orange ammolite signet ring, an “orange cz” ring and other similar rings;<sup>10</sup>

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<sup>1</sup> Exhibit 1, Pages 2 - 17

<sup>2</sup> Ditto, pages 18 - 22

<sup>3</sup> Ditto, page 25 - 27

<sup>4</sup> Ditto, page 23

<sup>5</sup> Ditto, page 24

<sup>6</sup> Ditto, page 28 - 32

<sup>7</sup> Ditto, pages 33 – 66, 70, 78 – 91, 93 - 101

<sup>8</sup> Exhibit 2

<sup>9</sup> Exhibit 3, pages 161 – 164, 166 - 169

<sup>10</sup> Ditto, pages 165, 170 - 181

- a wall clock coloured orange being offered for sale on the website luxxdesign.com.<sup>11</sup> There is nothing to indicate the website is targeted at the UK.
- clocks and watches all coloured orange;<sup>12</sup>

16. The applicant asserts that the word “orange” and the colour are commonly used in financial and insurance services in class 36. Evidence of the colour being used in respect of the services consists of further Internet screenshots all obtained on “21/09/2023”. The evidence can be summarised as follows:

- Screenshots from various websites showing shop banners, a cash machine and promotional pages in respect of Sainsbury’s bank, ICICI Bank and ING banking that all prominently use the colour orange;<sup>13</sup>
- A screenshot of the “About” page from the website of a company called MagicOrange describing itself as an “IT Financial Management platform”;<sup>14</sup>
- A screenshot of the website orangelogic.com that is offering “enterprise DAM for financial services and insurance” (“DAM” appears to be an acronym for “digital asset management”);<sup>15</sup>
- A screenshot of the website blueorangeuk.com that appears to offer “fintech, forex” and “financial services marketing”;<sup>16</sup>
- A screenshot of the website orangeumbrella.co.uk that promotes itself as being a “financial consultancy”;<sup>17</sup>
- A screenshot of the website theorangepartnership.co.uk an assurance provider for capital investment programmes;<sup>18</sup>
- A screenshot of the website orange-and-black.co.uk, a provider of travel insurance as well as other services;<sup>19</sup>

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<sup>11</sup> Ditto, page 182

<sup>12</sup> Ditto, pages 183 - 189

<sup>13</sup> Exhibit 4

<sup>14</sup> Exhibit 5, page 203

<sup>15</sup> Ditto, page 204

<sup>16</sup> Ditto, page 205

<sup>17</sup> Ditto, page 206

<sup>18</sup> Ditto, page 207

<sup>19</sup> Ditto, page 208


- a screenshot of the website [orangegrovefostercare.co.uk](http://orangegrovefostercare.co.uk) that appears to provide advice to foster carers including in respect of allowances and national insurance;<sup>20</sup>

17. The applicant also asserts that the colour orange and the word “orange” are commonly used in communication services in class 38. Again, the evidence consists of further Internet screenshots all obtained on “25/09/2023”. It can be summarised as follows:

- screenshots of the websites [gigaclear.com](http://gigaclear.com) and [kcom.com](http://kcom.com), both offering broadband services where the predominate colour of the pages is orange;<sup>21</sup>
- a screenshot of the website [blueorangeit.co.uk](http://blueorangeit.co.uk) offering a cloud platform for smart phones;<sup>22</sup>
- a screenshot of the website [orangesolutions.co.uk](http://orangesolutions.co.uk) offering, among other services, industrial communications and industrial Internet of things (IIoT);<sup>23</sup>
- a screenshot of the website [orangetechnology.co.uk](http://orangetechnology.co.uk) of The Orange Group Ltd that appears to be in the fields of hospitality, corporate services, construction and “tools”;<sup>24</sup>
- a screenshot of the website [amazon.co.uk](http://amazon.co.uk) offering Orange Television Network as a free download;<sup>25</sup>

18. The applicant relies on a number of decisions and provides copies of these. They are:

- (i) EUIPO decision in case EUTM 014427157 in respect of the following mark:
 



 dated 17 May 2016.<sup>26</sup> The decision maintained the examiner’s finding that the mark could not be registered because it did not have the minimum degree of distinctive character and because the mark was

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<sup>20</sup> Ditto, page 209

<sup>21</sup> Exhibit 6, pages 211, 212

<sup>22</sup> Ditto, page 213


<sup>23</sup> Ditto, page 214

<sup>24</sup> Ditto, page 215

<sup>25</sup> Ditto, page 216

<sup>26</sup> A copy of which is provided at Exhibit 7

descriptive of the external appearance of the goods. It was rejected for many of the Class 9 goods applied for.

