

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2341223
IN THE NAME OF ICELAND FOODS LIMITED**

**AND IN THE MATTER OF OPPOSITIONS Nos. 94461 – 94466 THERETO
BY (1) ICELANDIC SPRING IN ICELAND (2) ICELANDIC GROUP PLC
(3) BLUE LAGOON LIMITED (BLAA IONID H.F) (4) ICELANDAIR EHF
(5) ALFESCA LIMITED (6) MINISTRY OF FOREIGN AFFAIRS AND OTHERS**

**AND IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON
BY THE APPLICANT
AGAINST DECISIONS OF MR. O. MORRIS
DATED 8 AUGUST 2012 AND 12 NOVEMBER 2012**

DECISION

Introduction

1. This appeal is about the registrability of geographical names as trade marks, specifically Iceland. The issue arose in the context of 6 oppositions brought by organisations with interests in Iceland including the Icelandic Government and several Icelandic trade associations (“the Opponents”).
2. The Hearing Officer, acting for the Registrar, in Decision BL O/307/12, dated 8 August 2012, and Supplementary Decision BL O/440/12, dated 12 November 2012 allowed a series of 3 trade marks containing and for the word ICELAND to be registered for various goods and services, but denied registration of the series in respect of a number of other goods and services including in Class 29: *Meat; fish, poultry, and game, none being live; all for food for human consumption.*
3. Iceland Foods Limited (“IFL”) appealed those decisions but only in relation to meat, poultry and game. In response, the Opponents *inter alia* made an application to introduce fresh evidence. Finally, IFL contested the Hearing Officer’s costs award.
4. At the appeal hearing, Mr. Roger Wyand of Queen’s Counsel, instructed by Groom Wilkes & Wright LLP appeared for IFL. Mr. Douglas Campbell of Counsel instructed by Page White & Farrer appeared for the Opponents.

Law on the registration as trade marks of geographical names

5. Section 3(1)(c) of the Trade Marks Act 1994 (implementing Article 3(1)(c) of Directive 2008/95/EC to approximate the laws of Member States relating to trade marks) provides that:

“3. - (1) The following shall not be registered –

- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the ... geographical origin ... or other characteristics of goods or services.”

6. A proviso to Section 3(1)(c) (the proviso implementing Article 3(3) of Directive 2008/95/EC) gives a defence to that objection where before the date of application for registration, a trade mark has in fact acquired a distinctive character as a result of the use made of it. The Hearing Officer held that IFL had not on the evidence established acquired distinctiveness of the ICELAND trade marks applied for *inter alia* for meat, poultry or game. IFL did not contest that finding of lack of acquired distinctiveness. The appeal on Section 3(1)(c) concerns therefore only the *prima facie* or inherent registrability of the ICELAND trade marks in suit for meat, poultry and game.
7. The public policy behind Section 3(1)(c) of the Act is that descriptive indications should remain available to all traders for use in relation to their goods and services. This is regardless of the number of competitors interested in using the designation and the availability of other, more usual, descriptions (Case C-363/99, *Koninklijke KPN Nederland NV v. Benelux-Merkenbureau* [2004] ECR I-1619, paras. 54 – 63).
8. The principles governing the exclusion from registrability under Section 3(1)(c) particularly of geographical names, are well-established in the EU case law. It was accepted that the Hearing Officer correctly directed himself by reference to the judgment of the EU Court of Justice (“CJEU”) in Joined Cases C-108/97 and 109/97, *Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) v. Boots- und Segelzubehör Walter Huber and Franz Attenberger* [1999] ECR 2779, paras. 26, 28 – 37), and the decisions of the EU General Court (“GCEU”) in Case T-295/01, *Nordmilch eG v. OHIM* [2003] ECR II-4365, paras. 29 – 38 and Case T-379/03, *Peek & Cloppenburg KG v. OHIM* [2005] ECR II-4633, paras. 47, 49 – 51.
9. Mr. Campbell referred me to the recent synthesis of these principles by the GCEU in Case T-320/10, *Fürstlich Castell’sches Domänenamt Albrecht Fürst zu Castell-Castell v. OHIM*, 13 September 2013, at paragraphs 43 – 49, to which Mr. Wyand took no objection and is set out below¹:

“43. As regards, more particularly, signs or indications which may serve to designate the geographical origin of the categories of goods in relation to which registration of the mark is applied for, especially geographical names, it is in the public interest that these remain available, not least because they may be an indication of the quality and other characteristics of the categories of goods concerned, and may also, in various ways, influence consumer tastes by, for instance, associating the goods with a place that may give rise to a favourable response (see, by analogy, Joined Cases C- 108/97 and C- 109/97 *Windsurfing Chiemsee* [1999] ECR I- 2779, paragraph 26; Case T- 295/01 *Nordmilch v OHIM (OLDENBURGER)* [2003] ECR II- 4365, paragraph 30; and *PASSIONATELY SWISS*, paragraph 29).

¹ The GC decision in *Castell* is the subject of an appeal to the CJEU in Case C-622/13 P.

