

O-071-14

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2624704  
BY AHMET EROL  
TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 25:



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**Background**

1. On 15 June 2012, Mr Ahmet Erol ('the applicant') applied to register the trade mark shown above for the following goods.

Class 25: Clothing, footwear, headgear.

2. On 28 June 2012, the Intellectual Property Office ('IPO') issued an examination report in response to the application. In the report, an objection was raised under section 3(1)(b) of the Trade Marks Act 1994 ('the Act') on the basis that the mark (in the examiner's words) *"consists (essentially) of an image of a T-shirt decorated with the picture of a heart and a pair of lips with the letter and word 'I London', meaning 'I Love London', being a sign which would not be seen as a trade mark as it is devoid of any distinctive character because it would be seen as a representation of the goods namely a T-shirt, rather than as an indication of trade origin. Therefore the mark does not have the capacity to identify the goods of one particular trader"*.

3. The examiner raised a further objection under section 3(1)(b) of the Act relating to the wording and devices contained on the T-shirt as the mark consists essentially of the words 'I' and 'London' with a heart device being *"a sign which is devoid of any distinctive character. London is a well known city for tourism and therefore when the mark is applied to the goods claimed it would fail to indicate brand or source trade origin, but rather would send out a purely promotional statement that could apply to any undertaking"*. In line with routine IPO procedure in respect of 'Right Start' applications, a period of 14 days was allowed for the applicant to respond.

4. On 5 July 2012, Mr Erol filed the Form TM3S in order to pay the second part of the 'Right Start' application fee. However, the form did not contain any information relating to the section 3(1)(b) objection, and so under cover of the official letter dated 9 July 2012, the examiner allowed two further months for submissions to be made addressing the

outstanding objection. No submissions were made in writing to the office, but on 6 August 2012 Mr Erol requested that an *ex parte* hearing be arranged to discuss the section 3(1)(b) objection.

5. A hearing took place at the Newport Office on 29 January 2013 where Mr Erol attended in person along with a colleague who provided translation services when needed. Mr Erol confirmed that he manufactures clothing, operates a wholesale business, and has a retail shop selling his goods in Camden Town, London. He has been trading since 1998 and he holds a Design registration for this mark. The mark was first used in 2007, and Mr Erol provided a sealed and dated envelope to confirm the date of first use. He explained that he has been using this mark as a brand and, because unauthorised copying by third parties is affecting his business, he sought to protect it via trade mark registration.

6. Witness Statements and supporting Exhibits were presented and considered at the hearing but, in my view, were not able to demonstrate that the mark has acquired distinctiveness through the use made of it. The resulting hearing report issued on 26 February 2013 confirmed that the section 3(1)(b) objection had been maintained, with two months allowed for further submissions.

7. Mr Erol replied on 5 April 2013, stating that he had found examples of the design and name 'Love Lips' (the title he uses for the particular design/sign which is the subject of this trade mark application) being copied by others without permission, and repeating his wish to have the design protected via trade mark registration. Mr Erol also asked for information on how to register his swing tags or neck ties to avoid someone else copying the design.

8. My official reply of 8 May 2013 confirmed that use of a mark on a neck tag and/or a swing tag could well constitute use as a trade mark use, but also emphasised that no use of this mark on a neck label or swing tag had been filed for consideration. I confirmed that nothing in the evidence filed to date was able to demonstrate use of the sign as a trade mark, and that the 'love lips' design was not capable of indicating trade origin. I concluded by stating that, in the absence of any further relevant material to persuade me otherwise, the application would be refused. A final period of one month was allowed for the filing of material showing use of the sign as a trade mark.

9. No further materials were received showing the sign in use as an indicator of trade origin, and so on 2 July 2013 a formal notice of refusal was issued. On 9 July 2013, Mr Erol asked for further information regarding the next stage of the appeal process and formally filed form TM5 on 16 July 2013 requesting a statement of reasons for the Registrar's decision

10. I am now asked under section 76 of the Trade Marks Act 1994, and rule 69 of the Trade Marks Rules 2008, to state in writing the grounds of my decision and the materials used in arriving at it.

