

O-594-18

TRADE MARKS ACT 1994

TRADE MARK REGISTRATION NO. 3108262

IN THE NAME OF THE COMPLEAT FOOD GROUP LIMITED

AND

APPLICATION NO. 501857

BY GREENCLIFF ASSOCIATES LTD

FOR THE REGISTRATION TO BE DECLARED INVALID

Background and pleadings

1. This is an application dated 31 October 2017 by Greencliff Associates Ltd (“the applicant”) to invalidate trade mark registration 3108262 in the name of The ComplEAT Food Group Limited (“the proprietor”).

2. The trade mark consists of the single word BRUNSWICK. The application to register the mark was filed on 12 May 2015 (“the relevant date”) and the mark was registered on 26 August 2016 in relation to *cooked, cured and smoked hams* in class 29.

3. The grounds for invalidation are based on Sections¹ 3(1)(b), (c) and (d) of the Trade Marks Act 1994 (“the Act”). The central theme of the grounds is that the term ‘Brunswick ham’ is used in respect of a type of ham originating from Brunswick (which is the English translation for Braunschweig), in Germany. The mark is said to be descriptive (3(1)(c)) and used in the food industry (3(1)(d)) and, consequently, devoid of distinctiveness (3(1)(b)). The applicant states that:

- The term ‘Brunswick ham’ is a generic term to describe a type of mild smoked ham that originates from Braunschweig, in the East Westphalian region of Germany;
- The mark consists exclusively of a sign used by suppliers, manufacturers, retailers, and consumers in the food industry to describe the origin, type and/or characteristic of cooked, cured and smoked hams;
- Consumers of ham and related products do not recognise the mark as indicating origin. The mark is therefore not capable of distinguishing the registered proprietor’s goods from those of other undertakings;
- The registration inhibits free competition and trade by restricting unnecessarily through the fear and threat of litigation, the language that can be used honestly to describe the goods;
- The registration is contrary to public policy;

¹ These are relevant in invalidation proceedings by virtue of section 47 of the Act

4. The statement of grounds included the results of Internet searches which were subsequently re-filed as part of the applicant's evidence. I shall return to the content of these searches later.

5. The proprietor filed a counterstatement denying the grounds of invalidation. It stated:

“The registered owner opposes the application for invalidity and wishes to defend the subject registration.

The registered owner denies that the subject registration is invalid under Sections 47(1), 3(1)(b), (c) and (d) of the Trade Marks Act and puts the Applicant to strict proof of all of the allegations made in the Statement of Grounds.

The Applicant did not notify the registered owner of its intention to seek invalidation of its trade mark registration, and the [proprietor] requests that the Applicant reveals its interests in making this application, including trading interests and relevant associations.

In the absence of valid grounds for invalidation, the registered owner requests rejection of the Application for invalidity in its entirety, and an award of costs in its favour in these proceedings.”

6. The applicant is represented by Cooley (UK) LLP. The proprietor is represented by CSY London. Only the applicant filed evidence; it also filed written submissions during the evidence rounds. Neither party asked to be heard, but the applicant filed written submissions in lieu of attendance at a hearing. Consequently, this decision is taken after a careful study of the papers.

The applicant's evidence

7. This consists of a witness statement by Nicholas Christopher Alwyn Bolter of Cooley LLP, who are the applicant's legal representatives. The witness statement is dated 2 March 2018 and attached to it are three Annexes (Annex 1-3) and four Exhibits (Exhibits 1-4). The evidence is as follows:

- Exhibit 1 is a copy of the applicant's statement of grounds. This includes Annexes 1-3, all of which are Internet printouts. As a preliminary point, I should say that the statement of grounds was signed by Martin Whittle, a member of Cooley LLP staff and that although it is not possible to identify who carried out the Internet searches and prepared the Annexes (re-introduced with Mr Bolter's witness statement), there is no dispute about their authenticity. In any event, it does not seem to me that the printing of data from third party's websites by someone other than the person giving the evidence creates any hearsay problems.
- Annex 1 contains various prints as follows:
 - i. A print from the website www.glourious-food-glossary.com, which includes the following translation: "Braunschweiger Schinken which is called Brunswick ham in English, refers to a mild German cooked ham which is made from prime top and silverside pork based on the recipe from the East Westphalian region of Germany";
 - ii. A print from the website www.dict.cc, which includes the following translation: "Braunschweiger Schinken (m) Brunswick ham [a mild German ham (cooked)]";
 - iii. An extract from the book "Oxford Companion to Food" published on www.books.google.co.uk. The quality of the print is very poor, but the words "Brunswick ham, a mild German ham" can just about be made out;

