

**O/0103/24**

**TRADE MARKS ACT 1994**

**TRADE MARK APPLICATION No. 3712413**

**BY MARKS AND SPENCER PLC**

**AND**

**OPPOSITION No. 431245**

**BY ALDI STORES LTD**

## BACKGROUND AND PLEADINGS

1. This is an opposition by Aldi Stores Ltd (“the opponent”) to an application filed by Marks and Spencer plc (“the applicant”) on 20<sup>th</sup> October 2021 (“the relevant date”) to register the words SNOW GLOBE as a trade mark in relation to:

Class 33: Alcoholic beverages (except beers); spirits; liqueurs; gin; rum; vodka; whisky; tequila; brandy; cognac; armagnac; cocktails.

2. According to the opponent, registration of the mark would be contrary to subsections (b), (c) and (d) of section 3(1) of the Trade Marks Act 1994 (“the Act”), which is as follows:

*“(1) The following shall not be registered—*

*(a) signs which do not satisfy the requirements of section 1(1),*

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

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

*(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade:*

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

3. The opponent claims that:

*“...the consumer would assume that SNOW GLOBE describes the receptacle (being globe shaped) in which the alcoholic beverage (containing snow flakes) is provided. In addition, the Opponent submits that SNOW GLOBE describes*

*the visual effect and characteristic of a traditional snow globe, namely a globe-shaped receptacle which, when shaken, creates a "storm effect" with the internal snow flakes."*

4. The opponent further pleaded that it:

*"...will show in evidence that there are many alcoholic beverages sold in globe-shaped receptacles and that these alcoholic beverages contain glitter, gold flecks or snow flakes producing a traditional snow globe effect (i.e. when the receptacle is shaken, the internal snow flakes will give a storm effect). These are commonly referred to in the trade as, for example, snow globes or glitter globes."*

5. The applicant filed a counterstatement denying the grounds of opposition.

6. Both sides seek an award of costs.

## **REPRESENTATION**

7. The applicant is represented by Stobbs. The opponent is represented by Freeths LLP.

8. Neither side asked for a hearing. Both sides filed written submissions in lieu. I have taken these into account in reaching my decision.

## **EVIDENCE**

9. The opponent's evidence consists of a witness statement by Fiona Lawson of Freeths LLP with 17 exhibits. Ms Lawson is a trade mark attorney. The purpose of her statement is to put in evidence the results of her research into snow and glitter globes.

10. No evidence was filed on behalf of the applicant.

## **DECISION WITH REASONS**

11. There is no claim or evidence that the contested mark had acquired a distinctive character through use prior to the date of the application for registration. Consequently, I have only the *prima facie* case to consider.

12. According to the online Cambridge dictionary, the meaning of 'snow globe' is:

*"...a toy or decoration made from glass or plastic containing a clear liquid and a substance that looks like snow, which falls on a scene inside when the object is shaken."*<sup>1</sup>

13. The applicant accepts that this is the usual meaning of the term in the English language.<sup>2</sup>

14. Exhibit FL7 to Ms Lawson's statement shows snow globes on sale on the websites of major UK retailers, such as Amazon, Etsy, The Range, Fortnum and Mason and Hobbycraft. The applicant correctly points out that these pages are dated after the relevant date. However, I note the pages from the website of Hobbycraft include reviews of 'snow globes' going back up to eight years. Further, pages 13 to 17 of exhibit FL9 are from the internet archive called the WayBack Machine. They show that Bradford Exchange was selling various themed snow globes in May 2020. In any event, given that the usual meaning of 'snow globe' at the relevant date is not in dispute, the dates of the other downloads do not appear to make any difference. If necessary, I would have taken judicial knowledge of the fact that 'snow globes' corresponding to the dictionary definition shown above have been traded in for many years, particularly around Christmas time.

15. The real dispute between the parties appears to be about whether SNOW GLOBE has been, or could be, used in trade as a descriptor for alcoholic beverages.

