

O-443-16

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION No 1230792
AND THE REQUEST BY BED BATH 'N' TABLE PTY LIMITED
TO PROTECT THE TRADE MARK
BED BATH 'N' TABLE
IN CLASSES 20, 24 & 35**

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 404587
BY LIBERTY PROCUREMENT CO. INC.**

BACKGROUND

1) On 4 June 2014, Bed Bath 'N' Table Pty Limited (hereinafter the applicant) on the basis of its international registration based upon its registration held in Australia, requested protection in the United Kingdom of the trade mark shown below.:

BED BATH 'N' TABLE

2) Protection was sought for the following goods and services:

In Class 20: Furniture.

In Class 24: Bath linen, bed clothes, bed covers, bed covers of paper, bedspreads; brocades; calico, calico cloth; canvas for tapestry or embroidery; cloth; cotton fabrics; coverlets (bedspreads); covers (loose) for furniture; crepe (fabric); curtain holders of textile material, curtains of textile or plastic; damask; dish towels for drying; door curtains; eiderdowns; fabric; face towels of textile; felt; flannel; furniture coverings of plastic; household linen; jersey (fabric); linen (bed), linen (household), linen cloth, material (textile); mattress covers; net curtains; non-woven textile fabrics; pillowcases; quilts; runners (table); serviettes of textile; sheets (textile); silk (cloth); table cloths (not of paper), table linen (textile), table mats (not of paper), table napkins of textile; taffeta (cloth); towels of textile; upholstery fabrics; woollen cloth, woollen fabric; textiles for blinds; embroidery fabric.

In Class 35: Retail services, wholesale and mail order services connected with the sale of textiles and textile goods, namely, bath linen, bed clothes, bed covers, bedspreads, brocades, calico, calico cloth, canvas for tapestry or embroidery, cloth, cotton fabrics, coverlets (bedspreads), covers (loose) for furniture, crepe (fabric), curtain holders of textile material, curtains of textile or plastic, damask, dish towels for drying, door curtains, eiderdowns, fabric, face towels of textile, towels, bathmats,

felt, flannel, furniture coverings of plastic, household linen, jersey (fabric), linen (bed), linen (household), linen cloth, material (textile), mattress covers, net curtains, non-woven textile fabrics, pillowcases, quilts, runners (table), serviettes of textile, sheets (textile), silk (cloth), table cloths (not of paper), table linen (textile), table mats (not of paper), table napkins of textile, taffeta (cloth), towels of textile, upholstery fabrics, woollen cloth, woollen fabric, textiles for blinds, embroidery fabric, giftware, namely, candles and wicks for lighting, trinkets, ornamental statues, sculptures and statuettes, napkin holders and rings, nutcrackers, letter openers, ring holders, medals, candle extinguishers, flower vases, artistic prints, busts, bowls (basins), cutlery, jewellery cases, personal ornaments of precious metals, jewellery, horological and chronometric instruments, postcards. boxes and bins of paper and cardboard, gift bags, photographs, stationery, umbrellas, purses and bags, storage cases and containers, boxes, chests, glassware, porcelain and earthenware, games and playthings, bathroom products, namely, waste bins, mirrors, toilet roll holders, sponges, loofahs, soap dishes, shower curtains, soap, shampoo, laundry baskets, furniture, kitchen ware, including cutlery and crockery.

3) The United Kingdom Trade Marks Registry considered that the request satisfied the requirements for protection in accordance with Article 3 of the Trade Marks (International Registration) Order 1996 and particulars of the international registration were published in accordance with Article 10.

4) On 25 June 2015 Liberty Procurement Co. Inc. (hereinafter the opponent) filed notice of opposition to the conferring of protection on this international registration. The grounds of opposition are in summary:

- a) The goods and services claimed relate to furniture, soft furnishings and bed, bath and table linen and to retail of these goods. The registration of the mark in suit would bestow upon the applicant an unfair monopoly which would prevent the legitimate and fair use by other traders to promote their goods and services in the normal course of their business using words which are of common English parlance. The element 'N' within the mark would merely be perceived by the average customer as "and". The

term has no capabilities of acting as an indicator of origin because the words in this formation are wholly non-distinctive of all the goods and services claimed. The mark in suit therefore offends against section 3(1)(b) of the Act.