- iv. A print from www.wikitravel.org (in English) about the city of Brunswick (the name in German is said to be Braunschweig) which, it is said, counts about 250,000 people and is situated in the federal state of Lower Saxony. The article talks about the history of city and the etymology of the word Brunswick. Notably, it does not contain any reference to 'Brunswick ham';
- v. A print from www.germanfood.org showing an article headed "Guide to German Hams and Sausages". The only reference to Brunswick appears under the heading "Tea sausage" and reads "the best-known variety is a spread made according to a traditional Brunswick recipe". Exhibit 2 contains a screenshot from the Wayback Machine showing the same article on February 2015.

8. Apart from the dates they were printed (19 and 25 October 2017), the web prints included in Annex 1 are not dated.

- Annexes 2-3 are web prints showing the results of two Google searches for 'Brunswick ham' carried out on 12 and 13 October 2017 (after the relevant date). According to Mr Bolter, the purpose of this evidence is to show "examples of third party use of the term Brunswick ham in respect of ham products dated prior to the date of filing of the registration". The results include, inter alia, a few hits to the UK website www.mysupermarket.co.uk which seem to advertise Sainsbury's 'Brunswick Ham' as well as a few hits to UK websites² which seem to refer to 'Brunswick ham' in some way. The prints are not in the archive form but they do display the publication date associated with the relevant webpages under the weblinks. According to the prints, the content of the UK-related hits was published on various dates in 2012, 2013 and 2014;

² www.community.babycentre.co.uk, www.fifecreamery.co.uk, www.thrstickyfig.co.uk, www.fatsecret.co.uk, www.huffingtonpost.co.uk

The Annexes also include a photocopy of two photos of sliced ham packaged and sold under third party brands, namely Sainsbury and Delicatessen. The goods are marketed as “German Brunswick Ham” and are described as “slices of Westphalian ham [...]”. Though the copy is of very poor quality, it is possible to discern a “best before date” of 2009 on both packaging³;

Mr Alwyn Bolter says that “where available, the examples are supported by screen prints from Internet archive tool, Wayback machine”. Only two screenshots are provided. They show two pages from www.mysupermarket.co.uk offering Sainsbury’s Brunswick Ham Slices for sale. However, on one page the date is not visible, on the other one it is not clearly legible;

- Exhibit 3 and 4 consist of two screenshots from the Wayback machine. Exhibit 3 is said to show a page from the website www.recipies.wikia.com dated 21 September 2012 (though neither the website address nor the date are clearly legible). It shows the words ‘Brunswick ham’. Exhibit 3 is a copy from a website called www.uk.openfoodfacts.org however, due to the poor quality of the print, the specific date is not clearly legible (though it is shown as being after 2012). The page contains the following text “Brunswick ham sliced cooked and beechwood smoked ham-Sainsbury-100”. The information listed indicates that the product is manufactured in Germany and sold in the UK by Sainsbury.

Decision

9. Section 72 of the Act states:

“In all legal proceedings relating to a registered trade mark (including proceedings for rectification of the register) the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the original registration and of any subsequent assignment or other transmission of it.”

³ There is also a third photo however, due to the poor quality of the copy the “best before date” is illegible.

10. As Section 72 states that registered marks should be treated as *prima facie* valid, the onus is on the applicant to persuade me that the proprietor's BRUNSWICK mark is not valid. This means that if, having considered the evidence and submissions I find that I cannot make a clear decision as to whether the registration is invalid, then I must reject the application for invalidation.

11. Section 47(1) of the Act states:

“47. - (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.”

12. The proprietor has not pleaded a case of acquired distinctiveness as a result of the use it has made of the mark. Therefore, I only have the inherent distinctiveness to consider.