44. Furthermore, it may be observed, first, that the registration of geographical names as trade marks where they designate specified geographical locations which are already famous or known for the category of goods concerned, and which are therefore associated with those goods in the mind of the relevant class of persons, is excluded as, secondly, is the registration of geographical names which are liable to be used by undertakings and must remain available to such undertakings as indications of the geographical origin of the category of goods concerned (see, by analogy, *Windsurfing Chiemsee*, paragraphs 29 and 30; *OLDENBURGER*, paragraph 31; and Case T- 379/03 *Peek & Cloppenburg v OHIM (Cloppenburg)* [2005] ECR II- 4633, paragraph 34).

45. However, Article 7(1)(c) of Regulation No 207/2009 does not in principle preclude the registration of geographical names which are unknown to the relevant class of persons – or at least unknown as the designation of a geographical location – or of names in respect of which, because of the type of place they designate, such persons are unlikely to believe that the category of goods or services concerned originates there or was conceived of there (see, by analogy, *Windsurfing Chiemsee*, paragraph 33, and *Cloppenburg*, paragraph 36).

46. Consequently, it is necessary, in order to assess whether a sign is likely, in the minds of the relevant class of persons, to designate the geographical origin of the category of goods concerned, to establish whether the geographical name in question designates a place which is currently associated in the minds of the relevant class of persons with the category of goods concerned, or whether it is reasonable to assume that such an association may be established in the future (see, by analogy, *Windsurfing Chiemsee*, paragraph 31). To that end, regard must be had to the degree of familiarity among such persons with that name, with the characteristics of the place designated by the name, and with the category of goods concerned (see, by analogy, *Windsurfing Chiemsee*, paragraph 32).

47. As regards word marks, it must also be pointed out that any perceptible difference between the formulation of the term submitted for registration and the terms used in the common parlance of the relevant class of consumers to designate the goods or services or their essential characteristics is apt to confer distinctive character on that term enabling it to be registered as a trade mark (*Procter & Gamble v OHIM*, paragraph 40).

48. Furthermore, in order to be caught by Article 7(1)(c) of Regulation No 207/2009, it is sufficient that at least one of the possible meanings of a word sign designates a characteristic of the goods or services concerned (*OHIM v Wrigley*, paragraph 32, and Case T- 344/07 *O2 (Germany) v OHIM (Homezone)* [2010] ECR II- 153, paragraph 21).

49. It must also be borne in mind that the descriptiveness of a trade mark cannot be assessed other than by reference to the goods or services in respect of which the sign has been registered, on the one hand, and by reference to the

perception which the relevant public has of it, on the other (*OLDENBURGER*, paragraph 34, and *Cloppenburg*, paragraph 37).”

The Application

10. Application number 2341223 was filed by IFL on 20 August 2003 requesting registration of the following series of 3 designations for use as trade marks in the UK in relation to goods and services in Classes 3, 4, 5, 6, 7, 8, 9, 11, 16, 20, 21, 29, 30, 31, 32, 33, 34, 35, 41, 42 and 43 (the full list is set out in Decision BL O/307/12):



ICELAND

11. It was not suggested that the figurative elements of trade marks 1 and 2 took them outside the scope of Section 3(1)(c). That argument was in any event unavailable to IFL because of the presence of the third word mark in the series (*LOGICA Trade Mark*, BL O/068/03, *Sony Ericsson Mobile Communication AB's Trade Mark Application*, BL O/138/06).
12. The Application was published in the Trade Marks Journal on 31 March 2006. Within the opposition period, 6 separate oppositions were received against the Application by: (1) Iceland Spring in Iceland (No. 94461); (2) Icelandic Group Plc (No. 94462); (3) Blue Lagoon Limited (Blaa Ionid H.F) (No. 94463); (4) Icelandair Ehf (No. 94464); (5) Alfresca Ltd (No. 94465); and (6) The Ministry of Foreign Affairs, Iceland and 6 Icelandic trade federations/associations including the Trade Council of Iceland (No. 94466).
13. A number of the oppositions raised relative grounds of opposition that were abandoned at an early stage. I return to this point in connection with IFL's appeal against the Hearing Officer's costs order.
14. Otherwise the oppositions raised absolute grounds of objection under Section 3(1)(a) – (d), 3(3) and 3(4). The Hearing Officer held that these stood or fell with the Section 3(1)(c) objection against which there was no appeal. Although not consolidated, the 6 oppositions were heard together.

The Hearing Officer's decisions

15. The Hearing Officer collectively summarised the Opponents' evidence at paragraphs 5 – 30 of the main Decision BL O/307/12. No point was taken against that summary. I understood the parties to acknowledge that it was both comprehensive and accurate.