**The *prima facie* case for registration under section 3(1)(b) of the Act**

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

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

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

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

13. The general interest to be taken into account in each case must reflect different considerations according to the ground for refusal in question. In relation to section 3(1)(b) (and the equivalent provision referred to above) the Court has held that "...*the public interest... is, manifestly, indissociable from the essential function of a trade mark*", *SAT.1 SatellitenFernsehen GmbH v OHIM*, C-329/02P. The essential function thus referred to is that of guaranteeing the identity of the origin of the goods or services offered under the mark to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin (see paragraph 23 of the above-mentioned judgement). Marks which are devoid of distinctive character are incapable of fulfilling that essential function. Section 3(1)(c) on the other hand pursues an aim which reflects the public interest in ensuring that descriptive signs or indications may be freely used by all (*Wm Wrigley Jr v OHIM*, 'Doublemint', C-191/0P, paragraph 31).

14. Section 3(1)(b) must include within its scope those marks which, whilst not designating a characteristic of the relevant goods and services (i.e. not being necessarily descriptive), will nonetheless fail to serve the essential function of a trade mark in that they will be incapable of designating origin. In terms of assessing distinctiveness under section 3(1)(b), the CJEU provided guidance in *Koninklijke KPN Nederland NV v Benelux-Merkenbureau (Postkantoor)* C-363/99 where, at paragraph 34, it stated:

*"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 55/01 Linde and Others [2003] ECR I- 3161, paragraph 41, and C-104/01 Libertel [2003] ECR I-3793, paragraphs 46 and 75)."*

14. This establishes the principle that the question of a mark being devoid of any distinctive character is answered by reference firstly, to the goods and services applied for, and secondly, to the perception of the average consumer for those goods or services. The goods and services to which the objection applies are:

Class 25: Clothing, footwear, headgear.

15. In relation to identifying the relevant consumer, it is reasonable to assume that the goods and services claimed in this application can be described as being directed towards a non-specialist general public who would demonstrate an average level of attention when

considering their purchase. One must also be aware that the test is one of immediacy or first impression, as confirmed by the European Court of First Instance (now the General Court) which, in its decision on *Sykes Enterprises v OHIM, T-130/01 (Real People Real Solutions)*, stated the following:

*"...a sign which fulfils functions other than that of a trade mark is only distinctive for the purposes of Article 7(1)(b) of Regulation No 40/94 if it may be perceived immediately as an indication of the commercial origin of the goods or services in question, so as to enable the relevant public to distinguish, without any possibility of confusion, the goods or services of the owner of the mark from those of a different commercial origin."*

16. When assessing a mark's distinctiveness, it is necessary to consider the perception of that mark by the average consumer - who I have identified at paragraph 15 above as being the public at large. The mark consists essentially of the upper-case letter 'I' presented in a standard typeface; a stylised representation of a heart; the word 'London' presented in a stylised italic typeface; a stylised representation of a kiss; and a non-distinctive 'splatter' device. All of these elements are displayed on a 2 dimensional representation of the front of a conventional white T-shirt. I have considered the meaning and significance of each of these individual elements which combine to form the sign, and believe that the aforementioned public-at-large would understand them to mean the following:

- The letter 'I' is understood to refer to oneself, and expresses a personal view.
- The 'stylised heart' shape is a logograph commonly used in both product marketing and general language as an alternative means of expressing the sentiment 'love'. To my knowledge, the red heart symbol was first used in connection with the promotion of tourism in New York, and the use of a heart symbol in place of the word 'love' has since become commonly used to promote a variety of geographical locations. Examples of such use are presented at Annex A.
- London is a large geographical location and is the capital city of the United Kingdom. It has a population greater than 8 million people, and is a popular tourist attraction with more than 3.4 million overseas tourists reported as visiting London in the first quarter of 2013.
- The image of 'red coloured lips' is a pictorial representation of the imprint left by a kiss and, as such, is taken to denote affection or love.
- The 'splatter device' appearing in the mark is likely to be perceived as nothing more than a background design which adds no distinctive character to the mark as a whole.

