

O/154/12

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NUMBER 2566004  
BY INDIGO FURNITURE LIMITED  
TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 20:**

**PLANK**

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**Background**

1. On 1 December 2010, Indigo Furniture Limited ('the applicant') applied to register trade mark application number 2566004 for the mark PLANK for the following goods in class 20:

Furniture; wooden furniture; bespoke furniture; household furniture; furniture for use in bars, clubs and restaurants; office furniture; tables; chairs; cabinets; sofas; armchairs; coffee tables; footstools; chests; drawers; shelving; beds; bedside tables; wardrobes; kitchen units; kitchen furniture; dressers; cupboards; stools; racks; worktops; trays; boxes made of wood; dining tables; dining chairs; benches; dining cabinets; dining drawers; mirrors; picture frames; mattresses; box springs; pillows; slatted bed bases; mattress bases; divans; bedding; bolsters and cushions; goods of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother of pearl, meerschaum and substitutes for all these materials or of plastics; parts and fittings for all the aforementioned goods.

2. On 10 February 2011, the Intellectual Property Office ('IPO') issued an examination report in response to the application. In the report, an objection was raised under sections 3(1)(b) and (c) of the Trade Marks Act 1994 ('the Act') on the basis that the mark "consists exclusively of the word 'PLANK', being a sign which may serve in trade to designate the kind or style of the goods e.g. furniture made from or being in 'plank' style". To support this objection, the examiner sent Internet findings showing use of the word 'plank' in connection with furniture.

3. On 23 December 2010, McDaniel & Co acting as the applicant's representative requested an *ex parte* hearing. The hearing was attended by Mr Head-Rapson of McDaniel & Co, accompanied by his three clients using conference call facilities. Prior to the hearing, evidence was submitted in support of a claim to distinctiveness acquired through use. Although discussed at the hearing, I did not agree that the evidence showed the mark had become distinctive because of the use made of it, and subsequently maintained the objection, allowing two months for further submissions.

4. On 26 August 2011, following an extension of time, Mr Head-Rapson responded by putting forward arguments for *prima facie* acceptance of the mark. I did not agree with these arguments, maintained the objection, and issued a notice of refusal of the application. Given that submissions were made in respect of both inherent and acquired distinctiveness, this decision addresses both the *prima facie* acceptability of the mark *and* an assessment of the evidence of use.

5. A TM5 was duly received at IPO on 13 October 2011. I am now asked under section 76 of the Trade Marks Act 1994 and rule 69 of the Trade Marks Rules 2008 to state in writing the grounds of my decision and the materials used in arriving at it.

## The applicant's case for registration

6. Prior to setting out the law in relation to sections 3(1)(b) and (c) of the Act, I will set out the applicant's case for *prima facie* acceptance of the mark. At the hearing, Mr Head-Rapson submitted that, although others may be using the word 'plank' in relation to furniture, his clients were the first to do so, and that third parties using the word to describe their furniture were infringing his client's mark. He held that the word 'plank' is *not* a generic term for furniture, and that relevant consumers would not say, for example, that they would purchase a 'plank' for one's bedroom. Although furniture may be made from planks of wood, Mr Head-Rapson submitted that the word 'plank' itself is not descriptive of a type of furniture. I rejected these submissions for reasons set out further in the decision.

## Decision

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

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

*(a) ...*

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

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

*(d) ...*

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

The above provisions mirror Article 3(1) (b) and (c) of First Council Directive 89/104 of 21 December 1988. The proviso to Section 3 is based on the equivalent provision of Article 3(3).

## Relevant authorities – general considerations

8. The European Court of Justice (ECJ) has repeatedly emphasised the need to interpret the grounds for refusal of registration listed in Article 3(1) and Article 7(1), the equivalent provision in Council Regulation 40/94 of 20 December 1993 on the Community Trade Mark, in the light of the general interest underlying each of them (*Bio ID v OHIM*, C-37/03P, paragraph 59 and the case law cited there and, more recently, *Celltech R&D Ltd v OHIM*, C-273/05P).

9. The general interest to be taken into account in each case must reflect different considerations according to the ground for refusal in question. For example, in the case of

the registration of colours *per se* not spatially delimited, the Court has ruled that the public interest is aimed at the need not to restrict unduly the availability of colours for other traders in goods or services of the same type. Also, in relation to section 3(1)(b) (and the equivalent provisions referred to above) the Court has held that "...the public interest... is, manifestly, indissociable from the essential function of a trade mark" (*SatellitenFernsehen GmbH v OHIM C329/02 (SAT. 1)*). The essential function thus referred to is that of guaranteeing the identity of the origin of the goods or services offered under the mark to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin (see paragraph 23 of the above mentioned judgment).

