

O/580/22

TRADE MARKS ACT 1994

TRADE MARK APPLICATION No. 3533928

**BY STAMFORD STONE HOLDINGS LTD
TO REGISTER**

STAMFORD STONE

IN CLASSES 19, 37, 40 AND 42

AND

OPPOSITION THERETO UNDER 423405

BY GOLDHOLME STONE LIMITED

Background and pleadings

1. On 16 September 2020 Stamford Stone Holdings Ltd (“**the Applicant**”) applied to register the words STAMFORD STONE as a trade mark in respect of the goods and services listed below. (The Applicant holds the intellectual property rights of Stamford Stone Company Ltd, but since the latter is the operative business underpinning the Applicant’s evidence in this case, this decision also refers to Stamford Stone Holdings Ltd as “the Applicant” as a convenient, if not precisely accurate, shorthand.)

Class 19

Stone; stones; stone slates; stone ornaments; stone monuments; manufactured stone; building stone; wall stone; natural stone; footing stone; stone sculptures; paving stone; stone chippings; monument stone; memorials of stone; natural stone slabs; natural stone tiles; stone roofing tiles; limestone [calcareous stone]; agglomerated stone materials; stone for building; worked natural stone; works of stonemasonry; blocks made from natural stone; construction materials of natural stone; natural stone slabs and tiles; natural stone for building purposes; stone, rock, clay and minerals; fire surrounds [mantles and mantelpieces] of stone; works of art of stone, concrete or marble; statues and works of art made of materials such as stone, concrete and marble, included in the class; aggregates; agricultural limestone; non-agricultural lime; limestone in granular form; limestone in powdered form; limestone; lime building materials; flooring tiles (non-metallic -); tile flooring, not of metal; flooring materials (non-metallic -); blocks (non-metallic -) for use in flooring construction.

Class 37

Restoration of architectural works; building maintenance; building services; custom building construction; building consultancy services; building repair; building restoration; specialist building restoration; preservation of buildings; maintenance of buildings; refurbishment of buildings; renovation of buildings; stone fixing services.

Class 40

Stone carving; stone crushing; stone grinding; stone cutting.

Class 42

Architectural services; architectural advisory services; architectural consultation services; architectural consultancy services; architectural design services; preparation of architectural plans; preparation of architectural reports; architectural and engineering services; architectural design for interior decoration; architectural design for exterior decoration; providing information in the field of architectural design via a website.

2. The application was published for opposition purposes on 4 December 2020 and is opposed across its full scope by Goldholme Stone Limited (“**the Opponent**”) based on grounds under sections 3(1)(b) and 3(1)(c) of the Trade Marks Act 1994 (“**the Act**”).
3. The section 3(1)(b) claims are:
 - that the applied-for mark is devoid of any distinctive character, being comprised simply of the words STAMFORD and STONE which, when assessed in relation to the goods and services listed in classes 19, 37, 40 and 42 is not capable of acting as an indicator of commercial source;
 - it does not enable consumers to identify the origin of those goods or services;
 - it does not enable consumers to distinguish the Applicant's goods or services from those of other undertakings.
4. The section 3(1)(c) claims are:
 - that the applied-for mark is descriptive and serves to designate the characteristics of the goods and services specified in classes 19, 37, 40 and 42;
 - the word STAMFORD is a direct reference to the town of the same name and this designates the geographical origin of the goods and services;
 - the word STONE designates the nature of the Class 19 goods and the subject matter of the class 37, 40 and 42 services;
 - the mere combination of two descriptive elements with no additional fanciful or imaginative elements does not give rise to a registrable mark and the mark should be kept free for all undertakings to use.
5. The Applicant denies the claims. Its counterstatement states:
 - “the mark STAMFORD STONE is just as capable of distinguishing the goods and services of the Applicant as any other word mark used in the course of trade” and “the Opponent has given no good reason for why this should not be the case”;

- the mark is not descriptive of the goods and services – “for instance, STAMFORD STONE is not descriptive of *preparation of architectural plans* or *preparation of architectural reports*”.
- “In any event, the Applicant has used its STAMFORD STONE trade mark in the course of trade in respect of the goods and services claimed under the Applicant’s mark for many years now. Therefore, the Applicant’s trade mark has acquired distinctive character through use.”

Papers filed, the hearing and representation

6. During the evidence rounds the Opponent filed evidence in chief and the Applicant filed both evidence and submissions in chief. An oral hearing of the matter was held before me by video conference on 15 March 2022. The attorneys for the Applicant are Shoosmiths LLP; the attorneys for the Opponent are Forresters IP LLP. At the hearing, Georgina Messenger of counsel acted for the Opponent; Dr Dominic Murphy of Shoosmiths LLP attended for the Applicant. Skeleton arguments were filed in advance of the hearing. I have read all the papers filed and shall refer to their contents where I consider it warranted to do so.

EVIDENCE / SUBMISSIONS FILED

The Opponent’s evidence

7. The Opponent’s evidence comprised a **witness statement** of **Matthew Shaw** dated 7th July 2021 with 24 exhibits. Mr Shaw is one of the attorneys at Forresters IP LLP, the Opponent’s representatives. He explains that the purpose of his witness statement is to provide information from publicly available and independent sources on the descriptive nature of the applied-for mark when considered in connection with the goods and services covered by the application and thus to demonstrate that there is a real, current and serious need to leave the applied-for mark free for use by other traders. He states that “the evidence should also show the town of Stamford has strong existing connections with stone and architecture, and consequently the threshold to show that the applied for mark has acquired a distinctive character through use is very high indeed.”
8. **Exhibit 5** shows an extracted page (undated) from the Applicant’s website: stamfordstone.co.uk. The exhibit highlights that the Applicant, in 2001, bought the Clipsham Medwells Quarry, which secured the Applicant’s “supply of the finest quality

limestone and block stone.” It states that that quarry has beds of limestone that are very similar in colour and composition, such that “the supply is consistent, giving customers continuity and peace of mind about quality.” It then refers to the acquisition in 2018 by “Stamford Stone” (the Applicant) of its second quarry, Clipsham Bidwells Quarry, making it the exclusive global supplier of Clipsham limestone. It states that “the Lincolnshire stone has been specified for use on some of the most prestigious buildings in the UK including Windsor Castle, York Minster and several historical college buildings in the cities of Cambridge and Oxford.” It refers to excellent production facilities from its limestone quarry, explaining that “quarrying raw material and preparing it for commercial use takes great skill. It is a blend of innovation and traditional craftsmanship” and the Applicant has therefore invested in “some of the most advanced cutting technology on the market” which “interprets design data and cuts stone automatically, resulting in better efficiency, greater productivity and less waste.”