16. The Hearing Officer's review of Ms. Shackleton's evidence² provided him with an overall picture of the characteristics, production and export trade of Iceland at the time of the Application. For convenience, the relevant paragraphs are reproduced at Annex A.
17. Since this appeal involves solely meat, poultry and game, I note from Ms. Shackleton's evidence that at the relevant time, in brief:
- (a) Iceland was a significant agricultural producer of *inter alia* lamb, mutton, beef, pork and poultry. 3.9% of Iceland's labour market was in agriculture. Icelandic lamb was said to be gaining worldwide recognition for its unique taste and nutritional value.
 - (b) Iceland's exports included meat. The UK was one of Iceland's largest importers.
 - (c) Several UK companies with links to Iceland/Icelandic goods used the word Iceland in their names (also websites).
 - (d) Several Icelandic exporters used the word Iceland in their company names.
 - (e) Many visitors to Iceland (over 2 million per year) were from the UK.
18. The Hearing Officer held:
- (1) The relevant public would be familiar with the country of Iceland; and
 - (2) Iceland had a reputation for fish.
19. Beyond that situation where there was a current association in the minds of the relevant public between the geographical name and the goods/services (as there was for Iceland and fish), the Hearing Officer recognised that the law required him to perform a balancing exercise (taking into account the *Windsurfing* factors).
20. Going through the Classes in the Application, the Hearing Officer determined that the goods and services in question fell into 3 types:
- (i) those that were not objectionable under Section 3(1)(c) (or any of the other absolute grounds pleaded), ranging from drinking straws and dishwashers to retail and restaurant services;
 - (ii) those where the objection under 3(1)(c) (and any other of the absolute grounds pleaded) could be cured by an appropriate limitation, for example, food for babies and prepared meals *none of the aforesaid goods consisting wholly or principally of fish*;

² Witness statement of Nicola Shackleton, a Director of Page White & Farrer, dated 22 September 2008.

- (iii) those where the objection under Section 3(1)(c) was made out so that registration must be refused. This category included fish (not disputed) and the items under appeal namely, meat, poultry and game.
21. The majority of the goods and services applied for were found by the Hearing Officer to be unobjectionable. He therefore ordered the Opponents to pay to IFL as the overall successful party a contribution towards IFL's costs of the oppositions in the sum of £1800 (£300 per Opponent).

The appeal

22. On 5 December 2012, IFL filed Notice of Appeal to the Appointed Person under Section 76 of the Act. As I have said, the appeal was limited to the Hearing Officer's refusal of registration in Class 29 to: *Meat; poultry, and game, none being live; all for food for human consumption* under Section 3(1)(c) of the Act, and there was no suggestion that the Hearing Officer misstated the law in that respect.
23. The grounds of appeal were listed as twofold:
- (1) The Hearing Officer ignored his own findings on the evidence in refusing registration to meat, poultry and game, when the Opponents had failed on their evidence to establish their objections to these goods. Further he wrongly took into account his own "consciousness" that meat, poultry and game were the type of goods often stamped with the name of the originating country, which was unsupported in the evidence.
 - (2) The Hearing Officer erred in deciding costs in Decision O/307/12 when the UK IPO covering letter accompanying that decision invited the parties' submissions on costs. Those submissions included that IFL should receive an additional £400 from each of the 5 Opponents who raised but then abandoned relative grounds of objection.
24. The Opponents filed a Respondent's Notice on 8 May 2013³. On 8 May 2013, the Opponents also made a request to introduce fresh evidence into the appeal.

The Opponents' application to introduce fresh evidence on appeal

25. The parties were agreed that I should be guided by the following passage in Kerly's Law of Trade Marks and Trade Names, 15th Edition, paragraph 5-155 (reproduced without footnotes):

"On appeal before the court or the Appointed Person new evidence may be admitted only with leave. The onus is on the party applying for leave to admit the evidence to justify the exercise of the discretion in his favour but there are no express limits placed upon the discretion or criteria set for its exercise, save that the discretion should be exercised in accordance with the overriding objective and the concept of proportionality. Relevant factors are likely to include the following:

³ Having been granted by the UK IPO an extension of time of 21 days in which to do so.

- (1) Whether the evidence could have been filed earlier and, if so, how much earlier.
 - (2) If it could have been, what explanation for the late filing has been offered to explain the delay.
 - (3) The nature of the mark.
 - (4) The nature of the objections to it.
 - (5) The potential significance of the new evidence.
 - (6) Whether the other side will be significantly prejudiced by the admission of the evidence in a way which cannot be compensated, for example by an order for costs.
 - (7) The desirability of avoiding multiplicity of proceedings.
 - (8) The public interest in not admitting onto the Register invalid marks.”
26. The Opponents’ fresh evidence comprised a Witness Statement of María Kristín Gunnarsdóttir, the Opponents’ Icelandic trade mark attorney, dated 8 May 2013.
27. Ms. Gunnarsdóttir exhibited to her Witness Statement:
- (a) Exhibit MKG1 – documents regarding export figures of meat, poultry and game from Iceland to the UK from 1990 – 2002. Most of the exports were of lamb and mutton (with 1 mention of “swine”). Volumes and values of meat exports were given for each of the years 1990, 1993, 1994, 1996, 1997, 1999, 2000, 2001 and 2002 with the source stated to be Statistics Iceland, 6 May 2013.
 - (b) Exhibit MKG2 – a “To whom it may concern” letter from Statistics Iceland certifying the above meat and edible meat offal exports to the UK. The letter was dated 6 May 2013, signed by Auður Ólína Svavarsdóttir, Head, External Trade, Statistics Iceland and stamped with a Statistics Iceland stamp.
 - (c) Exhibit MKG3 – historic exchange rates to convert Icelandic Krona to British Pounds from 1990 – 2002 obtained electronically from The Central Bank of Iceland.
28. The new evidence was obviously directed at the Hearing Officer’s expressed difficulty in assessing the impact in the UK of Icelandic exports (other than fish) especially since he had not been provided with conversion rates for ISK/GBP (Decision BL O/307/12, para. 37).
29. IFL objected to the admission of the fresh evidence on the basis that it had clearly been available to the Opponents to put before the Hearing Officer and no explanation had been given for the delay. IFL also pointed out that the new evidence failed to meet the Hearing Officer’s criticism that no information was provided as to what proportion of the relevant UK market the exports from Iceland represented.
30. The Opponents on the other hand argued that this was publicly available information that merely supported the Hearing Officer’s decision on the evidence before him. The new evidence was limited in scope and appeared inherently credible. The application was made on 8 May 2013 and IFL had had plenty of time to verify the materials.

