

O/046/19

TRADE MARKS ACT 1994

**IN THE MATTER OF UK REGISTRATION NO. 3154717 BY
MCMUG LTD
IN RESPECT OF THE TRADE MARK:**

okayest

IN CLASS 21

AND

**AN APPLICATION FOR A DECLARATION OF INVALIDITY
THEREOF UNDER NO. 501992 BY
AMC PHOTOGRAPHICS LIMITED**

Background and pleadings

1. The trade mark **okayest** was applied for on 14 March 2016 and entered in the register on 22 July 2016. It stands in the name of McMug Ltd (the registered proprietor).
2. The mark is registered in respect of the following goods:

Class 21

Beakers of glass; Beer jugs; Beer mugs; Beverage coolers [containers]; Bottle coolers; Bottle openers; Bottles; Boxes for biscuits; Boxes of ceramics; Boxes of china; Boxes of earthenware; Boxes of glass; Ceramic mugs; Ceramic tableware; China mugs; Chinaware; Coasters, not of paper and other than table linen; Coasters (tableware); Coffee cups; Coffee mugs; Coffee pots; Cups; Cups and mugs; Cups (egg-); Cups (Egg -); Cups (Fruit -); Cups made of china; Cups made of earthenware; Cups made of porcelain; Cups made of pottery; Cups of paper or plastic; Drinking cups; Drinking cups and saucers; Drinking flasks; Drinking receptacles; Drinking steins; Earthenware; Earthenware mugs; Flasks; Flasks for travellers; Flasks for travellers (Drinking -); Glass mugs; Hip flasks; Money boxes; Mugs; Mugs made of china; Mugs made of plastic; Mugs made of porcelain.

3. On 27 February 2018, AMC Photographics Limited (the applicant) applied under section 47 of the Trade Marks Act 1994 (the Act) for the trade mark registration to be declared invalid. The application is based on sections 3(1)(b), (c) and (d) of the Act. Under sections 3(1)(b) and (c), the applicant claims that the mark is devoid of any distinctive character as it is a wholly descriptive dictionary word (a superlative of “okay”) that can be used of any object or person. It also claims that the word is used by many traders in phrases printed on novelty goods. Under section 3(1)(d) it claims that at the time of application many traders were using the word as part of phrases printed on novelty goods; the word was in use in the current language; and that therefore the word was customary in the current language and in the bona fide and established practices of the trade of novelty goods.
4. The registered proprietor filed a counterstatement denying the claims made.

5. Only the applicant filed evidence in these proceedings. This will be summarised to the extent that is considered necessary. The applicant also filed written submissions on 10 July 2018 and 25 September 2018 which will not be summarised but will be referred to as and where appropriate during this decision.
6. In these proceedings, the applicant is represented by IP-Active.com Limited and the registered proprietor by HGF Limited.
7. No hearing was requested and so this decision is taken following a careful perusal of the papers.

Evidence

8. The applicant's evidence comes from Annette Chalmers, trading as AMC Photographics since 2003 and founder and director of AMC Photographics Limited since its incorporation in 2012. Her witness statement is dated 9 July 2018. There is also a witness statement from Gary Smith, who has been trading as Millhouse Prints since 2010. This is dated 6 July 2018.
9. The applicant specialises in the printing of large, professional-quality poster, photo and canvas prints, CD and DVD duplication and printing, and the production of printed novelty items, such as mugs, mouse mats and tote bags. Sales of novelty products are carried out by the applicant under the registered trade mark **MUG-TASTIC** on Amazon and through other traders.
10. Ms Chalmers states that she first came across the word "okayest" on a T-shirt in Canada in 2011. In 2014, she designed a range of mugs decorated with phrases that included the word, such as "WORLD'S OKAYEST BROTHER", and started selling them in March of that year. I have reproduced the sales data below:

	Number of Units Sold	Turnover (£)
2014	72	576
2015	200	1700
2016	500	3500

11. The applicant was not the only business selling products bearing similar phrases. Exhibit AC3 contains Amazon print-outs showing seven different retailers (including MUG-TASTIC) selling mugs with a phrase beginning “WORLD’S OKAYEST...”. These print-outs are undated but show that in all cases the mugs were first available in 2014, 2015 or January 2016. Prices are in sterling.
12. A further example is provided by Mr Smith in his witness statement. Millhouse Prints specialises in the printing of mugs, T-shirts, mouse mats, button badges, fridge magnets, stickers and decals. In July 2015, he created a number of mug designs which included the word “OKAYEST”:
- THE WORLD’S OKAYEST MUM
 - THE WORLD’S OKAYEST BROTHER
 - THE WORLD’S OKAYEST SISTER
 - THE WORLD’S OKAYEST BOSS

Mr Smith explains that

“In these designs, the word OKAYEST is being used to describe the person with the mug. It is saying that the person is not brilliant, or the best, but the most OK. It’s a sort of back hand compliment.”