- b) With the conceivable exception of “canvas for tapestry or embroidery” and “dish towels for drying” all of the goods and services claimed are goods or services for use in relation to beds, bath and tables, The Class 20 claim to “furniture” clearly includes all types of furniture including beds, baths and tables. Thus the sign applied has no function but to describe some of the goods covered by the Class 20 claim. Further, all of the goods in Class 24 are for use on, for, or in relation to, or may be used on, for, or in relation to beds, baths or tables, with the exception of “canvas for tapestry or embroidery” and “dish towels for drying”. The perception of the average consumer can be no other than that the goods for sale are beds, baths or tables or are otherwise goods adapted for use with beds, baths or tables. The letter ‘N’ is a common abbreviation for the word “and” and as such adds nothing to assist the distinctive character of the mark. The mark in suit consists of a sign which may serve in trade to designate the kind and intended purpose of goods and services and thus offends against Section 3(1)(c) of the Act.

5) On 1 September 2015 the applicant filed a counterstatement basically denying the charges laid by the opponent.

6) Both sides filed evidence. Both seek an award of costs in their favour. The matter came to be heard on 13 September 2016 when the opponent was represented by Miss McFarland of Counsel instructed by Messrs Keltie LLP; the applicant chose not to attend but supplied written submissions.

OPPONENT’S EVIDENCE

7) The opponent filed a witness statement, dated 8 November 2015, by Rosemary Anne Cardas the opponent’s Trade Mark Agent. She provides the following exhibits:

- RAC1: An undated page from the internet. It shows a website “NOT ON THE HIGH St.” which has a section for “Bed, bath & Table linen”.
- RAC2: Two pages from internet sites. The first is undated and shows a company offering bed linen, bath linen, table linen, soft furnishings, etc. available from different areas of its website. The second page is dated 8 October 2015 and shows another company with separate areas for bed linens, bathroom linens, table linens, kitchen linens, healthcare textiles etc. It also has the following description: “We are Linen Connect and since 1968 our group has been a market leading supplier of bed, bath, kitchen and table linens, to markets ranging from....”.
- RAC3: This shows a variety of undated pages from different internet sites, not all based in the UK. They all provide the customer with options to narrow their search, so have different areas e.g. “soft furnishings”, “home accessories”, “kitchen and dining” and “bed and bath”. Others have “Bed and bath” areas or “bed/bath”, “bed & bath”. Another website is called “Bath Bed & Home”.
- RAC4: A page from the SFERRA website, dated 8 October 2015, which offers search areas of “Bedding, Hotel, Bath, Table, Home Décor, Best sellers, Clearance”.
- RAC5: More undated pages from internet sites which offer customers the opportunity to search for beds or tables, seating, storage or under the room such as living room or bedroom and then by subset of, inter alia, sofas or tables for the former and beds or tables for the latter.
- RAC6: An undated screen shot from the eBay website which shows that the website can be searched for items under the following topics; Beds & mattresses, bedroom furniture sets, bedside tables and cabinets etc.
- RAC8-11: Yet more pages from the internet showing that retailers use the word “table” to allow customers to search for tables; “bath” to allow customers to search

for baths etc. etc. Also other pages showing that retailers often substitute the letter “N” for the word “AND”.

- RAC12: Consists of a page from the applicant’s website which shows the name of the company “BED BATH ‘N’ TABLE” at the top of the page. It then offers customers the opportunity to search under categories such as “bed”, “bath”, “table”, “decorator”, “kids”, “gift” and “outdoor”.
- RAC13: A copy of a page from the Oxford English dictionary which shows that the term 'N' is the equivalent of the word “and”.

APPLICANT’S EVIDENCE

10) The applicant filed a witness statement, dated 11 January 2016, by Jennifer Kathryn Good the applicant’s Trade Mark Attorney. She states that the mark has been registered in Australia since 1995 and that the applicant has been trading under its name since 1975. She states, and provides exhibits to confirm, that the opponent has the mark “BED BATH & BEYOND currently registered in the UK for goods in Classes 20 and 24 as well as services in Class 35.

11) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

12) The grounds of opposition are under Sections 3(1)(b) & (c) of the Act which read:

“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.”

13) I turn first to consider the ground under section 3(1)(c). 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 summarised by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch):

“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]."

14) I also take into account the comments in *Campina Melkunie BV and Benelux-Merkenbureau*, Case C-265/00, where the Court of Justice of the European Union stated that:

“39. As a general rule, the mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics within the meaning of Article 3(1)(c) of the Directive even if the combination creates a neologism. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned.

40 However, such a combination may not be descriptive within the meaning of Art.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 mark, which is intended to be heard as much as to be read, that condition will have to be satisfied as regards both the aural and the visual impression produced by the mark.