31. I decided to allow in Ms. Gunnarsdóttir's evidence in spite of its earlier availability. My reasons were (in no particular order):
- (1) The exchange rates and the statistics were on the public record.
 - (2) Statistics Iceland is the centre for official statistics in Iceland and is governed by statute. The figures for meat exports from Iceland to the UK from 1990 – 2002 supplied by Ms. Gunnarsdóttir and certified by Statistics Iceland were credible.
 - (3) The new evidence documented significant quantities of meat exports (chiefly lamb and mutton) from Iceland to the UK. These appear to have been highest in 1996 and 2001 with volumes at around 320,000 kg and values of over 500k GBP.
 - (4) This serves therefore to confirm the Hearing Officer's findings on the original evidence of some examples of lamb and beef being exported from Iceland to the UK.
 - (5) In my judgment the fresh evidence was pertinent if not crucial to the outcome of the case in clarifying the extent of Icelandic meat exports to the UK before the relevant date. I accept, however, that information was still lacking on how to relate these figures to the relevant UK market overall.
 - (6) The fresh evidence was limited in scope and any prejudice to IFL could be compensated in costs. IFL was sent copies of the Opponent's application and further evidence on 8 May 2013. IFL objected to the application in a letter to the UK IPO dated 20 May 2013, on the sole ground that that the evidence could have been obtained for use at the hearing below. Verification of the Statistics Iceland data was not raised by IFL until shortly before the appeal hearing. IFL had over 6 months in which to verify the data if so minded. In any event, as I have already indicated, I considered the further evidence credible.
 - (7) The public interest aspect of these oppositions that geographical indications should remain freely available for traders to use in connection with their goods and services.
 - (8) The preponderance of factors listed at paragraph 25 above operated in my judgment in favour of admission.

Standard of appeal

32. It was accepted that this appeal was a review of the Hearing Officer's decision and not a rehearing (but with the benefit of the fresh evidence) and that the approach stated by Robert Walker L.J. in *REEF Trade Mark* [2002] EWCA Civ 763 at paragraph 28 applied:

“In such circumstances an appellate court should in my view show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle.”

33. Robert Walker L.J. went on in *REEF* to observe:

“29. The appellate court should not treat a judgment or written decision as containing an error of principle simply because of its belief that the judgment or decision could have been better expressed. The duty to give reasons must not be turned into an intolerable burden: see the recent judgment of this court in *English v Emery Reimbold & Strick Ltd* (and two other appeals heard with it) [2002] EWCA Civ 605, 30 April 2002, para 19:

“... the judgment must enable the appellate court to understand why the Judge reached his decision. This does not mean that every factor which weighed with the Judge in his appraisal of the evidence has to be identified and explained. But the issues the resolution of which were vital to the Judge’s conclusion should be identified and the manner in which he resolved them explained. It is not possible to provide a template for this process. It need not involve a lengthy judgment. It does require the Judge to identify and record those matters which were critical to his decision.”

And see similar observations by Lewison L.J. in *FAGE UK Limited v. Chobani UK Limited* [2014] EWCA Civ 5 at paragraphs 114 – 115.

34. Mr. Campbell took me to the judgment of Lindsay J. in *esure Insurance Limited v. Direct Line Insurance Plc* [2007] EWHC 1557 (Ch) at paragraph 12 for a further explanation of what constituted an error of principle in this context:

“I shall not be ambitious enough to attempt a full definition of what is, for present purposes, an error of principle such as to justify or require departure from the decision below save to say that it includes the taking into account of that which should not have been, the omission from the account of that which should have been within it and the case (explicable only as one in which there must have been error of principle) where it is plain that no tribunal properly instructing itself could, in the circumstances, have reasonably arrived at the conclusion that it reached.”

Merits of the appeal

35. IFL’s first ground of appeal rested on an alleged inconsistency between paragraphs 37 and 62 in the Hearing Officer’s Decision BL O/307/12.

36. Paragraph 37 contains some of the Hearing Officer’s conclusions on the parties’ evidence which he expressed following his review of the EU case law on the registrability of geographical names (listed at para. 8 above). It is instructive to view paragraph 37 in the context of his other such conclusions:

“35) The country of Iceland is a small one, at least in terms of population if not in size. Its population is just over 300,000 people, the size of an averagely sized city in the UK. Having considered the evidence, I have no doubt that the country has a reputation for fish, particularly cod. IFL do not take issue with this. The fish are likely to be caught in the waters surrounding Iceland and perhaps processed in its ports – this is how the relevant public is likely to appreciate the reputation. However, notwithstanding the evidence filed by Ms Shackleton, I do not consider that the country has a specific reputation for anything else. The country may be known for other things, banking and volcanoes spring to mind, but this is not relevant to the matters to be determined here. In any event, the infamous events surrounding Icelandic banks and the country’s volcanic activity postdates the relevant date here.