- (ii) EUIPO decision in case EUTM 014427116, also dated 17 May 2016, in respect of the word “Orange” in a standard typeface.<sup>27</sup> The decision maintained the examiner’s finding that the mark could not be registered because it did not have the minimum degree of distinctive character and because the mark was descriptive of the external appearance of the goods. It was rejected for many of the Class 9 goods applied for.
- (iii) EUIPO (under its previous name OHIM) decision R 7/87-3, dated 12 February 1998, and, in particular, at [12] where it notes that the word “orange” is a “... *wide generic term*...”;<sup>28</sup>
- (iv) The decision of the Grand Board of Appeal after a corrigendum in the EUIPO Case R 1801/2017-G, dated 25 January 2018. In particular, the applicant refers to [37] – [39].<sup>29</sup> This decision was in respect of the mark  in respect of goods in Class 9 and services in Classes 36 and 42. It was found that the ordinary typeface and the orange background is of no distinctive character and that there was “no combination effect arising from presentation of the word elements in white letters before that orange background” and that the “overall combination is not more than the sum of its non-distinctive parts”;

19. I point out at this stage that I am not bound by these decisions but I keep them in mind. I am not bound by the guidance provided in the Registry’s Work Manual but, nevertheless, 5.5. of The Examination Guide provides the following useful guidance:

“This section (s.3(1)(c)) is used to prohibit the registration of marks which would be seen purely as a descriptor of the characteristics of the goods and services the mark is to be used upon. For example, a direct reference to the goods

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<sup>27</sup> A copy of which is provided at Exhibit 8

<sup>28</sup> A copy of which is provided at Exhibit 9

<sup>29</sup> A copy of which is provided at Exhibit 10

themselves, i.e. 'soap' for soap; or a term which may be descriptive of a feature of the product, 'strawberry' could be the smell of the soap. Such terms would be objectionable under section 3(1)(c) and would be accompanied by an objection under section 3(1)(b) as well because it naturally follows that if a mark is descriptive it must also be non-distinctive."

20. The relevant dates in these proceedings are the filing dates of the contested marks, namely 24 July 2018 (917934186) and 1 February 2019 (3372129 and 3372116).

21. The proprietor criticises the applicant's reliance upon the OHIM decision R 7/87-3 on the basis that the comment relied upon by the applicant was made in the context of the classification of colour marks compared to figurative marks. This is indeed true. The decision did observe that the word "orange" is a generic term., however, generic terms may still qualify as trade marks because an assessment must be made by reference to the goods and services for which protection is sought. Whilst the generic term "soap" would be unacceptable for such goods in Class 3 it may, for example, be acceptable in respect of telecommunication services in Class 38. Similarly, the name of a colour, such as in issue in the current cases may be unacceptable in respect to paint (where colour is an intrinsic characteristic). In light of these observations, the OHIM decision relied upon by the applicant does not further its case beyond uncontentious assertion that the word "orange" is a generic word to describe a particular colour.

22. In respect of the applicant's reliance upon the Grand Board's decision in *easyBank*, I do not consider that this mark is on all-fours with the circumstances in the current cases. The word element *easyBank* consists of two words that were found to designate an institution offering financial services that are straightforward and easy to use. In the current cases, the word "orange" describes a colour. Consequently, the analysis required in the current cases is different to that undertaken by the Grand Board. The case is, therefore, of limited assistance in the current cases.

23. At the core of the issue before me is the tension illustrated by the cases relied upon by the applicant and the judgment of the General Court ("the GC") in *Off-White*

*LLC v EUIPO*<sup>30</sup>, 25 June 2020, relied upon by the proprietor. This judgment is from a higher authority and post-dates the cases relied upon by the applicant. Therefore, the EUIPO or the Board of Appeal did not have the benefit of the GC's guidance when making the decisions referred to be the applicant. Since leaving the EU, such GC judgments are not binding upon me but it keep in it in mind because of its potentially persuasive value.

