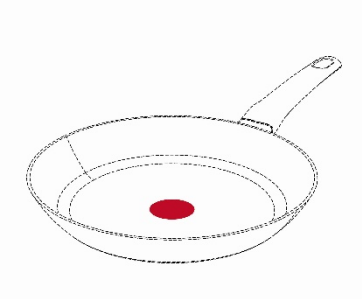
O/587/20

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION NO 3361324
BY TEFAL
TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 21



The application was accompanied by a written description as follows:

> This application is for a position mark.[1] The mark consists of a plain red dot affixed centrally to the bottom of a cooking receptacle (such as a pan, saucepan) as shown. The dotted lines do not form part of the mark and are entered to show the position of the mark on the goods.

Background

1. On 17 December 2018, Tefal ('the applicant') applied to register the above trade mark for the following goods and services:

> Class 21
>
> Frying pans, saucepans, casseroles, stew-pans, cooking pots, crepe pans, grills, woks.

2. On 8 January 2019, the Intellectual Property Office ('IPO') issued an examination report in response to the application. The examination report contained an objection under section 3(1)(b) of the Trade Marks Act 1994 ('the Act') as follows:

> The application is not acceptable in Class 21. There is an objection under Section 3(1)(b) of the Act as the mark is devoid of any distinctive character. This is because when seen by the relevant consumer a plain red circle would have no trade mark significance attributed to it and would be seen as banal. A trade mark is in essence a way to distinguish your goods from those of your competitors but mark does not provide this most basic function.

3. An extension to respond to this letter was requested on 5 March 2019 and this was allowed up to 8 May 2019.

[1] This was subsequently clarified to a 'figurative' mark as there is no classification in the UK, unlike the EUIPO, for 'position' marks.

4. By letter dated 4 April 2019, the applicant, through its attorney, sought permission to conduct a survey, which would involve 250 interviews across UK High Streets. The proposed questions were as follows:

> 1. We are conducting a survey and would like to speak to people who buy cookware products. Do you buy cookware products?
> Response:
> NO —Take no further
> YES —Continue to question (2)
>
> 2. In the context of cookware products, when you see this (show card displaying trade mark) what, if anything, comes to mind?
> Response:
> If Tefal is mentioned then conclude here.
> If Tefal is not mentioned, then move on to question 3)
> If the response is unclear, ask if they are able to expand further and clam what they mean,
>
> 3. In your opinion, would a product showing this [show card displaying trade mark) come from any particular company?
> Response:
> NO — Take no further
> Yes —Continue to question 4)
>
> 4.Which company would you understand the product comes from?

5. The examiner responded to this request, saying that the applicant must decide for itself what type of evidence it chose to submit to demonstrate acquired distinctiveness and therefore no comment was made in relation to the proposed questions being asked. The applicant subsequently questioned this, by reference to Tribunal Practice Notice (TPN) 2/2012. This relates to the requirement to give notice to the tribunal if it is proposed to adduce survey or expert witness evidence. This followed a number of cases before the court concerning the desirability of seeking leave to file such evidence, given especially the cost and delay involved to the parties. It should be noted, however, that the TPN clearly refers to inter-partes actions before the registrar in their quasi-judicial role, deciding matters involving two or more parties. As such, the TPN was never intended to cover this ex-parte situation where the registrar is deciding whether or not to allow an application to be published for opposition purposes.

6. That said, I would note in passing that it seems to me a matter of inherently good practice that if an applicant wants to adduce evidence of this nature in an ex-parte context, which is similarly costly and may involve delay, it has an opportunity to discuss the matter with an examiner or hearing officer. This would inevitably be on the understanding, however, that advice provided by the registrar would be offered only on a provisional and informal basis; that is to say, the examiner or hearing officer is in no position to provide any guarantee as to the outcome in the event advice on the methodology, or even the questions being asked, is followed. Not least this is because the examiner or hearing officer is under an obligation to evaluate the evidence of acquired distinctiveness as a whole, as and when it is presented. Any survey will generally only be part of that corpus of evidence. It is also the case, as in this scenario, that the applicant has its own legal advisors whose function will include that of guiding and directing the evidence which best presents the case for acquired distinctiveness. The applicant and its legal advisor must then assume final responsibility for its own evidence, rather than rely on advice from the registrar.

7. Be that as it may, the examiner declined to offer advice on any proposed survey as, in his words, the application was not at a hearing stage at that point. By implication, if the applicant wanted advice or guidance at this point it could and should have sought a hearing before a senior official of the registry (hearing officer). I should perhaps record, again in passing, that in my opinion the capacity to offer advice in relation to a proposed survey, as above, ought not to be limited to situations where a hearing has been requested, or otherwise provided only by a hearing officer at a certain stage of proceedings. These matters can be raised at any stage. In this case, a further extension was sought up to 8 July 2019 in which to respond to the examination report. A still further extension was then requested and allowed up to 9 September 2019 to respond, although the examiner noted this was the 'final' extension to be allowed.

8. By letter of 9 September 2019 the applicant submitted its evidence of acquired distinctiveness, including a survey and other material intended to demonstrate acquired distinctiveness. It is also clear that, notwithstanding the intention to rely on acquired distinctiveness, the applicant had not (and has never) conceded the prima facie case, and I will therefore need to deal with that firstly in my decision. The examiner was not persuaded by the submissions and evidence filed. The matter duly came before a hearing officer on 6 December 2019. The hearing officer at this hearing was Mark Jefferiss.

9. A record of the hearing is attached to Mr Jefferiss' letter of 16 December 2019 and it states as follows:

> ***"Hearing discussion***
>
> *At the hearing Mr Joy and Ms Wilkinson-Duffy of Baker and McKenzie LLP, who represented the applicant, began by raising the issue surrounding the mark type. Mr Joy specifically drew my attention to the examiner's letter dated 26 September which drew attention to the fact that the mark was a 3D mark. Mr Joy pointed out that the mark as filed, together with the mark description, clearly indicates that the mark is a "position" mark. However, whilst the EUIPO has such a mark type, the UK IPO do not. [2]Mr Joy also drew my attention to the CJEU decision C578/17 where the court ruled that the mark type is not determinative in deciding the mark as such.*
>
> *I thanked Mr Joy for his submissions in this area and I agreed with the premise that the mark type generally merely serves as an administrative tool. There are exceptions, musical notation filed in respect of a sound mark for example, but in this case, it is clear from the representation, together with the mark description, what the mark actually is. Whilst the UK IPO do not have a separate mark type category for position marks, they are generally recorded as figurative marks.*
>
> *I therefore agreed to amend the mark type to "Figurative".*
>
> *Mr Joy then proceeded to discuss the 3(1)(b) objection and in particular the evidence of acquired distinctiveness that had been filed. Mr Joy accepted the*

[2] In my opinion, and I do not understand the applicant to contend, that anything hinges on the purely administrative matter of how the mark is designated, whether as a 'position' or 'figurative' type of mark. See, for example, Case C-223/18P *Deichmann SE v EUIPO*

prima facie objection. The examiner had raised a number of areas where it was considered that the evidence was deficient in some way and Mr Joy addressed these issues in turn.