36) In terms of the degree of familiarity with the country of Iceland, the relevant public for all of the goods and services are likely to know of the country. As Mr Baldwin submitted, it is a European country not an obscure, unrecognizable one. This, however, does not mean that the word ICELAND used as a trade mark in relation to the goods and services would automatically be taken as a description of geographic origin for everything. This is where the balancing act outlined in the jurisprudence needs to be taken into account.

37) As I have said, the country may be known for its fishing industry. As a matter of fact, the country does export goods other than fish. However, from the evidence provided to the tribunal, it is difficult to ascertain its significance and likely impact on the UK public. The export figures to the UK for 2002 were 35,739 million Krona. No conversion figures to £s are provided. Nor is any information provided as to what proportion of the relevant UK market the exports from the country of Iceland represent. They may be just a drop in the ocean. A high proportion of the exported goods are fish. Mineral products also seem important. So what is left is spread over what Ms Shackleton describes as a diverse export economy. When all this is weighed up, the significance on the UK public of Icelandic exports (other than fish) must, therefore, be limited.

38) Some words or phrases are more apt to be perceived as a description. For example, “Made in Iceland” sends a very direct message. The word Icelandic may also have a reasonably direct meaning. Whilst it could be said that there is little difference between ICELAND and ICELANDIC it is, nevertheless, a distinction to bear in mind as part of the factual matrix of the case. As the case-law suggests, the mark must be carefully assessed against the goods and services put forward for registration. I should add that Mr Baldwin gave various examples of what he considered to be normal descriptive use of phrases including the word ICELAND (as a reference to the country) which he says would constitute infringing use if the opposition did not succeed; I have borne the public interest in mind when coming to the findings set out below ...”

37. At paragraph 62 the Hearing Officer was considering the Section 3(1)(c) objection in relation to IFL’s goods in Class 29, specifically *meat; fish, poultry and game, none being live; all food for human consumption*:

“62) Care needs to be exercised here given that many of these goods are natural products. The specification includes fish. As discussed already, the country of Iceland has a reputation and is associated with fish, particularly cod. I consider the objection to be made out for the term fish (and not just cod). In relation to “meat, poultry and game”, I am conscious that these are the types of goods that are often stamped with the name of the originating country. The goods are of the type where traceability is paramount. Whilst the evidence is not overwhelming, there are some examples of lamb and beef being exported. Whilst it is not clear as to the level of exports to the UK and whilst, therefore, I cannot say that there is a current association, these are the sorts of goods for which foreseeability may be an issue. **I consider the objection to be made out here.**”

38. Mr. Wyand argued that the Hearing Officer’s findings at paragraph 62 in relation to meat, poultry and game were at odds with his previous conclusions in paragraph 37 as to the perceptions of the public with regard to Iceland, which were relevantly limited to fish.
39. Mr. Wyand also criticised the Hearing Officer for taking into account his own awareness that meat, poultry and game were the type of goods that were often stamped with the name of the originating country.
40. Further, Mr. Wyand contended that the Hearing Officer gave no reasons for his determination that foreseeability might be an issue regarding meat, poultry and game.
41. Taking first, Mr. Wyand’s second criticism. It is well established under UK and EU trade marks law that a Hearing Officer is entitled to bring to bear his or her own common sense and experience in deciding objections to registrability especially those concerning the absolute grounds for refusal of registration (*Marks and Spencer plc v. Interflora Inc.* [2012] EWCA civ 1501, para. 50, Case T-68/13 and *Novartis AG v. OHIM*, 23 January 2014, para.27 and the cases referred to therein).
42. As Mr. Campbell highlighted, the Hearing Officer had before him plenty of evidence of foodstuffs being marked with the country of origin in the Witness Statement of John Groom of Groom Wilkes & Wright LLP, dated 19 February 2009. Much of this evidence related to fish (e.g. Scottish Haddock, Greek Sea Fillets Farm Reared in Greece, New Zealand Mussels, Icelandic Cod) but also to chocolates and wines
43. During the appeal hearing, Mr. Wyand admitted to knowing that New Zealand lamb sometimes had New Zealand stamped on it (transcript, p.13).
44. In my judgment, Mr. Wyand’s second criticism was unjustified and the Hearing Officer was entitled to take into account his own experience that meat, poultry and game were the type of goods where the public had an interest in, and might expect to be told their place of origin.
45. As for the alleged inconsistency, it seems to me that in paragraph 37 on the one hand the Hearing Officer was concerned with determining generally on the evidence any current association in the minds of the public between the country Iceland and the goods and services applied for. This was certain in relation to fish but limited in

relation to anything else. In paragraph 62 (and paras. 63 – 65) on the other hand, the Hearing Officer was considering 2 issues specifically in relation to the Class 29 goods: (1) any current association between the country of Iceland and those goods - made out in relation to fish; and (2) any future association the public was liable to make between the country of Iceland and those goods – made out in relation to meat, poultry and game.