24. The proprietor submits that at [43] of the judgment, the GC commented that in respect of Article 7(1)(c) (the equivalent of section 3(1)(c) of the UK Trade Mark Act) the reference to colour in a trade mark must “*constitute a characteristic which is objective and inherent to the nature of the goods in question, as well as being intrinsic and permanent for those goods*”. The GC, having established that the average consumer would perceive the word element *Off-White* as a description of a colour,<sup>31</sup> went on to comment that:

*“36. It follows that the fact that the EU legislature chose to use the word ‘characteristic’ highlights the fact that the signs referred to in Article 7(1)(c) of Regulation 2017/1001 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. Consequently, a sign can be refused registration on the basis of that provision 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 judgment of 7 May 2019, *vita*, T-423/18, EU:T:2019:291, paragraph 43 and the case-law cited).*

...

45. ..., *it must be noted that, although off-white corresponds, ..., to one of the possible colour variations which those goods may have, it does not, however, constitute the sole or even predominant colour. **That colour is presented only as a purely random and incidental aspect which only some of those goods may have and which does not, in any event, have any direct and***

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<sup>30</sup> *Off-White LLC v EUIPO*, T-133/19

<sup>31</sup> At [32] of the judgment

***immediate link with their nature. Thus, the mere fact that the goods in question are more or less usually available in off-white, among other colours, is irrelevant, since it is not ‘reasonable’, within the meaning of the case-law referred to in paragraph 36 above, to believe that for that reason alone that colour will actually be recognised by the relevant public as a description of an intrinsic characteristic which is inherent to the nature of those goods*** [my emphasis] (see, to that effect, judgment of 7 May 2019, *vita*, T-423/18, EU:T:2019:291, paragraphs 45 and 46).”

25. At this point, I note that the proprietor has provided dictionary references<sup>32</sup> for the word “orange” that illustrates it is a word that describes a “round, sweet fruit” and “a tree bearing that fruit” as well as “a colour between red and yellow”. It submits that none of these meanings are descriptive of an essential characteristic of the contested goods and services. It points out that the goods and services in question are not those for which “orange” is an essential characteristic unlike food or drink products, food and drink processing machines or agricultural products and services. I understand from this and the proprietor’s reliance upon the *Off-White* judgment is that it does not challenge the applicant’s assertion that the contested goods may be provided in a variety of colours, one of which may be orange but, rather, it argues that the colour of the goods or its use in respect of the contested services is not a reference to an essential (or intrinsic) characteristic of those goods or services.

26. Further, the proprietor submits that there is no evidence that, at the relevant dates, the contested marks were descriptive of the contested goods and services because the evidence post-dates the relevant dates (by some four or five years). It also submits that the applicant’s evidence fails to portray the goods and services as having the fruit, the fruit tree or the colour as objective and permanent characteristics. These meanings, that could possibly be attributed to the word “orange”, are not relied upon by the applicant. His case is based solely on the word “orange” describing the specific colour.

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<sup>32</sup> At Exhibit AC12

27. In its evidence in reply, the applicant also relies upon a Registry decision<sup>33</sup> in respect of the following mark where, a Registry hearing officer maintained a section 3(1)(b) objection because the mark was considered devoid of distinctive character in respect of various Class 18 and Class 25 goods:



28. I note that the analysis of distinctiveness of the mark in the context of goods in Class 18 and Class 25 is different to the analysis required in the current case, in particular, the assessment of whether the name of a colour is an intrinsic characteristic in respect of, for example, clothing may present a different outcome that when considering the issue in the context of the contested goods and services in the current case. I conclude that I must still undertake my analysis taking account of the goods and services in issue, which are different to those in the Registry's earlier case, and it is possible that the outcome could be different.

29. It is established case law that for section 3(1)(c) to apply, there must be a sufficiently direct and specific relationship between the mark and the contested goods and services. It is not necessary that the mark is used at the time of filing in a way that is descriptive of the goods or services. Rather, it is sufficient that it could be used in such a descriptive way. The proprietor makes the criticism that the applicant's evidence was obtained some years after the relevant dates in these proceedings and fails to show the position at these relevant dates. Whilst I keep in mind that the evidence relates to a time after the relevant dates, it may still "shed light backwards" and illustrate an unchanged position or, alternatively, provide support for it being foreseeable, at the relevant date, that a sign could come to indicate a characteristic of the contested goods and services.

