O/0623/25

TRADE MARKS ACT 1994

IN THE MATTER OF
TRADE MARK APPLICATION NO. 3985788
IN THE NAME OF LOCKSLEY DISTILLING COMPANY LIMITED
TO REGISTER AS A TRADE MARK

Co-Lab

IN CLASS 33

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 445824
BY 58 AND CO

BACKGROUND AND PLEADINGS

1. On 29 November 2023, Locksley Distilling Company Limited ("the applicant") applied to register the trade mark **Co-Lab**, in the United Kingdom, for the following goods:

Class 33: *Rum [alcoholic beverage]; Pre-mixed alcoholic beverages; Beverages (Alcoholic -), except beer; Alcoholic beverages, except beer; Alcoholic beverages (except beer); Grain-based distilled alcoholic beverages; Alcoholic cocktails; Alcoholic fruit beverages; Cordials [alcoholic beverages]; Alcoholic beverages except beers; Alcoholic beverages (except beers); Alcoholic beverages [except beers]; Alcoholic beverages containing fruit; Alcoholic aperitifs; Prepared alcoholic cocktails; Distilled beverages; Beverages (Distilled -).*

2. The application was accepted, and published for opposition purposes on 22 December 2023.

3. The application is opposed by 58 and CO ("the opponent"). The opposition was filed on 12 February 2024 and is based upon section 3(1)(b) and section 3(1)(d) of the Trade Marks Act 1994 ("the Act"). The opposition is directed against all the goods in the application.

4. Under Section 3(1)(b), the opponent claims that the term "co-lab" or "collab" is an abbreviation of "collaboration" which is a very common term used to describe two or more brands working together on a project or product. It submits that it is not unique or distinctive.

5. Under Section 3(1)(d), the opponent claims that a "co-lab" or "collab" product, or series of products, has been widely used in the drinks industry for years to describe two or more brands working together and that the term is generic and descriptive of the process.

6. The applicant filed a counterstatement denying each of the claims made by the opponent and putting the opponent to strict proof of each of its allegations. It requests that the opposition be dismissed in its entirety, and that an award of costs be made against the opponent in these proceedings.

7. Only the opponent filed evidence. Neither party requested a hearing; only the opponent filed written submissions in lieu of a hearing. This decision is taken following careful consideration of the papers on file.

8. In these proceedings, the opponent is represented by Venner Shipley LLP[1] and the applicant is represented by Barker Brettell LLP[2].

EVIDENCE AND WRITTEN SUBMISSIONS

9. The opponent filed evidence in the form of a witness statement dated 12 July 2024, in the name of Carmen Dunphy O'Neal. Ms O'Neal is Director of the opponent, a position she has held since 12 July 2019. Alongside the witness statement, the opponent adduces two exhibits, labelled Exhibit CDO1 and CDO2, in support of the opposition.

10. Exhibit CDO1 comprises screenshots from various online dictionaries providing definitions of the words "collab", "colab" and "collabo".

11. Exhibit CDO2 comprises various screenshots which are described in the witness statement as demonstrating "the abbreviated terms being used in a descriptive sense and in a customary manner in the trade sector of food and drinks".

12. I have read and considered all the evidence and I will refer to the relevant parts in further detail, to the extent I consider necessary, within this decision.

[1] Form TM33P appointing Venner Shipley LLP as representatives of the opponent was filed on 12 April 2024, the details of which have been recorded accordingly in these proceedings.
[2] Form TM33 appointing Barker Brettell LLP as representatives of the applicant was filed on 18 March 2024, the details of which have been recorded accordingly in these proceedings.

13. The opponent also filed written submissions in lieu of a hearing, dated 22 November 2024, which will be referred to as and where appropriate in my decision.

DECISION

14. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Section 3(1)

15. Section 3(1) of the Act provides as follows:

> "3(1) The following shall not be registered –
>
> (a) […]
>
> (b) trade marks which are devoid of any distinctive character,
>
> (c) […]
>
> (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade:
>
> Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it."

16. I bear in mind that the above grounds are independent and have differing general interests. It is possible, for example, for a mark not to fall foul of section 3(1)(d), but

still be objectionable under Section 3(1)(b): *SAT.1 SatellitenFernsehen GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) ("OHIM")*, Case C-329/02 P at [25].