13. The date of application for the mark is 12 May 2015. Under section 47(1), the question of whether the mark was registered in breach of section 3(1)(b), (c) and (d) falls to be decided as of this date, i.e. the relevant date.

14. Section 3(1) of the Act is 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) 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.”

15. It must be borne in mind that these grounds are independent and have differing general interests. It is possible, for example, for a mark not to fall foul of section 3(1)(c), but still be objectionable under section 3(1)(d) and/or 3(1)(b) of the Act. In *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P, the Court of Justice of the European Union stated that:

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

Preliminary observations

16. The applicant's case is that the mark BRUNSWICK describes the origin of a type of ham. According to the applicant, 'Brunswick ham' is "a generic term to describe a type of mild smoked ham that originates from Braunschweig, in the East Westphalian region of Germany".

17. In the first place, it is necessary to clarify that the proprietor's mark is BRUNSWICK, not 'Brunswick ham', so the correct approach is to disregard the word 'ham'. The validity of the mark must, therefore, be determined in relation to the single component BRUNSWICK.

18. Clearly, from a *prima facie* perspective, the single word BRUNSWICK is not a descriptive term for ham. On the evidence before me, it is the English name for the German city of Braunschweig. On that basis, the only possible characteristic that BRUNSWICK may designate in relation to the goods concerned, is their geographical origin. This means that the applicant's case under Section 3(1)(c) must be confined to the question of whether BRUNSWICK is likely to be seen by the relevant public as designating the geographical origin of the goods concerned. It also means that the other part of the applicant's case, i.e. that BRUNSWICK designates a characteristic of the goods (other than their origin), namely the type and/or characteristic of cooked, cured and smoked hams, depends exclusively on the proposition that BRUNSWICK has become a generic name in the sense that consumers regard it as an indication of a type of product and must, therefore, be assessed under Section 3(1)(d).

19. I find it convenient to start with Section 3(1)(c).

The Section 3(1)(c) ground of invalidation

20. Section 3(1)(c) prevents the registration of 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”. As I have already said above, the applicant’s claim under Section 3(1)(c) must be confined to the question of whether BRUNSWICK is likely to be seen by the relevant public as designating the geographical origin of the goods covered by the registration.

21. The case law under Section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was set out by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-

12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94 . Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia , *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44 , paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley* , paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94 , it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie* , paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-

109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland* , paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94 , the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56)."

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97]."

22. The leading authority relating to geographical names and Section 3(1)(c) of the Act is the judgment of the CJEU in *Windsurfing Chiemsee Produktions-und Vertriebs GmbH (WSC) v Boots-und Segelzubehor Walter Huber and Franz Attenberger* (Joined cases C-108/97 and C-109/97) (“Windsurfing”). In paragraphs 24 to 36 it was stated:

“24. It should first of all be observed that Article 3(1)(c) of the Directive provides that registration is to be refused in respect of descriptive marks, that is to say marks composed exclusively of signs or indications which may serve to designate the characteristics of the categories of goods or services in respect of which registration is applied for.

25. However, Article 3(1)(c) of the Directive pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the categories of goods or services in respect of which registration is applied for may be freely used by all, including as collective marks or as part of complex or graphic marks. Article 3(1)(c) therefore prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks.

26. 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 they 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.

27. The public interest underlying the provision which the national court has asked the Court to interpret is also evident in the fact that it is open to the Member States, under Article 15(2) of the Directive, to provide, by way of derogation from Article

3(1)(c), that signs or indications which may serve to designate the geographical origin of the goods may constitute collective marks.

28. In addition, Article 6(1)(b) of the Directive, to which the national court refers in its questions, does not run counter to what has been stated as to the objective of Article 3(1)(c), nor does it have a decisive bearing on the interpretation of that provision. Indeed, Article 6(1)(b), which aims, *inter alia*, to resolve the problems posed by registration of a mark consisting wholly or partly of a geographical name, does not confer on third parties the right to use the name as a trade mark but merely guarantees their right to use it descriptively, that is to say, as an indication of geographical origin, provided that it is used in accordance with honest practices in industrial and commercial matters.