16. Ms Lawson says she typed 'snow globe alcohol' into the Google search engine to see how third party businesses use the term 'snow globe' in relation to alcoholic beverages. The results from the UK are set out in exhibit FL11 and show:

(1) A screenshot from Cocktails Distilled website announcing the launch of the snow globe gin liqueur by Harvey Nichols. The announcement is dated 30 September 2020.

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<sup>1</sup> See exhibit FL4

<sup>2</sup> See paragraph 16 of the applicant's written submissions dated 26<sup>th</sup> July 2023

(2) Screenshots from the Funky Pigeon website advertising for sale a snow globe gin.

(3) Screenshots from Notonthehighstreet advertising for sale a 'snow globe gin bottle with glitter' with customer reviews for the product dating back to December 2021.

(4) A screenshot from Gravity Drinks website advertising for sale a snow globe gin liqueur.

(5) Webpages from Amazon advertising for sale the Gravity Drinks snow globe gin liqueur and stating that the product was first available on Amazon on 22 October 2020.

(6) A screenshot from the ilGusto website advertising for sale a snow globe pink vodka liqueur.

17. The applicant submits that the use described at points (1), (4) and (5) above is use of SNOW GLOBE as a brand (i.e. not descriptive use), which it says can be seen from the pictures of the products. The article from the Cocktails Distilled website says that:

*"British retail giant Harvey Nichols have announced they will soon release an Orange and Gingerbread Snow Globe Gin Liqueur in time for Christmas."*

18. This suggests that Harvey Nichols was used to indicate the trade source of the goods and *Orange and Gingerbread Snow Globe Gin Liqueur* was used to describe the product. The use of capital letters for *Snow Globe* is no more significant than for *Orange and Gingerbread* (which clearly describes a characteristic of the product), or for *Gin Liqueur* for that matter. The picture of the product confirms that it took the form of a spherical transparent bottle with a winter scene inside, just like a snow globe decoration.

19. The same applies to the use shown of SNOW GLOBE in relation to the (very similar) Gravity Drinks product. I note that the web pages from Amazon identify Gravity Drinks as the 'brand'.

20. The applicant points out that the pages from the Funky Pigeon, Notonthehighstreet and ilGusto websites are dated after the relevant date. Further, although the pages from Notonthehighstreet include customer reviews, the earliest one is dated 30<sup>th</sup> December 2021, which is still more than two months after the relevant date. This is correct. However, given the 'Personalised Snow Globe Gin' product marketed by Notonthehighstreet was self-evidently a Christmas product, it would be surprising if it did not go on sale in the run-up to Christmas 2021 (i.e. around the relevant date).

21. Exhibits FL13 and 14 to Ms Lawson's statement consists of media coverage of the sale of glitter and snow globes. The Sun published an article dated 7<sup>th</sup> October 2021 with the headline:

*"Cheers! Aldi is selling a glitter snow globe gin that's £6 cheaper than the M&S sell-out one."*

22. Manchester Evening News published an article on 8<sup>th</sup> October 2021 with the headline:

*"Aldi releases snow globe gins that are £6 cheaper than M&S."*

23. You magazine published an article on 10<sup>th</sup> November 2021 (shortly after the relevant date) with the headline:

*"Morrisons has created a light up glitter gin snow globe liqueur to rival M&S's"*

24. The Liverpool Echo published an article on 30<sup>th</sup> November 2021 (not long after the relevant date) with the headline:

*"B&M launches light up snow globe gin that's £5 cheaper than M&S."*

25. There is similar media coverage of the parties' rival Glitter Globe Gin Liqueurs.

### **The section 3(1)(c) ground of opposition**

26. I will start with the section 3(1)(c) ground because this goes to the heart of the opponent's case, which is that SNOW GLOBE is descriptive of a characteristic of

alcoholic beverages, i.e. those sold in containers corresponding to the dictionary definition of a snow globe.

27. 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 some decisions of the EU courts which predate the UK's withdrawal from the EU.