Mr Joy drew my attention to paragraph 32 of the submissions dated 5 September 2019 and the factors listed in a) to f) which the court highlighted in the "Hansen" case (T-304-16). Mr Joy drew my attention to various annexes in the evidence which covered each of these areas.

The examiner had also raised the fact that there was no evidence to show use of the mark as filed. Mr Joy accepted that the applicant did not use the mark solus but maintained that it was used as a secondary trade mark. Mr Joy referred me to two CJEU cases, namely the "Specsavers" case (C252/12 paragraphs 247 25) and the "Levi" case (C12/12 paragraph 36). In both of these cases the court confirmed that use of a "secondary" trade mark on its own was not required to justify use of the mark.

Mr Joy referred to the high turnover and significant period of use of the mark. This, together with the survey evidence that has been provided, clearly shows that the mark has acquired a distinctive character through the use made of it. Ms Wilkinson-Duffy referred me to the "Kit-Kat" case and she highlighted the fact that this case differed in the sense that the red dot has been in existence in advertising which was unlike the situation in the Kit-Kat case where the mark was never actually used as it had been applied for.

I thanked Mr Joy and Ms Wilkinson-Duffy for their submissions. I advised that I would defer my decision until after I had the opportunity to consider the case law that had been drawn to my attention. I asked if there were any instances to show that the applicant had referred to the red dot mark in any way. Ms Wilkinson- Duffy advised that, as far as she was aware, there were no such references, but the visual purchase and impact of the mark has a high degree of significance.

The packaging of the pan and the marketing of it has attempted to show that the red dot is in use as a trade mark.

I agreed to consider the arguments made and give my decision. What follows is my decision following an assessment of all the evidence filed and the arguments made.

The evidence of acquired distinctiveness shows substantial turnover over a significant period of time. To a certain extent this is not unexpected as the applicant is one of the leading brands in the area of cookware. The issue essentially comes down to the question of whether the red dot, on its own, would be seen as an indicator of brand origin by the average consumer. This has been attempted to be proved with the submission of the survey evidence which shows that 32.5% of those surveyed mentioned "TEFAL" in response to the question "In the context of cookware products, when you see this [the application] what, if anything comes to mind". A further 27.75% mentioned "TEFAL" when asked a further question which prompted which particular company came to mind.

The case law that was discussed at the hearing, namely the "Kit-Kat" and "Levi" cases are indeed relevant and in relation to survey evidence the "Kit-Kat" case

is particularly relevant. This case introduced the issue relating to reliance as opposed to association and this, in my opinion, is the fundamental question in this application.

Whilst I also acknowledge the "LEVI" decision and the principal of secondary trade mark use, I am not convinced that this application is completely on a par with this case, as I am unaware of the marketing and or use shown of that particular mark.

In my opinion the evidence supplied does not demonstrate that the red spot, alone, would be seen as an indicator of brand origin as opposed to associating the mark with the applicant. In particular there are three main reasons for this. Firstly, there is nothing in the evidence that specifically draws attention to the red spot as being a badge of origin in itself. This is something that would have been helpful in demonstrating that the applicant has educated consumers that the sign is a trade mark of the applicant. For example, references to "the pan with the red spot" would help to draw attention to the mark in the eyes of an average consumer.

Secondly, the first question in the survey does not, in my opinion, assist in this case because those who responded may simply be reminded of TEFAL as opposed to seeing the sign as a badge of origin. This may well be enough in a survey under section 5(3) to establish a link (or bring to mind) but this does not help for the provision to section 3. It may have assisted if there was a follow up question to those who responded "TEFAL" along the lines of "Why do you say that?".

Finally, the second question contained in the survey invites the person to speculate about a brand, so is leading them to guess which. Therefore, it is unsafe to conclude that the consumer is seeing the sign as a badge of origin from the responses to this question.

Conclusion

The mark type has been amended to read "Figurative".

The section 3(1)(b) objection is maintained for the reasons given above. As I did not give my decision at the hearing, I allow a period of two months for the submission of any further arguments or for further evidence to be supplied.

Failure to respond within this time period will result in the application being refused in its entirety."

10. By letter dated 17 February 2020, the applicant responded to the hearing report. It clarified that it had not conceded the case in the prima facie and addressed the hearing officer's concerns as regards the survey. I shall quote from the letter.

> "The Applicant submits that while the third question may point consumers in the direction of speculation, it is intended to supplement the second question and put the consumer in the frame of mind that they would be in when encountering cookware or homeware products bearing the Applicant´s red spot mark, i.e. assessing the origin of the product based on the sign(s) which are displayed.

As such, while the responses to the third question in the survey may carry less weight than answers to the second question, the Applicant submits that they are nevertheless helpful in demonstrating the overall impression to UK consumers of the Applicant's mark as an indication of origin. The Applicant submits that this was not given due consideration in the Hearing Report.

Even if the responses to the third question are given slightly less weight than the responses to the second question, the 32.5% of people who mentioned Tefal in response to the second question should still be considered a highly valuable statistic when it comes to demonstrating acquired distinctiveness. Even if the additional 27.75% of people who mentioned Tefal in response to the third question are considered less relevant, it is remiss to suggest that this statistic is irrelevant, or even insignificant.

CJEU Decision in *Case C-12/12, 'Levi Strauss'*

In the Hearing Report, the Hearing Officer indicated that he is "*not convinced that this application is completely on par with [the Levi Strauss case], as [the Hearing Officer is] unaware of the marketing and / or use shown of that particular mark*". While the Applicant accepts that the relevant facts of the *Levi Strauss* case may not be precisely aligned with the present matter, the Applicant maintains that it is the legal precedent set by the case which is a useful source of guidance in the present matter.

The Applicant seeks to rely on the *Levi Strauss* case to support the position that evidence of use showing the Applicant's red spot with, for example, a letter "T" embossed on the redspot, could still constitute use of the Applicant's mark, and thus provide valuable evidence of acquired distinctiveness.

In the *Levi Strauss* case, the CJEU held that a registration for the famous Levi's red tab, sewn into the seam of a jean pocket, but absent the "LEVI'S" word, was put to genuine use where the use made of the mark included the word "LEVI'S" on the red tab. While the marketing and / or use of the LEVI'S branded products will of course not be precisely the same as the manner in which the Applicant's products feature its red spot mark, the *Levi Strauss* case is useful in demonstrating the general principle that, regardless of whether a sign is used as part of a registered trade mark or in conjunction with the registered trade mark, as a consequence of that use the sign for which trade mark registration is sought may serve to identify, in the minds of the relevant class of persons, the goods to which it relates as originating from a particular undertaking.

The Applicant therefore submits that the *Levi Strauss* case is highly relevant in the present case, as it demonstrates that evidence of use of the Applicant's mark which includes a letter "T" should be given more weight than it has to date in these proceedings."

11. Further submissions were made by letter dated 23 July 2020, and this was, as I understand it, because of the interrupted days situation, which prompted the hearing officer to make a further offer to the applicant to respond to the hearing report. It is unclear from the correspondence whether he had considered the earlier letter of 17 February 2020. In the event I will need to cover the applicant's further submissions of 23 July 2020 and quote from those, also at some length below, even if some of the points had already been made in the letter of 17 February 2020.