17. The average consumer has been exposed to use of the heart device as a substitute for the word 'love' since at least 1977 when it was first used in relation to the promotion of New York City<sup>1</sup>. Its use to promote other geographical places is now common place, and it is fair to

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<sup>1</sup> Designed by Milton Glaser as part of a advertising campaign see:  
[http://en.wikipedia.org/wiki/I\\_Love\\_New\\_York](http://en.wikipedia.org/wiki/I_Love_New_York)

assume that the public would immediately perceive a combination of the letter 'I', the 'heart device', and the word 'London', as meaning 'I love London'. I acknowledge that the figurative elements (i.e. the 'heart shape' and the 'lips') are not faithful or realistic pictorial representations of a heart and a kiss. However, I still take the view that both of these images would be understood by the average consumer as being an indication of love or affection. The individual elements (the words, the font and the stylised images) combine together to build an artistically pleasing presentation that conveys the meaning 'I love London'. It is unlikely that the average consumer would apportion any trade mark significance to the presentation or message conveyed by this mark. It would ultimately be seen as origin neutral.

18. Applying the CJEU's guidance in case law mentioned above, and having factored in my own findings, I have concluded that the mark applied for will not be identified as a trade mark without first educating the public that it functions as such. I therefore conclude that the mark applied for is devoid of any distinctive character and is thus excluded from *prima facie* acceptance under section 3(1)(b) of the Act.

### **The evidence of use**

19. Following the *ex parte* hearing held on 29 January 2013, Mr Erol provided evidence in support of a claim to acquired distinctiveness. This came in the form of a Witness Statement dated 4 February 2013, and accompanying exhibits. It was provided by Mr Erol, in his capacity as director of the company Nasline UK Ltd, being the UK importer, distributor and retailer of the goods. The Witness Statement provided details of turnover over a 5 year period from the date of first use in 2007 to the date of filing in 2012, amounting to a value of £4.2 million. A breakdown of figures detailing sales of 'I kiss London' T-shirts/sweatshirts amount to £25,000 over the same period. The evidence contained no materials showing the mark being advertised in a conventional fashion, and Mr Erol has also confirmed that this is the case. Rather than promote his sign via advertising, Mr Erol confirmed that promotion is instead via sales visits to retail customers and potential customers. This means that, apart from those retailers visited by Mr Erol, public exposure to the sign is strictly limited to potential customers' visits to the shops in which Mr Erol's products are sold.

20. A photograph showing the mark on a T-shirt as displayed inside Mr Erol's shop in Camden Town was submitted in order to demonstrate how the goods are sold. In this photograph, the T-shirt bearing this mark is offered for sale on the central rack of a three-tier floor-to-ceiling clothes rack. The display consists of a range of 13 different decorated styles of T-shirts, with the sign in question being displayed on the front of a T-shirt in the centre row alongside three other different styles. Other T-shirts are decorated with images depicting stylised forms of the Union Jack and prominent London landmarks such as the Tower Bridge and Big Ben at Westminster. The mark is only shown in relation to T-shirts and is not shown being used in relation to any of the other goods listed in, or covered by, the specification filed.

21. In addition to the photograph, a total of 60 invoices covering a 5 year period have been supplied showing sales of goods to trade customers in London, Watford, Birmingham, Southampton, Cambridge, Watford, Liverpool and Edinburgh. The invoices do not specifically refer to the mark claimed but refer to 'casual wear' which could include sales of the T-shirts.

22. There are also 10 Witness Statements provided by trade customers of Mr Erol. The statements are very similar in content and each declarant confirms that they recognise the mark as being one supplied by Mr Erol. They also confirm that they have been approached by other third-party souvenir suppliers and have refused to stock their goods on account of the quality and performance of Mr Erol's products.

