

O-082-15

TRADE MARKS ACT 1994

TRADE MARK REGISTRATION No. 2611720

CONSISTING OF THE WORD 'SOLAFIELDS'

IN THE NAME OF GB RENEWABLES INVESTMENTS LTD

AND

APPLICATION No. 500386

BY ANDREW FREETH

FOR A DECLARATION THAT THE TRADE MARK IS INVALID

Background and pleadings

1. This is an application by Mr Andrew Freeth (“the applicant”) to have trade mark registration No. 2611720 – the word mark **SOLAFIELDS** - declared invalid and cancelled.

2. The application to register the trade mark was filed on 24 February 2012 and the mark was registered on 1 June 2012. The mark is registered in the name of GB Renewables Investments Ltd (“the proprietor”).

3. The mark is registered in class 40 for:

Production of electricity from solar photovoltaic farms.

4. The application to invalidate the trade mark registration was filed on 6 May 2014. The grounds for invalidation are that:

- SOLAR FIELDS describes solar photovoltaic installations located in fields.
- Numerous traders use these words to describe installations of this kind.
- The mark SOLAFIELDS is phonetically identical to the description ‘solar fields’.
- The omission of the letter ‘R’ from the word ‘solar’ in the trade mark is likely to go unnoticed by, or to make only a minor visual impact on, the relevant average consumer.
- The trade mark is therefore incapable of distinguishing the proprietor’s services from those of other undertakings, is devoid of any distinctive character for the services at issue, designates a characteristic of the registered services, and has become customary in the current language or in the bona fide and established practices of the trade.
- Registration of the trade mark was therefore contrary to sections 3(1)(a),(b),(c) and/or (d) of the Act.

5. In support of these grounds the applicant filed numerous pages taken from the internet. These indicate, inter alia, that:

- Solar photovoltaic farms may be located in fields in agricultural areas.
- They are usually called solar farms or solar parks.

- Someone in the USA called 'Stephanie' posted an article on a website called Peachygreen.com in 2009 in which she called solar farms 'solar fields'.
- Sami Grover wrote articles that appeared on the website treehugger.com in 2011 which described Britain's biggest 'solar field' as having been built in 6 weeks and Israel's first 'solar field' as having just been built.

6. The proprietor filed a counterstatement denying the applicant's claims and asserting that SOLAFIELDS was a coined term and inherently distinctive.

7. Both sides seek an award of costs.

Representation

8. The applicant is represented by Walker Morris LLP, Solicitors. The proprietor is represented by Saunders and Dolleymore LLP, Trade Mark Attorneys. Neither side asked to be heard. I have, however, received comprehensive written submissions from both sides.

The evidence

9. The applicant's evidence takes the form of a witness statement by Christopher Hoole, who is a solicitor with Walker Morris. Mr Hoole's evidence is that the applicant's company – Renewable Energy Projects Limited - trades as SolarFieldsUK via a website which includes that name. In January 2014, the applicant received a letter from Saunders and Dolleymore on behalf of the proprietor claiming that it was infringing the registered mark SOLAFIELDS and also passing itself off as the proprietor. This was followed by draft particulars of the claims. The applicant responded with this application to invalidate the trade mark registration. So far as I am aware, there are no related proceedings before the courts (yet).

10. In August 2014, Mr Hoole conducted various internet searches against the term SOLAR FIELD. He exhibits the search results. I have reviewed them all. Some are irrelevant because they do not show what Mr Hoole says they do. For example, he provides evidence¹ that searching on 'Solar field' results in sponsored advertisements on Google for solar panels and solar farms, and he suggests that this shows that other traders have bought the term 'solar field' as a keyword. In fact this could equally mean that other traders have bought 'solar' alone as a keyword. None of the advertisements in question use the words SOLAR FIELD. Other search results are of some, but not the highest, degree of relevance. This is because although they are accessible from the UK (and are in English) they relate to

¹ At page 27 of exhibit CJH4

developments elsewhere in the world. Whilst keeping this evidence in mind, I will focus mainly on the evidence directed at the position in the UK.