The Hearing Officer´s decision to maintain the objection under Section 3(1)(b) appears to be based on the following points:-

1. The second question in the survey does not, in the Hearing Officer´s opinion, demonstrate that the Applicant's mark would be seen as an indicator of brand origin, as opposed to demonstrating that consumers merely associate the mark with the Applicant. The Hearing Officer feels that those responding to the second question may simply be reminded of the Applicant, instead of relying on the mark as a badge of origin. The Hearing Officer believes that the fundamental question in this matter surrounds the concept of reliance.

2. The third question in the survey, in the Hearing Officer´s opinion, invites the person to speculate about a brand, thus leading them to guess.

3. The Hearing Officer is unconvinced that the *Levi Strauss* case is on par with the present case because he is unaware of the marketing and/or use of the mark in that particular case.

The Applicant seeks to address each of these points in turn. For ease of reference, the Applicant has set out the survey questions at the **Appendix** to these submissions.

Hearing Officer´s concerns with the survey evidence

General remarks concerning the survey

While we appreciate that the survey evidence has not been discounted on principle, we wish to make the general point that while courts have in some cases been critical of survey evidence, a survey which is conducted properly, and in accordance with the guidelines can, as confirmed by the courts, be useful in demonstrating the acquired distinctiveness of a mark. Such a survey may only represent part of the overall package of evidence. In the present case, it is submitted that the methodology of the survey was not flawed and, when taken as a whole, the questions are not leading those surveyed to a conclusion in favour of the Applicant. Further, the survey represents only a part of the overall evidence package provided by the Applicant and must be considered not only in the context of the questions, but in the context of the evidence as a whole.

When taken as a whole, it must be noted that the Applicant's survey showed that 60.25% of the consumers surveyed mentioned the Applicant in their responses. As CJEU case law tells us, there is not a prescribed minimum percentage level of recognition for acquired distinctiveness to be shown (*Joined cases C217/13 and C218/13 Oberbank, Banco Santander and Santander Consumer Bank v Deutscher Sparkassen-und Giroverband eV*).

Nevertheless, while there may not be a prescribed minimum, in the present case the Applicant submits that the percentage value of 60.25% is statistically very significant, and comfortably above any reasonable arbitrary level that might be expected.

Second question in the survey

The Hearing Officer believes that because of the structure of the second question (whereby consumers were shown an image of the mark as filed and asked if anything came to mind), consumers may simply be reminded of the Applicant, or else associate the mark with the Applicant, rather than actually see the mark as a badge of origin belonging to the Applicant. However, the Applicant submits that the Hearing Officer has incorrectly dismissed the results from the second question, particularly as the impact of the results from the second question were not taken into consideration in combination with the results of the survey as a whole, as well the entirety of the Applicant's evidence. When assessed in a wholistic manner, it is submitted that the evidence does show that the relevant UK consumers do in fact rely on the Applicant's mark as an indication of brand origin.

This leads on to the concept of reliance from the *Kit-Kat* case (*Societe Des Produits Nestle SA v Cadbury UK Ltd [2017] EWCA Civ 358*). In the *Kit-Kat* case, it was found that consumers did not rely on the mark in question as an indication of brand origin and therefore the mark did not have acquired distinctiveness. However, as mentioned at the Hearing, the present case substantially differs to the *Kit-Kat* case because the Applicant's mark had been in use in the manner applied for for a number of years prior to the filing of the Application. This is in contrast with the factual background of the *Kit-Kat* case in which the mark in question had never actually been used in the form applied for. In view of this differing factual background, the *Kit-Kat* case cannot be considered to be on a par with the issues relevant to these proceedings.

A further key difference between the present case and the *Kit-Kat* case is that the mark in the present case is, and has been throughout its longstanding use, visible at the point of purchase, whereas the mark in question in the *Kit-Kat* case was not. To elaborate on this point, the Applicant's red spot on its frying pan products is immediately visible to consumers at the point of purchase and not hidden by packaging, both online and in store.

In fact, the Applicant deliberately exposes the red spot because it is a known indicator of origin and assists purchasers in immediately identifying the product as originating from Tefal. As can be seen from the evidence previously submitted by the Applicant in this matter (see paragraphs 28-36 of the Witness Statement of Nabil Yanar, and the corresponding evidence exhibits), the Applicant's frying pan products have been sold with a cardboard wrap-around, but the red spot is cut out and exposed so as to be deliberately visible to consumers. An example is included again below for ease of reference:-

In contrast, the mark in question in the *Kit-Kat* case was hidden beneath a plastic chocolate wrapper and was not visible to consumers at the point of purchasing the confectionary goods. This creates a significant disparity between the present case and the *Kit-Kat* case.

Unlike in the *Kit-Kat* case where consumers were shown to merely associate the mark applied for with its applicant, the evidence in the present case shows that consumers rely on the Applicant's mark as a badge of origin due to its longstanding, prominent, standalone and immediately perceiveable presence on products.

The Applicant therefore submits that the responses to the second question of the survey do meet the test for reliance as set out in the *Kit-Kat* case. That is to say, that for many respondents, the Applicant's red spot is regarded as having clear 'brand significance' and thus they are able to rely on the Applicant's mark as an indication of brand origin

Third question in the survey

The Hearing Officer suggested in the initial Hearing Report that the third question in the survey may point consumers in the direction of speculation. The Applicant addressed these concerns in its submissions dated 17 February 2020. However, these were not directly addressed in the Hearing Report dated 4 March 2020. The Applicant, therefore, refers to its previous submissions on this point. That is to say, the Applicant submits that while the third question may point consumers in the direction of speculation, the question was intended to supplement the second question and put the consumer in the frame of mind that they would be in when encountering cookware or homeware products bearing the Applicant´s red spot mark, i.e. assessing the origin of the product based on the sign(s) which are displayed to them.

The Applicant accepts that the responses to the third question in the survey may carry less weight than answers to the second question. However, the Applicant submits that the results to the third question are nevertheless helpful in demonstrating the overall impression to UK consumers of the Applicant's mark as an indication of brand origin.

Even if the responses to the third question are given slightly less weight than the responses to the second question, the 32.5% of people who mentioned Tefal in response to the second question should still be considered a highly valuable statistic when it comes to demonstrating acquired distinctiveness. The additional 27.75% of people who mentioned Tefal in response to the third question serve to supplement the initial very positive response.