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

10. There are a number of ECJ judgments which deal with the scope of Article 3(1) (c) of First Council Directive 89/104 and Article 7(1) (c) of Council Regulation 40/94 (the Community Trade Mark Regulation), whose provisions correspond to section 3(1) (c) of the UK Act. I derive the following main guiding principles from the cases noted below:

- subject to any claim in relation to acquired distinctive character, signs and indications which may serve in trade to designate the characteristics of goods or services are deemed incapable of fulfilling the indication of origin function of a trade mark (*Wm Wrigley Jr & Company v OHIM, C-191/01P (Doublemint)*, paragraph 30);
- Article 7(1)(c) (section 3(1)(c)) pursues an aim which is in the public interest that descriptive signs or indications may be freely used by all (*Doublemint*, paragraph 31);
- it is not necessary that such a sign be in use at the time of application in a way that is descriptive of the goods or services in question. It is sufficient that it could be used for such purposes (*Doublemint*, paragraph 32);
- it is irrelevant whether there are other, more usual signs or indications designating the same characteristics of the goods or services. The word 'exclusively' in paragraph (c) is not to be interpreted as meaning that the sign or indication should be the only way of designating the characteristic(s) in question (*Koninklijke KPN Nederland NV v Benelux Merkenbureau, C-363/99 (Postkantoor)*, paragraph 57);
- an otherwise descriptive combination may not be descriptive within the meaning of Article 3(1)(c) of the Directive provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements. In the case of a word trade mark, which is intended to be heard as much as to be read, that condition must be satisfied as regards both the aural and the visual impression produced by the mark (*Postkantoor*, paragraph 99).

11. In *Matratzen Concord AG v Hukla Germany SA, C-421/04* the ECJ stated that "...to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say in trade and or amongst average consumers of the said goods or services, who are reasonably well informed and reasonably

observant and circumspect, in the territory in respect of which registration is applied...". I am also mindful of the decision of the General Court (formerly the CFI) in *Ford Motor Co v OHIM*, T-67/07 where it was stated: "...there must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the category of goods and services in question or one of their characteristics".

12. It is clear from the aforementioned case law that I must determine, assuming notional and fair use, whether the mark in suit will be viewed by the average consumer as a means of directly designating an essential characteristic of the goods for which registration is sought.

13. The goods at issue are:

Furniture; wooden furniture; bespoke furniture; household furniture; furniture for use in bars, clubs and restaurants; office furniture; tables; chairs; cabinets; sofas; armchairs; coffee tables; footstools; chests; drawers; shelving; beds; bedside tables; wardrobes; kitchen units; kitchen furniture; dressers; cupboards; stools; racks; worktops; trays; boxes made of wood; dining tables; dining chairs; benches; dining cabinets; dining drawers; mirrors; picture frames; mattresses; box springs; pillows; slatted bed bases; mattress bases; divans; bedding; bolsters and cushions; goods of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother of pearl, meerschaum and substitutes for all these materials or of plastics; parts and fittings for all the aforementioned goods.'

14. In relation to identifying the relevant consumer, it is reasonable to assume that the goods claimed will be purchased by both the general public and the trade (being, for example, bars, clubs, restaurants and offices). Items of furniture for use in domestic households are not specialist goods, and their purchase does not involve or require any particular level of knowledge or technical skill. Such goods are usually purchased for their aesthetic appeal and/or their level of comfort. At the same time, the specification also covers furniture intended for use in bars, clubs, restaurants, and offices. If the purchaser concerned is, for example, refurbishing an office or a restaurant, then it is likely that he or she will have a sound knowledge of the particular industry in which the furniture is being used, and may be purchasing in bulk at a considerable price. It is therefore also reasonable to assume that such trade consumers might pay a higher level of attention to their purchase than if they were buying furniture for the home.

15. In determining the mark's suitability for acceptance and registration under section 3(1)(c), the Registrar is obliged to consider the semantic content of the sign and consider, in the context of the goods and/or services claimed, whether or not the relevant consumer is likely to perceive it as being descriptive of a particular characteristic of the goods. The mark in question consists of the word 'plank'. One of the dictionary definitions of the word 'plank' is '*a long flat piece of timber used esp. in building, flooring, etc.*' (Oxford Dictionary of English). Although this definition does not specifically mention furniture, the use of the abbreviation 'etc' indicates that the list is not exhaustive. As much furniture is made from timber, it is reasonable to assume that planks could be used in the manufacture of furniture and that the average consumer, on seeing furniture described as 'plank', would expect a specific type of furniture i.e. items manufactured from long flat pieces of timber.