9. **Exhibit 7** to the witness statement Mr Shaw presents a case study from the Applicant's website, which shows that the Applicant's stone is quarried less than 10 miles away from Stamford. The Opponent highlights that the case study quotes one of the architects of a building in the area referring to the central atrium being “completely lined with Stamford Stone dry stone wall, the perfect backdrop to a museum celebrating regional culture.” The Opponent's underlining emphasis is as I have it here, though in my view, the reference to Stamford Stone may be considered use as a trade mark, rather than as a damning descriptive use by the Applicant's own hand.
10. **Exhibit 8** highlights, via the Wayback Machine, that archived webpages from January 2015 show the Applicant's website referring to their being based just outside the “beautiful stone town of Stamford, Lincolnshire”. I note that in its webpage at that date the Applicant referred to itself as Stamford Stone Company, and that it states that it offers products to both commercial and residential builds, working with architects, developers, contractors, builders' merchants, self-builders and renovators nationwide.
11. **Exhibit 10** shows that as of June 2021 there were 738 Grade I, II, and III Listed buildings in Stamford, according to historic England. **Exhibit 14** shows that in 1967, on account of its special architectural and historical interest, Stamford was the first area in England designated as a conservation area. Mr Shaw states that Stamford is well-known as a

stone town and for Georgian architecture which he submits is illustrated by third party articles at **Exhibit 17**. Exhibit 17 includes the following:

- i. Visitsouthkesteven.com - which refers to the description of Stamford by Sir Walter Scott as “the finest stone town in England”;
 - ii. discover-rutland.co.uk - which states that Stamford is widely regarded as one of the finest stone towns in England, and is widely used by film and television producers, for instance serving a location role in adaptations of Pride and Prejudice and Middlemarch;
 - iii. Loveexploring.com – where the article (dated 20 March 2020) is headed “Explore scenic Stamford: England’s finest stone town”;
 - iv. Heritagecalling.com – an Historic England blog – mentions Stamford as one high street featuring Georgian aspects (though the picture used in of Harrogate, and the other places mentioned are Bath and Woodbridge). The blog is shown to have garnered only two comments.
 - v. Issuu.com showing an article from Stamford Pride dated October 2020 (after the relevant date of application for the contested trade mark). The article focuses on “Stamford in 6 buildings”.
 - vi. The other three articles are short profiles of Stamford from the websites of Stamford.co.uk, visitoruk.com and Burghley.co.uk.
12. **Exhibit 18** shows the Applicant on its website in June 2017 citing Sir Walter Scott’s proclamation, and stating “our much loved market town have more than 600 listed buildings with mellow limestone in the town centre including five mediaeval churches.”
13. **Exhibit 20** shows a brochure from the 2019 Stamford Georgian Festival “The Age of Wonder and Invention”, organised by South Kesteven District Council. The 2019 festival was the fourth Georgian festival, and included a celebration of “the massive legacy of Georgian arts and architecture” and was intended to once again highlight the importance of Stamford as “England’s finest stone town”. It notes that its previous Georgian festival attracted over 56,000 visitors. Although the brochure shows the festival as including tours of buildings within Stamford such as its town hall, it also shows a greater number of events including; a discussion of Georgian art by Andrew Graham Dixon; an exhibition on Captain Cook and the botanist Sir Joseph Banks; Georgian costume exhibitions; a celebration of Jane Austen; and Georgian inventions and developments in transport.

14. **Exhibit 22** shows an extract drawn from British History Online - the website at www.british-history.ac.uk - entitled "An Inventory of the Historical Monuments in the town of Stamford", published Her Majesty's Stationery Office in 1977. The report acknowledged the historical and architectural value of Stamford as a whole and that its mediaeval town should be regarded with special consideration for conservation purposes. A section of the report headed "Building Materials and Construction", under the subheading "Stone" states: "*The outcrop of Jurassic rock running from Yorkshire to Somerset provides some of England's finest building stone. Stamford lies on this outcrop within 4 miles of the quarries at Barnack and Ketton and seven miles from Clipsham; it is unlikely that much stone was carried to the town from a greater distance before the 19th century. Within and immediately around Stamford the Lincolnshire Limestone produces an oolite suitable for general building purposes, some beds yielding stone of a very high quality, this is known as Stamford stone.*"
15. **Exhibit 23** shows an extract from a publication by Lincolnshire County Council, called "Alec Clifton-Taylor's Stamford" first published in 1978, republished in 1995. It refers to the excellent "local Stamford stone" being used in the 19th century for repairs and additions with other limestones such as Ketton, Clipsham and Ancaster.
16. **Exhibit 24** shows an extract from a publication by Stamford Town Council published in 1986. It opens with the heading "Stamford and Casterton stone" and includes the text: "sometimes described as Stamford stone but also as Casterton, this is a block oolitic freestone quarried in the area North West of the town. Over the years, there have been at least five quarries, some of which within the boundaries of Stamford and two in the parish of great Casterton. Hence the two names, but it is all virtually the same deposit. The quarrying of building stone here is a very ancient industry....". It contains a picture from 1984, labelled Stamford quarry, and shows a man cutting out blocks of stone from their natural beds in the quarries using a very long handheld chainsaw with tungsten carbide teeth (the photo's labelling informs).

The Applicant's evidence

17. The Applicant's evidence comprises an 18-page **witness statement** from **Laura Green**, with 88 exhibits. Dr. Dominic Murphy also filed submissions.