41 Thus, a mark consisting of a neologism composed of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, is itself descriptive of those characteristics within the meaning of Art.3(1)(c) of the Directive, unless there is a perceptible difference between the neologism and the mere sum of its parts: that assumes that, because of the unusual nature of the combination in relation to the goods or services, the word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts.”

15) I also look to the comments in *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04, where the Court of Justice held that:

“24. In fact, 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, reasonably well-informed and reasonably observant and circumspect, in the territory in respect of which registration is applied for (see Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 29; Case C-363/99 *Koninklijke KPNNederland* [2004] ECR I-1619, paragraph 77; and Case C-218/01 *Henkel* [2004] ECR I-1725, paragraph 50).”

16) I also take into account the comments in *Fourneaux De France Trade Mark*, Case BL-O/240/02, where Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“Having listened with care to the arguments that have been addressed to me on this appeal, I have come to the conclusion that cooker hoods and extractors are closely connected items of commerce, and that they are both so closely connected with cookers that it would be unrealistic to treat the words FOURNEAUX DE FRANCE as descriptive of the character of the latter but not the former. The expression "cookers from France" is descriptive at a high level of generality. That makes it suitable, in my view, for descriptive use in the marketing of units of equipment of the kind found in modern cooker installations including not only grilling and roasting units, but also hood and extractor units”.

17) Lastly, I look to the comments in *Canary Wharf Group plc v The Comptroller General of Patents, Designs and Trade Marks* [2015] EWHC 1588 (Ch), where Mr Iain Purvis QC sitting as a Deputy Judge of the High Court set out the correct approach to assessing whether a trade mark is descriptive of the subject matter of the goods/services. He stated that:

“39. The general approach to be taken by a tribunal dealing with a ‘subject matter’ or ‘theme’ objection under s3(1)(c) or s3(1)(b) was recently considered by Geoffrey Hobbs QC sitting as the Appointed Person in *NMSI Trading Ltd's Trade Mark Application (Flying Scotsman)* [2012] RPC 7 by reference to a number of authorities

including the General Court in *Danjaq v OHIM (Dr No)* [2009] ECR II-2097 , Mr Richard Arnold QC (as he then was) sitting as the Appointed Person in *Linkin Park* [2006] ETMR 74 , the First Board of Appeal of OHIM in *Ferrero OHG v FIFA* [2008] ETMR 76 and Mr Allan James in *Diana Princess of Wales Trade Mark* [2001] ETMR 25 .

40. Following, in general terms, the approach of Mr Hobbs as set out in particular in paragraph 18 of *Flying Scotsman* , I believe that at least three matters need to be considered where a ‘subject matter’ or ‘theme’ objection arises under s 3(1)(c) or (b) :

(a) The nature of the goods or services for which the application is made. Are they in principle apt to provide or convey information about (or imagery relating to) the subject matter of the sign?

(b) The nature of the sign. Is it something which it is reasonable to believe would be recognised by the relevant class of persons (that is to say average consumers of the goods or services in question) as indicating a particular subject matter or theme?

(c) Is the subject matter or theme of a kind which (in the context of the goods or services in question) the average consumer would consider was controlled by a single economic undertaking, as opposed to something which was free to be used and exploited by anyone. See for example *Psytech International v OHIM* [2011] ETMR 46 at [34]-[43] and the concept of ‘official merchandise’ recognised in *Arsenal Football Club v Reed* [2003] RPC 9 (CJEU) and [2003] RPC 39 at [50]-[69] (Court of Appeal).”

18) The opponent contends:

“19. Accordingly we shall invite the learned hearing officer to attribute full weight to the material set out in Ms. Cardas' w/s and the exhibits thereto as demonstrating that the mark BED BATH N TABLE is simply too descriptive and to show the manner in which the relevant commercial landscape and market place is already over

populated and crowded with many examples of traders using the said words BED BATH TABLE in sequence to describe the goods for sale - hereunder we particularly refer to paragraphs 3 & 5-13 (inclusive) in particular in her w/s and the accompanying exhibited material she has supplied to support her w/s.”