46. Contrary to IFL’s assertion, it seems to me that the Hearing Officer gave 4 reasons for his “foreseeability” determination in paragraph 62: (a) meat, poultry and game were natural products; (b) such goods were often stamped with the name of the originating country; (c) traceability was paramount in respect of such goods; (d) there was some evidence before him of Icelandic lamb and beef exports although the level of such exports to the UK was unclear on the evidence before him (since clarified by the additional evidence).
47. The Hearing Officer had already noted that the majority of persons in the UK would be familiar with the European country of Iceland and that Iceland was an agricultural producer.
48. Although in his skeleton argument for the appeal, Mr. Wyand criticised the Hearing Officer for relying on the UK IPO Work Manual of practice in relation to the registrability of geographical names when this was not expressly argued before him: (1) Ms. Shackleton made references to the Manual as relevant in her evidence; and (2) I detected no undue reliance by the Hearing Officer on the Manual, rather it was clear he was guided by the applicable case law and the circumstances of the particular case. Of course, he would have been aware of the Office practice guidelines but I see nothing wrong with that.
49. Earlier in his decision the Hearing Office had said that his deliberations would be informed by the public interest. That included the evidence of the Iceland/UK export/import trade even though the establishment of a current need to use by other traders is not a pre-condition to the operation of the exclusion from registration under Section 3(1)(c).
50. I agree with Mr. Wyand that the matter must be judged against the perceptions of the average public at the time of the application. However, those perceptions are of the sign in relation to the goods or services in question. The average consumer is a notional consumer and the exercise is objective.
51. Where there is currently no association in the minds of the average public between the sign and those goods or services, the tribunal must assess whether it is reasonable to assume that such an association may be established in the future. In undertaking that latter task, the tribunal is directed by *Windsurfing* to give particular consideration to the degree of familiarity amongst the average public with the geographical name in question, with the characteristics of the place designated by that name, and with the category of the goods/services in question.
52. Mr. Wyand posed me the question: what would the average consumer understand on seeing ICELAND stamped on a piece of meat? I believe the answer was obvious once Mr. Wyand retracted his argument that ICELAND would convey to the average

public ICELAND supermarket. Mr. Wyand conceded that the matter had to be judged in the *prima facie* since IFL had failed to establish on the evidence that ICELAND had acquired distinctiveness through use for meat, poultry and game.

53. In my judgment, the Hearing Officer did not err in finding that the objection under Section 3(1)(c) was made out in respect of meat, poultry and game. He was entitled on the evidence before him to conclude that this was in the public interest, a conclusion that was subsequently borne out by the additional evidence admitted into the appeal.
54. Finally under this head, IFL argued that the proper adjective would be “Icelandic” not “Iceland”. This point had been taken on board by the Hearing Officer, but to his mind did not affect the outcome in respect of the goods in suit. Mr. Campbell rightly reminded me that the availability of other descriptions does not defeat the objection under Section 3(1)(c) (Case C-191/01 P, *OHIM v. Wm. Wrigley Jr. Company* [2003] ECR I-12447, para. 26).
55. The first ground of appeal fails.

Costs appeal

56. IFL’s second ground of appeal relates to the amount of the costs award made in their favour by the Hearing Officer.
57. The Hearing Officer gave his determination of costs at the end of Decision BL O/307/12 in the following terms:

“84) IFL has been the most successful party and I consider it is entitled to a contribution towards its costs. However, given that the opposition did succeed in part, I will reduce such contribution by a proportionate amount. Although not consolidated, the oppositions have been dealt with as one and there is a large overlap in evidence in terms of that filed by IFL and that filed by Ms Shackleton. The total amount will, therefore, be split between the six sets of opposition proceedings. The total amount is the sum of £1800 calculated as follows:

Preparing statements and considering the other sides’ statements
£400

Filing evidence and considering the other sides’ evidence
£800

Attending the hearing
£600

85) For each set of proceedings, the relevant opponent(s) shall, therefore, pay IFL the sum of £300 each. In the case of opposition 94466 from the Ministry of Foreign Affairs (and others), the eight joint opponents shall be jointly and severally liable for such a sum. This should be paid within seven days of the expiry of the appeal period (which will begin when I issue a supplementary

decision dealing with the point in paragraph 83) or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.”

58. It was clear from this that the only matter left over for a supplementary decision was the finalisation of limitations the Hearing Officer had proposed to IFL’s “food for babies” in Class 5 and “prepared meals and constituents therefor, snack foods” in Class 29.
59. That notwithstanding, the UK IPO letter effectively inviting the parties’ submissions on the proposed limitations also asked for the parties’ submissions on costs (UK IPO to parties, 8 August 2012). Having been granted an extension of time within which to file submissions on costs (UK IPO to Groom Wilkes & Wright LLP, 14 August 2012), IFL filed its submissions on the proposed limitations and on “the costs award” by letter dated 18 September 2012. Page White & Farrer by letter dated 27 September 2012, confirmed that the Opponents had no objection to the revised limitations put forward by IFL but pointed out that the Hearing Officer had not invited the parties to make any representations as to costs.
60. In his Supplementary Decision BL O/440/12, the Hearing Officer merely remarked that the UK IPO letter dated 8 August 2012 had erroneously invited the parties’ submissions on costs and he confirmed his previous decision in this regard.
61. IFL’s complaint on appeal is that the Hearing Officer failed to take into account IFL’s “interim” submissions on the costs award, which was in any event wrong.
62. The interim submissions and the grounds of appeal challenged the costs award on the basis that it failed to include a contribution towards IFL’s costs of defending in its Notices of defence and counterstatements, the relative grounds for refusal of registration raised independently in each of the 5 out of 6 oppositions but dropped at an early stage.
63. IFL claimed that its costs for preparing statements and considering the other sides’ statements should be raised to £400 per opposition making that part of the award £2400 instead of £400. No details (other than the fact that 5 of the oppositions originally included relative grounds) were supplied to justify how those figures had been arrived at.
64. It is not clear to me that the Hearing Officer made any allowance to IFL in his first item for considering the Section 5 grounds raised by 5 of the oppositions. On the one hand, it is clear from his Supplementary Decision BL O/440/12 that he was aware of IFL’s arguments but nevertheless confirmed his previous award. On the other hand, paragraph 85 of Decision BL O/307/12 indicates that no allowance was made for the Section 5 grounds because the Hearing Officer equally divided liability for the total contribution towards IFL’s costs between the 6 main Opponents (£300 each).
65. It seems to me that some allowance in costs ought to have been made to IFL in respect of the abandoned Section 5 grounds. I do not consider it proportionate to remit the case to the Registry for reconsideration on this issue. Having reviewed the statements of grounds of opposition and the counterstatements, to my mind IFL’s