18. Ms Green has been the Director of Stamford Stone Company Ltd since October 2014. Ms Green is also a Director of the Applicant, which was incorporated on 13 April 2017, in order, as I mentioned earlier, to hold the assets of Stamford Stone Company Ltd.
19. There are two central planks to Ms Green’s evidence:
- i. The first is that whilst the term Stamford stone was formerly used (at least colloquially) as a description of a type of limestone derived from a single quarry near Stamford, it is no longer used to describe a type of limestone recognised in the industry today. The particular quarry had not been worked since the 1980s and has since been infilled and built on with houses. (I note here some possible tension between the reference I mentioned above in Exhibit 24 to “at least five quarries” “over the years” – but the Opponent highlighted no contradiction to Ms Green’s evidence on that point, and I infer that the quarries dwindled in number, to the closure of the final such in the 1980s.) Ms Green states that the stone extracted from Stamford and the surrounding areas is described by reference to terms such as Clipsham limestone, Lincolnshire limestone and Ketton limestone.
 - ii. The second theme of the Applicant’s evidence is that her business has been trading as Stamford Stone for over two decades, providing, it is claimed, the goods and services specified under the applied-for trade mark, such that it has an established reputation and that use of Stamford Stone is recognised as an indication of origin and a trading company.
20. I will refer to further particular details from the Applicant's evidence later in this decision and will weigh up the merits of the parties’ respective arguments and evidence.

Relevant legislation

21. Section 3 of the Act deals with the so-called “absolute grounds” for refusal of registration, based on the inherent characteristics of the trade mark concerned, and the relevant provisions are as follows:

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

...

(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,*

...

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.

Relevant legal principles

22. There was no disagreement between the parties about the relevant legal principles. Aspects of the relevant principles were cited extensively in Ms Messenger’s skeleton argument on behalf of the Opponent. I set out much of the same in some detail below (albeit omitting some references for the sake of brevity):

23. The case law under section 3(1)(c) (corresponding to Article 7(1)(c) of the EUTM Regulation) was summarised by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc*¹ at [91]-[92]:

“91.The principles to be applied under Article 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.

...

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 ...

1 [2012] EWHC 3074 (Ch). The principles were restated by Arnold J. in *W3 Ltd v. easyGroup Ltd* [2018] EWHC 7, para. 154.

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
38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM² 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
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 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.
- ...
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.
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... 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.

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 ...”

24. In relation to questions relating to the perception of descriptiveness, I also note the decision in *Case BL O-238-18*³, where Professor Ruth Annand, sitting as the Appointed Person, referred to the ruling in *LG Electronics, Inc. v EUIPO*⁴. The latter ruling included

3 16 April 2018, hearing an appeal by Business Insider.
4 Case T-804/16, LG Electronics, Inc. v EUIPO EU:T:2018:8

another statement by the CJEU, equivalent to the *Agencja Wydawnicza* quoted above, but expressed as to include the following:

“19.The case-law has also stated that, for the purposes of applying Article 7(1)(c) of Regulation No 207/2009, it is necessary to consider whether, from the viewpoint of the relevant public, there is a sufficiently direct and specific relationship between the sign for which registration as a mark is sought and the goods or services concerned that enables that public immediately to perceive, without further thought, a description of those goods or services, or one of their characteristics

.....

21. Lastly, it should also be noted that the descriptiveness of a sign may be assessed only, first, by reference to the way in which it is understood by the relevant public and, secondly, by reference to the goods or services concerned ...”.

25. Professor Annand noted, in reference to the above, that:

“29.As this passage from the GCEU makes clear, to fall foul of Section 3(1)(c) the meaning(s) conveyed by the contested sign must be sufficiently concrete in order immediately and without further reflection to create a specific and direct link with a description of the goods and services in question or one of their characteristics in the minds of the relevant public.

30. ... the test is a question of degree. It seems to me that this was recognised by AG Jacobs in his Opinion in Case C-191/01, *OHIM v. Wm. Wrigley Jr. Company* [2003 I-12447:

“57.There is clearly a line to be drawn between terms which may be used to *designate* products or their characteristics and those which are merely suggestive of such characteristics. The latter may be registered and are obviously of great value to the trade mark owner.

58. Exactly where that line is to be drawn is however less clear. In each case, there will come a point where an individual decision must be made.

[...]

61. It seems obvious that there is no clear-cut distinction between indications which designate a characteristic and those which merely allude suggestively to it. There is no precise point at which a term suddenly switches from one category to the other, but rather a sliding scale between two extremes and an element of subjective judgment will often be required in order to determine to which extreme a term is closer ...”⁶

26. Given the mark at issue, I note too the law regarding registration of geographical place names as trade marks has been explained and clarified by the Court of Justice of the European Union (‘CJEU’) in its judgments on cases *Windsurfing Chiemsee v Boots Attenberger* C-108/97 and C-109/97. At paragraph 31-36 of its judgment it concluded as follows:

“31 Thus, under Article 3(1)(c) of the Directive [equivalent to section 3(1)(c) of the UK Trade Marks Act 1994 or ‘UKTMA’], the competent authority must assess whether a geographical name in respect of which an 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 [section 3(1)(c) UKTMA] 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.

My approach to dealing with the grounds

27. Sections 3(1)(b) and 3(1)(c) are grounds independent of each other with different emphases of underlying principles. While it is also clear from case law that if a word mark is found to be descriptive, and thus objectionable under section 3(1)(c), it is necessarily devoid of any distinctive character for the same goods and thus objectionable under section 3(1)(b), in the present case the parties agreed that the arguments directly overlap. This decision consequently focuses on the claimed descriptive nature of the Applicant's mark and whether by the date of application for the trade mark ("the relevant date"), it was capable of acting as an indicator of commercial source, enabling consumers to distinguish the Applicant's goods or services from those of other undertakings. I will first deal with the prima facie descriptiveness of the applied-for mark in relation to the goods and services applied for, before considering the Applicant's claim that the mark has acquired distinctiveness through use in light of still further case law principles.

DECISION

Is the applied-for mark objectionable prima facie?