11. Mr Hoole exhibits 28 hits obtained from UK sites². The following are the most relevant of these hits. A page from the Daily Mail website dated November 2010 is headed *“The solar panel gold rush that threatens to ruin our countryside...and make millions for the Germans and Chinese”*. The article starts *“Farmers are being offered up to £50k per year to fill fields with solar panels”*. Another is from the UK website of a firm called Solar Securities, which describes itself like this: *“Solar Securities is a developer of solar fields...”*. Another page, this time from the website ‘betterthanfreesolar.co.uk’, says that the company provides businesses with SolarWorld products *“From 4kW on an office or shop to a utility scale solar-field.”* An article on the webpage of the Lincolnshire Echo describes how Lincolnshire Fire and Rescue intended to submit a planning application for ‘solar field’ on a 750sqm site adjacent to Bardney fire station.

12. A page from a website called ‘renewableenergyhub.co.uk’ describes the planning issues surrounding the installation of *“solar fields”* and notes that they sometimes provoke strong opposition in the same way as wind turbines. The article also notes that *“solar PV technology is increasingly becoming profitable for larger pieces of land”*. Apart from the article on the Daily Mail website referred to at paragraph 11 above, all of these articles appear to post date the proprietor’s application to register SOLAFIELDS as a trade mark.

13. In August 2014, Mr Hoole also searched the Twitter website and found various references to solar energy and solar fields³. A post by a land owner on the website farmingforum.co.uk under the heading ‘solar fields’ recorded that he had been offered £900 per acre by a company offering to install solar technology⁴.

14. Mr Hoole also provides evidence produced by a search conducted by a colleague of his on Nexis News, which offers current and historical business news. The search was directed at articles published during the two year period leading up to the proprietor’s application to register the trade mark SOLAFIELDS on 24 February 2012. The search yielded 68 results, of which Mr Hoole says that 60 refer to the use of ‘solar field’ in the context of solar panels. I find that less than half of those relate to relevant solar developments in the UK, and many of the ones that do refer to the same 3 or 4 developments.

15. Mr Hoole refers to 12 internet hits and 2 articles from printed publications as showing that people use ‘solar farm’ and ‘solar field’ interchangeably. Of the internet hits, the strongest cases are, in my view, entries from the websites

² As exhibit CJH5

³ See exhibit CJH8

⁴ See exhibit CJH9, page 186

'renewableenergyworld.com', 'betterthanfreesolar.co.uk' and 'hinckleytimes.net'. The first mentioned website records a spokesperson for the UK Solar Energy Association saying that the government's plans for solar energy include one third from rooftop solar, one third from industrial and commercial roofs, and one third from "solar fields". Those words are used to mean solar farms in that example, and in the other two examples cited above.

16. Extracts from entries during 2011 in the Scunthorpe Telegraph and the Mail of Sunday⁵ also appear to show solar field being used to mean solar farm.

17. Most of the references described above are to solar panels being located literally in fields. However, there are few other references where 'field' appears to be used figuratively to mean 'a very large area'. For example, an article on the BBC News webpage of 16 June 2008 showed a picture of a development on open land in Israel featuring a 60m tower covered in solar panels with 1641 associated mirrors, which it describes as a 'solar field' and as a 'solar plant'.

18. Mr Hoole provides evidence⁶ that entering the term SOLA into search engines produces hits for words beginning 'solar', and that searching on 'sola field' produces the query "Did you mean Solar field?" He therefore submits that 'sola' is an obvious misspelling of 'solar'. However, search engines are designed to predict (i.e. guess) the term the user intends to search so as to save the user time. The fact that entering SOLA as a search term in Google provokes the suggestion 'SOLAR(x)' does not therefore necessarily mean that SOLA is a common misspelling of SOLAR. Similarly, search engines are designed to make sense of the search terms entered by users. If the software does not recognise a word or words, it will suggest as an alternative the most similar word(s) that it does recognise based in part on the history of past usage by other users. Consequently, the fact that search engines suggest SOLAR FIELD as an alternative to SOLA FIELD only means that the software recognises that SOLA FIELD is not a known term and that the nearest matching words are SOLAR FIELD. I do not therefore accept that this evidence proves that human beings regard 'sola' as an obvious misspelling of 'solar'.