16. When assessing the inherent distinctiveness of a mark, the Registrar has an obligation to not only consider the semantic analysis of the mark, but must also take into account additional factors such as the channels of trade for such goods, the way those goods are presented for sale within those channels of trade, and also use by others in the trade. At the time of her initial assessment, the examiner carried out Internet research and copies of the Internet findings were attached to the examination report. These included pages from Home and Furniture.co.uk's website referring to 'plank' wardrobes, cupboards and coffee tables etc., and from the website of ponytonpine.co.uk giving details of a plank style table. Prior to the hearing I also carried out Internet research and, as I did not have the time to send these to the agent prior to our discussion, findings were sent with the hearing report. They included a page from cabinet maker Andrew Broome's website referring to his range of 'rustic plank furniture'; a reference from the Hertfordshire-based 'Pine Oak' company's website describing its 'plank solid pine distressed furniture'; a page from the 'Kingsman Interiors' website referring to its 'bespoke kitchens and plank furniture'; a reference to 'plank furniture' from the 'Atlantic Plank Furniture' website; and a page from the website of 'West End Furniture' referring to its 'rustic plank range'. This list is not exhaustive, but provides a fairly typical representation of materials found on the Internet. Some of these web pages have been reproduced in an appendix to this decision.

17. It does not automatically follow that, as the applicant was the first to use the word 'plank' to describe its furniture, it should have the right to register the mark. At the hearing, I referred Mr Head-Rapson to a previous attempt to register the phrase 'Oven Chips' in respect of frozen potato chips (*McCain International Ltd v Country Fair Foods Ltd and another* (1981) RPC 69 (The "Oven Chips" case). The product intended for protection was cooked in a domestic oven rather than a fryer and was, as a result, a new and innovative product. In this case, the applicant submitted that it was first to bring the product to market, and first to use the phrase, but the Court concluded that the sign was still an apt description, and it was reasonable to assume that it would become the natural description in trade for that category of goods. On pages 72, lines 37-48, Templeton L.J. said:

"Mr Harman, in a very forceful and if I may say so, very attractive argument, submitted that 'oven chips' is a fancy name and not a phrase in common use in the English language, so that it will be associated with one particular manufacture and not with a product. He said it is a novel phrase - and that is true; it has never been used before - that also is true. He castigated the phrase as an ungrammatical aggregate of two English nouns and said that it was nonsensical without an explanation. But in my judgement the words 'oven chips', grammatical or not, constitute an expression which is an ingenious and apt description of the contents, namely, potato chips prepared for cooking in the oven; and 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 product rather than a manufacturer, the product being potato chips prepared for cooking in the oven"

Mr Head-Rapson did not agree that his mark was equitable to the 'Oven Chips' example, pointing out that the earlier sign was likely to be used by consumer as a direct descriptor (in the sense that a consumer would directly ask for 'oven chips', but would not use the word 'plank' *solus* when referring to items of furniture). At the hearing, I disagreed with this

distinction, pointing out that consumers may well ask to see a range of plank furniture, or furniture manufactured from planks - thereby indicating that the word 'plank' does designate a characteristic of such furniture. The fact that other traders are using the word 'plank' to describe their goods only reinforces the Registrar's position that the word is the most apt description for furniture items made from planks.

18. Consequently, given both the dictionary definition of the word 'plank', and the evidence of third party use collated from the Internet, I have concluded that the mark applied for consists exclusively of a sign which may serve in trade to designate a characteristic of the goods and is therefore excluded from registration by section 3(1)(c) of the Act. Having found that to be the case, it effectively ends the matter. However, in case I am found to be wrong in this decision, I will go on to determine the matter under section 3(1)(b) of the Act.