28. STAMFORD is a town located in the county of Lincolnshire.⁵ Geographic origin is explicitly identified by section 3(1)(c) as a "characteristic" of goods and services. I agree with Ms Messenger that even for consumers who are not specifically aware of the location of Stamford, it would be understood that this refers to a place name, or alternatively, that a significant proportion of consumers would recognise it as being a place name.
29. STONE would be understood by any consumer in the UK as being a type of natural material. There is nothing about the combination of the words that alters their individual descriptive meanings and it is clear that the phrase STAMFORD STONE may be understood as meaning stone that comes from Stamford.
30. The applied-for Class 19 goods are all goods that are either a type of stone, or are or could be made from stone, or are made from a material that contains stone. The contested mark STAMFORD STONE may therefore be perceived as describing a characteristic of the Class 19 goods – namely that Stamford is the geographic origin of the stone that they are, are made from or contain. Moreover, this perception is borne out

5 Exhibit 1.

by the location of the Applicant's quarries near to Stamford and there is evidence too of an association of Stamford with this category of goods, reflecting the fabric of many of that town's buildings. I find the mark inherently descriptive in respect of the Class 19 goods and prima facie objectionable under section 3(1)(c) and prima facie non-distinctive under section 3(1)(b).

31. The applied-for Class 40 services are *Stone carving; stone crushing; stone grinding; stone cutting*. Ms Messenger submitted that in respect of these services STAMFORD STONE would be perceived as referring to the type of stone to which that service relates (e.g. that the service is for carving Stamford Stone).
32. In my view, whereas the (objectionable) "designation" aspect is direct and obviously sustainable in respect of the Class 19 goods, the connection loosens in relation to services. The Opponent filed no clear evidence that there is something particular about the stone from Stamford that would differentiate the skill set, technique or demands in its carving, crushing, grinding, or cutting, such that the mark as a whole (i.e. taking account of the presence of the word "Stamford") must be said to "designate a characteristic of the service" – rather than allude to trade source. There is, after all, no evidence of these services as such having a particular connection with Stamford, nor even that the stone comes from Stamford itself. However, since there is evidence of stone emanating from quarries at least in the vicinity of Stamford, I do not rule out that it may be argued that the words STAMFORD STONE could be considered prima facie descriptive and non-distinctive for the Class 40 services, such as in the extracting and preparation of the stone from those quarry sites. This would be premised on there being a sufficiently strong connection between the nature of these Class 40 services (cutting etc) and the production of the stone goods named by the mark. I will proceed on the basis that I deem the Class 40 services objectionable.
33. The remaining two classes of services applied for are:

Class 37: *Restoration of architectural works; building maintenance; building services; custom building construction; building consultancy services; building repair; building restoration; specialist building restoration; preservation of buildings; maintenance of buildings; refurbishment of buildings; renovation of buildings; stone fixing services.*

And

Class 42: *Architectural services; architectural advisory services; architectural consultation services; architectural consultancy services; architectural design services; preparation of architectural plans; preparation of architectural reports; architectural and engineering services; architectural design for interior decoration; architectural design for exterior*

34. With regard to these services Ms Messenger argued that they all relate to the construction industry, in particular the construction and restoration of buildings. Stone is a material commonly used in building. Therefore, consumers would perceive STAMFORD STONE as referring to a characteristic of these services in that it would be perceived as a reference to the type of material used in the carrying out of those services. Alternatively, it would be perceived as referring to the particular expertise of the company offering those services – for example that the company offering the service *building restoration* specialised in the restoration of buildings made from Stamford Stone.
35. Having in mind the comments from *OHIM v. Wm. Wrigley Jr. Company*, it is my view that the services in Classes 37 and 42 tend to fall on the unobjectionable side of the line, being merely allusive/suggestive rather than expressly designating a characteristic of the services in a sufficiently direct sense. I find this to be the case even though some of the services (especially in Class 37 - such as “stone fixing” and “specialist building restoration”) are closer to the line than others (such as “architectural design services”).
36. In reaching the above conclusions I do not overlook the claimed enhancement to the descriptive nature of the mark based on the references to the “stone town” of Stamford. Ms Messenger reminded me of the following principles: (a) that a ‘significant proportion’ of average consumers being confused is sufficient for a finding of likelihood of confusion,⁶ and I accept that the same principle applies in respect of considering whether a mark is inherently non-distinctive; and
(b) that there is no ‘single meaning rule’ according to which a tribunal must ‘identify one, and one only, perception amongst the relevant class of average consumer.’⁷

6 For instance Mann J. in *Soulcycle Inc v Matalan Ltd* [2017] EWHC 496 (Ch)
7 *Interflora Inc v Marks and Spencer plc* [2013] EWHC 1291 (Ch)

37. In *Hearst Holdings Inc*,⁸ Birss J explained that “... trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect ... the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word “average” denotes that the person is typical”. In my view, the average consumer in respect of the goods and services applied-for – the typical consumer - would be a professional seeking raw materials for building or restoration works, and associated services. I accept that the general public may also be constituent of the average consumer group – for example self-builders, as referenced in the evidence - though in my view the great majority of consumers will be purchasing in a professional capacity. Moreover, even where the general public may be the ultimate consumer, they will often access the goods and services via intermediary builders or architects,⁹ and in all cases, given the nature of the goods and services and their relative expense, attention levels in the purchase will be high.
38. I note the evidence indicating that Stamford is a conservation area on account of the fact that it has a substantial number of listed buildings, constructed of local limestone;¹⁰ I note too the numerous references in the evidence to Stamford as “the finest stone town in England”, in the opinion of Sir Walter Scott. However, whilst those who live in and around Stamford may be aware of the stone fabric of many of the town’s buildings, I am not satisfied that a significant proportion of the UK public at large would be aware of the town’s association with stone. There is, for instance, no indication of the reach of the webpages evidenced at Mr Shaw’s Exhibit 17, from sources such as discover-rutland and Visitsouthkesteven. The Georgian Festivals evidenced at Exhibit 20 have attracted over 56,000 visitors, but not only will that likely have included local people, but the focus of those festivals is far from exclusively focused on architecture, let alone stone. Moreover, even for those who have visited Stamford and admired its historic stone buildings, I am not satisfied that the general public will have consciously considered the source of the stone building materials used (notwithstanding that in fact locally sourced building materials would have often been used due to the difficulty of transporting materials in the

8 *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), at paragraph 60.