19. More relevantly, Mr Hoole draws attention to an article in the Hampshire Chronicle in October 2013 in which a journalist refers to the proprietor as 'Solar Fields' instead of Solafields⁷.

20. Mr Hoole also provides some evidence about the use of SOLA in trade names, and about the content of the proprietor's website, but I find this to be of no assistance. This is because (a) the inclusion of an allegedly descriptive/non-distinctive word in trade names has no bearing on whether the word is registrable as

⁵ Pages 200 and 211 of exhibit CJH10

⁶ In exhibit CJH12

⁷ See pages 249-250 of exhibit CJH13

a trade mark, and (b) the proprietor does not use the term SOLAR FIELD(S) on its website.

21. The registered proprietor's evidence consists of a witness statement by Mark Candlish, who is a Director of the company. Mr Candlish provides copies of two documents issued by the Department of Energy & Climate Change in 2013 and 2014⁸. These are quite long documents, around 100 pages in total. They are intended to show that the Government did not, at least in these documents, refer to solar farms as solar fields. I have not been through every line of these documents, but the applicant has not drawn my attention to anything which contradicts the registered proprietor's statement, so I accept it. I note that the foreword of the second document entitled 'UK Solar PV Strategy Part 2', states that the UK solar sector increased from almost nothing in 2010 to 4 GWp in 2014.

22. Mr Candlish also provides pages from the websites of two trade associations called The Renewable Energy Association and Solar Trade Association⁹. These are much shorter documents and mainly describe these associations. However, there are two pages from each association about solar energy production and neither of these uses the term 'solar field(s)'.

23. Mr Candlish conducted searches of the websites of trade associations, Government departments, leading industry players and other organisations involved in the UK "*solar power station sector*". His searches were intended to identify uses of solar farm and/or solar field so as to establish the extent to which these terms were used interchangeably. Mr Candlish looked at 39 websites in total. Every website revealed at least one use of the term 'solar farm'. Some had multiple uses of that term. None of the websites of the three trade associations searched revealed any use of the term 'solar field'. Of the various Government websites reviewed, one revealed use of that term. This was a webpage from the site of the Department for Environment, Food & Rural Affairs, which recorded that in a speech given on 19 October 2014 the Environment Secretary, Elizabeth Truss MP, announced that she was scrapping farm subsidies for 'solar fields'. The same press release used the term 'solar farm' eight times.

24. Only one of the websites of the 21 providers of solar energy that Mr Candlish searched revealed use of 'solar field'. This was the website of Anesco, which describes itself as "*The UK's leading energy efficiency solutions provider*". A page from its website dated 17 May 2012 records that the company was working on a ground mounted solar project on farmland on the Cadland Estate in the New Forest. A spokesperson for a partner organisation called SSE (which describes itself as "*the UK's largest generator of renewal energy*") said that "*We are delighted to be working*

⁸ See exhibit MC1

⁹ See exhibits MC2 and MC3

with Anesco to develop one of the largest solar fields in this country.” The Anesco website also included 13 uses of the term ‘solar farm’.

25. The websites of the trade journals Renewable Energy Focus and Solar Power Portal revealed more mixed usage of the terms. The former website included 33 uses of ‘solar field’ against 97 uses of ‘solar farm’, whilst the website of the latter revealed 13 uses of ‘solar field’ against 100 uses of ‘solar farm’.

Findings of fact

26. I find that ‘solar field’ is a term used to describe a field on which solar panels are installed for energy production. I accept that the extent of such usage is limited and much less than the use of ‘solar farm’. I also accept that the terms are not frequently used interchangeably. ‘Solar field’ usually has the meaning described above, whereas ‘solar farm’ has a broader meaning designating any wide expanse of solar panels. However, there are a few examples in evidence of ‘solar field’ being used to mean the same thing as ‘solar farm’.

27. Most of the uses of ‘solar field’ identified in the evidence post date the application to register the trade mark SOLAFIELDS. However, some pre-date the application¹⁰.