28. The case law under section 3(1)(c) of the Act was summarised by Arnold J (as he then was) in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc.*<sup>3</sup> These are the most relevant points:

- (a) The general interest underlying section 3(1)(c) 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.
- (b) With a view to ensuring that that objective of free use is fully met, 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.
- (c) 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. 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.
- (d) The situations specifically covered by section 3(1)(c) of the Act are those in which the sign in respect of which registration as a mark is sought is capable

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<sup>3</sup> [2012] EWHC 3074 (Ch)

of designating a 'characteristic' of the goods or services referred to in the application. By using 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.

- (e) The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in section 3(1)(c) of the Act 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. A sign can be refused registration on the basis of section 3(1)(c) 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.
- (f) In addition, a sign is caught by the exclusion from registration in section 3(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned.

29. The applicant's answer to the opponent's section 3(1)(c) case is, essentially, that:

- (1) SNOW GLOBE describes a type of decoration; it does not describe anything else, including any characteristic of alcoholic beverages;
- (2) The opponent's evidence shows that the applicant was the first to launch an alcoholic beverage in a container resembling a snow globe; others subsequently launched similar products, mostly after the relevant date;
- (3) The average consumer would not have immediately recognised 'snow globe' as a description of alcoholic beverages at the relevant date;



- (4) The applicant's product would have been regarded as novel and SNOW GLOBE as a trade mark for it;
- (5) The snow globe effect of the container is not a "*central or essential*" characteristic of alcoholic beverages;
- (6) With one exception, the opponent's evidence only shows containers with snow globe effects used in relation to gin, not other beverages.

30. I accept there is no evidence that prior to 30<sup>th</sup> September 2020, SNOW GLOBE was used in relation to anything other than a traditional decoration. The first use of the SNOW GLOBE in relation to an alcoholic beverage bottle concretely identified in the evidence is the Harvey Nichols' product publicised on 30<sup>th</sup> September 2020 (i.e. just over a year prior to the relevant date).

31. The applicant relies on the following extracts from articles that appeared in the Liverpool Echo on 27<sup>th</sup> and 30<sup>th</sup> November 2021 to substantiate its submission that it was the first to market gin in a bottle reminiscent of a snow globe:

*"Marks and Spencer's version arrived on the scene a few years ago, with shoppers desperate to get their hands on the stunning bottle and others going as far as to collect all the different flavours to create a collection.*

*This Christmas, Aldi has released a similar bottle, from The Infusionist, and it's already received five star reviews online."*

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*"Snow globe gins are all the rage these days with a number of retailers offering shoppers the luxury treat.*

*Marks & Spencer launched the trend with its light up bottles that sold out incredibly quickly, followed by the likes of Aldi which offers a cheaper alternative. You can see how they compare here.*

*This year bargain retailer B&M is also offering another option for gin lovers."*

32. The applicant decided not to file evidence of its own. The evidence it relies on is hearsay evidence from the journalist who wrote the articles included in the opponent's evidence. I do not doubt that it reflects her understanding of the relevant market at the time of the articles. However, it is not clear how much of this was based on her own first-hand knowledge, and how much was based on what she had been told or read elsewhere. Given that the applicant could easily have filed evidence as to when it actually launched the product mentioned in these articles, I regard the evidence from the Liverpool Echo as weak evidence that the applicant was the first to market gin liqueurs in a container resembling a snow globe decoration.

33. In any event, it does not matter who first launched 'snow globe' gin. Trade mark law does not protect novel products. It protects signs that designate their trade source. Therefore, the mere fact that the applicant may have been the first trader to market a 'snow globe' gin, and/or that the public might not have known what that was before a product matching that description existed, is not fatal to the opponent's case. As Lord Templeman stated long ago in *McCain v Country Fair Foods*<sup>4</sup> in response to an argument that OVEN CHIPS was a protectable and hitherto unknown 'fancy' name:

*"...although the consumer may not have been aware, and could not have been aware of what the expression meant until oven chips came on to the market, once they had come on the market he could recognise a name which is apt and appropriate to describe a produce rather than a manufacturer, the product being potato chips prepared for cooking in the oven."*

34. The evidence indicates that in addition to the applicant's product, the Harvey Nichols, Aldi and Gravity Drinks snow globe gin liqueurs were marketed in the UK prior to the relevant date. Therefore, even if average consumers of alcoholic beverages would have struggled to understand what a 'snow globe' gin liqueur was before they encountered one, the evidence indicates that a significant proportion of the relevant public would have encountered such products prior to the relevant date.