9 See for example Exhibit 28 (more legible in the submitted digital version).

10 See for example Exhibits 8, 14, 17,18 and 20.

Georgian era). Still less has it been shown that a significant proportion of the general public is likely to be aware of any ongoing quarrying sources in the vicinity of Stamford.

39. There are a few references in the Opponent's evidence to publications specifically referring to Stamford stone as being a named *type* of building material from the Stamford area. However, these publications are unlikely to have reached a wide audience, and with the exception of the 1995 republication at Exhibit 23, the references are well over thirty years old. I am not persuaded that those now historical usages effectively enhance the claimed objection beyond merely the abstract concept of the stone originating from a particular geographical location. Just as with the public at large, the evidence does not establish that Stamford particularly known by the professional public, but I do not rule out that those with professional interest in stone, will more likely be aware of Stamford's stone connection and the ongoing quarrying activities in the area. I bear this in mind in this decision.

The Applicant's claim of acquired distinctiveness

40. The evidence shows that there is no type of limestone or other stone 'officially' named "Stamford stone". This is clear from Laura Green's witness statement at paragraphs 4 and 5 and from the absence of the term from the abridged version of the Standard for the Denomination of Natural Stone (BS EN 12440: 2017). If Stamford stone had been an official term, it seems to me that that would have made significantly more difficult the prospect of acquiring distinctiveness. Of course, it is also clear that a refusal under section 3(1)(c) "does not depend on there being a real, current or serious need to leave a sign or indication free" and that "it is 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."
41. That said, the evidence contains almost no references to the use of the term STAMFORD STONE in actual use descriptively for well over two decades, which aligns with the permanent closure by the late 1980s of the particular single quarry highlighted by the Applicant – seemingly that referenced in Mr Shaw's Exhibit 24. An exception to this general lack of descriptive use is found in the evidence from the Applicant, where Laura Green highlights that the Opponent's current website makes numerous references to

Stamford Stone.¹¹ However, Ms Green's (unchallenged) evidence is that the Opponent's website as it existed from 2001 – 7th May 2019 contained no mention at all of Stamford Stone. Ms Green expresses her belief that the Opponent's introduction of such references on its website was intended to siphon web-traffic searching for Stamford Stone, so that the Opponent may benefit from the Applicant's claimed goodwill and reputation based on the Applicant's use of its Company name.

42. It is not for this decision to consider or determine the merits of that allegation. I have so far found that the words STAMFORD STONE are prima facie descriptive for the goods in Class 19 and potentially too for the stone cutting etc services in Class 40, and therefore prima facie objectionable on absolute grounds under section 3(1)(c) and section 3(1)(b). What I must now consider is whether the Applicant is able to rely on the proviso in section 3 that permits registration of a mark 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.*" I also note that where an applicant has used a sign in trade in such a way that it has become an indicator of commercial source, this does not necessarily prevent other undertakings using the term in a way that is descriptive.
43. The general interest underlying section 3(1)(c) is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services. However, this must be balanced with the legitimate commercial interests of a trader who has used a sign in trade, in respect of relevant goods or services, such that the sign has acquired distinctive character, sufficient to overcome objectionable prima facie descriptiveness.
44. The relevant case law was summarised by Arnold J (as he then was) in Frank Industries Pty Ltd v Nike Retail BV [2018] EWHC 1893 (Ch):

"68. Acquired distinctive character. The following propositions are settled by the case law of the CJEU.

11 Exhibit 85 – showing a screen grab said to have been taken on 6 August 2020, so just before the relevant date of 16 September 2020

69. *First, for a trade mark to possess distinctive character, it must serve to identify the goods or services in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish the goods or services from those of other undertakings.*

70. *Secondly, the distinctive character of a trade mark must be assessed by reference to (i) the goods or services in respect of which registration has been applied for and (ii) the perception of the average consumer of those goods or services, who is deemed to be reasonably well-informed and reasonably observant and circumspect.*

71. *Thirdly, the criteria for assessment of distinctive character are the same for all categories of trade marks, but nevertheless the perception of the relevant public is not the same for all categories of trade marks and it may therefore be more difficult to establish distinctive character in relation to some categories (such as shapes, colours, personal names, advertising slogans and surface treatments) than others.*

72. *Fourthly, in assessing whether a trade mark has acquired a distinctive character the competent authority must make an overall assessment of the relevant evidence, which in addition to the nature of the mark may include (i) the market share held by goods bearing the mark, (ii) how intensive, geographically widespread and long- standing the use of the mark has been, (iii) the amount invested by the proprietor in promoting the mark, (iv) the proportion of the relevant class of persons who, because of the mark, identify the goods or services as emanating from the proprietor, (v) evidence from trade and professional associations and (vi) (where the competent authority has particular difficulty in assessing the distinctive character) an opinion poll. If the relevant class of persons, or at least a significant proportion of them, identifies goods or services as originating from a particular undertaking because of the trade mark, it has acquired a distinctive character.*

73. *Fifthly, with regard to the acquisition of distinctive character through use, the identification by the relevant class of persons of the product or service as originating from a given undertaking must be as a result of the use of the mark as a trade mark. The expression "use of the mark as a trade mark" refers solely to*

use of the mark for the purposes of the identification, by the relevant class of persons, of the product as originating from a given undertaking.

74. Sixthly, a trade mark may acquire a distinctive character in consequence of the use of that mark as part of, or in conjunction with, another trade mark (which may itself be a registered trade mark).

75. Seventhly, it is not possible to state in general terms, for example by referring to predetermined percentages relating to the degree of recognition attained by the mark within the relevant section of the public, when a mark has acquired a distinctive character through use. Nor can the results of a consumer survey be the only decisive criterion to support the conclusion that a distinctive character has been acquired through use.

76. Eighthly, the trade mark applicant or proprietor must prove that the relevant class of persons perceive the goods or services designated exclusively by the mark applied for, as opposed to any other mark which might also be present, as originating from a particular company. It is not sufficient for the applicant or proprietor to show that a significant proportion of the relevant class of persons recognise and associate the mark with the applicant or proprietor's goods.”