28. Most of the use of ‘solar field’ shown is use by journalists or trade journalists. However, there is some evidence of the term being used descriptively by those providing solar energy solutions and by a landowner.¹¹

Evidence of acquired distinctiveness

29. Although the registered proprietor has not pleaded a case of acquired distinctiveness, Mr Candlish provides evidence of use of the mark SOLAFIELDS prior to the date of the application for invalidation. According to Mr Candlish, Solafields Ltd started to use of the mark in January 2012. He says that Solafields Ltd uses the mark with the consent of the registered proprietor.

30. It appears that the SOLAFIELDS website was established in April 2012. It received 23 hits that month. The number of hits rose to over 1000 (in total) by March 2014. A 0800 number appears to have been established for telephone enquiries by February 2012. Four enquiries were received in that month. By March 2014, over 500 enquiries had been received in total and 157 qualifying sites for solar panels identified. The first ‘Heads of Terms’ agreement with a landowner was signed in May 2012. By March 2014, 34 such ‘Heads of Terms’ agreements had been signed¹². By

¹⁰ See paragraphs 14, 16 and 17 above.

¹¹ See paragraphs 11, 13, 15 and 24 above.

¹² See exhibit MC4.

November 2014, planning permission had been granted for 8 sites and two projects had been completed.

31. Examples of Solafields Ltd's advertising material are in evidence¹³. They show the name used in advertisements and on the company's website. One has the headline "*Solar rent for low grade land*". It is not clear where the advertisements were placed.

32. Mr Candlish also provides figures for turnover and marketing spend for 2012 – 2014. These show that the company spent £5k on marketing in 2012, £22k on marketing in 2013 and £34k in 2014 (up to November 2014). There is no recorded turnover for 2012. Turnover for 2013 was £934k. Turnover in 2014 (up to November) was £3.6m. However, only use of the mark prior to the date of the application for invalidation on 6 May 2014 is potentially relevant for current purposes.

The law

33. Section 47(1) of the Act is as follows:

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

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

Section 3(1) of the Act is as follows:

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

- (a) signs which do not satisfy the requirements of section 1(1),
- (b) trade marks which are devoid of any distinctive character,
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for

¹³ See exhibit MC7

registration, it has in fact acquired a distinctive character as a result of the use made of it.”

Section 1(1) is as follows:

“1(1) In this Act a “trade mark” means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.”

34. The first matter to be decided is whether any of the exclusions set out in s.3(1) of the Act applied at the date of the application to register SOLAFIELDS as a trade mark on 24 February 2012 (“the relevant date”).

35. As the registered proprietor’s representatives point out, s.72 of the Act states that registration is *prima facie* evidence of validity. Consequently, the burden of showing that the mark was registered contrary to s.3(1) of the Act falls on the applicant. However, the courts have been keen to stress that a decision maker should not resort to the burden of proof except where, despite having striven to make a decision on the weight of the evidence, he or she finds it impossible to do so¹⁴.

35. There is no need to say very much about the s.3(1)(a) ground. As Mr Geoffrey Hobbs Q.C., as The Appointed Person pointed out in *AD2000 Trade Mark*¹⁵, s.3(1)(a) permits registration provided that the mark is ‘capable’ to the limited extent of “*not being incapable*” of distinguishing. Consequently, if I am satisfied that the mark complies with s.3(1)(b), (c) and (d) of the Act, the ‘incapable of distinguishing’ objection under section 3(1)(a) is bound to fail. Alternatively, if any of the grounds under section 3(1)(b),(c) or (d) succeed the outcome under section 3(1)(a) becomes moot. Either way, there will be no need for me to address the s.3(1)(a) ground separately to the other grounds.

36. Turning next to the ground under s.3(1)(d) of the Act, I note that the General Court summarised the case law of the Court of Justice under the equivalent of s.3(1)(d) of the Act in *Telefon & Buch Verlagsgesellschaft mbH v OHIM*¹⁶ as follows:

“49. Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959,

¹⁴ See, for example, *Verlander v Devon Waste Management Ltd* [2007] EWCA Civ 825

¹⁵ [1997] RPC 168

¹⁶ Case T-322/03

paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma* (BSS) [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public's perception of the mark (BSS, paragraph 37).