29. Article 3(1)(c) of the Directive is not confined to prohibiting the registration of geographical names as trade marks solely where they designate specified geographical locations which are already famous, or are known for the category of goods concerned, and which are therefore associated with those goods in the mind of the relevant class of persons, that is to say in the trade and amongst average consumers of that category of goods in the territory in respect of which registration is applied for.

30. Indeed, it is clear from the actual wording of Article 3(1)(c), which refers to '...indications which may serve ... to designate ... geographical origin, that geographical names which are liable to be used by undertakings must remain available to such undertakings as indications of the geographical origin of the category of goods concerned.

31. Thus, under Article 3(1)(c) of the Directive, the competent authority must assess whether a geographical name in respect of which application for registration as a trade mark is made designates a place which is currently associated in the mind 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.

32. In the latter case, when assessing whether the geographical name is capable, in the mind of the relevant class of persons, of designating the origin of the category of goods in question, regard must be had more particularly to the degree of familiarity amongst such persons with that name, with the characteristics of the place designated by the name, and with the category of goods concerned.

33. In that connection, Article 3(1)(c) of the Directive 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 (say, a mountain or lake), such persons are unlikely to believe that the category of goods concerned originates there.

...

36. Finally, it is important to note that, whilst an indication of the geographical origin of goods to which Article 3(1)(c) of the Directive applies usually indicates the place where the goods were or could be manufactured, the connection between a category of goods and a geographical location might depend on other ties, such as the fact that the goods were conceived and designed in the geographical location concerned” (my emphasis).

23. The CJEU subsequently summarised their findings at paragraph 37 as follows:

“37. In view of the foregoing, the answer to the questions on Article 3(1)(c) of the Directive must be that Article 3(1)(c) is to be interpreted as meaning that:

- it does not prohibit the registration of geographical names as trade marks solely where the names designate places which are, in the mind of the relevant class of persons, currently associated with the category of goods

in question; it also applies to geographical names which are liable to be used in future by the undertakings concerned as an indication of the geographical origin of that category of goods;

- where there is currently no association in the mind of the relevant class of persons between the geographical name and the category of goods in question, the competent authority must assess whether it is reasonable to assume that such a name is, in the mind of the relevant class of persons, capable of designating the geographical origin of that category of goods;
- in making that assessment, particular consideration should be given to the degree of familiarity amongst the relevant class of persons with the geographical name in question, with the characteristics of the place designated by that name, and with the category of goods concerned;
- it is not necessary for the goods to be manufactured in the geographical location in order for them to be associated with it.”

24. Applying the principles of *Windsurfing*, the first question to address is whether BRUNSWICK is known to the relevant public, namely the average consumer of ham in the United Kingdom, as the designation of a place. What is more, for the applicant to succeed, it must establish i) that the relevant UK public seeing the sign BRUNSWICK on ham will perceive it indicating the geographical origin of the goods, or ii) that it is reasonable to assume that the use of the sign BRUNSWICK on ham may, in the future, be recognised as designating the geographical origin of the goods.

25. The evidence establishes that BRUNSWICK is the English translation of the German name *Braunschweiger*, which is a city in Lower Saxony (in Germany) with a population of around 250,000 people. This is not sufficient to demonstrate that the UK consumers would recognise in the word BRUNSWICK the name of a German city. In any event, even if the relevant public does know of the city of BRUNSWICK, it does not automatically

follow that BRUNSWICK will be seen as designating the geographical origin of the goods at issue. In this connection, account must be taken of all the relevant circumstances, such as the nature of the goods designated, the degree of reputation, especially within the economic sector involved, of the geographical location in question and the relevant public's greater or lesser familiarity with it.

26. Firstly, as regards the degree of familiarity of the relevant UK public with the German city of BRUNSWICK, the applicant has not referred to any tourist attraction or any other reason why the city of BRUNSWICK would be known to consumers in the UK. The only piece of evidence which describes the city of BRUNSWICK comes the website www.wikitravel.org, which is not a UK specific top-level domain. Further, the size of BRUNSWICK does not seem to be comparable to that of other German cities, which are well-known locations, such as Berlin and Munich. Consequently, I do not see why the UK average consumer of ham, who cannot be assumed to be particularly familiar with German geography, would know of BRUNSWICK or (in the absence of any specific knowledge) would assume that BRUNSWICK is a geographical name (rather than, for example, a surname or an invented word). My conclusion is, therefore, that if the average consumer knows that BRUNSWICK is a German city, the degree of familiarity with it must be modest.