claim to be awarded £2400 in this regard was over inflated. I will increase the amount allowed for preparing statements and considering the other sides' statements in IFL's favour to £650 (i.e., an extra £50 in respect of each of the 5 oppositions that raised relative grounds). That gives an overall sum of £2050 awarded to IFL as a contribution towards the costs of the hearing below. (I leave it to the Opponents to decide how this is to be paid between them.)

Conclusion and costs

66. The appeal was unsuccessful in overturning the Hearing Officer's decision under Section 3(1)(c) of the Act. I confirm therefore that Application number 2341223 must be refused registration for *meat; poultry and game, none being live; all food for human consumption* (and for the other goods/services refused by the Hearing Officer).
67. However, the appeal was successful on the issue of costs. I re-determined that the Opponents should pay IFL a contribution towards its costs of the hearing below in the sum of £2050, such sum to be paid within the time limit ordered by the Hearing Officer.
68. Bearing in mind that both parties enjoyed a measure of success on appeal and that IFL was put to the cost of considering the Opponent's admitted fresh evidence, I will make no order in respect of the costs of this appeal.

Professor Ruth Annand, 17 March 2014

Mr. Roger Wyand of Queen's Counsel instructed Groom Wilkes & Wright LLP appeared on behalf of the Applicant/Appellant

Mr. Douglas Campbell of Counsel instructed by Page White & Farrer appeared on behalf of the Opponents/Respondents

ANNEX A

Extract from Hearing Officer's summary of the Opponents' evidence (minus footnotes)

"Witness statement(s) of Ms Nicola Shackleton

6) Ms Shackleton is a trade mark attorney with Page, White & Farrer. She has provided a witness statement for each of the oppositions. They are primarily the same. The bulk of her evidence provides various facts and figures about the country of Iceland, including its:

Size: 103,000 KM², 4970km of coastline, 105 municipalities and a rising population of 316,000 people.

Labour market (as of 2002): 3.9% agriculture, 3.4% fishing, 4.1% fish processing, 10.2% mining and manufacturing, 0.9% electric and water supply, 7.8% construction, 13.7% wholesale/retail/repair, 3.5% hotels and restaurants, 6.2% transport and communication, 3.9% financial services, 8.5% real estate and business services, 5% public administration, 8.1% education, 13.8% health/social sector, 7.1% other.

Agricultural production: 9000 tonnes of potatoes, 800 tonnes of turnips, 3000 tonnes of cereal grain, 900 tonnes of tomatoes, 800 tonnes of cucumbers (all in 2000) and, also, over 2 million square meters of hay yield. In 2002 there were 67,000 cattle, 469,000 sheep, 71,000 horses, 4000 pigs and 160,000 hens in the country.

Meat and milk production: 8676 tonnes of mutton and lamb, 3639 tonnes of beef, 6011 tonnes of pork, 4633 tonnes of poultry, 110 million litres of milk (all in 2002).

Fish: Over 2 million tonnes of fish caught in 2002 – various types of fish caught.

Minerals: 125,000 tonnes of cement, 245,000 tonnes of aluminum, 20,000 tonnes of diatomite, 111,000 tonnes of ferro silicon (2001).

Visitors: Just under 2 million visitors via airports, many coming from Germany, UK, Sweden and Denmark. 50 liners arrive each year, 58% of whose passengers come from Germany and the UK.

GDP: 13, 251 million Euro. 4238 million Euro worth of exported goods and services. Lowest unemployment rate in the EEA with the third highest rate of car ownership.

7) Ms Shackleton states that exports are a significant part of the country's business. The largest importers of goods from the country are the UK, Germany and the Netherlands. 81% of exports are for the European market. In 2002, 1,441,292 tonnes of marine products were exported. 33% of all exports relate to manufacturing products and 64% relate to agricultural and marine products.

8) Ms Shackleton makes various submissions that will be borne in mind but not summarized here. She adds that ICELAND may be doubly descriptive for frozen goods because ICE and LAND conjoined could describe an area where there are iced goods or where goods for freezing can be purchased. This is not within the pleaded

case so I will say no more about this; in any event, what Ms Shackleton states seems far-fetched.