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

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

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

37. This requires me to determine who is the average consumer of the services at issue? It is submitted on behalf of the registered proprietor that the average consumer is composed of buyers of the electricity produced by solar photovoltaic farms, and those landowners who would permit their land to be used to accommodate such installations. The applicant submits that the relevant consumer is composed of "specialists" and owners of fields looking to utilise their land to produce solar energy. The parties therefore appear to agree that landowners are average consumers. I am not sure what the applicant means by "specialists", but I accept the registered proprietor's submission that energy companies that buy solar energy are also average consumers of the registered services.

38. Although there is some evidence of the term 'solar fields' being used in relation to 'production of electricity from solar photovoltaic farms' prior to the relevant date, there is insufficient evidence, in my judgment, to establish that the term was "*customary in the current language or in the bona fide and established practices of the trade*" from the viewpoint of relevant average consumers. Consequently, I reject the ground for invalidation based on s.3(1)(d).

39. I turn next to the ground based on s.3(1)(c) of the Act, which appears to me to be the most relevant ground in this case. The case law under s.3(1)(c) was summarised as follows by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch):

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

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).

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

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

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

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

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

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

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

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

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

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

40. I will start by considering whether the word(s) SOLAR FIELDS is caught by s.3(1)(c). If it is not, there can be no question that SOLAFIELD being caught by that provision. If SOLAR FIELDS is caught by s.3(1)(c), then I must decide if SOLAFIELDS is similarly caught.

41. There can be no question that SOLAR describes a characteristic of services for producing energy using solar technology. It is common for such energy to be produced from solar panels. The number of solar panels installed can be small, e.g. a few on the roof of a building, or it can be larger number installed over a larger area. A large number of solar panels arranged in a particular location is sometimes called a solar farm. The services at issue are those for producing electricity from such large installations. The evidence indicates that a combination of rising energy costs and the Government's commitment to producing energy from renewable sources have made it financially viable to utilise large areas of low grade land, including whole fields of low grade agricultural land, for solar energy production. In these circumstances, I find that relevant average consumers are likely to immediately recognise 'solar fields' as meaning electricity produced from solar installations located in fields.

42. It is submitted on behalf of the proprietor that when something is placed in a field the natural syntax of the language dictates that the word 'field' comes first, such as a 'field of cows'. Accordingly, the correct way of describing the production of electricity from installations of this kind would be 'fields of solar panels', not SOLAR FIELDS. I do not accept that there is anything syntactically unusual about placing a word before the word FIELD(S) in order to indicate the type of field(s), e.g. CORN FIELDS, POTATO FIELDS. I accept that the word 'panel' is strictly missing in the term SOLAR [PANEL] FIELDS, but I do not think that the presence of that word is

necessary in order for the words SOLAR FIELDS to convey the same descriptive message to relevant average consumers. In the same way that consumers (albeit different consumers) would have no difficulty in equating POTATO FIELDS with 'fields of potato plants', relevant average consumers of the services at issue would have no difficulty immediately understanding SOLAR FIELDS to mean 'fields of solar panels'.

43. I accept that the evidence shows only limited use of the words SOLAR FIELDS in the sense described above. However, the uses that are shown are consistent with the view that the public were expected to understand what SOLAR FIELDS meant in the context of large scale solar energy production. Further, the evidence indicates that the use of whole fields for solar energy production is a relatively new thing. It is therefore not surprising to find relatively limited use of the term to date. The case law indicates that it is sufficient that the words SOLAR FIELDS are capable of being used to describe a characteristic of the service in question. In my view, the evidence establishes that these words are capable of being so used, and have in fact been used to a certain extent to describe production of electricity from fields of solar panels.

44. There is also evidence of a limited number of uses of SOLAR FIELDS to mean any large expanse of solar panels, as in solar farm. It is sufficient for me to note from the *Wrigley* case that the fact that SOLAR FIELDS can be used to convey two slightly different descriptive meanings does not prevent s.3(1)(c) from applying.

42. Likewise, it is irrelevant that there are other more usual signs than the sign at issue which might also be used to designate a similar characteristic of the services, such as SOLAR FARM or SOLAR PARK.