45. Ms Messenger drew my attention to the following passage from *British Sugar plc v James Robertson & Sons Limited*,¹² where Jacob J. (as he was then) stated (emphasis added by Ms Messenger):

“I think the registrar was wrong to accept this evidence as demonstrating that the mark was “capable of distinguishing” for the purpose of the Act. Mere evidence of use of a highly descriptive or laudatory word will not suffice, without more, to prove that it is distinctive of one particular trader - is taken by the public as a badge of trade origin. This is all the more so when the use has been accompanied by what is undoubtedly a distinctive and well recognised trade mark. 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

¹² 1996 R.P.C. 281 (Chancery Division) (U.K.)

be beguiled by such evidence. There is an unspoken and illogical assumption that “use equals distinctiveness.”

46. Ms Messenger also cited the following from *Audi AG, Volkswagen AG v OHIM* Case T-318/09, where the Court commented (emphasis added):

“73.....in the advertising material submitted by the applicants and included in the administrative file, the sign TDI always appears with another mark belonging to the applicants, such as the trade marks Audi, VW or Volkswagen. The Court has, however, held on numerous occasions that advertising material on which a sign which is devoid of any distinctive character always appears with other marks which, by contrast, do have such distinctive character does not constitute proof that the public perceives the sign applied for as a mark which indicates the commercial origin of the goods (Shape of a beer bottle, cited in paragraph 41 above, paragraph 51, and Shape of a lighter, cited in paragraph 27 above, paragraph 77).

47. While I note the principles singled out in the above two paragraphs (from *British Sugar* and *Audi*), in my view the facts underlying those references are readily distinguishable from the present case, where the non-distinctiveness of the signs were of an order of magnitude greater than the contested mark in the present case. In the first case the word “treat” registered in respect of dessert sauces was a common laudatory word used alongside the plaintiff’s more distinctive “Silver Spoon” mark. In *Audi* the issue concerned whether TDI on cars was perceived to indicate trade origin, and the references in the quoted text are around the shapes of a beer bottle and a lighter, where again the origin function is apt to be less readily perceived by an average consumer.
48. Ms Messenger stated that in respect of goods and services directly related to the provision of limestone, it is not disputed that the Applicant has been providing limestone as a building material for a number of years. Ms Messenger emphasised that mere evidence of use of a highly descriptive sign does not suffice, without more, to prove that it is distinctive of one particular trader. Ms Messenger argued that the evidence provided by the Applicant does not establish the proportion of the relevant class of persons who, because of the mark STAMFORD STONE, identify goods or services relating to the provision of stone as originating from a single undertaking. In this regard, Ms Messenger

made various overarching criticisms of the Applicant's evidence, which she then corresponded to particular exhibits. The criticisms included:

- i. the frequency and geographical scope of Applicant's advertising and promotion;
- ii. that the Applicant has promoted its services under and by reference to a figurative mark and/or its full company name, so has not used the sign STAMFORD STONE as a badge of origin in advertising and promotion;
- iii. much of the evidence relied upon as evidencing that consumers have been educated to perceive STAMFORD STONE as a badge of origin comes from a single source (www.stonespecialist.com) whose circulation is modest;
- iv. there is no independent evidence evidencing the perception of either the trade or consumers of STAMFORD STONE when used solus and without reference to the full company name or the logo as a trade mark.

49. I bear in mind these criticisms as I consider the Applicant's evidence as a whole. Ms Green's evidence includes the following points.

50. Stamford Stone Company Ltd was set up by Ms Green's father (an architectural reclamation and stone supplier). It was incorporated on 3 April 1997, but has been trading as Stamford Stone since 1996. The company has grown to operate three quarry sites and employs 48 people.

51. The company is recognised for the quality of its goods. In 2006 it became the first UK stone company to be awarded the kite mark of the British Standards Institution (BSI) in recognition of the high quality characteristics and performance requirements of natural stone masonry units. Exhibit 3 shows coverage of this achievement where an article from 15 August 2006 on the website stonespecialist.com is headed "Stamford Stone are first to carry BSI Kitemark." The article clearly refers to "Stamford Stone" as the source of the Clipsham walling and masonry products.

52. At paragraph 49 of Ms Green's witness statement she refers to the success and renown of the company being reflected in its profits made since its establishment in 1996. Turnover figures are given for the years 2013 – 2021. These show, for instance turnover

of well over £4.3 million in each of the years from 2016, and exceeding £7.1 million in 2018.

53. At **Exhibit 2** the Applicant provides 27 illustrative invoices from 2010 and 2018. They are to customers in England including around Leicester, Rutland, Peterborough, Lincoln, Doncaster and Northamptonshire. The invoices are for sums ranging from around the low hundreds of pounds to over £10k. They are shown to be in respect of various stone goods and services such as: “Clipsham sawn sides; Greetham limestone; working to add curve to the above; Quoins – bespoke, as charts 1 & 2 / as per diagram; Great Tew Ironstone; sills; cropped walling – grey; arrow slits”.



55. Ms Messenger argued that any use of the words “Stamford Stone” solus (for instance in articles appearing on stonespecialist.com) “has been in a descriptive sense as a shorthand for the company name rather than use as a trade mark. As such, insofar as the Applicant has educated consumers to perceive a sign as a badge of origin denoting its services it has done so only in respect of the figurative mark.” Taking account of matters in the round, I find I do not fully agree with that analysis. It seems unlikely to me that the logo component, which suggests the letters “SS” on two adjacent rock faces, is what shoulders the badge of origin function. The case law principle I cited above is clear

that a trade mark may acquire a distinctive character in consequence of its use as part of, or in conjunction with, another trade mark. I accept that Stamford Stone has been used as a shorter version of Stamford Stone Company Limited; I accept too that the figurative mark above includes the abbreviation “Co.”. However, it seems to me that the origin message - the mark of trade, distinctive of the source of the goods or services - rests solidly with the words “Stamford Stone”. Not only are those two words separated in the colour tone in the figurative mark above on the 2018 invoices (and signalled by the two letters “SS” on the rock logo), but more fundamentally, I find that the average consumer (reasonably well-informed and reasonably observant and circumspect) will accord little or no distinctive significance to the Co or Company Limited component. Rather, the average consumer will see the source of the goods or services as distinguished by the presence of the words Stamford Stone.