19. I approach this ground of objection on the basis of the following principles derived from the ECJ cases presented below:

- an objection under section 3(1)(b) operates independently of objections under section 3(1)(c) – (*Linde AG (and others) v Deutsches Patent-und Markenamt*, Joined Cases C-53/01 to C-55/01, paragraphs 67 to 68);
- for a mark to possess a distinctive character it must identify the product (or service) in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product (or service) from the products (or services) of other undertakings (*Linde paragraphs 40-41 and 47*);
- a mark may be devoid of distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive (*Postkantoor* paragraph 86);
- a trade mark's distinctiveness is not to be considered in the abstract but rather by reference to the goods or services in respect of which registration is sought and by reference to the relevant public's perception of that mark (*Libertel Group BV v Benelux Merkenbureau*, Case C-104/01 paragraphs 72-77);
- the relevant public must be deemed to be composed of the average consumer who is reasonably well-informed and reasonably observant and circumspect (*Libertel* paragraph 46 referring to Case C-342/97 *Lloyd Schuhfabrik Meyer*).

20. Furthermore in relation to section 3(1)(b) it was held in *Postkantoor* that:

In particular, a word mark which is descriptive of characteristics of goods or services for the purposes of Article 3(1)(c) of the Directive is, on that account, necessarily devoid of any distinctive character with regard to the same goods or services within the meaning of Article 3(1)(b) of the Directive. A mark may none the less be devoid of any distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive. (Paragraph 86)

21. In this case, the Internet evidence presented by the Registrar shows that the word 'plank' is meaningful in relation to a particular style of furniture, as described in paragraph 13 above.

Even if the mark were to fall short of conveying the requisite level of specificity to support an objection under section 3(1)(c) (which I do not believe to be the case), I would nevertheless hold that it would not be capable of performing the essential function of a trade mark without the relevant public being educated into seeing it that way. In my view, relevant consumers would not consider furniture marked with the sign 'plank' to be from one particular manufacturer or supplier over another. This is because most people would be aware of the word 'plank' and its potential relevance to furniture. On this basis, the section 3(1)(b) objection is also made out.

22. The specification does include a number of goods for which the word 'plank' would clearly not designate any characteristics. Therefore, I am waiving the section 3(1)(b) and (c) objection in respect of the following:

Mattresses, pillows, bolsters and cushions and goods made of cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother of pearl and meerschaum.

### **Evidence of use**

23. The evidence submitted consists of a Witness Statement by Mr David Castle, Director of Indigo Furniture Limited (the applicant), together with supporting exhibits all of which are summarised below:

**Exhibit 1** gives an overview of the company. It explains that the applicant began trading in January 1999 and is well known for its rustic, chunky wood furniture, and particularly for its plank furniture range. The exhibit refers to other companies using the word 'plank' to describe their furniture, and the applicant believes that 'plank furniture' has become a familiar term within the industry solely because of the applicant's own successful marketing of such products. The exhibit goes on to explain that in 2005, the Independent newspaper voted Indigo Furniture the sixth best furniture shop in the UK, and mentions that the applicant is always returned at the top entry in any Google search for the term 'plank furniture'.

**Exhibit 2** gives sales turnover figures (excluding VAT) as shown below:

<b>Year ending</b>	<b>Total Turnover</b>	<b>'Plank Furniture' Turnover</b>	<b>Plank as a % of Total Turnover</b>
31-Mar-00	£247,296	£128,594*	52%
31-Mar-01	£327,168	£183,214*	56%
31-Mar-02	£444,244	£239,892*	54%
31-Mar-03	£717,520	£337,234*	47%
31-Mar-04	£983,174	£481,755*	49%
31-Mar-05	£1,487,786	£877,794*	59%
31-Mar-06	£2,078,015	£1,317,526	63%
31-Mar-07	£2,867,012	£1,692,965	59%
31-Mar-08	£3,888,096	£2,644,724	68%
31-Mar-09	£3,901,576	£2,531,048	64%

31-Mar-10	£3,903,698	£2,236,049	57%
31-Jan-11	£3,925,747	£2,147,334	55%

As the applicant's sales IT system was introduced in 2005 and all previous sales information is contained in paper files, those figures marked with an asterisk have been estimated (by the applicant) using a sample selection of 15 invoices.

**Exhibit 3** shows images of the applicant's Matlock-based showroom prior to its opening. It gives details of the applicant's website and marketing brochure. Together with the exhibits the applicant has included a list of schedules, which take the form of photographs referred to in the exhibits. Schedules 3, 4 and 5 show photographs from the applicant's website and marketing brochure and Schedule 6 shows photographs of the van livery.

**Exhibit 4** gives details of the applicant's online marketing statistics and number of visitors to their website.

**Exhibit 5** gives details of domain names owned by the applicant and/or employees of the applicant acting on its behalf.