9) In relation to the section 3(1)(c) objection, she states that Iceland's products have a good quality and it is renowned for its agriculture, fishing and manufacturing; this is simple assertion and adds nothing beyond the factual evidence provided.

10) An internet search is provided, the hits of which relate primarily to the country of Iceland. I note, though, that the search conducted was not limited to UK websites. Ms Shackleton refers to two community trade marks containing the word ICELAND that were opposed and which are now refused.

11) Ms Shackleton refers to a large number of UK companies that have the word Iceland in their name, she also provides further information about them to illustrate that the companies have some form of link to Iceland (the country) or to Icelandic goods. She states that this exemplifies why there is a need to keep the word ICELAND free for the use by other traders. The company names include:

Iceland Seafood Limited;
Icelandic Commodities Exports Limited;
The Icelandic Trading Company Limited;
Path (Iceland) Limited – (a project relating to civil aviation, airline management and tourism promotion);
Project Iceland Limited – Building Installation;
Iceland Tours Limited;
Essential Iceland Limited – a travel agency;
Icelandic Group Plc – Seafood;
Icelandic UK Ltd – Seafood;
Icelandic Group UK Ltd – Seafood;
Alcan Iceland Ltd – Aluminum;
Iceland Drilling Company Ltd (and a version of the name with UK in the title).

Also exhibited are prints of websites etc with Iceland used as part of a name, including:

Iceland Holidays.Com;
Iceland Express (an airline);
Skyn Iceland – skincare products;
Iceland Spring Holdings;
Iceland Metal Recycling;
Interseafood Iceland Hf;
Optimar Iceland – Refrigerating (Industrial refrigeration for ships).
Tms Sambaland of Iceland (seafood).

12) Exhibit D consists of extracts from the website of the Trade Council of Iceland and which refer to Iceland as being primarily a food producing country. It appears to have strict regulations to ensure a good quality is achieved. Another page refers to the type of food produced in Iceland. Many of the items referred to earlier are mentioned. Fish is again stressed and it is stated that Icelandic fish has established a reputation. Exhibit D comes from the same website and relates to Iceland's economy. Fishing is

important but there is now more diversity. Fishing represented 90% of exports in the 1970s which has now dropped to 70% with only 50% total foreign currency earnings. Further information shows that in 2002 17.5% (35,739 million Krona) of exports were to the UK. In exhibit E there are extracts from the register of Icelandic exporters. A reasonably large number of companies are identified who export and who use Iceland or Icelandic in its name. Information from the same website is provided after conducting searches on it. The first search is for the word FROZEN which revealed 29 categories of business involved in frozen goods, many, but not all, relate to fished products. Another search relates to the word FISH with 99 categories of fish business revealed. Beyond fish or entries which cannot be identified I note, Icelandic Business Information Centre, the Hand knitting Association of Iceland, Iceland Post, Iceland Music Info Centre, Icelandic Sales agency, Icelandic textiles, Icelandic Dairy Produce Marketing Association, Icelandic Building Research Institution, Icelandic Skins Ltd, Air Atlanta-Icelandic, Iceland Air Cargo, Farm Foods Iceland, Iceland Air Hotels Group, Iceland Waters Ltd, Icelandic Eiderdown, Iceland Stock Exchange, Iceland Geo Survey, the national band of Iceland, Icelandic Fur Breeders Association, Confederation of Icelandic Employers, Iceland Telecom. A list of the types of goods exported is also provided, many are fish, but, also, beef and veal, food specialties, mutton and lamb, pork, fishing boats, animal feed, buoys. There are also details of other companies who export goods such as aluminum casting, lamb, dairy products, marine oils, confectionary, textiles (Icelandic wool).

13) Reference is made to the more diverse trade between Iceland and the UK (diverse from fish). Reference is made to some awards that Icelandic companies have won. Extracts are provided from randburg.com which contains an Iceland Export Directory. They include companies involved in Aluminum smelting, fish, seafood, caviar, lamb, salmon, sea salt, dairy products, omega 3, confectionary, woollen goods. Reference is made to other companies who produce white goods. It is stated that the class 16 goods sold under the mark ICELAND will be perceived as having the country as its subject matter. It is stated that many books sold in Iceland will be about the country and that visitors will buy postcards and other tourist goods. In relation to the foodstuff classes, reference is made to various companies who produce fish and other food products (of the type indicated above). Reference is made to companies who also operate in high tech fields.

14) Exhibit G is a print from www.buyicelandic.com which contains a sponsored link to icelandapplicances.co.uk which is said to be a link to IFL's website. It is highlighted that the nature of the website informs the consumer that the goods obtained from the link are Icelandic and that confusion/deception could arise. The website is a portal type page.

15) Exhibit G is a news article which relates to complaints that IFL received due to Iceland's (the country) whaling activities. The CEO of IFL had to write back to the complainers explaining that they had no link with the country and that IFL opposed whaling.

16) Further export statistics and details of Icelandic companies are provided which do not really add to the whole picture. What does help is a breakdown of exports by product type. The largest is in respect of marine products (104,898k), the next largest is manufacturing goods (57,670k) then agricultural (3,081K) and then other 3,256k."