56. Ms Messenger criticised the frequency and geographical scope of Applicant’s advertising and promotion. Ms Green gives an account of the Applicant’s advertising and promotion in paragraphs 33 – 41 of her witness statement with supporting exhibits. Paragraph 42 gives the marketing costs expended by the Applicant since 2012 as follows:

Year	Marketing Costs
2012	£6,994
2013	£6,998
2014	£10,520
2015	£22,188
2016	£48,953
2017	£58,968
2018	£189,107
2019	£151,043
2020	£138,835

57. The annual sums range from around £7-10k from 2012 – 2014, followed by £22k to nearly £60k from 2015 -2017, rising to nearly £140k - £190k from 2018 – 2019. Whilst these sums are not enormous in absolute terms, they are at least reasonably substantial, have been sustained and very significantly expanded over the years.

58. The avenues of promotion include:



it may very well date from after the relevant date. Nonetheless, it is at least clear that the website has operated since 2004,¹⁴ and the URL clearly includes the applied-for trade mark. Exhibit 28 shows a page from the website retrieved from the Wayback Machine from 2007. It is headed with the full company name and its content states that since its formation in 1997 it has established itself as “one of the country’s leading suppliers of limestone products for the construction industry” and highlighted its quality recognition by the British Standards Institute.



- iii. Exhibit 44 is marred by highlighting rendering parts of it illegible, but the promotional content shown from The Natural Stone Source Book – which is published by the

13 See Exhibit 66
14 paragraph 33 of Ms Green’s statement

Stone Federation of Great Britain¹⁵ - refers to the Applicant both as “Stamford Stone Company” and repeatedly as “Stamford Stone” and describes it as “a prestigious stone supplier this has been at the forefront of the stone industry several decades” and which has “gained global recognition as the world’s exclusive supplier of the precious Clipsham limestone which can only be quarried from its two sites.” The article’s coverage refers to the Applicant’s work on the featured Sutton Lodge building “from concept to completion”, creating the build drawings and specifying supplying and fixing the external stone for the Georgian-fronted house.



¹⁶ I also consider it reasonable to infer that the sign would have been displayed.

- v. Networking and third party referrals – Ms Green states at paragraph 36 that the Applicant has 814 followers on LinkedIn, although I note that it is not clear when the Applicant joined the LinkedIn network. While such numbers of followers are not enormous, they strike me as reasonably considerable, especially bearing in mind the specialised nature of a stone company. Ms Green also states (at paragraph 43) that customers seeking high quality limestone are regularly referred to the Applicant by third parties from websites such as: construction.co.uk, stonefed.org.uk and

15 This is clear from Exhibit 45
16 See Exhibits 49, 52 and 55.

nationalchurchestrust.org. Various related exhibits show the Applicant's details and profiles on such sites, though the absence of dates means that these exhibits are of limited assistance in themselves. At most they tend to indicate that the Applicant has taken steps to ensure that its business profile is fostered and maintained amongst what appear important and relevant forums for the stone industry.

59. The Applicant's evidence contains numerous articles sourced from stonespecialist.com. Around 20 articles are shown to have appeared in the publication between 2006 - 2020, where the Applicant is referenced by the words "Stamford Stone" (or even "Stamford"), even if, for example, the heading of an article might have used the fuller term Stamford Stone Company. These articles tend to focus on highlighting particular achievements or recognition of the Applicant and/or on seeking the views of the Applicant about the impact of varying economic conditions (such as in the face of Brexit) on the sale of stone. The articles cover the Applicant's success in securing contracts for work on memorials and notable buildings. For instance, the Applicant is named in connection with:

- i. its cutting and supply work on an Oxford college building shortlisted in 2014 for the Stirling Prize – the major architectural award of the Royal Institute of British Architects (RIBA) and another shortlisted Oxford college building in 2018;¹⁷
- ii. shaping the Portland limestone memorial to those killed in conflicts in Iraq and Afghanistan, unveiled by the Queen in Horse Guards Parade, London in March 2017;¹⁸
- iii. Exhibit 6 from January 2011 states that "Stamford Stone expanded its coverage geographically during the good times and employed six masons to provide dressed stone and architectural details as well as the walling so they can satisfy all the stone requirements of a project...". Exhibit 13 from November 2016 refers to the Applicant as set up in 1997 and having "quickly established a significant customer base across a large section of the Midlands, and sometimes further afield including London." The same article refers to the Applicant supplying stone to Jesus college Cambridge and a hotel in Dubai in 2016.

17 Exhibit 10, 21
18 Exhibit 15

60. The Opponent was critical of the degree to which the Applicant relied on that source in arguing its case for acquired distinctiveness. I note that stonesspecialist.com is the online version of the publication by the QMJ group of Natural Stone Specialist which the evidence shows to be the UK's only magazine dedicated to the natural stone industry, covering “the most interesting projects in stone, both new build and conservation, including the views of architects and designers, clients and the masonry companies involved.”¹⁹ Natural Stone Specialist has been serving the industry since 1882 and its circulation exceeds 4000. Exhibit 27 gives a breakdown of the profile of its readership, which includes architects, fabricators, masons, heritage officers and sculptors. I find that the publication is clearly a centrally important one for the relevant average consumer. I note that the evidence shows extracts from the online version, but there is no evidence (for instance from the Opponent) that the content would have differed from the print version. The circulation figures strike me as respectable and in line with what may be expected in a specialised field.
61. I also note that Exhibit 64 shows that “Stamford Stone” (solus and the operative Applicant) was winner of the Stamford and Rutland Mercury Established Business of the Year Award 2015.
62. The case law highlights the desirable inclusion of evidence “from trade and professional associations”. The written submissions from Dr Murphy explained that the Applicant had sought a witness statement from the Stone Federation, which is the official trade association for the natural stone industry, but that the request was regrettably declined on the basis that the trade association wished to remain completely impartial in legal matters.
63. Short of an association, the Applicant provides testimony from trade. Ms Green’s Exhibits 69 to 79 are witness statements from experienced professionals in the relevant industry. The witnesses range geographically, including from areas local to Stamford, to London, Cambridge, Sheffield and Cheltenham. These witnesses encompass building companies, stonemasons, quarry owners and architect firms. The following paragraphs illustrate the content of their statements.
64. (Exhibit 69, Peterborough): *“the term Stamford Stone to me means the Stamford Stone Company, the company has a strong brand in both the local building industry an national*

19 See for instance Exhibit 3, paragraph 32 of Ms Green’s witness statement and Exhibit 27

stonemasonry industry and is known for its Clipsham limestone masonry and building products. I have installed their products in commercial and residential new builds around the country, but primarily in the colleges of Oxford and Cambridge.”