12. The applicant then amplifies its reasons for reliance on the ‘Levi Strauss’ case. In particular it notes that the hearing officer ought to have considered that, although he did not have the evidence in the Levi Strauss case before him, it ought to have been clear from the legal principles that emerged, that the case had relevance to this case, and it was unnecessary to have that evidence before him. Secondly, the applicant submits that the hearing officer’s head, in effect, may have been turned by the fact that some of the evidence presented shows use of the sign with the letter ‘T’, which

was not how the mark was represented on Form TM3. It is worth recording these submissions of the applicant in the same letter of 23 July 2019 in full as follows:

> "As mentioned, the reason the *Levi Strauss* case links to the present case is because in some of the evidence submitted by the Applicant, a letter "T" had been embossed over the top of the red spot. The Applicant intended to demonstrate that use of the Applicant's mark with a letter "T" embossed over the top would constitute use of the mark as applied for, i.e. a red spot without the "T" embossed over the top. As the *Levi Strauss* case shows us that use of the mark with the word "LEVI'S" embossed over the top constituted use of the mark without the word element, the Applicant submits that this concept is sufficiently on par with the present case.
>
> Notably, in so far as the evidence shows use of the Applicant's mark with the letter "T", the letter "T" is separate and apart from the red spot, and the *Levi Strauss* case makes it clear that this is possible. The "T" is essentially a separate mark and the Applicant's evidence shows multiple pieces of branding including the red spot and the letter "T". It is worth noting at this point how difficult it is for a single letter to function as a trade mark, i.e. if a distinctive word mark like "LEVI'S" could be used alongside and still constitute trade mark use of the red label *per se*, it follows that the red spot with an otherwise non-distincive single letter "T" could constitute use of the red spot *per se*.
>
> The Applicant submits that the large volume of evidence shows that the mark has been consistently and widely used (even if some of the images include the letter "T"), and that the extensive evidence of use in combination with the survey evidence and the statement from the trade, shows that the mark has acquired distinctiveness. "

13. Neither the submissions made on 17 February 2020, nor those on 23 July 2020, persuaded the hearing officer to change his mind. Indeed, he felt that the submissions on 23 July merely reiterated those on 17 February and duly, and formally, refused the application on 17 August 2020. The applicant has now asked for a full statement of reasons for the decision.

14. I should add one final point and in particular the reason I have quoted at such length from the applicant's submissions in this case. That is, that the hearing officer, Mark Jefferiss, has now retired. By letter dated 5 October 2020 the registrar offered the applicant the opportunity to ask for another hearing before Dafydd Collins, or for Mr Collins to write the full decision as he had access to all the papers, including submissions. The applicant said it had made all the arguments it wanted to in support of the plea of both the case in the prima facie and on the basis of acquired distinctiveness, and that it was content for Mr Collins to write the decision.[3] In the event it is not Mr Collins who is writing the decision but myself. I have assumed this does not alter the applicant's view that it has made all the submissions and arguments it considers necessary. In part, this circumstance explains why I have been unusually assiduous in quoting from the applicant's letters. Because of my lack of any prior involvement in the case, I wish to avoid any possibility of unfairly paraphrasing the submissions or worse, not recording them at all. I find myself in the somewhat unusual position of reviewing the material before the original hearing officer, without being privy to his thought processes, beyond those expressed in correspondence. As such though, it is important to stress in this case that I also have access to all the paperwork

[3] A similar situation arose in BL O/079/10 'NO HALF MEASURES', see para 9 and following

on file, I have read and considered it and that I have understood the submissions clearly and do not require further clarification.

Decision

15. The relevant parts of section 3 of the Act read as follows:

> *"3.-(1) The following shall not be registered –*
>
> *(a) …*
>
> *(b) trade marks which are devoid of any distinctive character,*
>
> *(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,*
>
> *(d) …*
>
> *Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it."*

The relevant legal principles - Section 3(1)(b)

16. The Court of Justice of the European Union ('CJEU') has emphasised the need to interpret the grounds for refusal of registration listed in Article 3(1) of Directive 2008/95/EC ('the Directive', being the codified version of the original Directive 89/104/EEC) and Article 7(1) of Council Regulation (EC) No 207/2009 ('the Regulation', being the codified version of original Council Regulation 40/94) in light of the general interest underlying each of them (Case C-37/03P, *Bio ID v OHIM*, paragraph 59 and the case law cited there, and e.g. Case C-273/05P *Celltech R&D Ltd v OHIM*).

17. The general interest to be considered in each case must reflect different considerations according to the specific ground for refusal in question. In relation to section 3(1)(b) (and the equivalent provisions referred to above upon which section 3(1)(b) is based) the Court has held that *"...the public interest... is, manifestly, indissociable from the essential function of a trade mark"* (Case C-329/02P *'SAT.1' Satelliten Fernsehen GmbH v OHIM*). The essential function, thus referred to, is that of guaranteeing the identity of the origin of the goods or services offered under the mark to the consumer or end-user by enabling him or her, without any possibility of confusion, to distinguish the product or service from others which have another origin (see paragraph 23 of the above mentioned judgment). Marks which are devoid of distinctive character are incapable of fulfilling that essential function. Moreover, the word 'devoid' has, in the UK at least, been paraphrased as meaning 'unpossessed of', from the perspective of the average consumer.

18. The question then arises as to how distinctiveness is assessed under section 3(1)(b). Paragraph 34 of the CJEU Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (*'Postkantoor'*) reads as follows:

"A trade mark's distinctiveness within the meaning of Article 3(1)(b) of the Directive must be assessed, first, by reference to those goods or services and, second, by reference to the perception of the relevant public, which consists of average consumers of the goods or services in question, who are reasonably well informed and reasonably observant and circumspect (see inter alia Joined Cases C-53/01 to C-55/01 Linde and Others [2003] ECR I-3161, para 41, and Case C-104/01 Libertel [2003] ECR I-3793, paras 46 and 75)."

19. So, the question of a mark being devoid of distinctive character is answered by reference to the goods and services applied for, and the perception of the average consumer for those goods or services.

20. It is also a well-established principle these days that the registrar's role is to engage in a full and stringent examination of the facts, underlining the Registrar's frontline role in preventing the granting of undue monopolies, see to that effect, CJEU Case C-51/10 P, *Agencja Wydawnicza Technopol sp. z.o.o. v. OHIM* [2011] ECR I-1541. Whilst that case was, technically speaking, in relation only to section 3(1)(c) or its equivalent in European law, the principle about the 'prevention of undue monopolies' must hold good whether section 3(1)(b) and/or (c)

Application of legal principles – Section 3(1)(b)

The case in the prima facie

21. Applying the above principles to this case, I must first identify who, given the goods specified, would comprise the relevant consumer. Following that, whether that relevant consumer would have any characteristics which may pre-dispose them to perceiving trade marks in a manner which may be unique in some way. The applicant submits (para 19 of its letter of 5 September 2019) that the relevant consumer consists of a very attentive consumer with a level of attention that is higher than the norm, which is 'reasonable'. It does so on the basis that cookware is not necessarily an everyday purchase and made only infrequently. I am happy to accept that the cookware purchasing public will pay particular attention to a pan's, primarily functional features, which may include e.g. being non-stick, the length of handle, its size and weight, the material from which it made and so forth. This however is of no great assistance to the applicant since I do not concede that such a consumer will be especially pre-disposed to any form of unique appreciation of trade marks.

22. The applicant's primary submissions regarding the inherent characteristics (the prima facie case) of the mark can be summarised as follows:

- That a minimum degree of distinctiveness is required to pass the threshold for registration and which correlates to a sign's capacity to function as a trade mark, guaranteeing the origin of the goods or services;
- That the sign is factually unusual in the relevant market place;
- That it is identifiable and memorable and not 'banal' as the examiner claimed;
- That it is also visually striking;
- That the UKIPO has accepted many similar simple marks for registration, such as e.g. 3119279, 3121872, 3112610 and others;

- That the mark in suit has also been accepted by other jurisdictions having an examination-type procedure, similar to the UK's. Details of these are provided by the applicant.