And:

“22. Although we recognise that the learned hearing officer will be well familiar with the leading authorities in relation to s. 3(1) b and c of the TMA we would add one or two notes on case law below, which may provide some further guidance to the learned hearing officer:

23. The first reference is to the "Corn Thins" appeal which, is recent [March 2016] and although applying EU law (and not the TMA) is, in our submission a useful example of an application of parallel and related EU guidance. In that case Rude Foods Limited had early success in claiming distinctiveness in their brand "Corn Thins" for crisp breads and the like but the Fourth Board of Appeal found that 'Corn Thins' is indeed descriptive of the goods. According to the Board, as expressed at para 18 of their decision [with emphasis added];

“Indeed, no evidence at all is necessary for the self-evident fact that the average English-speaking consumer will immediately perceive the word ‘THINS’ for the registered goods ‘crisp bread slices predominantly of corn’ just as a description that such slices are thin”

and [at para 19] the Board of Appeal continued their common-sense approach and stated that;

“The relevant products being slices of food, the only reasonable quality that the word ‘THINS’ could refer to for the English-speaking relevant public is that the slices are thin. This is not mere allusion but it clearly describes the product at

hand, regardless of the fact that the word may be newly coined and is not present in English dictionaries.”

24. The Board of Appeal also noted that combining two descriptive terms does not make them any less descriptive, and the capitalisation of ‘T’ in thins did not equate to use as a trade mark. They also to the cases of C-191/01 Doublemint [para 32] and T-19/04 Paperlab [para 20], which both state that that the mark did not have to be descriptive at the time of registration, but rather, the assessment depends on whether the mark *could be* descriptive. Which we submit is the case here.

25. The second case is a General Court (as it then was) case involving the "Greasecutter" mark [*Ecolab USA Inc. Case No. T-610/13* in which the General Court confirmed OHIM’s refusal of the word mark “GREASECUTTER” for goods in Classes 3 and 5. The mark, an international registration designating the EU, was initially owned by Ecolab Deutschland GmbH and then transferred to Ecolab USA Inc.]. At paragraphs 18 and 19 the General Court stated as follows with emphasis added;

“18. It has also been held in the case-law that, for the purposes of the application of Article 7(1)(c) of Regulation No 207/2009, a determination must be made as to whether, in the light of the relevant meaning of the word sign at issue, there is, from the point of view of the relevant public, a sufficiently direct and specific relationship between that sign and the goods or services for which registration was sought, such as to enable that public to perceive immediately and without further thought a description of the goods and services in question or one of their characteristics (see, to that effect, judgments of 28 June 2012 in XXXLutz Marken v OHIM, C-306/11 P, EU:C:2012:401, paragraph 79, and 7 July 2011 Cree v OHIM (TRUEWHITE), T-208/10, EU:T:2011:340, paragraph 14 and the case-law cited).

19. Accordingly, the descriptive character of a mark must be assessed, first, by reference to the goods or services in respect of which registration is sought and, second, by reference to the perception of the relevant public (see

judgment of 12 June 2007 in MacLean-Fogg v OHIM (LOKTHREAD), T-339/05, EU:T:2007:172, paragraph 32 and the case-law cited)."

26. In line with the current case (in our submission) the General Court also found that the mark sought could be construed by the relevant public only as a combination of the two descriptive elements of which it is composed and whose meaning does not extend beyond what each of those elements means separately. Consequently, it is reasonable to think that the mark sought would potentially be understood and be recognised by the relevant class of persons as a description of one of the characteristics of those goods (and/or as in our case, the goods themselves)."

19) The opponent contends that the mark in suit is simply a list or inventory and states that this is how it will be perceived and how the words are used by other companies. I accept that the individual words will be used to designate areas in a website or a retail outlet where items relating to e.g. beds/bedding can be found. I accept that it is possible to find the words "bed", "bath" and "table" listed on websites and probably on in-store guides, and in some instances they will be listed in the order that they are used in the mark. Indeed I accept that the opponent's evidence shows that on a number of websites the words are used in the same order as in the mark in suit to offer consumer a chance to more readily find what they are seeking. However, the evidence provided by the opponent simply does not show use of the words "bed bath 'N' Table" or even "Bed bath and table" without other components such as the descriptor "linen" being added. I accept that it is not unusual for bath towels, hand towels and tea towels to be in similar areas to bed linen as they are similar goods. Baths would not be regarded as furniture and so would be sold in a totally different area, such as sanitary ware or even plumbing. The opponent's evidence shows companies, unsurprisingly, using the individual words "bed", "bath" and "table" along with other descriptors such as linen, furniture etc. when identifying areas of their website for customers to search in order to find such goods.

20) The authorities make it clear that I must regard the mark as a whole, and as such I do not believe that the mark in suit offends against Section 3(1)(c), as it does not describe a

good or service but merely alludes to the fact that the goods are for use in the household.

The ground of opposition under Section 3(1)(c) therefore fails.