17. The relevant date for determining whether the applicant's mark is objectionable under sections (3)(1)(b) and 3(1)(d) is the date on which the application was made, being 29 November 2023.

Section 3(1)(d)

18. I will first consider the opposition under section 3(1)(d) of the Act.

19. In *Telefon & Buch Verlagsgesellschaft GmbH v OHIM,* Case T-322/03, the General Court ("GC") summarised the case law of the Court of Justice under the equivalent of section 3(1)(d) of the Act, as follows:

> "49. Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma* (BSS) [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public's perception of the mark (*BSS*, paragraph 37).
>
> 50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (*BSS*, paragraph 38).

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

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

20. In light of the above case law, the pertinent question is whether, on the relevant date (29 November 2023), the mark "Co-Lab" had, based on the perception of the average consumer of the goods in the UK, "become customary in the current language or in the bona fide and established practices of the trade" to designate the goods covered by that mark.

21. In my view, the average consumer of the goods, being various forms of alcoholic beverages, will be the general adult (over 18) UK alcohol-drinking public, including connoisseurs of such goods. I acknowledge that the average UK consumer of the goods may also be a specialist in trade, such as a third party supplier of the goods to retail or wholesale outlets or directly to establishments such as bars and restaurants, who is likely to have a broader knowledge of the goods at hand than a member of the general public.[3]

22. The opponent claims that the applicant's mark is widely used in the drinks industry to describe a collaboration between two or more parties and therefore is customary

[3] See *Matratzen Concord AG v Hukla Germany SA,* Case C-421/04, paragraph 24.

in the language of trade.[4] It submits that current usage of the term "co-lab" or "collab" in the relevant trade sector (being, in this instance, the alcoholic drinks industry) is shown at pages 1 to 30 of Exhibit CD02. I note that the screenshots pertinent to these pages within the exhibit are derived from ten different sources, including extracts from both the opponent's and the applicant's own websites:

Taken from the opponent's website[5]:

PRODUCTS > 58 AND CO OLIVE OIL VODKA

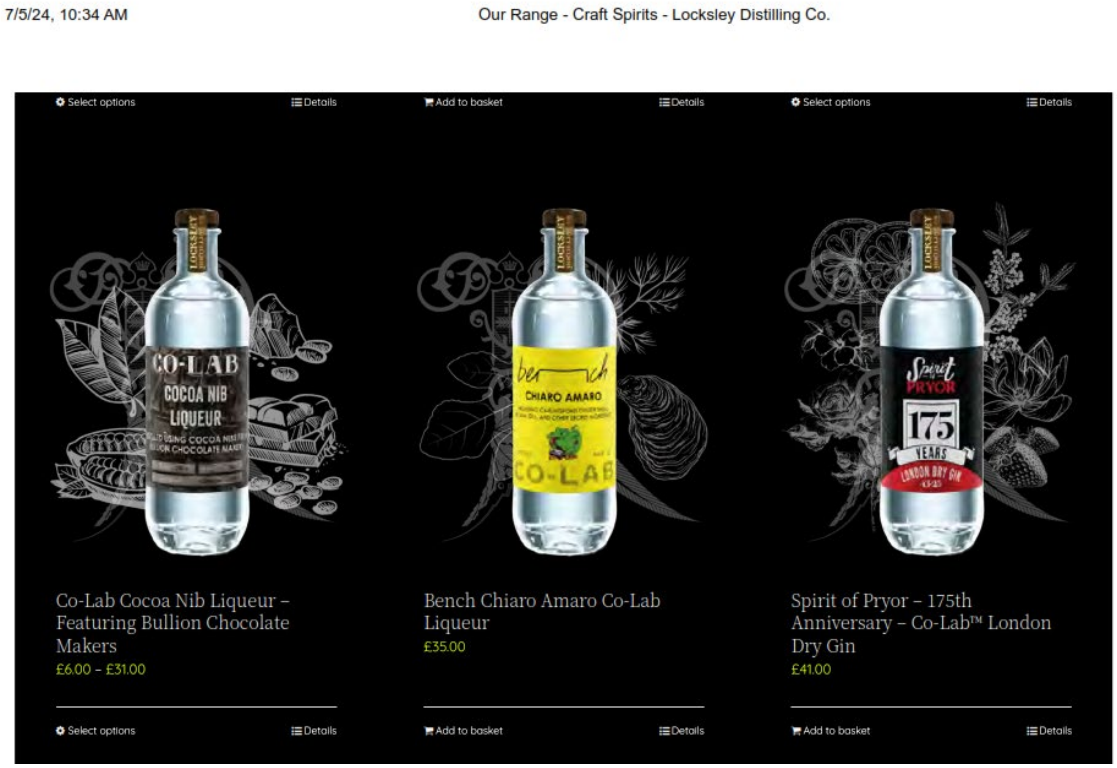
58 and CO Olive Oil Vodka

This limited-edition spirit is a characterful and clean vodka that celebrates the fresh and flavourful aromatics of small batch extra virgin olive oil.

The 58 and CO CO-LAB Series partners with like-minded brands, rescuing surplus produce and turning it into elevated experimental spirits. This Olive Oil Vodka sees a collaboration between 58 and CO and elevated olive oil brand, Citizens of Soil.

[4] Point 12 of the written submissions in lieu of a hearing.
[5] Pages 3 and 4 of Exhibit CD02.

Taken from the applicant's website[6]:



From the stylisation of the words "THE CO-LAB SERIES" and "CO-LAB", and their placement on the labels as presented on the bottles of both the opponent's and the applicant's goods, as evidenced in the extracts from the exhibit shown above, I consider that the relevant public would perceive the words as trade mark use rather than descriptive of a characteristic of the goods themselves, although I note that in relation to the opponent's goods, as illustrated above, that the article speaks of a collaboration between the opponent and an "elevated olive oil brand, Citizens of Soil".[7] To my mind, the words "THE CO-LAB SERIES" on the label on the bottle of the opponent's olive oil vodka serves as a secondary trade mark to the house mark "58 & CO".

23. I note that none of the extracts within pages 1-30 of exhibit CD02 show a date of publication, with the only visible date on the screenshots being the date the sites were

[6] Page 16 of exhibit CD02.
[7] At page 3.

accessed for the purpose of providing evidence, all being in 2024. I note that only three websites enjoy a .co.uk domain, one of which, from brewcavern.co.uk, is pertinent to a stout and coffee mix. Another article within exhibit CD02 which does indicate the sale of the goods in the UK is for a beer and cider mix. Although I accept that these extracts give a general indication of collaborations relating to drinks, both are outside the scope of protection of the applied-for goods. Further, I take the words "MEGA COLAB" in the Brew Cavern article to be trade mark use:

[8]

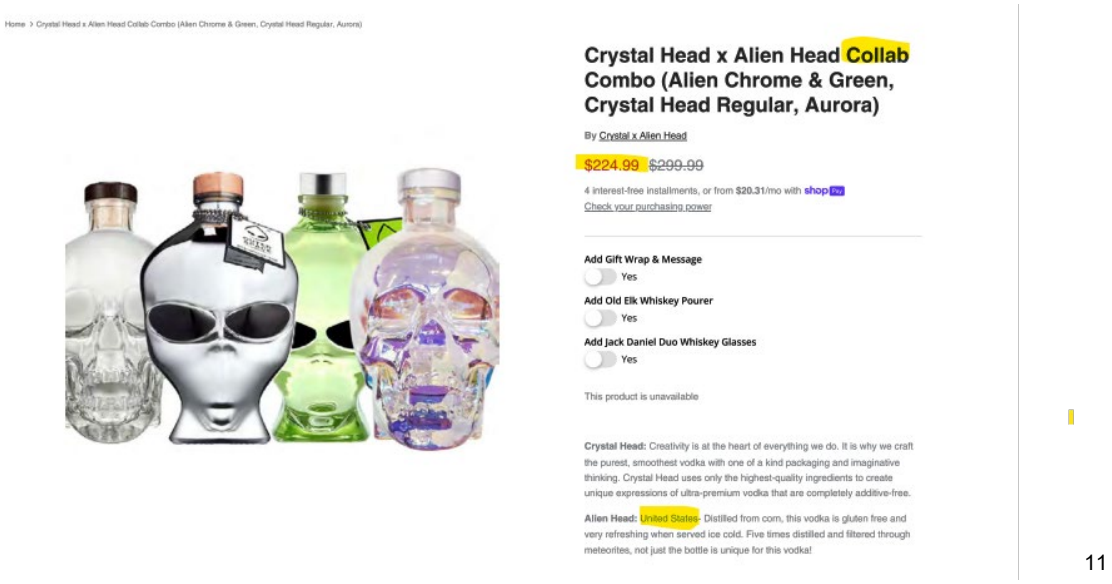
The remaining seven of the ten articles are derived from .com domains and therefore do not demonstrate that they are pertinent to the UK market. Further to this, one site offers the goods for sale priced in US dollars, while another one is located in France and talks of the brand "La Co-lab",[9] which in my view clearly indicates trade mark use. Notwithstanding the use of the word 'collaboration' in the product information, I consider the further examples below of the products on offer by the applicant, as