35. In this connection, it is important to keep in mind that although the matter must be judged at the relevant date the enquiry under section 3(1)(c) is forward looking.

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<sup>4</sup> 1981 RPC 69

This is why it is not necessary to show that a description was already in use as such at the relevant date: it is sufficient to show that the sign could be used and recognised as a description in the future.<sup>5</sup>

36. I reject the applicant's submission that relevant average consumers would have perceived the use of SNOW GLOBE as branding (as opposed to a description). The picture below shows how the words appeared on the Harvey Nichols product.



37. As can be seen, the appearance of the bottle is entirely consistent with the definition of a snow globe, albeit in the form of a decorative bottle. I have no doubt that average consumers would have immediately recognised SNOW GLOBE GIN as a description of the product.

38. I reject the argument that SNOW GLOBE does not designate a “*central or essential*” characteristic of alcoholic beverages. As a matter of law, it is not necessary for a characteristic of a product to be a “*central or essential*” one in order for a description of that characteristic to be caught by section 3(1)(c) of the Act. This is clear

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<sup>5</sup> Thus in *Labowicz v EUIPO*<sup>5</sup> the EU's General Court refused to register NANO for fishing lines, weights and floats on the basis that at the time of the application for registration, nanotechnology was already being used to manufacture fishing equipment or to improve the functioning of that equipment. Therefore, it could be deduced from that 'nano' would be perceived by the relevant public as designating that the goods concerned had been manufactured using nanotechnology. The mark was descriptive and excluded from registration.

from CJEU's answer to the seventh question posed by the referring court in *Koninklijke KPN Nederland NV and Benelux-Merkenbureau*, 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.”*

39. I am aware that despite this authority, the EU's (lower) General Court subsequently decided in *Fissler GmbH v EUIPO*<sup>6</sup> that the word VITA, meaning 'white' in Swedish, was not descriptive of characteristics of food processors, cookers and cooking apparatus. This was because the name of the colour was not an intrinsic characteristic of the goods. Rather, it was merely an “*incidental*” property of some of the goods bearing the trade mark (others being marketed in different colours), and this would be apparent to average consumers of the goods. The court contrasted the facts in that case with those in *Colgate-Palmer v OHIM (VISIBLE WHITE)*<sup>7</sup>, and *Cree v OHIM (TRUE WHITE)*<sup>8</sup> in which registration of the marks was refused in relation to toothpaste and light emitting diodes, respectively. The court pointed out that colour was intrinsic to the purpose of those goods and, therefore, a relevant characteristic. Even if it was open to the General Court to make a distinction (if that is what it was doing) between ‘ancillary’ characteristics and ‘incidental’ properties, I do not consider that it would assist the applicant in this case. This is because what evidence there is contradicts the applicant's submission that a snow globe feature would not be perceived by consumers as a “*central or essential*” characteristic of alcoholic products marketed in such containers. For example, the article from the Liverpool Echo, relied on by the applicant for another purpose, states in reference to the applicant's product:

*“...shoppers [are] desperate to get their hands on the stunning bottle and others going as far as to collect all the different flavours to create a collection.”*

40. The applicant has not specifically argued that a description of a container for a product cannot be a characteristic of the goods. It was right not to do so. In many cases the container and the contents are viewed by consumers as a single commercial

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<sup>6</sup> Case T-423/18

<sup>7</sup> Case T-136/07

<sup>8</sup> Case T-208/10

product, e.g. chocolate sold in an advent calendar.<sup>9</sup> Although the administrative classification system puts chocolate in class 30 and (empty) containers in other classes, this has no bearing on how such products would be perceived by consumers. And it is the perception of the goods as articles of commerce that counts. In that context, it would be absurd to suggest that an ‘advent calendar’ does not describe a kind of chocolate product.