23. These are familiar arguments made in relation to section 3(1)(b). The question for me can be simplified to, 'What is the likely perception of the relevant consumer upon seeing the sign applied for, in normal and fair use in relation to the goods specified' Specifically, would the consumer see the sign as being 'origin neutral' or 'origin specific', based only on its inherent characteristics? It is well established, for example, that I am under no obligation to rule on any dividing line between the concept of lack of distinctiveness and that of minimum distinctiveness. [4] As far as the earlier UK marks are concerned and those applications for the same mark in other jurisdictions, the position in law is similarly clear[5], namely that such comparisons are certainly not binding or even necessarily persuasive, not least because the circumstances under which such marks have been accepted is far from clear and any errors that may have been made cannot be allowed to be perpetuated.

24. Whilst I may not have chosen to use the term 'banal' in respect of the sign as filed, I cannot disagree with the examiner's and hearing officer's conclusion that, in the prima facie case the sign is devoid of (any)[6] distinctive character. In short, the sign comprises a feature of the appearance of the product concerned; it is a feature of a certain colour, proportion and position, being plainly visible within the overall shape of a(ny) pan. It is perhaps debateable whether the sign is an 'independent' feature of the product. Some may say it is 'independent' in the sense that it is not a feature of shape per se. That said, it is an undeniable feature of the appearance of an everyday product. As such, it seems to me that, analogously, and as with the legal position as regards shape marks[7], the consumer may not customarily or ordinarily consider such a feature as a trade mark, in and of itself. Even if the analogy with shape marks is an unfair one on my part, the European Courts have considered this specific type of mark in a number of cases, for example, Case T-547/08 *X Technology v OHIM* (Orange- toed socks), Case C-521/13P *Think Schuwerk GmbH v OHIM* (Red shoe laces), Case T-433/12 and T-434/12 (STEIFF bear button) and others. The precise circumstances are not the same of course but I do not think it unfair to draw an overall conclusion that, in the prima facie case, it would be considered most unlikely that such signs perform the essential function of trade marks because they are primarily perceived by the relevant consumer as being either (and purely) decorative and/or functional. The sign is a simple geometrical shape in red, being at the centre of the inside of the pan. This shape further resonates with the overall shape of the product; it is not completely arbitrary as such (for example, a square or triangle in a round pan). As far as the submission that the red dot is unique in the marketplace is concerned, or 'outside the norms and customs of the trade' to use the term used in case law, this is, in my opinion, a question to be established by reference to evidence rather than assertion. Even if there was evidence of intrinsic uniqueness, or distinctiveness in the broad sense (not TM distinctiveness) I would add that would not necessarily mean that such a sign would in its inherent characteristics perform the function of a trade mark.

25. For the reasons given, in short, I think the hearing officer and examiner were correct in rejecting the case in the prima facie and as a consequence, requiring the applicant

[4] By way of example only, see BL O/185/12 FEEDBACK MATTERS, para 42
[5] By way of example only, see BL O/262/18 BREXIT, para 9 and following for the legal position regarding so called 'state of the register' evidence
[6] The word 'all' in the provision seems to me to be redundant given that 'devoid' has the same effect
[7] See e.g. C-136/02/P *Mag Instrument v OHIM* [2004] ECR I-9165, Case C-25/05 P *August Storck KG v OHIM* para 47 and others

to show that it had educated the relevant public, or a significant proportion thereof, to see the sign as a trade mark guaranteeing the origin of the goods specified.

Acquired distinctiveness

Legal principles regarding acquired distinctiveness

26. In the case of *Windsurfing Chiemsee*[8] the relevant factors are set out as follows:

> "51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: the market share held by the mark; how intensive, geographically widespread and longstanding use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from Chambers of Commerce and industry or other trade and professional associations.
>
> 52. If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied. However, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general abstract data such as predetermined percentages
>
> 53. As regards the method to be used to assess the distinctive character of a mark in respect of which registration is applied for, Community law does not preclude the competent authority, where it has particular difficulty in that connection, from having recourse, under the conditions laid down by its own national law, to an opinion poll as guidance for its judgments (see, to that effect, Case C-210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 37)".

27. Further, in the case of *Societe de Produits Nestle v Cadbury UK Ltd* [2017] EWCA Civ 358 (the 'Kit Kat' case), I would highlight the following:

> The fact that a particular sign may be associated by the relevant public with a single undertaking or recognised by a proportion of that is not sufficient for it to amount to distinctiveness for the purposes of the Act (see para 78);
>
> Registration of this sign would (notwithstanding that it may be arguable that it is not a shape mark, per se) involve conferring rights in relation to any pan having a red spot or feature that may be considered similar. As such, in order to cause 'confusion' the sign in question must be proven to operate as a trade mark. If that is not proven, from the evidence taken as a totality then the shape (or whatever the sign is) is not properly a trade mark (see also *Nestle v Unilever [2002] EWHC 2709 (Ch)*);
>
> As a consequence of the above, the sign must have been used as a trade mark in order to educate the relevant consumer to the fact that it guarantees the origin of the product (see para 83). The consequence of this, in my opinion, is that if the evidence discloses that the sign may have another function, other

[8] Joined cases C-108 and C-109/97

than that of a trade mark, then at the very least this would be a material factor in my overall assessment.

28. It is important to record that the applicant has sought to distinguish the *Kit Kat* case from its own application. It does so primarily on the basis of the marks or signs involved. It says its mark had been in use in the manner applied for, over a number of years prior to the filing of the application. This is in contrast with the factual background of the *Kit-Kat* case in which the mark in question had never actually been used in the form applied for, being inside a wrapper. It also says that that in *Kit Kat* the sign applied for was not visible at the point of purchase, unlike the applicant's sign. In response to this, it is important for me to acknowledge that, whilst differences exist as between the respective signs applied for, and that 'Kit Kat' often referred to 'shapes', these differences do not, in my opinion, detract from the core underlying rationale, enunciated in *Kit Kat.* That rationale unequivocally requires the applicant to have used the sign applied for as a trade mark.

29. In this latter regard, in my opinion there is an illuminating passage in the case of BL O/072/18 'Sole of a shoe' case, at para 31 which states:

> 31. The third alleged error was that the Hearing Officer applied the wrong test for acquired distinctiveness because she required the Proprietor to show sales by reference to the sole device. It is asserted that the sole device is a sub-brand, and based on the Hearing Officer's conclusion, no sub-brand could ever have acquired distinctiveness when sold in conjunction with a main brand. Here, the 'main brand' is the word mark Birkenstock. It is a common and well-recognised problem that it is difficult to show that part of the appearance of the goods conveys an origin message when the 'main brand' conventionally conveys a very clear origin message. However, one way to show that a sub-brand does convey an origin message is to show that the proprietor has the confidence to rely on the sub-brand to convey an origin message in its marketing. In other words, a possible approach is to ask: does the proprietor trust the sub-brand to convey an origin message and is this apparent in the proprietor's marketing?

30. As regards this passage, firstly, I do not think it unreasonable to treat this application as a 'sub brand' in the sense referred to above; the main brand is clearly that of the word 'TEFAL'. Whilst the signs are of course not the same, I think it is a perfectly legitimate question to pose the applicant, as to what measure, if any, of 'trust' or 'confidence' it has placed in its sign, such that it has educated the public to it being a guarantee of origin. I believe it was this consideration, admittedly amongst other matters, that led the hearing officer to question how, and in what manner, the applicant had used or promoted the sign (shown confidence in its sub-brand), over and above what would be seen as a mere feature of the product itself.