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

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

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

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

*- A trade mark acquires distinctive character following the use which has been made of it where the mark has come to identify the product in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product from goods of other undertakings;*

*- In determining whether a trade mark has acquired distinctive character following the use which has been made of it, the competent authority must make an overall assessment of the evidence that the mark has come to identify the product concerned as originating from a particular undertaking and thus to distinguish that product from goods of other undertakings;*

*- If the competent authority finds that a significant proportion of the relevant class of persons identify goods as originating from a particular undertaking because of the trade mark, it must hold the requirement for registering the mark to be satisfied;*

*- Where the competent authority has particular difficulty in assessing the distinctive character of the mark in respect of which registration is applied for, Community law does not preclude it from having recourse, under the conditions laid down by its national law, to an opinion poll as guidance for its judgment.”*

25. I am also mindful of the CJEU decision in *Bovemj Verzekeringen NV v Benelux Merkenbureau (Europolis)*, C-108/05 where it was held that a trade mark may be registered on the basis of acquired distinctiveness “...only if it is proven that the trade mark has acquired distinctive character through use throughout the territory of a member state”.

26. The mark is one with low distinctive character as it consists of a message that is commonly used in the souvenir market. The intended customers are most likely to be those visiting London (or any of the other locations where the products are sold) seeking to purchase a souvenir as a token of their experience (London being such a tourist destination where a large number of souvenir products are widely available. This mark is most obviously aimed at the tourist market where the average consumer is likely to be knowledgeable and circumspect but also unlikely to spend a great deal of time or attention on selecting the goods at issue here. For it to be seen as a badge of trade origin, the consumer would need to be educated that the mark is there to serve such a purpose. Such recognition can be achieved through *inter alia* advertising and point of sale material which inform the consumer of the mark's intended purpose.

27. In this case, the mark has not been promoted to the general public or to the relevant tourist market through conventional advertising channels. Instead, exposure to the relevant consumer is effectively limited to in-store customer encounters with the product. And even though we know from the aforementioned witness statements that some retailers have will offer the goods for sale to the general public, there is no indication that any of the retailers promote the sign as a *trade mark* at the point of sale. In the absence of any proof showing such use, there is little to suggest that the sign has acquired any distinctiveness as an indicator of trade origin. The proven fact that the sign (in the form of a printed T-shirt) is available from a number of unrelated stores in the London area is not sufficient. In making these comments, I bear in mind Morrith LJ's observation in *Bach and Bach Flower Remedies Trade Mark* [2000] RPC 513 at paragraph 49, where it was stated that:

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

28. The invoices supplied by Mr Erol attest to sales in both the London area and in a limited number of other locations, although it is the case that sales *outside* of London are a small proportion of the total number. Such levels of exposure are not considered sufficient to demonstrate that the mark has been used throughout the whole of the relevant territory.

29. The sign has also been described as the 'I Kiss London' design by the applicant, and there is nothing in the evidence which suggests that it has been promoted as a trade mark, for example, by displaying it in more conventional fashion on the neck or swing tags of clothing items. T-shirts are often decorated with imagery that has a purely decorative function - particularly where the goods are aimed at the souvenir market. The type of message conveyed by this sign can be found in almost any souvenir outlet in almost any popular tourist destination, and nothing has been provided to show why - in this case - the sign would be perceived any differently.

30. The phrase 'I heart London' is one that others may wish to use to promote their goods and, although this particular mark contains additional matter beyond the mere phrase, the overall message remains a promotional one.

31. In my view, this mark will not be seen as an indication of trade origin without first



educating the consumer that it performs such a function. Furthermore, I do not consider that the applicant has succeeded in demonstrating that such consumer education has taken place.

**Conclusion**

32. Taking into account the guidance set out in relevant case law and the documents and exhibits filed, I consider the evidence has failed to show that, at the date of application, the average consumer had been educated into seeing the sign as indicating the trade origin of the good and services. The mark is therefore excluded from acceptance because it fails to qualify under section 3(1)(b) of the Act.