27. Secondly, as regards the degree of reputation of BRUNSWICK within the economic sector involved, neither the print from wikitravel.org about the city of BRUNSWICK nor the copy of the article headed "Guide to German Hams and Sausages" make any mention of ham. Conversely, this appears to substantiate the view that BRUNSWICK is not traditionally well-known for ham products.

28. Thirdly, as to the applicant's argument that "'Brunswick ham' is a generic term to describe a type of mild smoked ham that *originates* from Braunschweig, in the East Westphalian region of Germany", there is no evidence that the goods identified as 'Brunswick ham' are manufactured in BRUNSWICK.

29. Whilst, I bear in mind that it is not necessary for the goods covered by the registration to be manufactured in BRUNSWICK for there to be an association, it is not entirely clear how the goods originate from BRUNSWICK. In this connection, the dictionary definition exhibited at Annex 1 refers to 'Brunswick ham' being made "from prime top and silverside pork *based on the recipe from the East Westphalian region of Germany*", which suggests that the recipe for 'Brunswick ham' (not the ham) originates from a German region called East Westphalian. Aside from the fact that there is no evidence that BRUNSWICK is situated in East Westphalian (and I do not know, as a matter of fact, whether it is or not), the fact that a type of ham has been named after a geographical name is not, by itself, evidence of origin and cannot establish any connection between that geographical name and the goods concerned. It is not established, for example, that BRUNSWICK designates the place where the goods identified as 'Brunswick ham' were designed or conceived.

30. Accordingly, I find that the sign BRUNSWICK has not, in the eyes of the relevant UK public, a link with the goods covered by the mark and that that public is unlikely to perceive the sign as designating the origin of those goods.

31. In view of the above, it is necessary to consider whether it is reasonable to believe that the sign BRUNSWICK used on cooked, cured or smoked ham products may, in the future, be recognised as designating the geographical origin of the goods. In my opinion, as the geographical name BRUNSWICK does not at present, in the view of the public concerned, have any link with the category of goods concerned, it is not reasonable to imagine that the indication at issue might in the future designate the geographical origin of those goods. The applicant has not offered any reason why this view would be incorrect.

32. In view of the above, I dismiss the invalidation claim based on Section 47(1) and Section 3(1)(c) of the Act.

Section 3(1)(b)

33. Section 3(1)(b) prevents the registration of marks which are devoid of distinctive character. Thus, the relevant question under Section 3(1)(b) of the Act (applicable by virtue of Section 47(1) of the Act) is whether BRUNSWICK is capable of distinguishing cooked, cured and smoked hams for which it is registered.

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

“29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C 456/01 P and C 457/01 P *Henkel v OHIM* [2004] ECR I 5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C 304/06 P *Eurohypo v OHIM* [2008] ECR I 3297, paragraph 66; and Case C 398/08 P *Audi v OHIM* [2010] ECR I 0000, paragraph 33).

32. It is settled case law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three dimensional marks and slogans (see, to that effect, respectively, Case C 447/02 P *KWS Saat v OHIM* [2004] ECR I 10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

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

35. It is well established in law that the absolute grounds for refusing registration must be examined separately, although there is a degree of overlap between Sections 3(1)(b) and (c) of the Act⁴. That degree of overlap is reflected in the applicant's pleadings in which, effectively, descriptiveness (i.e. Section 3(1)(c)) is given as a reason for lack of distinctive character under Section 3(1)(b).

⁴ See *Koninklijke KPN Nederland NV v BeneluxMerkenbureau* [2004] E.T.M.R. 57, the Court of Justice of the European Union ("CJEU"), paragraphs 67 to 70.

36. In my view, the applicant's claim for invalidation is no stronger under this ground of attack than Section 3(1)(c). The lack of distinctive character is argued mainly on the basis that the mark designates origin and would therefore lack distinctive character.