65. Exhibit 70 is a witness statement from the Operations Director at the London-based firm Szerelmey Ltd shown as “*specialists in stonework and restoration since 1855*”. The witness likewise states that to her the term Stamford Stone means the Stamford Stone Company and no other meaning and that her company “*has purchased Clipsham Limestone from the Applicant for many years for use on large scale commercial projects nationwide.*”
66. All of the witnesses state that they understand the term Stamford Stone to mean the Applicant. One witness – at Exhibit 76 is a draughtsman and stone mason with 44 years in the natural stone industry states that for him the term means two things: “*the first is the local company of that name which has been trading for many years and supplies stones of various types and in various formats such as walling stone, sawn six sides stone, and worked stone. The other meaning of Stamford stone to me is the name of the limestone which was formerly quarried locally, close to Stamford town itself. This stone is currently unavailable as far as I'm aware, and has been so for many years.*”

My conclusion on acquired distinctiveness

67. Having reviewed relevant aspects of the evidence and taking account of the case law principles I set out earlier, I must decide whether or not I am satisfied that the Applicant has established that at least a significant proportion of the relevant class of user, identifies goods or services as originating from a particular undertaking because of the trade mark, such that it has acquired a distinctive character.
68. I am conscious that the nature of the mark is potentially prima facie directly descriptive of the goods in Class 19, and potentially too for Class 40 services. I find that the evidence filed relates directly to use in relation to those goods and services. The evidence refers to the Applicant supplying more than one type of stone (Clipsham, Greetham, ironstone), but even proceeding on the basis that its clear focus is on the supply of (Clipsham) limestone, I find that sufficient to address the specified goods in Class 19. (It seems to me of no consequence that there is, for instance, no evidence of use specifically for

“works of art of ... marble” or for “fire surrounds [*mantles and mantlepices*] of stone”.) There is also evidence going to the services Class 40, where the goods supplied are cut, shaped and ground to meet customer requirements. These services go along with the goods, and the descriptive aspect is anyway less direct or strong as compared with the goods themselves.

69. I have noted the Opponent’s claim that the connections of the town of Stamford with stone and architecture elevate the threshold to show that the applied for mark has acquired a distinctive character. I have also indicated my resistance to that position inasmuch as I am not satisfied that a significant proportion of the UK public at large would be aware of the town’s association with stone and may not anyway mentally link it with a source of stone. I also note the extent to which publications more local to Stamford have advertised or recognised the work of the Applicant by reference to the sign “Stamford Stone”.
70. There are weaknesses in the Applicant’s evidence, as highlighted by Ms Messenger and elsewhere in this decision. There is, for instance, no detail provided on market share. However, taking matters in the round and making an overall assessment of the evidence, **I find that I am satisfied that the contested mark may be considered to have acquired distinctive character.** In reaching this conclusion, I particularly take into account the following:
- i. the longevity of the Applicant’s presence on the market, trading by reference to the sign for over 23 years by the time of the application (and over 22 years before the Opponent made descriptive use on its own website) whereby “Stamford Stone” has been a distinctive indicator of origin, as part of the company name;
 - ii. the Applicant’s BSI recognition since 2006 for the quality of its stone and the global exclusivity of its Clipsham limestone;
 - iii. annual turnover figures of between £4.3 million - £7.1 million from 2016 – 2021;
 - iv. various references to the Applicant as one of the country’s leading suppliers of limestone products for the construction industry and the recognition of Stamford Stone in business and industry awards and its association with notable building works (including Ely and Salisbury cathedrals, York minster, Windsor castle and the Houses of Parliament);
 - v. the Applicant’s advertising spend of around £400,000 between 2017 – 2019. The natural stone sector is a specialised field and it seems to me that the expenditure of

such sums on promotion, year on year, and by the various avenues described, would likely bring the Applicant to the attention of a significant proportion of relevant consumers, especially those professionally engaged in the field;

- vi. that the Applicant has consistently featured as a point of reference between 2006 – 2020 in the leading specialist publication for the relevant industry;
- vii. The absence of descriptive use for over two decades.

71. With regard to the witness statements from the various sources such as Szerelmey, Ms Messenger argued that this hearsay evidence, relied upon as evidencing consumer perception, is not independent and does not address the relevant question. Although solicited and de facto known to the Applicant, the testimony of the witnesses is far from irrelevant, since it comprises truthful statements of diverse practitioners in a specialised field, including from undertakings with considerable heritage and experience. The statements support the view that I have formed that at least a significant proportion of the relevant class of user would perceive Stamford Stone as the distinctive carrier in the Applicant's company name.

72. The applied-for mark identifies the goods or services as originating from a particular undertaking, such that it has acquired a distinctive character. The opposition therefore fails and the application may proceed to registration in its entirety.

Costs

73. The Applicant has succeeded and is entitled to a contribution towards its costs. Based on the guidance in Tribunal Practice Notice 2/2016 I award the Opponent the following:

Considering the statement of grounds and preparing a counterstatement:	£250
Preparing and filing evidence:	£2000
Preparing for and attending hearing:	£1000
Total:	£3250

74. I order Goldholme Stone Limited to pay Stamford Stone Holdings Ltd the sum of £3250. This sum is to be paid within 21 days of the end of the period allowed for appeal or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings (subject to any order by the appellate tribunal).

Dated this 7th day of July 2022

**Matthew Williams
For the Registrar**