**Exhibit 6** refers to the geographical spread of the applicant's sales.

**Exhibit 7** provides details of the applicant's marketing activities. Its website is the primary focus of marketing activity, and this exhibit includes photographs of the showroom, photographs of products as they appear on the website, and also photographs of the applicant's stands at various exhibitions. The exhibit also shows photographs of the applicant's furniture used on television shows such as 'Sweet Medicine', 'Britain's Next Top Model', 'the X-Factor', 'Grand Designs' and 'the Home Show' (noting that, in December 2009, London radio station KISS FM ran a competition for a plank bed signed by contestants of the X Factor). The exhibit also gives examples of advertisements in the press as detailed below:

- A press advert dated 2001 which was published in Midlands-based newspapers and magazines, and which shows photographs of the applicant's plank range of furniture. The trade mark displayed in the advertisement is the word 'Indigo'. The word 'plank' does not appear anywhere in the advertisement.
- Advertisements placed in Grand Designs Magazine of November 2004 and the Independent newspaper of April 2005. These also show photographs of the plank range of furniture but, once again, the trademark shown is 'Indigo'. The word 'plank' does not appear in the advertisements.
- Advertisements in 4Homes magazine dated December 2006, in Derbyshire Life magazine dated January 2007, and Grand Designs magazine dated May 2009. Although that applicant states that there *is* an express mention of the word 'plank' within these advertisements, the typeface in the representation of both the '4Homes' and the 'Grand Designs' magazines is too small to make out the word 'plank'. By contrast, the word 'Indigo' is clear to see. In the Derbyshire Life magazine, the mark shown is 'Indigo' and

the advertisement refers to “furniture that will stand the test of time. Both from the Oak and the Plank ranges”.

**Exhibit 8** gives details of the applicant's registered trademarks, one of which includes the word ‘plank’ and is shown below:



**Exhibit 9** gives details of a selection of PLANK furniture taken at the first photo shoot held in the applicant’s Matlock showroom (full details appear in schedule 4 attached to the exhibits supplied with the witness statement).

**Exhibit 10** refers to unlawful targeting of Indigo customers i.e. the applicant refers to companies who do not sell goods produced by Indigo Furniture Limited, but who allegedly use its trade marks within their online advertising. The applicant confirms that Google Inc, has removed any such adverts on approach from the applicant.

**Exhibit 11** refers to intellectual property rights infringement, in particular, a legal dispute with FutureLook Ltd and legal action against Home and Furniture.

**Exhibits 12 and 13** contain a copy of the absolute grounds for refusal as set out in the examination report and arguments previously submitted. There is nothing in this exhibit which has not been previously referred to in paragraphs 2 and 6.

**Exhibit 14** gives details of the applicant’s direct advertising expenditure. As the applicant has asked for this to be kept confidential, I need not disclose any details here. I have to point out however, that had details of the advertising figures been made available for the purpose of ascertaining distinctiveness acquired through use, they would not have affected my decision to refuse the application.

### **The case for registration based on acquired distinctiveness**

24. The question to be determined is whether, through the use made of it, the sign applied for has acquired a distinctive character in respect of the goods for which registration is sought. In making this assessment, the question must be asked through the eyes of the average consumer who is reasonably well informed, observant, and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel BV*, C-342/97[1999] ECR I-3830 para.26). In this case, I have already identified at paragraph 11 the average consumer as being both the general public and the trade.

25. The key authority for acquired distinctiveness is *Windsurfing Chiemsee Produktions Und Vertriebs GMBH v. Boots-Und Segelzubehor Wlater Huber* C109/97 (*Windsurfing*), the relevant test being set out in paragraph 55:

“...the first sentence of Article 3(3) of the First Directive 89/104/EEC is to be interpreted as meaning that:

- a trade mark acquires distinctive character following the use which has been made of it where the mark has come 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 goods of other undertakings;
- in determining whether a trade mark has acquired distinctive character following the use which has been made of it, the competent authority must make an overall assessment of the evidence that the mark has come to identify the product concerned as originating from a particular undertaking and thus to distinguish that product from goods of other undertakings;
- If the competent authority finds that a significant proportion of the relevant class of persons identify goods as originating from a particular undertaking because of the trade mark, it must hold the requirement for registering the mark to be satisfied;
- where the competent authority has particular difficulty in assessing the distinctive character of the mark in respect of which registration is applied for, Community law does not preclude it from having recourse, under the conditions laid down by its national law, to an opinion poll as guidance for its judgment.”