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<sup>33</sup> A copy of which is at Exhibit 5 of the applicant's evidence-in-reply. The cover page containing the reference number is not exhibited but the missing reference number is BL O/327/00

30. The applicant maintains that all three contested marks consist of signs that designate a characteristic of the contested goods and services and that this is an intrinsic characteristic.

31. Returning to the proprietor reliance upon the *Off-White* judgment, there appears to be some tension between this and the comments of the CJEU in *Koninklijke KPN Nederland NV and Benelux-Merkenbureau (Postkantoor)*<sup>34</sup> where the court held:

*“... it is irrelevant whether or not.... the characteristics of the goods or services which may be the subject of the description are commercially essential or merely ancillary.”*

32. This guidance from the EU’s highest trade mark court envisages that “ancillary characteristics” are potentially objectionable. The comments of the GC in *Off-White* are predicated on comments made in the *Vita* judgment<sup>35</sup> and other GC judgments it cites. In *Vita*, the GC highlights that the word “characteristic” used in Article 7(1)(c) of the EU Trade Mark Regulations (equivalent to section 3(1)(c) Act) is intended to cover characteristics that 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*”. In *Off-White*, the GC appears then makes its distinction between an “incidental aspect” and an “inherent characteristic”.

33. Geoffrey Hobbs, sitting as the Appointed Person in *FLYING SCOTSMAN Trade Mark*<sup>36</sup> drew attention to a number of cases, two of these being judgments of the CJEU, where it has found that signs he described as having “characteristics that goods and services ...may **optionally possess**” [my emphasis] be refused registration. These cases are:

- (i) *Agencja Wydawnicza Technopol sp. zo. o v. OHIM*, Case C-51/10 P where the CJEU upheld the GC’s findings that the sign “1000” was objectionable under Article 7(1)(b) and Article 7(1)(c) (equivalent to section 3(1)(b) and

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<sup>34</sup> C-363/99 at [102]

<sup>35</sup> T-423/18 at [43]

<sup>36</sup> BL O-313-11 at [15]

section 3(1)(c) of the Act) as a description of the number of pages, the volume of information, or printed matter being ranking lists and collections. The underlying objective of Article 7(1)(c) was identified as being the need to keep the sign free for others traders to use;

- (ii) *Powerserv Personalservice GmbH v. OHIM (MANPOWER)*, Case C-533/08 P where the CJEU upheld the GC in finding that the sign MANPOWER would, prima facie, be understood as indicating the content of various Class 9 and Class 16 goods.

34. Therefore, the various authorities relied upon by the parties and the additional authorities I have referenced variously refer to “characteristics of goods and services that they may optionally possess”, “ancillary characteristics” and “incidental aspects”. I am not aware of any authorities that discuss the interplay between these terms or whether they are essentially discussing the same or different concepts. In *Postkantoor*, the court commented that it does not matter whether characteristics are “ancillary” or “commercially essential” because both are “characteristics” and, therefore, caught by the wording of Article 7(1)(c) (and, by extension, section 3(1)(c) of the Act). I have some difficulty in understanding how the scope of “ancillary characteristics” or “characteristics of goods and services that they may optionally possess” can differ from the scope of “incidental aspects”. On the face of it, there appears to be no difference in concept and, giving due regard to these various authorities, I have come to this conclusion. In doing so, I acknowledge that there is tension between the outcomes on the facts in some of the authorities but I keep in mind that the term “characteristics” used in the text of Article 7(1)(c) (and section 3(1)(c) of the Act) can include both “ancillary characteristics” and “intrinsic characteristics”. Consequently, a sign indicating ancillary characteristics/incidental aspects may still be caught by the provision, but consideration must be on a case-by-case basis and must take account of the contested goods and services.

35. In light of my comments above it is, therefore, necessary that I consider the current case by reference to the goods and services. I find it convenient to firstly consider this ground of invalidation in respect of the various goods in the proprietor’s Classes 9, 11 and 14.