43. I therefore turn to the second issue, which is whether SOLAFIELDS is excluded by s.3(1)(c) as I have found that SOLAR FIELDS would be. *In Koninklijke KPN Nederland NV v Benelux-Merkenbureau*¹⁷ the CJEU considered a question as to whether a new word made up of elements each of which is descriptive of a characteristic of the goods/services is to be regarded as distinctive or non-distinctive. The court's judgment stated that:

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

¹⁷ Case C-363/99

99. However, such a combination may not be descriptive within the meaning of Article 3(1)(c) of the Directive, provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements. In the case of a word mark, which is intended to be heard as much as to be read, that condition must be satisfied as regards both the aural and the visual impression produced by the mark". (emphasis added)

44. It is true that the requirement for word marks to be distinctive both to the eye and to the ear did not make it into the operative part of the court's judgment. Nevertheless, the guidance of the CJEU on this matter must plainly be given considerable weight. The General Court has followed that guidance on several occasions: see *ratiopharm GmbH v OHIM*¹⁸ (*BioGeneriX*) and *En Route International Ltd v OHIM*¹⁹ (*FRESHHH*).

45. This point is highly relevant in the current case because whatever arguments there might be as to how closely SOLAFIELDS resembles SOLARFIELDS to the eye, there is no doubt in my mind that SOLAFIELDS and SOLARFIELDS are aurally identical. Nevertheless, in order to decide whether this point is fatal to the proprietor's case I think it must still be necessary to consider the nature of the trade in question and the extent, if any, to which the services are marketed aurally and selected orally. If the answer to that is 'not at all' or 'hardly at all', then it must be relevant if, to the eye, the mark is sufficiently far removed from the sum of its descriptive elements.

46. I would expect the services at issue to be selected primarily through visual tools, such as printed matter and websites. However, I think it likely that oral means are also used. For example, with services aimed partly at landowners, it would be natural for word of mouth recommendation to play a part in the way that the services are selected. Further, I note that one of the registered proprietor's first steps in marketing its products was to establish a 0800 number for telephone enquiries. I therefore conclude that the trade mark SOLAFIELDS is likely to be used in the course of trade primarily through visual means, but that the mark will also be verbalised to a material extent.

47. Turning to the significance of the visual distinction between SOLAFIELDS and SOLARFIELDS/SOLAR FIELDS it is necessary to retain the viewpoint of relevant average consumers. It is pointed out on behalf of the proprietor that the services at issue are not purchased without a good deal of thought and the attention level of average consumers is therefore likely to be higher than average. This might mean that the difference between SOLAFIELDS the trade mark, and SOLARFIELDS or

¹⁸ Case T-47/07

¹⁹ Case T-147/06

SOLAR FIELDS the description, is more likely to be immediately apparent to such consumers when they see the mark.

48. I accept that the services at issue are likely to be selected with a good deal of care and that purchasers of solar energy are likely to be particularly attentive to their selection of service providers. I am less convinced that landowners considering renting their land for solar energy production are likely to pay quite the same high level of attention, although I accept that they will pay a reasonable level of attention to the signs and marks used by solar energy producers.

49. I find that both kinds of average consumer are likely to notice the difference between SOLAFIELDS and SOLAR FIELDS, but that the difference between SOLAFIELDS and SOLARFIELDS is liable to go unnoticed.

50. Further, even if the consumer notices the visual distinction between the mark and the correctly written description, he or she is liable to regard the mark as having the same descriptive meaning as the description itself. This is because the mark is obviously composed of two elements: SOLA and FIELDS. The words 'fields' is very well known and instantly recognisable in the mark. And in the context of solar energy production, the word SOLA is very likely to be taken as meaning SOLAR, despite the misspelling.

51. I therefore find that SOLAFIELDS is “*not sufficiently far removed*” in meaning or syntax (or sound) from the descriptive words 'solar' and 'fields' so as to avoid being excluded from registration by s.3(1)(c).

52. Given the potential for the registration of SOLAFIELDS to interfere with the free use by other traders of the descriptive term SOLARFIELDS/SOLAR FIELDS, this conclusion also appears to me to be consistent with the CJEU's guidance to interpret article 3(1)(c) of the Trade Mark Directive (section 3(1)(c) of the Act) in accordance with its purpose, which the court described as follows²⁰:

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

53. I therefore find that SOLAFIELDS was registered contrary to s.3(1)(c) of the Act.

²⁰ Paragraph 25 of the CJEU's judgment in *Windsurfing Chiemsee*, joined cases 108 and 109/97.