31. Finally, and this is where I have to admit some sympathy with the applicant, I think their reliance on the 'Levi Strauss' case is well placed. The case is CJEU Case C-12/12 *Colloseum Holding AG v Levi Strauss & Co*. In short, the court advised that genuine use may be satisfied where a registered trade mark, which has become distinctive as a result of the use of another composite mark, of which it constitutes one of the elements, is used only through that other composite mark, or where it is used only in conjunction with another mark, and the combination of those two marks is, furthermore, itself registered as a trade mark. In the specific case, the use of:

was held to be genuine use of:

32. I do not have the same difficulty as the original hearing officer in accepting the legal principles engaged here. Firstly, the relationship between the notion of genuine use for the purposes of avoiding revocation and that of acquired distinctiveness is well established - see, for example, the case of *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) at para 93 and following:

> 93. The claimant submitted that the logic of the CJEU's judgment in ***Coloseum [the Levis Strauss case]*** is to draw an analogy between the assessment of use from the point of view of revocation for non use and from the point of view of use to acquire distinctive character and avoid invalidity. Since use in a form which does not alter the distinctive character of the registered mark is use which can be taken into account when considering revocation for non-use, this logic means that when considering whether a mark has acquired a distinctive character the effect of the same sort of non-identical use can be considered too.
>
> 94. I can see no good reason why European trade mark law should be as restrictive as the defendant's submission suggests. The defendant makes a strong point that there is no legislative provision corresponding to s46(2) (CTMR Art 15(1)(a)) in the context of acquired distinctiveness and that the language of the proviso (which is also in Art 7 CTMR and Art 3 Directive) refers to the "use which has been made of it". That is true but not determinative.
>
> 95. Proprietors do not always and consistently use a mark in precisely the form as registered. This is recognised in s46(2) (Art 15 CTMR, Art 10 Directive) which permits such minor variations to be taken into account in order to avoid revocation

of the mark. If such use can be relevant to avoid non-use it would be unfair to the proprietor to ignore the same use of a mark from the point of view of acquiring distinctiveness merely because it was not absolutely identical to the registered mark. For example I can see no good reason why a proprietor should be barred from relying on oral use of prominent parts of a word or device mark to support the acquisition of a distinctive character. In an (entirely plausible) situation in which a proprietor has used what it regards as its core brand in various slightly different forms in different contexts which do not differ in their distinctive elements, the defendant's submission would demand an impossible factual analysis in which one tried to separate out the effect of different acts of use.

33. The Levi Strauss case was cited in response to the hearing officer's observation that the evidence, or certain parts at least, did not show the mark as filed. The sign as filed shows a red spot in the middle of a pan, the spot being a plain circle and having no features, whereas certain aspects of the evidence shows the sign as having the letter 'T' prominently, in the middle of the spot. However, as the case law make abundantly clear, there is a range of what may be called 'acceptable variants' and 'uses in conjunction with other composite marks', which would not, in principle, undermine the case for acquired distinctiveness. The hearing officer's views were at the least capable of being misconstrued in this respect and furthermore, the evidence does not only show use with the letter 'T', in any event, and so any suggestion that the only use relevant for the purposes of showing acquired distinctiveness would have been that showing only a red spot, without the letter 'T', is plainly, in law and based on the available evidence, unsustainable.

The evidence

34. The first witness statement is by Nabil Yanar, dated 2 September 2019. Mr Yanar works for SEB Developement, a sister company of Tefal with a head office in Rumilly France. He was working in the Legal Department for Tefal from 2011 to 2016 as a Legal and Intellectual Property Manager, managing Tefal's Trade Marks, Designs, Patents and Copyrights. He details the applicant's use of its red spot sign. It is always referred to as the 'Famous Red Spot'. My attention has been drawn, for example, to the use being made across a wide range of products, as well as on packaging. The applicant has sold over 42 million units since 2000 and net sales have totalled over EUR 340 million. It has spent over £20 million in promoting its products in the UK over the last 10 years. The specific nature of the figures, says the applicant, ought to impact substantially on the assessment, by which I assume to mean, probative worth, of the evidence. The applicant has promoted its 'famous red spot' in major UK magazines and newspapers such as e.g. BBC Good Food, Easy Living, Good Housekeeping, as well as Daily Express, Daily Mirror, The Sun and The Times. 'Good Housekeeping' was read by 422,759 people on average per issue over six months. Readership figures are also provided for the other publications and these are independently provided. 'it is safe to say, says the applicant, that 'the advertisements displaying the products featuring the 'Famous Red Spot' must have generated millions of impressions and must have been seen by millions of UK consumers.' By 'impressions', the applicant includes online versions of the publications, only some of which I have mentioned above. Such impressions are also said to be unduplicated, in terms of the printed publication.

35. The applicant has further featured products bearing the 'Famous Red Spot' in numerous commercials which have aired on cable and network television during many of the most popular shows broadcast on British TV such as: MasterChef and

Something for the Weekend on the BBC. The viewing figures for these programmes are provided, for example, MasterChef had 4 million viewers in 2013.

36. In addition to this, the applicant collaborated with Jamie Oliver to introduce a line of products called 'Jamie Oliver by Tefal'. The collection is available online as well as at most third party resellers located in the UK and which are listed as an Exhibit to the Witness Statement. The coverage around the launch of this promotion is said to be extensive. Jamie Oliver has 7 million followers on Instagram and 4 million subscribers and followers on Twitter and YouTube. This is said to have enhanced the reach and exposure of the 'Famous Red Spot'.

37. The second witness statement is by William Jones who is Chief Operating Officer of the British Home Enhancement Trading Association ('BHETA'). Although the applicant says he is 'independent', he nonetheless acknowledges that Tefal are members of his trading association which represents suppliers and manufacturers of homeware and DIY products. He says that a round, red spot at the centre of a frying pan is known in the industry and understood as an indication that the product originates from Tefal. He is not familiar with any other producers or suppliers using a red spot in the centre of a frying pan. He has been familiar with the applicant's use for the last 8-10 years. He states also that if he were to come across a frying pan with such a spot he would assume it originated from Tefal or intended to give that impression.

38. The third witness statement is by James Hickson, a Research Director of Field Connection Ltd ('FCL') since 2006. FCL were commissioned by Baker & McKenzie LLP (the applicant's attorneys) to conduct a number of surveys on UK High Streets to determine whether a red spot, as shown in the application and as shown to interviewees, is associated exclusively with the applicant in relation to frying pans and kitchenware. He explains that the survey was designed to be a statistically significant representative cross section of the general population across the UK. The visual stimulus was to be an exact representation of the mark as filed and the questions being asked were, as originally proposed by the applicant and referenced above at para 4 above. It would be helpful to remind myself of those questions:

> 1. We are conducting a survey and would like to speak to people who buy cookware products. Do you buy cookware products?
> Response:
> NO —Take no further
> YES —Continue to question (2)
>
> 2. In the context of cookware products, when you see this (show card displaying trade mark) what, if anything, comes to mind?
> Response:
> If Tefal is mentioned then conclude here.
> If Tefal is not mentioned, then move on to question 3)
> If the response is unclear, ask if they are able to expand further and clam what they mean,
>
> 3. In your opinion, would a product showing this [show card displaying trade mark) come from any particular company?
> Response:
> NO — Take no further
> Yes —Continue to question 4)

4.Which company would you understand the product comes from?