26. Turnover figures are an important indicator in assessing whether there has been sufficient use of a mark for it to have achieved distinctiveness in the market place. In this case, turnover figures for the applicant's plank furniture range from £1,487,786 in 2005 to £3,903,698 in the year leading up to March 2010. These figures have to be considered in relation to the market for such goods. In this case, the goods are furniture for both the domestic market and the business market. When one considers that furniture is purchased by every household and business in the country, these figures represent a very small percentage of market share.

27. I must also take into account the fact that others in the industry are using the word 'plank' to *describe* the type of their furniture. If the average consumer merely sees the word as descriptive of a type of furniture, then it is possible that no amount of use by the applicant would indicate trade origin. I must bear in mind Morritt LJ's observation in *Bach and Bach Flower Remedies Trade Mark* [2000] RPC 513 at para 49, where it was stated that:

“...use of a mark does not prove that the mark is distinctive. Increased use, of itself, does not do so either. The use and increased use must be in a distinctive sense to have any materiality.”

The question therefore is not just the amount of use made by the applicant, but also whether that use generates customer recognition of the sign as an indicator of trade origin.

28. In response to the applicant's argument that it was *first* to use the word 'plank' in respect of furniture items, I have also considered comments made in the case of *British Sugar PLC*

and *James Robertson and Sons Ltd decision* (1996) RPC 281 (The *Treat* decision, page 302, line 22):

“I have already described the evidence used to support the original registration. It was really no more than evidence of use. Now it is all too easy to be beguiled by such evidence. There is an unspoken and illogical assumption that “use equals distinctiveness”. The illogicality can be seen from an example: no matter how much use a manufacturer made of the word “Soap” as a purported trade mark for soap the word would not be distinctive of his goods. He could use fancy lettering as much as he liked whatever he did would not turn the word into a trade mark. Again, a manufacturer may coin a new word for a new product and be able to show massive use by him and him alone of that word for the product. Nonetheless the word is apt to be the name of the product not a trade mark. Examples from old well known cases of this sort of thing abound. The Shredded Wheat saga is a good example. Lord Russell said: “A word or words to be really distinctive of a person’s goods must generally speaking be incapable of application to the goods of anyone else”.

29. Regarding the geographical spread of sales, the applicant’s showroom is in Matlock, Derbyshire, although its goods are also marketed nationwide via the website. The applicant has stated that sales within the Derbyshire postcode during 2005 amounted to only 18% of their sales, and only 13% in 2007, and went on to confirm that its customer base is national rather than local. However, no information has been provided to show that a spread of sales throughout the UK and I am mindful of the ECJ decision in *Bovemj Verzekeringen NV v Benelux Merkenbureau* (the *Europolis decision*, C-108/05) where it was held that a trade mark may be registered on the basis of acquired distinctiveness “...only if it is proven that the trade mark has acquired distinctive character through use throughout the territory of a member state”.

30. I note that the applicant’s plank range of furniture has been used in respect of a number of television programmes. However, this in itself does not demonstrate that the trade mark ‘PLANK’ has become distinctive through use.

31. Regarding advertising of the mark, I will not disclose marketing expenditure as the applicant has requested that they remain confidential. However, the applicant has submitted copies of various advertisements placed in the press. As detailed in paragraph 22 above, the only instance where the word ‘plank’ is clearly visible is the advertisement in Derbyshire Life dated January 2007, where it refers to the ‘oak and plank ranges’. This appears to describe a *type* of furniture and does not constitute use of the sign as a trade mark - the mark appearing in all the advertisement is the word ‘Indigo’. The Internet advertisements and marketing brochure also show the prominent trade mark ‘Indigo’, alongside the word ‘plank’ used to indicate a range of furniture. The photographs of the applicant’s vans also clearly show the trade mark ‘Indigo’ and there is no mention of the word ‘plank’.

32. Having taken all the above into consideration, together with the advice given in relevant case law such as *Windsurfing* and *Bovemj*, I do not consider the evidence submitted to show that the mark has become distinctive because of the use made of it, or that the average consumer has been educated into seeing the sign as indicating trade origin. In reaching my decision I took into account a number of different factors, including the fact that the turnover

indicates a low market share by the applicant; that there is a lack of information regarding the geographical spread of sales of the goods; and also the fact that other traders are using the word 'plank' to indicate and describe their furniture products. The mark is therefore excluded from acceptance under section 3(1)(b) and (c).