54. The principles to be applied under article 7(1)(b) of the CTM Regulation (which is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act) were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG*²¹ as follows:

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

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

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

55. A trade mark with a descriptive character for the services at issue is necessarily devoid of any distinctive character for the purposes of s.3(1)(b). Therefore subject to the point about whether SOLAFIELDS may have acquired a distinctive character through use prior to the date of the application for invalidation, the registration of the mark must be invalid on this ground too.

56. Further, if I am wrong to find that the mark was caught by s.3(1)(c), then in the alternative I would have found that it was *prima facie* unable to identify the services in respect of which the mark is registered as originating from a particular undertaking, and thus to distinguish those services from those of other undertakings. In this respect I note that in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc*²², Arnold J. held that a descriptive word with a minor figurative embellishment was, as a whole, devoid of any distinctive character. He found that:

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

²¹ C-265/09 P

²² [2013] F.S.R. 29

117. I would comment that it appears to me that PCCW only succeeded in obtaining registration of the CTM because it included figurative elements. Yet PCCW is seeking to enforce the CTM against signs which do not include the figurative elements or anything like them. That was an entirely foreseeable consequence of permitting registration of the CTM. Trade mark registries should be astute to this consequence of registering descriptive marks under the cover of a figurative figleaf of distinctiveness, and refuse registration of such marks in the first place.”

57. Although the difference between the mark and a description in this case is the absence of the letter ‘R’ from the end of the first element in the mark SOLAFIELDS, rather than the presence of a minor figurative element, I find that much the same reasoning applies. The missing letter is insufficient to distinguish SOLAFIELDS as a trade mark from SOLARFIELDS or SOLAR FIELDS as a description of a characteristic of the services, and therefore the mark is devoid of any distinctive character and caught by s.3(1)(b).

58. I note that as in the *Starbucks* case, the absence of a supposedly distinctive feature of the mark, in this case the misspelling of the words SOLAR FIELDS, does not appear to have prevented the proprietor of the trade mark from seeking to assert it against another party using ‘SolarFields’ with conventional spelling.

59. Having decided that the mark was registered despite *prima facie* failing to meet the requirements of s.3(1)(b) and (c), I must consider how to treat the proprietor’s evidence of acquired distinctiveness. As I have already noted, the proprietor has not pleaded a case of acquired distinctiveness under the proviso to s.47(1). However, in its written submissions it refers to the evidence of use filed as showing “*acquired enhanced distinctiveness*”.

60. It is clear from *Oberbank AG & Banco Santander SA and Another v Deutscher Sparkassen- und Giroverband eV*²³, that the burden of establishing acquired distinctiveness in these circumstances rests on the proprietor of the mark. The relevant part of the court’s judgment is as follows:

“68. In view of that objective and the structure and purpose of Article 3(3) of Directive 2008/95, the Court finds that, in the context of invalidity proceedings, the burden of proof concerning distinctive character acquired following the use which has been made of the mark at issue must be borne by the proprietor of that mark which invokes that distinctive character.

69. First, in the same way that distinctive character acquired following the use which is made of a mark is, in proceedings for registration, an exception to the grounds for refusal listed in Article 3(1)(b), (c) or (d) of Directive 2008/95 (see, to that effect, Case C-108/05 *Bovemij Verzekeringen* EU:C:2006:530,

²³ Joined cases C-217 and 218/13

paragraph 21), distinctive character acquired following the use which is made of a mark is, in the context of invalidity proceedings, an exception to the grounds for invalidity listed in Article 3(1)(b), (c) or (d). Since it is an exception, the onus is on the party seeking to rely on it to justify its application.

70. Second, the Court finds that it is the proprietor of the mark at issue which is best placed to adduce evidence in support of the assertion that its mark has acquired a distinctive character following the use which has been made of it. The same applies, in particular, to evidence capable of establishing such use, in respect of which the case-law cited in paragraphs 40 and 41 above contains a list of examples, such as evidence relating to how intensive, widespread and long-standing use of the mark has been and the amount invested in promoting it.