Dated this 11th day of February 2014

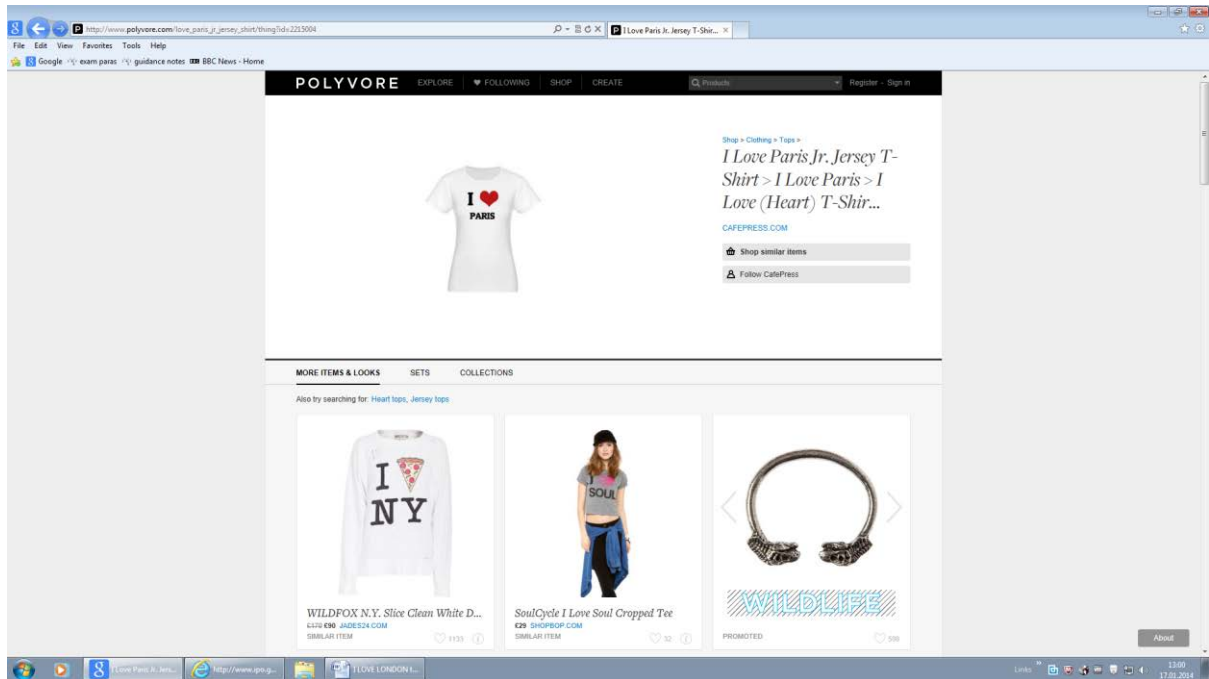
**Carol Bennett**

Acting for the Registrar  
The Comptroller General

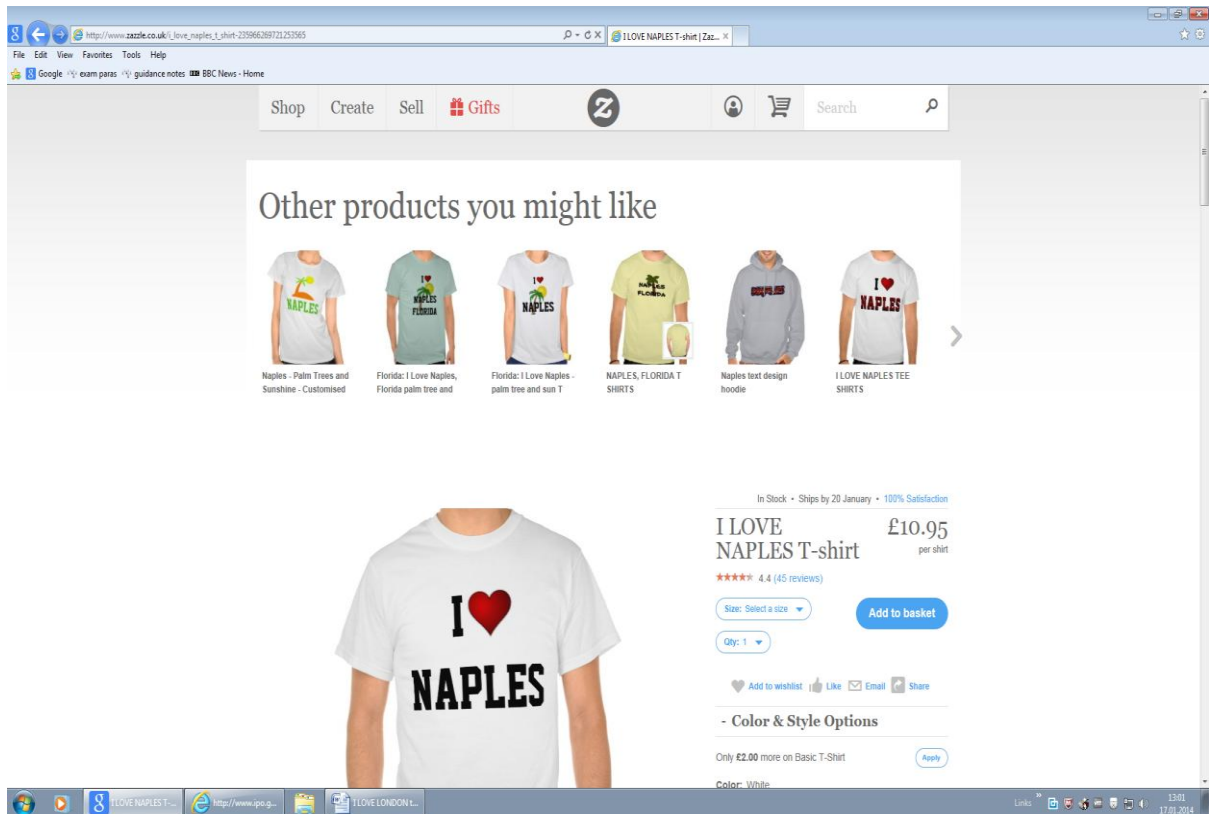


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Taken from: [http://www.polyvore.com/love\\_paris\\_jr\\_jersey\\_shirt/thing?id=2215004](http://www.polyvore.com/love_paris_jr_jersey_shirt/thing?id=2215004)



Taken from: [http://www.zazzle.co.uk/i\\_love\\_naples\\_t\\_shirt-235966269721253565](http://www.zazzle.co.uk/i_love_naples_t_shirt-235966269721253565)



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Taken from: [http://www.zazzle.co.uk/i\\_love\\_london\\_t\\_shirt-235098609216870677](http://www.zazzle.co.uk/i_love_london_t_shirt-235098609216870677)

The screenshot shows a Zazzle product page for an 'I Love London T-shirt'. The page features a navigation bar with 'Shop', 'Create', 'Sell', and 'Gifts' options. Below the navigation, there's a section titled 'Other products you might like' displaying six different t-shirt designs. The main product is a white t-shirt with the text 'I Love London' and a red heart. The price is listed as £14.95 per shirt. The page includes a 'Size' dropdown menu, a quantity selector set to 1, and an 'Add to basket' button. There are also social media sharing options and a 'Color & Style Options' section. The browser's address bar shows the URL: [http://www.zazzle.co.uk/i\\_love\\_london\\_t\\_shirt-235098609216870677](http://www.zazzle.co.uk/i_love_london_t_shirt-235098609216870677).

Taken from: <http://www.shirtcity.co.uk/i-love-london-t-shirt-895?gclid=C1q6yvSiHbwCFSEHwwoddVUA1w>

The screenshot shows a ShirtCity product page for an 'I Love London T-Shirt'. The page features a navigation bar with 'T-Shirt Shop', 'Product range', 'Create your own', and 'Sell' options. Below the navigation, there's a search bar and a 'Shopping cart' link. The main product is a white t-shirt with the text 'I Love London' and a red heart. The page includes a 'Design size' dropdown menu set to 5, a 'Remove design' button, and a 'Position in print area' section. There are also social media sharing options and an 'Add to shopping cart' button. The price is listed as £18.90. The browser's address bar shows the URL: <http://www.shirtcity.co.uk/i-love-london-t-shirt-895?gclid=C1q6yvSiHbwCFSEHwwoddVUA1w>.