## **The identical Class 9 goods present in all three contested marks**

36. I begin by considering the following goods:

*computer programs; computer software; VPN [virtual private network] operating software; WAN [wide area network] operating software; LAN [local area network] operating software; USB operating software; computer software supplied from the Internet; computer software for synchronizing data between computers, processors, recorders, monitors and electronic devices and host computers; cloud computing software; network operating systems programs; computer operating systems programs; computer software for providing secure remote access to computer and communications networks; computer security software; computer firewall software; software for ensuring the security of electronic mail; downloadable ringtones for mobile phones; electronic publications (downloadable) provided on-line from computer databases or the Internet; computer software ... to enable connection to databases, local area networks and the Internet; computer software to enable teleconferencing, videoconferencing and videophone services; computer software to enable searching and retrieval of data; computer software for accessing databases, telecommunications services, computer networks and electronic bulletin boards; computer software for use in or in connection with generation of power or electricity, provision and distribution of gas and water; computer games software; interactive multimedia computer games programs; virtual reality games software; downloadable music files; photographs, pictures, graphics, image files, sound bites, films, videos and audio-visual programmes (downloadable) provided on-line or from computer databases or the Internet or Internet websites; computer software for use in remote monitoring; software for GPS navigation; ...; software for the control and operation of robots; thermionic tubes and valves.*

37. It is not clear to me how these goods could be referred to by reference to colour, nor is it clear how colour could be considered a characteristic of such goods. In their physical form, these goods would generally be held on a data carrier or similar and packaged. Therefore, the goods themselves would not be perceived as having a colour and the visual aspects would be in the form of a carrier or more likely outer packaging such as a box. The colour of a carrier or packaging is not a characteristic of software. Further, it is not obvious to me that a colour can be a characteristic of downloaded items (such as *ringtones*, *music files* or *images* etc) in the general way asserted by the applicant because such items are not normally available in colour or normally have colour as a characteristic. Consequently, the relevant public will not expect a sign consisting of, or containing, the word “orange” to be describing a

characteristic of the items. For these reasons, the applications for invalidation based upon section 3(1)(c) fail in respect of these goods.

38. In respect of all the other Class 9 goods, these are all physical goods where colour may be a characteristic. I am mindful that colour may not be a commercially essential characteristic of these goods, but it may certainly be an ancillary characteristic, and the word “orange” will be perceived by the relevant public to be signs that are merely indicating the colour of the goods. This finding extends to the proprietor’s two logo marks. These marks consist of the word “orange” placed near the bottom of an orange-coloured square. The addition of the square and the position of the word within it, to my mind, is not sufficient for the relevant consumer to perceive the sign as an indicator of origin. *Prima facie*, its primary message is to indicate the colour orange as illustrated by the colour of the square. Therefore, it is my view that the “get-up” in these marks is such as to enhance the descriptive nature of the word “orange”. Finally, I recognise that in the absence of a colour limit or colour claim, the contested registrations will include the mark being presented in any colour or in black and white. Again, it is my view that this does not impact upon how the mark will be perceived by the relevant public because the square will merely be perceived as a non-distinctive background and the marks as a whole will retain their descriptive nature.

39. The applicant has provided evidence of many Class 9 goods coloured orange or partially coloured orange and often described by reference to the colour. These goods include mobile phones, tablets, computer cases, PC gaming cases, laptops, computers, smartwatches, speakers, amplifiers, MP3 music players, distortion and acoustic pedals, headphones, radios, flash drives and external hard drives. As I have already noted, whilst the proprietor has submitted that the evidence was obtained some years after the relevant dates in these proceedings, the evidence may have some value. Even if the goods identified in the evidence were not available in orange at the relevant dates (the evidence does not confirm this one way or the other), I consider that it was foreseeable that the colour orange could be used as a colour for such goods. To this end, the evidence provides some support that the foreseeability would have been correct.

40. In light of this, I consider that in respect of all the Class 9 goods listed in the three contested registrations, except those listed in paragraph 36 above, the marks are likely to be perceived as indicating the colour of the goods and, subsequently, as this is a characteristic of the goods, albeit an ancillary characteristic, they are debarred registration under section 3(1)(c) of the Act.

41. My findings apply equally to the proprietor's word mark and to the proprietor's two logo marks.

***The Class 11 goods present in contested mark 917934186***

42. In respect of the proprietor's Class 11 goods (in contested mark no. 917934186 only), I note that the applicant provides evidence of orange-coloured goods such as lights and light fittings, a cooker, fridges, fans, generators and an air filtration system. These are all goods covered by the proprietor's broad specification. As noted when discussing the grounds in respect of the Class 9 goods, I consider the evidence to be helpful at least in providing some support that a ground based upon section 3(1)(c) would have succeeded at the relevant dates on the basis that, if these goods were not already available in Orange or partially in orange, it was foreseeable that they may be in the future. On the basis that all of the proprietor's Class 11 goods could be provided in the colour orange, this is a characteristic of the goods and is indicated by the word "orange" and the word "orange" appearing inside an orange square.