41. In this case the applicant’s actual product appears to be a fusion between a bottle of gin liqueur and a decoration.<sup>10</sup> In these circumstances it is clear that the snow globe effect bottle would be perceived as a characteristic of the goods, and the words SNOW GLOBE as a description of that characteristic. That would be so irrespective of whether the product originated from the applicant, the opponent, or any other trader in such products. There is nothing unfair about maintaining that situation. Absent a relevant intellectual property right copying novel products is fair competition.

42. The applicant complains that such a conclusion would open the door for third parties to copy any distinctive branding for products. It cites the hypothetical example of a beverage called FOX bearing the image of a fox. According to the applicant, the logical result of rejecting this application would be that any third party would be free to flood the market with beverages featuring images of foxes and justify using FOX as a brand on the basis that it describes the packaging for the goods. I do not accept this argument. The obvious difference is that an image of a fox is not a characteristic of beverages or their packaging: it would be purely part of the branding for the product. In my view, the same cannot be said about alcoholic beverages marketed in containers doubling as snow globes.

43. As to the point about the opponent’s evidence only showing use of snow globe-like containers in relation to gin, I find it goes nowhere. If gin can be sold in such

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<sup>9</sup> In *Henkel*, case C-218/01, the CJEU held that “three-dimensional trade marks consisting of the packaging of goods which are packaged in trade for reasons linked to the very nature of the goods, the packing thereof must be assimilated to the shape of the goods... and may, where appropriate, serve to designate characteristics of the packaged goods, including their quality, within the meaning of Article 3(1)(c) of [the EU Trade Mark] directive.” The same must apply to words that describe the packing of goods, such as alcoholic beverages, which by their nature must be marketed in a container.

<sup>10</sup> The applicant has not suggested that use of the mark in relation to beverages marketed in containers resembling a snow globe would be anything other than a normal and fair example of use of the mark in relation to the goods covered by the application.

containers then so too can any other alcoholic beverage. The subsequent use of similar containers for a vodka-based product confirms this.<sup>11</sup>

44. I therefore uphold the opponent's opposition under section 3(1)(c) of the Act in relation to all the goods covered by the application.

### **The section 3(1)(d) ground of opposition**

45. My finding under section 3(1)(c) is sufficient to dispose of the matter. However, in case I am wrong about that I will briefly set out my findings on the opposition under section 3(1)(d).

46. In *Telefon & Buch Verlagsgesellschaft GmbH v OHIM*,<sup>12</sup> the EU's General Court summarised the case law of the CJEU under the equivalent of s.3(1)(d) of the Act as follows:

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

*50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably*

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<sup>11</sup> See paragraph 16(6) above.

<sup>12</sup> Case T-322/03

*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)."*

47. I find that the marketing of snow globe-type containers for alcoholic beverages by major UK retailers Harvey Nichols, Aldi, the applicant itself, and by Gravity Drinks, in the UK, prior to the relevant date, is sufficient to establish that SNOW GLOBE was a sign that had "*become customary in the .... bona fide and established practices of the trade to designate the goods*" at the relevant date.

48. The opposition under section 3(1)(d) of the Act therefore also succeeds.

### **The section 3(1)(b) ground of opposition**

49. I agree with the applicant that, at least as pleaded, this adds nothing to the other grounds of opposition.

### **OVERALL OUTCOME**

50. The opposition has succeeded. The registration of the trade mark will be refused for all the goods specified in the application.

### **COSTS**

51. The opponent has been successful and is entitled to a contribution towards its costs. I assess these as follows:

£200 for the official fee for filing a Notice of Opposition;

£400 for completing the Form TM7 and considering the applicant's counterstatement;

£1000 for filing evidence in support of the opposition;

£200 for filing written submissions in lieu of a hearing.

52. I therefore order Marks and Spencer plc to pay Aldi Stores Ltd the sum of £1800. This sum should be paid within twenty-one days of the expiry of the appeal period, or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful or withdrawn.

**Dated this 13<sup>th</sup> day of February 2024**

**Allan James**

**For the Registrar**