[8] At pages 13-14 of exhibit CD02.
[9] At pages 21-22.

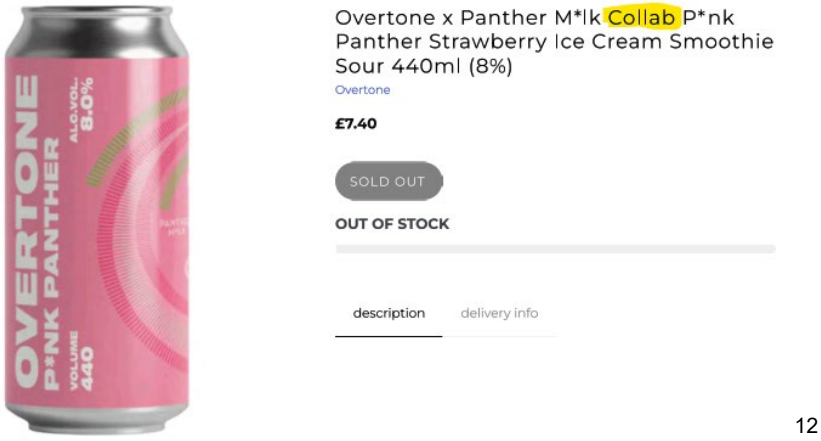
found on the label of the goods, would be seen as a trade mark, rather than descriptive use:[10]

[10] At pages 16 and 20.

24. The remaining articles which make up exhibit CD02 show examples of collaborations in various industries, including fashion, retail, music, and food and drink industries, with some examples of collaborations across two distinct industries, such as food and fashion. Those articles which do not directly relate to the goods applied for, however, are irrelevant under section 3(1)(d). I note that some of the articles include the term "collab" in relation to alcoholic beverages, but are not specific to the UK market, or it is not clear where the line is drawn between trade mark and descriptive use:



11



12

[11] Page 1 of exhibit CD02.
[12] Page 27 of exhibit CD02.

25. In order to be contrary to the provisions of section 3(1)(d), the mark must be shown to be customary in the course of trade at the time of application, in the United Kingdom. The majority of the evidence is undated and/or is not specifically targeted towards the UK. For example, the article at pages 38 - 42 of exhibit CD02 is in relation to the Chinese market, while pages 105 to 109 comprise an article directed towards the Australian market. I note other articles show the goods priced in $ and as such indicate that they are geared towards the USA (or possibly other countries outside the UK where dollars are the pertinent currency).

26. I do not dispute that the term collab/colab is a recognisable, dictionary defined abbreviation for the word collaboration, meaning a partnership of two or more people or entities working together towards a common goal, as demonstrated in the definitions provided by the opponent under exhibit CD01. While the term could realistically be used in relation to collaborations in any trade sector, in this instance, it is only the alcoholic drinks sector (excluding the likes of beer and cider), that is relevant. The applicant's mark is the word only mark "Co-Lab". As shown above, the opponent's examples of use of the mark "Co-Lab" by the applicant are for a stylised version of the sign, which to my mind would be perceived by the relevant public as trade mark use. The remaining evidence is either undated or largely irrelevant.