37. I have already found that BRUNSWICK is not descriptive of the geographical origin of the goods and no alternative argument why Section 3(1)(b) applies have been submitted. Therefore, the applicant has not shown that BRUNSWICK is incapable of distinguishing the registered goods and is therefore devoid of any distinctive character.

38. Consequently, I dismiss the invalidation claim based on Sections 47(1) and 3(1)(b) of the Act.

The sections 3(1)(d) grounds of invalidation

39. Section 3(1)(d) prevents the registration of 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".

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

"49. Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma* (BSS) [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even

though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public's perception of the mark (*BSS*, paragraph 37).

50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (*BSS*, paragraph 38).

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

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

41. See also: *Merz & Krell GmbH & Co* [2002] ETMR 21 (CJEU) and *Stash Trade Mark* – BL O/281/04 (AP)

42. The relevant question is therefore whether BRUNSWICK had become customary in the current language or in the *bona fide* and established practices of the trade to designate the goods in respect of which the mark is registered. That question must be answered taking account of the expectations of average consumers of the goods at issue.

43. The applicant has provided a few examples of use by third parties of the term 'Brunswick ham' on the Internet prior to the relevant date in relation to ham. The difficulties faced by the applicant in establishing that the sign BRUNSWICK had become customary at the time of the proprietor's application as a generic indication of a type of cooked, cured or smoked ham are threefold.

44. Firstly, most of the evidence is not dated, is non-UK-specific and it is not in the archive form, i.e. before the relevant date.

45. Secondly, even if I was prepared to accept that use by Sainsbury of the designation 'Brunswick ham' was used in the UK in 2009 and in 2012-2014, it is only an instance of use by a third-party retailer. There is no evidence as to the share of the UK market for ham sold by Sainsbury under the designation 'Brunswick ham' and there is no evidence as to the amount that Sainsbury has spent promoting these goods, so it does not prove that the term had become customary, by virtue of that use, by the relevant date. As regards to the evidence relating to other uses on UK websites, I place little weight on it, given the limited number of UK hits and given that the full context of the use is not clear.

46. Thirdly, and more significantly, even if the applicant had shown that a large proportion of the relevant public would have been familiar with the designation 'Brunswick ham' (which it has not) as an indication of a type of ham, it would not have demonstrated that absent the word 'ham', the word BRUNSWICK on its own would have been widely recognised as also denoting similar categories of goods.

47. In view of the above, the applicant's claim that BRUNSWICK is used in the current language or in the *bona fide* and established practices of the trade must be rejected. Therefore, the objection under Section 3(1)(d) also fails.

48. In reaching my conclusion I have not overlooked the applicant's argument that since the proprietor elected not to file any evidence or submissions in relation to the invalidity action, "it has accepted that the evidence filed in these proceedings by the [applicant] conclusively proves that the registration was invalidity filed". I reject this submission. The proprietor has not explicitly admitted that its mark is invalid and it has filed a proper defence. The filing of evidence or submissions is not mandatory and it is up to a party to decide how to run its case. Further, the onus is on the applicant under section 72 to prove its claim.

49. Finally, the applicant has referred me in its submissions to a number of decisions from the EUIPO as to the registrability of the following marks: OPEN RANGE, GLI AFFETTATI DEL MAIALINO, TASTE OF BAVARIA and TIROLER ALMWURST. Aside from the fact that those decisions are not binding upon me, it is self-evident that they refer to different marks, thus are not pertinent.

Overall outcome

50. The application for invalidation under Section 3(1)(b), (c) and (d), applicable by virtue of Section 47(1), fails.

Costs

51. The proprietor has been successful and is entitled to a contribution toward the cost of the proceedings. The registrar normally awards costs from the published scale, as set out in Tribunal Practice Notice 4/2007. Using that TPN as a guide, I award costs to the proprietor on the following basis. This take into account that the proprietor did not file evidence:

Preparing a statement and considering the other side's statement:	£200
Considering the applicant's evidence:	£250
Total:	£450

52. I order Greencliff Associates Ltd to pay The ComplEAT Food Group Limited the sum of £450 as a contribution towards its costs. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case, if any appeal against this decision is unsuccessful.

Dated this 24th day of September 2018

Teresa Perks

For the Registrar

The Comptroller – General