39. The surveys were completed between 7-11 May 2019. Ultimately 400 people were interviewed and this comprised 105 from the Midlands, 91 from the North of England, 156 from the South of England and 48 from Scotland. The respondents were selected at random using a handheld tablet and the visual stimulus being a show card. Mr Hickson says that the surveys show that a significant number of respondents associate the red spot with a single company. Indeed, at Question 2, 130 of the 400 respondents surveyed reported that they were aware that the image represented by the visual stimulus represented an association with the applicant. Tefal and this was without the interviewers mentioning any brands or companies. This equates to 32.5% of the total sample. The figures break down as follows:

	North	South	Midlands	Scotland
Numbers interviewed	91	156	105	48
Respondents mentioning Tefal	34	62	7	27
Total percentage	37%	40%	7%	56%

40. Those who did not reference the applicant were then asked Question 4. I note in passing there is no mention of Question 3 in Mr Hickson's Witness Statement but I shall deal with this later. As far as question 4 is concerned he notes that a further 111 respondents then referenced the applicant without any brands being mentioned. This extra group equates to 27.75% of the total sample. Overall therefore, he says, 241 respondents out of the total sample of 400 referenced the applicant at some point in the survey, equating to 60.25%. The total proportions of those referencing the applicant are shown in the table below:

	North	South	Midlands	Scotland
Number interviewed	91	156	105	48
Respondents mentioning Tefal	66	105	42	28
Total percentage	72.5%	67%	40%	58%

41. Mr Hickson concludes his evidence by saying that any 'degree of awareness above 50% indicates that a sign or brand is relatively well known, especially in the context of a crowded market such as the cookware and homeware industry'. That concludes my summary of the evidence and I shall now proceed to evaluate the evidence, as a totality, against the legal principles which I have set out above.

Evaluation of the evidence of acquired distinctiveness.

42. I must firstly recognise that the 'Windsurfing' factors do not represent a 'tick box' exercise and that my duty engages an evaluation of the 'totality' of the evidence, not just focussing on e.g. the survey or other material. Secondly, I also recognise as I have said, that the mark may have been used, sometimes with the letter 'T' being prominent

or visible, and on other occasions, not. In principle and by reference to the actual evidence, this is not an issue for me.

43. There is no doubting the extent of exposure of the sign to the UK cookware buying public. I am confident enough to say the figures for sales, promotion and advertising, even where I am unsighted on the total market share in the UK, are substantial. The applicant is undoubtedly a large player in the overall cookware market in the UK. Of course, it markets products which do not have the 'Famous Red Spot' but this does not undermine the consistent use of the red spot throughout a number of the applicant's cookware ranges. By cookware ranges I mean, pans. The red spot is also used on packaging. It has also shown that exposure, across the whole of the UK, can be inferred. As I know from the case law however, simple exposure of the sign does not make out the case for acquired distinctiveness.

44. At this point I must set out my grave concern that the applicant's exposure of its sign, 'The Famous red Spot' is, and has been all along, an indicator of heat rather than an arbitrary or random red spot. If the sign has been used to achieve a technical effect, as an optimal heat indicator to show the consumer when the pan is hot enough to start frying or cooking, in my opinion this would militate, at the very least, against any perception that may have arisen that the use was as a trade mark and a guarantee of origin.

45 At Exhibit NY2 (page 47) the following is exhibited taken from the applicant's own website:

The relevant words used are “INNOVATION. Tefal creates a new innovation for its frying pan, the THERMO-SPOT. This heat indicator changes its appearance depending on the temperature of the pan. With this new tool, cooks can now see when the pan has reached the right temperature. Cooking has never been so simple, even for beginners.’

46. Likewise, the evidence discloses use and recognition by third parties of the ‘THERMO-SPOT’ technology. The following is taken from Exhibit NY11 at page 489, being a GRATTAN Catalogue from, I believe, 2012.

The relevant words are: 'THERMO-SPOT™ Tefal's unique heat indicator lets you know when your pan is perfectly pre-heated and ready to cook.'

There are similar references to the 'THERMO-SPOT TM and its properties at, for example, pages: 497, 499, (TESCO catalogue), 507, 508, 511, 523, 529, 534, 539 and 540 ARGOS Catalogues.

47 These references, at the very least, have left me with considerable doubt as to the precise manner in which the applicants have been using and promoting this sign. In my opinion it is hard to conclude other than that the evidence has been carefully curated to seek to draw any attention away from the technical function of the red spot. It seems to me, as an aside, that it may have been prudent if the whole question of whether the sign was, and still is, performing a technical function was a matter that

ought to have been further explored at an earlier stage.[9] I have carefully considered the matter. It is my view, that as the application stands and based on the available evidence, the possibility that section 3(2) of the Act (which inevitably would have engaged questions about any patent or design protection that may have applied to the red spot) is not worth pursuing at this point. This is because, in my opinion, and based on existing case law, the application should, in any event, be refused under section 3(1)(b).

47. My substantial difficulty with this case, and in relation only to section 3(1)(b), is whether the evidence only goes to the question of 'association' with the applicant, and not, as required by the case law ('Kit Kat' and the cases that preceded and foreshadowed it), use as a trade mark.

48. At this point I wish to consider the survey. By way of preliminary observation it is clear from my extensive account of the background of this case the applicant first sought the guidance of the registrar in terms of the questions it proposed to put to the respondents. It is also clear from my account that any guidance or steer from the registrar was not, in fact, forthcoming. As I have also made clear, even if guidance had been given it could only have been on a provisional and informal basis without any guarantee as to the final outcome. The hearing officer would then have been perfectly within his rights, in an assessment of the totality of the evidence, to conclude that acquired distinctiveness had not been proven even though the registrar may have advised as regards the survey. As it was, by the time of the hearing the survey had been completed without any advice and results were made available to the hearing officer. The previous hearing officer plainly had a difficulty with the survey. He said:

> "Secondly, the first question in the survey does not, in my opinion, assist in this case because those who responded may simply be reminded of TEFAL as opposed to seeing the sign as a badge of origin. This may well be enough in a survey under section 5(3) to establish a link (or bring to mind) but this does not help for the provision to section 3. It may have assisted if there was a follow up question to those who responded "TEFAL" along the lines of "Why do you say that?".
>
> Finally, the second question contained in the survey invites the person to speculate about a brand, so is leading them to guess which. Therefore, it is unsafe to conclude that the consumer is seeing the sign as a badge of origin from the responses to this question."

49. For my part, I think his criticisms strike me as overly harsh. Question 2 was as follows:

> 2. In the context of cookware products, when you see this (show card

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[9] The application was filed on 17 December 2018. I am unsure whether the hearing officer considered the possible application of section 3(2) of the Act, which, at the date of filing read as follows:

"(2)A sign shall not be registered as a trade mark if it consists exclusively of—
(a)the shape**[**F1, or another characteristic,**]** which results from the nature of the goods themselves,
(b)the shape**[**F1, or another characteristic,**]** of goods which is necessary to obtain a technical result, or
(c)the shape**[**F1, or another characteristic,**]** which gives substantial value to the goods."