71. Consequently, where the proprietor of the mark at issue is requested by the competent authority to adduce proof of distinctive character acquired following the use which has been made of a mark which is intrinsically devoid of distinctive character but fails to do so, that mark must be declared invalid.”

Lloyd J. made a similar finding in *Dualit Ltd's Trade Mark*²⁴ in the context of UK based opposition proceedings. However, as noted above, the burden of proof should only become a material factor if I am unable to reach a decision on the weight of the evidence.

61. The CJEU provided guidance in *Windsurfing Chiemsee*²⁵ as to the correct approach with regard to the assessment of the acquisition of distinctive character through use. The guidance is 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 long-standing 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.

²⁴ [1999] RPC 890

²⁵ Joined cases C-108 & C-109/97

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 judgment (see, to that effect, Case C-210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 37).”

62. The proprietor appears to have used the mark SOLAFIELDS for around two years prior to the date of the application for invalidation (“the second relevant date”). The length of use is therefore quite short and the scale of use prior to the second relevant date also appears to be modest. The amount spent promoting the mark seems very modest. I have not been provided with information about the size of the relevant market, but even taking into account of the fact that it remains a somewhat niche market, I doubt that the proprietor has a substantial share of the UK market in solar energy production. My impression is that the proprietor’s business was just starting to take off at the second relevant date. I remind myself that I am not required to assess whether the proprietor had established a protectable goodwill under the mark for the purposes of passing off law. As Jacobs L.J. noted in *Phones 4U Ltd v Phone 4U.co.uk Internet Ltd*²⁶ the test under trade mark law is different. The judge described the difference like this.

“24 That brings me to the next point on passing off law. What counts as a “descriptive” name? One must be a little careful here. In the law of registered trade marks, stated broadly, marks may not be registered unless they are “distinctive”. Some marks are by their nature distinctive, the paradigm example being “Kodak”. No-one would naturally want to use that for films (or probably anything else). But other marks are not in that class — they are the sort of things that traders might well want to use. In those cases, before registration is granted, the law requires proof that the marks have become trade marks by use and recognition as trade marks by the public. That kind of mark is not confined to “descriptive” marks in the sense of words actually describing goods or services. It covers other things too. Thus laudatory epithets (“good”, “perfection”), deliberate misspellings of descriptive words (e.g. Kwik for “quick”), mere pictures of the thing to be sold, may all be regarded as unsuitable for registration as a monopoly without proof of actual distinctiveness.

25 The nature of the inquiry as to whether a mark is suitable for registration without proof of distinctiveness is different from that as to whether a plaintiff in a passing off action has established a goodwill in the name, badge or insignia relied upon. This is hardly surprising — for registration one must be reasonably sure that the mark has really become a trade mark to most relevant people — to grant a monopoly on a lesser test would be contrary to the policy behind the requirement of distinctiveness. So, for example, if it is necessary to prove distinctiveness, proof that a badge was well-known but

²⁶ [2007] RPC 5

only in a small area, would not be enough. Yet an action for passing off would lie in respect of the use of a deceptively similar badge in that small area.”

63. Applying the correct test for acquired distinctiveness under trade mark law, I find that the registered mark had not acquired a distinctive character prior to the second relevant date. The proprietor’s failure to formally plead the point is therefore of no consequence.

Conclusion

64. The trade mark is invalid and, subject to appeal, the registration will be cancelled.

Costs

65. The applicant has been successful and is entitled to a contribution towards its costs. In the circumstances I award the applicant the sum of £1800 as a contribution towards the cost of these proceedings. The sum is calculated as follows:

Filing the application for invalidation: £600 (including the £200 official fee) and considering the counterstatement

Filing evidence and considering the proprietor’s evidence: £1000

Filing written submissions in lieu of a hearing: £200

66. Subject to appeal, I therefore order GB Renewables Investments Ltd to pay Andrew Freeth the sum of £1800. The above sum should be paid within seven days of the expiry of the appeal period or within seven days of the conclusion of any appeal.

Dated this 18th day of February 2015

**Allan James
For the Registrar**