This explanation is consistent with the definitions from *Wiktionary* and *The Urban Dictionary* that are provided in Exhibit AC1 to Ms Chalmers’s witness statement.

13. Mr Smith uploaded the designs to Amazon on 22 July 2015 and sold 10 mugs that year, and 5 in 2016. He attributes the low sales to the number of existing traders offering similar products.

Legislation

14. Section 3(1) of the Act states that:

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

...

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

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

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

15. Section 47(1) of the Act states that:

“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.”

Relevant Date

16. The registered proprietor has not claimed that, in the event of a finding against its mark on a *prima facie* basis, its mark had acquired a distinctive character through use, and in any case has filed no evidence. It is therefore not necessary for me to

consider the provisos in sections 3(1) or 47(1) of the Act. The relevant date for the purpose of these proceedings is the date of the registered proprietor's application for registration: 14 March 2016.

Decision

17. The cancellation applicant has made claims under section 3(1)(b), (c) and (d) grounds. In *Koninklijke KPN Nederland NV v Benelux-Merkenbureau (POSTKANTOOR)*, Case C-363/99, the Court of Justice of the European Union (CJEU) stated that:

“... it is clear from Article 3(1) of the Directive that each of the grounds for refusal listed in that provision is independent of the others and calls for a separate examination (see, inter alia, *Linde*, paragraph 67). That is true in particular of the grounds for refusal listed in paragraphs (b), (c) and (d) of Article 3(1), although there is a clear overlap between the scope of the respective provisions (see to that effect Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraphs 35 and 36).”¹

18. In assessing the claims, I keep in mind the comments of the CJEU in *Libertel Groep BV v Benelux-Merkenbureau*, Case C-104/01:

“It is settled case-law that the essential function of a trade mark is to guarantee the identity of the origin of the marked goods or service to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin (see *Canon*, paragraph 28, and Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 22). A trade mark must distinguish the goods or services concerned as originating from a particular undertaking. In that connection, regard must be had both to the ordinary use of trade marks as a badge of origin in the sectors concerned and to the perception of the relevant public.”²

¹ Paragraph 67.

² Paragraph 62.

19. The applicant also makes comments about how the registered proprietor has been using its mark following registration. In its Statement of Grounds, it said:

“As a result of this dictionary word being registered by the UKIPO, the proprietor has been actively and vigorously using the registration to shut down other traders on Amazon who have been trading before the filing date of the registration.”

It is only open to me to consider the mark as it has been registered, on the basis of the evidence before the Tribunal. I shall therefore take no account of these comments in my decision.

Section 3(1)(d)

20. I shall first consider the claim under section 3(1)(d) that:

“At the filing date of the registration, many traders were using the word ‘okayest’ as part of phrases such as ‘World’s Okayest Mum’, ‘World’s Okayest Boss’ etc, printed on novelty goods such as mugs and tee shirts. Furthermore, at the filing date of the registration, the word ‘okayest’ was in use in the current language and can be found in articles, blogs and other published work. Thus, at the filing date of the registration, the word ‘okayest’ was customary in the current language and in the bona fide and established practices of the trade of novelty goods.”

21. In *Telefon & Buch Verlagsgesellschaft GmbH v OHIM*, Case T-322/03, the General Court summarised the case law of the CJEU under the equivalent of section 3(1)(d) of the Act:

“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 v Krell* [2001] ECR I-6959, 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).”

22. Although the applicant refers to the relevant trade as that of novelty goods, it is the goods of the application that I must consider. These are not novelty goods, but tableware, drinking vessels and food containers, as listed in paragraph 2, although the list does include mugs and some of the items could carry decorations, including slogans, which give them the character of novelty goods. The average consumer of these goods is a member of the general public who is buying them

for their own use or as a gift, or businesses such as bars, restaurants and cafés who will buy them to enable them to serve their own customers with food or drink. The goods may also be bought by general businesses as promotional items.

23. It seems to me that the word “customary” sets a relatively high bar to surmount. In *Stash Trade Mark*, BL O/281/04, Professor Ruth Annand, sitting as the Appointed Person, referred to the definition of the word in the *Oxford English Reference Dictionary*: “usual; in accordance with custom”.³ The evidence that the applicant has provided does not convince me that the word “okayest” has become customary in the bona fide and established practices of the relevant trade, or even that it has become a common part of the English language.

24. Besides the entries from online, user-generated dictionaries to which I have referred in paragraph 12 above, the applicant has provided extracts from the following sources:⁴

- Reddit (three posts);
- OkayestMomBlog.com and an associated Facebook page;
- A Facebook “About” page for the “World’s Okayest Mom” closed group;
- Blogs (three separate ones);
- Knowyourmeme.com, showing a cartoon of a woman wearing a “World’s Okayest Mom” T-shirt;
- Language learning website italki.com, on which a user posted a question as to what “okayest” means;
- Huffington Post; and
- An extract from a book, *Confessions of a Once Fashionable Mum*, by Georgia Madden, which appears to have been published in Australia in 2015. It is not clear whether this was available in the UK.