21) I next turn to the ground of opposition under Section 3(1)(b). 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 s.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)."

22) I also take into account the comments in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2013] F.S.R. 29, Arnold J. held that a descriptive word with a minor figurative embellishment was, as a whole, devoid of any distinctive character. He found that:

"116. Taking all of the evidence into account, I conclude that the CTM is precluded from registration by art.7(1)(c) in relation to the services in issue because NOW would be understood by the average consumer as a description of a characteristic of the service, namely the instant, immediate nature of the service. The figurative elements of the CTM do not affect this conclusion. In the alternative, if the inclusion of the figurative elements means that the CTM does not consist exclusively of the unregistrable word NOW, I consider that the CTM is devoid of distinctive character and thus unregistrable by virtue of art.7(1)(b) .

117. I would comment that it appears to me that PCCW only succeeded in obtaining registration of the CTM because it included figurative elements. Yet PCCW is seeking to enforce the CTM against signs which do not include the figurative elements or anything like them. That was an entirely foreseeable consequence of permitting registration of the CTM. Trade mark registries should be astute to this

consequence of registering descriptive marks under the cover of a figurative figleaf of distinctiveness, and refuse registration of such marks in the first place.”

23) The opponent contends:

“8. In summary, the Opponents contend that the ordinary English words "Bed, Bath and Table" are and would be ordinarily understood by the relevant public to describe the goods for which those words are apt to either describe them or goods/ articles etc. related thereto . There is no upliftment from the ordinariness of such words to "create" a distinctive or potentially distinctive trade mark merely by running the words together and using the very common abbreviation "N" for the word "and" or the ampersand symbol "&". In the context of the mark in suit, the words "BED BATH 'N' TABLE" which comprise the entirety of the mark do not satisfy those requirements for registration and the application should be refused registration in the UK.

9. It is accepted that there may be a possible exception in relation to the class 35 designation of "dish towels for drying" and /or "canvas for tapestry or embroidery" and this is made clear in the said pleading at paragraph 4, although given the overwhelmingly descriptive nature of the mark (and each of its component / constituent parts) we submit that even if the said mark were to be used on or in relation to such goods there would be an inevitable likelihood of an average consumer making an assumption as to the overriding descriptive nature of the labelling i.e.; a towel for use in drying tables or a bath (e.g.; after cleaning) or a canvas for embroidering to lay on some part of a sofa (an antimacassar or arm cover for example) or for use on a table, like a table cloth / table runner , or for example e.g.; an embroidered cover or decorative panel for a bed or pillow on a bed etc.”

And:

“11. b. They deny that registration of the Mark would "bestow on the Applicant an unfair monopoly right". This bald and unsupported assertion is made in a stark and wholly unsupported manner in para 8 of WM's pleading. They do not seek to particularise it and in our submission this is self-evidently because they cannot. On any analysis and as a matter of common sense if these three ordinary English Words are registered (

notwithstanding the addition of the "N") the effect of such registration and the monopoly rights thereby conferred on the proprietor and those devolving rights from it will inevitably curtail and circumscribe the manner in which others would be free and would *consider themselves to be free* to use such ordinary words. This is the very bane to which the restrictions conferred by s. 3 of the TMA are (quite rightly) the antidote. The protection of the wider trading public is an important consideration."

24) I do not accept the opponent's contentions. Whilst, as I have said earlier, individually each of the words is descriptive, collectively they merely allude to the fact that the goods are for use in the house. I accept that the mark in suit cannot benefit from any distinctiveness through use as this has not been shown. The average consumer cannot, therefore, be said to have been educated into viewing the mark in suit as an indicator of origin. To my mind, the average consumer will view the mark in suit not as a descriptor but as a mark of origin as, in its entirety, it is not descriptive of any of the goods and services applied for by the applicant and is not devoid of distinctive character. **The ground of opposition under Section 3(1)(b) therefore fails.**

CONCLUSION

25) The opposition under section 3(1)(b) and (c) have failed.

COSTS


26) The applicant has been successful and as such it is entitled to a contribution to its costs.

Preparing a statement and considering the other side's statement	£200
Preparing evidence and considering the evidence of the other side	£300
Submissions	£200
TOTAL	£700

27) I order Liberty Procurement Co. Inc. to pay Bed Bath 'N' Table Pty Limited the sum of £700. This sum 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 22nd day of September 2016

A handwritten signature in black ink, appearing to be 'G. W. Salthouse', written in a cursive style.

**George W Salthouse
For the Registrar,
the Comptroller-General**