The words 'or another characteristic' were inserted on 14 January 2019 by virtue of The Trade Marks Regulations 2018 (S.I. 2018/825).

displaying trade mark) what, if anything, comes to mind?
Response:
If Tefal is mentioned then conclude here.
If Tefal is not mentioned, then move on to question 3)
If the response is unclear, ask if they are able to expand further and clam what they mean,

50. To me this is an open question, not entirely dissimilar to the first question posed in a fairly recent case considered by the High Court on appeal from a decision of the registrar, *Jaguar Land Rover Ltd v Ineos Holdings Ltd* [2020] EWHC 2130 (Ch). In that case the same sort of structured and sequential approach to the questions was taken. At para 51, the learned judge notes:

> 51.The Hearing Officer set out at paragraph 113 the headline points from Mr Malivoire's analysis of the survey results, namely that they indicated that 11% of those shown the pictures of the **Land Rover** Defender 90 mentioned (only) **LAND ROVER** before they had been asked any questions. After the first question (*"What can you tell me about what you are looking at?"*) this rose to 44%. The second question was *"And what else, if anything, can you tell me about it?"*. After the third question, posed only to those who mentioned a car brand (*"You mentioned [X]. Why was that?"*), 50% had mentioned only **LAND ROVER,** including mentions of DEFENDER and DISCOVERY, another **Land Rover** model. He also noted that 4% of respondents mentioned (only) JEEP before being asked any questions, and after all the questions 15% of respondents had mentioned JEEP

51. In the *Land Rover* case and on appeal, it was felt that at the lower end, as many as 25% of respondents identified the shape unequivocally and clearly as that of a Land Rover and at the higher end, around 40%. The uncertainty being due to the ambivalent nature of the individual responses. In this case I think it fair for the applicant to rely on an initial recognition figure in response to question 2, of 32.5% of respondents who mentioned 'Tefal'. It may be somewhat statistically perplexing that this ranged from 56% recognition in Scotland to only 7% in the Midlands, but the reasons for that are not something I can speculate upon. In relation to the sequence of the questions, I can understand that the hearing officer may give less weight to questions 3 and 4, as he seems to be suggesting they draw the respondent further into the realm of speculation, but this should not be allowed to detract from the statistically significant and material responses to question 2.

52. An initial recognition figure of 32.5% is undoubtedly statistically significant. I note for example in the case of *Mermeran Kombinat AD v Fox Marble Holdings PLC [2017] EWHC 1408 (Ch)* it is said at para 77:

> 77. For the reasons discussed above, I do not accept Mr Hicks' submission. In line with what was said by the Court of Justice in *Windsurfing*, if it was shown that in August 2013 at least a significant proportion of relevant persons perceived that the Trade Mark, when used in relation to marble, identified it as originating from a single undertaking, the Trade Mark was validly registered pursuant to art.7(3). As earlier indicated, I take a significant proportion to mean markedly above *de minimis* but not necessarily over half.

53. The difficulty the applicant has, however, is whether, what the survey shows is simply 'recognition and association' of a major player in the cookware sector, rather than the

kind of material perception as a trade mark which is required by the case law. In the *Land Rover* case, noted above, it is remarked:

> 59. Of importance is the Hearing Officer's statement in paragraph 117, that by a respondent simply mentioning LAND ROVER and no other brand in response to the pictures of the Defender's shape it does not mean that respondents necessarily regarded the shape, by itself, as distinguishing the goods of JLR from those of other undertakings. He found there was force in the submission advanced before him by Mr Bloch for Ineos that the survey showed some degree of recognition of the shape and a level of association with JLR, but not recognition of the shapes as trade marks, i.e. as designating the goods of JLR and no other. The authorities make clear that he was correct to question whether the survey showed that a substantial proportion of relevant consumers had come to perceive the shape of the Defender as an indication of origin, rather than merely recognising it and associating it with JLR (see, for example, the discussion at [77]-[79] of the judgment of Kitchin LJ (as he then was) in *Nestlé*).

54. I have already mentioned above at paras 44-47 my concerns that the applicant's use as a trade mark had been tainted by the fact that it was, in reality, a sign which resulted from, and was intended to fulfil, a technical effect. These concerns are actually reinforced by the survey results which can be found at Exhibit SJ1 to the Witness Statement of James Hickson. In response to Question 2, no less that 65 of the 400 responders indicated that the sign showed a 'heat spot', or an alternative term such as 'hot spot', or even 'when the pan is hot enough', that is 16.75%. In the Midlands, the proportion is significantly higher, 36 out of 105 (34.2%), referenced the technical nature of the sign. I regard these figures as critically undermining the applicant's claim that the sign is simply a 'Famous Red Spot', suggesting a wholly random or arbitrary sign. In other words, this is a sign which, in the eyes of many of the relevant consumers, cannot, in fact, be divorced from its technical function. I would also note in passing that I have no difficulty in looking critically at the survey results rather than simply accepting Mr Hickson's account of the results. This was, after all, exactly what was done in the *Land Rover* case above and approved of on appeal.

55. Finally, on the survey results, I mentioned above at para 40 that James Hickson's evidence was silent on the answers to Question 3. This was:

> 3. In your opinion, would a product showing this [show card displaying trade mark) come from any particular company?
> Response:
> NO — Take no further
> Yes —Continue to question 4)

Having referred myself again to Exhibit SJ1, which records the answers, I note that of the 400 respondents, no fewer than 232 answered either 'no', or their answer is not recorded (58%). I will say no more than, self-evidently, this is a leading question, intended to illicit the answer, 'yes'. It is also, of course, a question for the tribunal (me) to answer. That 58% chose to reject the 'yes' answer or their answer simply isn't recorded, or worse for the applicant, for them to give the opposite answer to the one intended, is interesting to say the least. I should stress though that nothing hangs on the answers, or lack of, to Question 3, given my overall findings on the evidence.

56. Finally, there is another angle, referenced by the hearing officer, which is also relevant to this case. Notwithstanding the technical function angle, I am struggling from the

evidence to see exactly how the applicant may have shown the kind of 'confidence' in a sub-brand, spoken of at para 29 above. This was something that clearly concerned the hearing officer as well. The sort of confidence that may have helped here is not necessarily independent use of the sign, apart from the main brand 'Tefal', not least because the case law does not require that, but, and for example, a referencing of the 'red spot' in some way ('The pan with the red spot'), other than as a simple feature, or even as I suspect, a technical feature, of the product. It is not for me to prescribe how that confidence may be shown - 'The pan with the red spot' – is an obvious reference but there are a host of other means by which the 'red spot' could have been promotionally referenced and by which its trade mark credentials or intent could have been reinforced.

57. I have considered the totality of the evidence submitted and the legal submissions made and have concluded, like the hearing officer, that the plea of acquired distinctiveness fails to show that a significant proportion of relevant consumers, not just associate the sign with the applicant, but regard it as a trade mark guaranteeing the origin of the goods.

Conclusion

58. The application is hereby refused under Section 3(1)(b) and for all the goods specified.

Dated this 23rd day of November 2020

Edward Smith

For the registrar
The Comptroller General