### **Conclusion**

33. In this decision, I have considered all documents filed by the applicant/agent and all arguments submitted to me in relation to this application. Having done so, and for the reasons given above, the application is refused because it fails to qualify under sections 3(1)(b) and (c) of the Act.

**Dated this 12<sup>th</sup> day of April 2012**

**Linda Smith  
For the Registrar  
The Comptroller-General**

## APPENDIX 1

The following is a list of some of the Internet findings referred to in paragraph 16. Some of these were attached to the examination report; others were presented to the applicant with the ex parte hearing record.

Taken from [www.rustic-plank-furniture.co.uk](http://www.rustic-plank-furniture.co.uk)

The screenshot shows a web browser window displaying the website for Andrew Broome's Rustic Plank Furniture. The browser's address bar shows the URL <http://www.rustic-plank-furniture.co.uk>. The website has a red header with the text "Andrew Broome's RUSTIC PLANK FURNITURE" in a mix of script and bold serif fonts. Below the header is a navigation menu with links for Home, About, Product Catalogue, Bespoke Furniture, Custom Orders, Contact, and Delivery. A search bar with a "SEEK" button is located below the menu. The main content area features a welcome message: "Welcome to Rustic Plank Furniture" followed by a bio: "I'm Andrew Broome, a skilled cabinet maker - this website is a showcase for the distinctive range of Rustic Plank Furniture that I hand-craft in my Cheshire workshop and sell online." To the right, there is a "Buy Plank Furniture online" section with a list of product categories: Tables, Wardrobes, Bookcases, Mirrors, TV & DVD/Video Units, and Beds. Below this is a section titled "Start exploring my collections" with three image thumbnails: "Rustic Plank Bedroom Furniture", "Rustic Plank Living Room Furniture", and "Rustic Plank Dining Room Furniture". At the bottom of the main content area, there is a note: "Rustic Plank Furniture hand-made to order in Cheshire" and a link to "Find out more about custom orders...". The footer contains copyright information: "Copyright © 2007-2009 Rustic Plank Furniture. All Rights Reserved. All prices in GBP." and mentions the website is powered by Shopify and customised by Ivyparkmedia. The browser's taskbar at the bottom shows several open applications, including Start, Rustic PL..., Novell-de..., Inbox - ..., PLANK (...), RE: TM1..., Agenda f..., FW: C-21..., UK Intelle..., and a system clock showing 10:41.

Taken from [www.homeandfurniture.co.uk](http://www.homeandfurniture.co.uk)

plank search results - Windows Internet Explorer provided by IPO

File Edit View Favorites Tools Help

http://www.homeandfurniture.co.uk/searchresults.aspx?searchterm=plank

Log in or Register

# HOME

and furniture

Where have I been: [Homepage](#) / [Search](#)

[Shopping bag](#) Items: 0 Cost: £0.00

[My home](#)

Your search for plank returned the following results.

See also: [Bespoke Furniture](#), [Testimonials](#)

		
Plank Rustic robe £599.00	Plank Games Table £279.00	Plank TV Corner Unit £199.00
		
Plank Plasma TV unit £289.00	Plank Open TV Unit £169.00	Plank Map Table £289.00
		

Start Novell-deliv... Inbox - Micr... Plank decisi... PLANK (WI... TERN \* Cas... ternapp.dot ... plank sear...

Taken from [www.kingsmaninteriors.co.uk](http://www.kingsmaninteriors.co.uk)

Plank Furniture | Bespoke Kitchens, Larder Cupboards, Handmade Kitchens & Rustic Furniture - Windows Internet Explorer provided

File Edit View Favorites Tools Help

http://www.kingsmaninteriors.co.uk/

Plank Furniture | Bespoke Kitchens, Larder C... tel: 01636 613208

home our products about us our showroom product gallery ORDER ON-LINE customer testimonials



**Plank Furniture, Larder Cupboards & Bespoke Kitchens**

**FREE Mainland UK Delivery**

Welcome to Kingsman Interiors - a name synonymous with quality larder cupboards, plank furniture, rustic furniture and bespoke kitchens in Newark and the East Midlands.

A browse through the **online shop** will reveal the wonderful selection of **plank furniture** for every occasion. You will also find bespoke items including hand-crafted tables and chairs. Kingsman Interiors offer a style to suit every room, taste and budget without compromising on quality.