43. I consider the applicant's case to be made out and the application for invalidation based on section 3(1)(c) is successful in respect of these goods.

***The Class 14 goods present in contested marks 3372129 and 3372116***

44. For the same reasons, the success of the application for invalidation extends to the proprietor's Class 14 goods. Additionally, many of these goods may be considered as fashion items such as jewellery that is often selected as part of a co-ordinated outfit. Consequently, such goods are often selected by colour. In these circumstances, the colour of the goods can be said to be more than an ancillary characteristic because it is one of the primary characteristics that influences the purchase of such goods.

45. The proprietor's *horological and chronometric instruments, clocks, various watches* and the various items of what I will collectively call "smart jewellery" because of their stated function of communicating data to other devices, may also be selected based on their colour and may be promoted, in part, by reference to colour. Consequently, the contested marks may be perceived as merely indicating the available colour of the goods. The success of the application therefore also extends to these goods.

46. The remaining goods of the proprietor's Class 14 specifications are *wristbands*, all listed as having a "smart function" i.e. they incorporate sensors and or communicate data to smart phones etc. I consider that colour will be a characteristic of such goods in the same way as already discussed. The contested marks are likely to be perceived as designating the colour of the goods. Therefore, the application succeeds in respect of these goods.

47. I find that the application succeeds against all the proprietor's contested Class 14 goods.

***Services in Class 36 present in contested mark 3372129 and 3372116***

48. Next, I turn to consider this ground of invalidation in respect of the various contested services. I can keep my comments brief. Firstly, I note that the applicant's evidence in respect of the proprietor's services consists essentially of examples of companies:

- (i) using the colour orange as part of their livery used on shop banners, cash machines or websites. It is not clear to me how such use will render the contested marks objectionable under section 3(1)(c). Even acknowledging such use, it is not clear to me how the contested marks are designating a characteristic of the services, let alone an intrinsic characteristic. Further, as the proprietor points out, the contested marks are not in respect of the colour orange, per se. I conclude that this evidence fails to support a claim

that the contested marks should be invalidated under section 3(1)(c) of the Act;

- (ii) using the word “orange” as part of a distinctive brand name or part of a domain name or company name (“MagicOrange”, “orangelogic”, “blueorangeuk”, “orangeumbrella”, “theorangepartnership”, “orange-and-black” and “orangegrovefostercare”, “blueorangeit”, “orangesolutions” and “orangetechnology”. None of these examples support a claim that the contested marks consist of signs that designate characteristics of any of the proprietors listed services;
- (iii) using the colour orange as part of the colour choices used in the get-up of promotional webpages in respect to various Class 38 services. Again, it is not clear to me how the use of the colour orange as part of the get-up of a webpage supports a claim that the contested marks designate a characteristic of the contested services;
- (iv) Finally, there is a screenshot showing the online retailer Amazon offering the Orange Television Network as a free download. This appears to be a reference to a brand name and it does not appear to support the claim that the contested marks designate a characteristic of these services.

49. In light of these comments, I find that the applicant has failed to demonstrate that his ground, based upon section 3(1)(c) applies to any of the proprietor’s services.

50. I note that the proprietor’s fallback position is that its marks have an acquired distinctive character through use. Its evidence of such use comprises narrative evidence that, in the UK, it operates a digital consultancy that began trading under the name Orange Business in July 2006 and a cybersecurity business which started trading under the name Orange Cyberdefense in March 2020. I make the following observations:

- (i) the invalidation based on section 3(1)(c) of the Act, insofar as it challenged the contested registrations in respect of their list of services has failed and, therefore, evidence of acquired distinctive character cannot improve on the proprietor’s defence, and;

- (ii) in respect cybersecurity business, it only began after the relevant dates in these proceedings.

51. In summary, it is not necessary for me to consider further the proprietor's fallback position that the contested marks benefit from acquired distinctive character through use.

### ***Outcome under section 3(1)(c)***

52. In summary, I find that the application insofar that it based on section 3(1)(c) succeeds against all the contested goods, except those outlined in paragraph 36, above. It fails in respect of the contested services.