25. Of these examples, only two (one of the blogs and the book extract) contain any reference to the goods in issue. In both, the word “okayest” appears as part of a

³ See paragraph 33.

⁴ Exhibit AC2.

phrase on a mug – “WORLD’S OKAYEST MOM/DAD”. Exhibits AC3 and AC4 contain examples of mugs for sale bearing phrases of this kind.

26. The ground under section 3(1)(d) fails. As I have already said, the applicant has not supplied sufficient evidence to convince me that the word is customary in the current language. Furthermore, where it has been used, it has been used as part of a phrase. Such use does not assist the applicant’s case, as the registered mark is “okayest” on its own. No evidence has been provided of use of the single word.

Section 3(1)(c)

27. I turn now to the claim under section 3(1)(c) that:

“The mark comprises wholly of the word ‘okayest’ written in lower case letters without any form of distinctive character or stylisation. ‘Okayest’ was a dictionary word at the filing date of the registration and means ‘a superlative form of okay’. The word ‘okayest’ is thus a wholly descriptive word which can be used of any object or person. It is commonly used in a wry or jokey fashion to denote a ‘super average’ person or object.”

28. The case law under section 3(1)(c) was set out by Arnold J in *Starbucks (HK) Ltd and others v British Sky Broadcasting Group Plc and others* [2012] EWHC 3074 (Ch) as follows:

“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 L40, 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 WLR 1728 [2003] ECR I-12447; [2004] ETMR 9; [2004] RPC 18, paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] ECR 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] ECR I-5089; [2005] ETMR 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 the 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 the 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] ECR I-12447 at [32] and *Koninklijke Nederland NV v Benelux-Merkenbureau* (C-363/99) [2004] ECR I-1619; [2004] ETMR 57 at [97].”

29. To my mind, the word does not describe a characteristic of the goods covered by the registration. The evidence supplied does not indicate that the word “okayest” is used to designate any characteristic of goods. The most plausible possibility would be that it might describe the quality of the product, but it does not seem to me at all likely that traders in this field would legitimately wish to describe their goods in this way and attempt to tell the consumer that the mug they have purchased is “super average”. Neither would the relevant public perceive the word as a description of the goods or some characteristic of them. As shown in the small amount of use (on mugs) put forward, the word is intended to describe, as part of a longer phrase and in a jokey fashion, the person who is using the product. The ground under section 3(1)(c) therefore fails.

Section 3(1)(b)

30. The final ground to assess is section 3(1)(b). The cancellation applicant claims that the mark is devoid of distinctive character as the word was a dictionary word at the date of the application for registration and “is a wholly descriptive word which can be used of any object or person”. The *Urban Dictionary* definition to which I have already referred in paragraph 12 was added in 2015. It is not clear when the *Wiktionary* entry was first made, but it did receive minor revisions in 2014.⁵

31. The principles to be applied under this section were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG*, Case C-265/09 P:

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

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

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

32. It is settled case-law that the distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been

⁵ See Exhibit AC1.

applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P, *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37).”

32. Descriptiveness is the only claim that the applicant has made under this ground as to why the mark is devoid of distinctiveness. I have already found that the mark is not descriptive of the goods for which it is registered. The CJEU noted in *Koninklijke KPN Nederland BV v Benelux-Merkenbureau (POSTKANTOOR)*, Case C-363/99:

“85. ... although each of the grounds for refusal listed in Article 3(1) of the Directive is independent of the others and calls for separate examination, there is a clear overlap between the scope of each of the grounds for refusal set out in subparagraphs (b), (c) and (d) of that provision respectively.

86. In particular, a word mark which is descriptive of characteristics of goods or services for the purposes of Article 3(1)(c) of the Directive is, on that account, necessarily devoid of any distinctive character with regard to the same goods or services within the meaning of Article 3(1)(b) of the Directive. A mark may none the less be devoid of any distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive.”

33. The applicant has not made any pleadings that concern any possible other reasons. I can see no reason why the word in itself would not be able to function as a trade mark: being in the dictionary is not sufficient to engage this ground. Even if a phrase containing the word might be devoid of distinctiveness, the word alone would not be apt to communicate a similar non-distinctive message. The section 3(1)(b) ground therefore fails.

Outcome

34. The application for invalidation has been unsuccessful. The trade mark 3154717 will remain registered.

Costs

35. The registered proprietor has been successful and is entitled to a contribution towards its costs. In the circumstances I award the registered proprietor the sum of £200 as a contribution towards the cost of the proceedings. I have taken into account the fact that the registered proprietor filed no evidence and made no written submissions.

36. I therefore order AMC Photographics Limited to pay McMug Limited the sum of £200. The above sum should be paid within seven days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 24th day of January 2019

**Clare Boucher
For the Registrar,
The Comptroller-General**