27. I note that in the written submissions in lieu of a hearing, the opponent directs me to paragraphs 63 - 64 of *Psytech International Ltd v OHIM*, Case T-507/08, and submits that in the case before me, the evidence provided at pages 1 to 30 of exhibit CD02 show use of "co-lab" or "collab" by several traders, and not just one sole trader (other than the applicant), selling in the UK market. However, for the reasons already outlined above, overall, I do not consider that the evidence provided is sufficient to show that the sign "Co-Lab" has become customary in trade in the UK for the various alcoholic beverages applied-for under the applicant's class 33 specification.

28. The opposition based on section 3(1)(d) fails.

Section 3(1)(b)

29. Section 3(1)(b) of the Act prevents registration of marks which are devoid of distinctive character. The principles to be applied under article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation, and is identical to article 3(1)(b) of the Trade Marks Directive and section 3(1)(b) of the Act) were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

> "29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel* v *OHIM* [2004] ECR I-5089, paragraph 32).
>
> 30. Under that provision, marks which are devoid of any distinctive character are not to be registered.
>
> 31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel* v *OHIM*, paragraph 34; Case C-304/06 P *Eurohypo* v *OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi* v *OHIM* [2010] ECR I-0000, paragraph 33).
>
> 32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck* v *OHIM*, paragraph 25; *Henkel* v *OHIM*, paragraph 35; and *Eurohypo* v *OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively,

Case C-447/02 P *KWS Saat* v *OHIM* [2004] ECR I-10107, paragraph 78; *Storck* v *OHIM*, paragraph 26; and *Audi* v *OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble* v *OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM* v *Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel* v *OHIM*, paragraphs 36 and 38; and *Audi* v *OHIM*, paragraph 37)."

30. The opponent submits that the applicant's mark is one of a number of possible abbreviations of "collaboration", which is commonly used to describe the kind of goods and/or services borne out of a collaboration between two or more parties. It continues that the mark is descriptive and therefore it follows that it is necessarily devoid of distinctive character.[13]

31. I note that in its counterstatement, the applicant denies that the term "co-lab" or "collab" is an abbreviation of "collaboration". It further denies that the abbreviations are very common terms used to describe two or more brands working together on a project or product.[14] The applicant's mark is for the hyphenated words "Co-Lab" rather than either "colab" or "collab", as per the definitions provided by the opponent in exhibit CD01 as being abbreviations for the word "collaboration". In my view, the word "collaboration" itself is non-distinctive in relation to the goods at issue, merely referring to an arrangement where two or more entities work together, for example on a project or product, with the dictionary-defined abbreviations of collaboration being perceived in the same way. Further, I do not consider that the slightly unconventional presentation of the abbreviation in the applied-for mark to be strikingly different or unusual, or to require any mental effort to understand that the mark is an alternate or

[13] Points 8 and 9 of the written submissions in lieu of a hearing.
[14] At points 1.2 and 1.3.

mis-spelling of “colab”/“collab”. To my mind, the hyphenated presentation would not make a material difference in the perceptions of the relevant public of the goods who would still assume that the applicant’s word mark refers to goods which are borne of a collaboration between two or more entities. As such, I consider the term “Co-Lab” to be origin neutral and therefore the mark as applied for is unable to fulfil the essential function of a trade mark to indicate trade origin of the goods at hand.

32. The opposition under section 3(1)(b) succeeds.

CONCLUSION

33. The opposition has succeeded under section 3(1)(b) of the Act. Subject to any successful appeal, application No. UK00003985788 by Locksley Distilling Company Limited is refused.

COSTS

34. The opponent has been successful, and is therefore entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice (“TPN”) 1/2023. I take into account that much of the evidence filed to support the opposition was of little assistance to me in making my decision, which is reflected in the costs awarded. Applying the guidance in the TPN, I consider the following to be fair:

Official fee:	£200
Preparing the notice of opposition and considering the counterstatement:	£250
Preparing evidence:	£600
Preparing written submissions in lieu of a hearing:	£350
Total:	**£1400**

35. I therefore order Locksley Distilling Company Limited to pay 58 and CO the sum of £1400. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 8th day of July 2025

Suzanne Hitchings
For the Registrar,
the Comptroller-General