### **Section 3(1)(b)**

53. In *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P, the Court of Justice of the European Union ("the CJEU") stated that:

"25. Thirdly, it is important to observe that each of the grounds for refusal to register listed in Article 7(1) of the regulation is independent of the others and requires separate examination. Moreover, it is appropriate to interpret those grounds for refusal in the light of the general interest which underlies each of them. The general interest to be taken into consideration when examining each of those grounds for refusal may or even must reflect different considerations according to the ground for refusal in question (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-0000, paragraphs 45 and 46)."

54. As stated in *Starbucks (HK) Ltd v British Sky Broadcasting Group plc* (at para 46) descriptive signs are also devoid of any distinctive character. It, therefore, follows that to the extent that an application for invalidation has succeeded under section 3(1)(c), it must also succeed based upon its section 3(1)(b) grounds.

55. The applicant makes no independent claim as to why the marks are non-distinctive other than because they are claimed to be descriptive signs. This points to there being no need to consider the section 3(1)(b) ground separately to the section 3(1)(c) ground (see the comments of Anna Carboni, sitting as the Appointed Person in O-363-09 *COMBI STEAM Trade Mark*). Therefore, whilst recognising that section 3(1)(b) and section 3(1)(c) are independent of each other, the circumstances in this case are such that it is not necessary for me to consider separately the ground based upon section 3(1)(b).

56. I conclude that the ground based upon section 3(1)(b) will follow the outcome in respect of the grounds based upon section 3(1)(c) and, consequently, succeeds in part and fails in part.

### **The applicant's final written submissions**

57. In its final written submissions, for the first time, the applicant makes a claim that the proprietor is registering its "Orange" marks in various countries around the world to abusively prevent other undertakings from using the word "Orange". This argument would have potential relevance in respect of grounds based upon section 3(6) (bad faith), but no such ground is relied upon. These arguments are not relevant to the assessment I have undertaken in respect of grounds based only on section 3(1) and I need say no more on the issue.

### **Summary**

58. All three applications for invalidation succeed in respect of all the listed goods shown in paragraph 1, except:

*computer programs; computer software; VPN [virtual private network] operating software; WAN [wide area network] operating software; LAN [local area network] operating software; USB operating software; computer software supplied from the Internet; computer software for synchronizing data between computers, processors, recorders, monitors and electronic devices and host computers; cloud computing software; network operating systems programs; computer operating systems programs; computer software for providing secure remote access to computer and communications networks; computer security software; computer firewall*

*software; software for ensuring the security of electronic mail; downloadable ringtones for mobile phones; electronic publications (downloadable) provided on-line from computer databases or the Internet; computer software ... to enable connection to databases, local area networks and the Internet; computer software to enable teleconferencing, videoconferencing and videophone services; computer software to enable searching and retrieval of data; computer software for accessing databases, telecommunications services, computer networks and electronic bulletin boards; computer software for use in or in connection with generation of power or electricity, provision and distribution of gas and water; computer games software; interactive multimedia computer games programs; virtual reality games software; downloadable music files; photographs, pictures, graphics, image files, sound bites, films, videos and audio-visual programmes (downloadable) provided on-line or from computer databases or the Internet or Internet websites; computer software for use in remote monitoring; software for GPS navigation; ...; software for the control and operation of robots; thermionic tubes and valves.*

59. The applications fails in respect of the services of contested registrations 3372129 and 3372116 as listed in paragraph 1 and they remain registered for these services.

## **COSTS**

60. In its written submissions, the proprietor refers to, what it describes as, a pattern of abusive behaviour towards it by the applicant and other third parties. It claims that these behaviours include the filing of conflicting trade marks and the filing of numerous cancellation actions. I am unable to comment on these behaviours, but the applications do not strike me as being unreasonable in any way. The applicant pursued an arguable, and ultimately partially successful, case. Consequently, I see no reason why the costs award should be influenced by the proprietor's claims.

61. The proprietor also identifies a number of allegations made by the applicant in its evidence and submissions, such as a claim that the proprietor left the UK market in 2015, something the proprietor disputes, and argues that these statements are false. I consider these issues to be evidential in nature and do not, to my mind, illustrate something that would contribute to an abusive pattern of behaviour.

62. The parties have both achieved a measure of success and I find it appropriate that each party bears its own costs.

**Dated this 30<sup>th</sup> day of May 2025**

**Mark Bryant**

**For the Registrar,**

**The Comptroller-General**