Kingsman Interiors pride themselves on offering the customer something unique and our range of **hand-crafted, handmade kitchens** and **larder cupboards** is just that. Boasting an impressive portfolio of designs from rustic charm to modern country cottage, there is very little that Kingsman Interiors cannot achieve to meet the bespoke requirements of each customer.

Every item is hand produced by master-craftsmen. They lovingly work the finest timber to create furniture that is not only creative, but will also stand the test of time. This is not mass-produced furniture... **This is Kingsman's Quality!**

Done Internet

Start Novell-deliv... Inbox - Micr... Plank decisi... PLANK (WI... TERN \* Cas... ternapp.dot ... Plank Furn...

Taken from [www.lancashireplank.com](http://www.lancashireplank.com)

The screenshot shows a web browser window displaying the website for Bolton Furniture, The Lancashire Plank Furniture Company. The browser's address bar shows the URL <http://www.lancashireplank.com/>. The website has a yellow background and features the following content:

# THE LANCASHIRE PLANK FURNITURE COMPANY

...bespoke furniture manufacturers...

[Home](#) [About Us](#) [Kitchens](#) [Bedrooms](#) [Dining](#) [Lounge](#) [Mirrors](#) [Bespoke](#)

**Lancashire Plank Furniture Company**

If you would like high quality, made to measure, bespoke plank furniture for your home at straight from the factory prices then we may be the furniture company you have been looking for. Please browse our website and if you see something you like and want to discuss further then please email or ring us and we'll get in touch. Although we don't have a shop or show room we welcome visitors to our workshop so that they can discuss their furniture with the people who make it and see it being made. Please click on our address below for directions to the workshop

**[Kitchens](#)**

**[Dining](#)**

**The Lancashire Plank Furniture Company**  
**Unit 5 Undershore Business Park**  
**Brookside Road**  
**Bolton**  
**BL2 2SE**  
**Tel: 01204 380300**

The taskbar at the bottom shows several open applications: Start, Novell-deliv..., Inbox - Micr..., Plank decisi..., PLANK (WI..., TERN \* Cas..., ternapp.dot ..., and Bolton Fur... The system tray on the right shows the Internet icon.

Taken from [www.pinestation.co.uk](http://www.pinestation.co.uk)

RUSTIC PLANK - Windows Internet Explorer provided by IPO

File Edit View Favorites Tools Help

http://www.pinestation.co.uk/rustic%20plank%20furniture.html

Home ABOUT US PRODUCTS Contact Us

**RUSTIC PLANK furniture**  
Any item made Your size or ours  
Fully Fitted if required

**"Great Furniture Needs To Be Seen" Visit Our Factory Showroom**



Done

Start Novell-deliv... Inbox - Micr... Plank decisi... PLANK (WI... TERN \* Cas... ternapp.dot ... RUSTIC PL...

Taken from [www.edenforest.co.uk](http://www.edenforest.co.uk)

Eden Forest Furniture - Windows Internet Explorer provided by IPO

File Edit View Favorites Tools Help

http://www.edenforest.co.uk/search.asp

Search - Enter Keywords

Eden Forest

Call us now on 0845 226 4755 and speak to our team

INDOOR FURNITURE OUTDOOR FURNITURE GIFTS IN THE HOME IN THE GARDEN SPECIAL OFFERS

Home > Search

Total Results: 17 Page: 1

Keywords:  Sorting: Price - Lowest to highest Results per page: 15

 <p>Rustic Plank Dining Chair £115.00 <a href="#">Buy</a></p>	 <p>Rustic Plank Wall Mirror £169.00 <a href="#">Buy</a></p>	 <p>Rustic Plank Coffee Table £185.00 <a href="#">Buy</a></p>	 <p>Rustic Plank Coffee Table &amp; Shelf £285.00 <a href="#">Buy</a></p>	 <p>Rustic Plank Corner TV Unit £299.00 <a href="#">Buy</a></p>
 <p>Rustic Plank Double Trunk Table £325.00 <a href="#">Buy</a></p>	 <p>Rustic Plank Tables from £339.00 <a href="#">Buy</a></p>	 <p>Rustic Plank TV Unit £365.00 <a href="#">Buy</a></p>	 <p>Rustic Plank Mini Gun Cupboard £365.00 <a href="#">Buy</a></p>	 <p>Rustic Plank Coffee Table With Drawers £365.00 <a href="#">Buy</a></p>

Start Novell-deliv... Inbox - Micr... Plank decisi... PLANK (WI... TERN \* Cas... ternapp.dot ... Eden Fore...