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TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION: 3340925

BY ALAN FERGUSON trading as THE AD GEFRIN DISTILLERY

**TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 33, 35, 40, 41 and
43:**

NORTHUMBRIAN DISTILLERY

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Background

1. On 25 September 2019, Alan Ferguson trading as the Ad Gefrin Distillery (“the applicant”) applied to register the mark for the following goods and services:

Class 33: Alcoholic beverages (except beer); spirits; distilled spirits; whisky; gin; vodka; rum; absinthe; liqueurs; wine.

Class 35: Advertising; business management; business administration; retail services and on-line retail services connected with the sale of alcoholic beverages, spirits, distilled spirits, whisky, gin, vodka, rum, absinthe, liqueurs, wine, beers, water, mineral water, aerated water, non-alcoholic beverages, fruit beverages, fruit juices, syrups, preparations for making beverages, alcohol free beverages, low alcohol beverages, alcohol free beers, low alcohol beer, non-alcoholic wine, non-alcoholic cocktails, foodstuffs, marmalade, marmalade containing and/or flavoured with alcohol, jams, jam containing and/or flavoured with alcohol, jellies, jelly containing and/or flavoured with alcohol, conserves, preserves, conserves and preserves containing and/or flavoured with alcohol, compotes, compotes containing and/or flavoured with alcohol, preserved, frozen, dried and cooked fruits and vegetables, fruits preserved in alcohol, dairy products, milk, milk products, cheese, cheese containing and/or flavoured with alcohol, eggs, meat, fish, poultry and game, meat, fish, poultry and game containing and/or flavoured with alcohol, meat extracts, meat extracts containing and/or flavoured with alcohol, meat products, meat products containing and/or flavoured with alcohol, haggis, haggis containing and/or flavoured with alcohol, smoked meat and fish containing and/or flavoured with alcohol, edible oils and fats, oils containing and/or flavoured with alcohol, coffee, flavoured coffee, tea, flavoured tea, cocoa, artificial coffee, flavoured artificial coffee, rice, tapioca, sago, flour and preparations made from cereals, bread, baked goods, baked goods containing and/or flavoured with alcohol, pastries, cakes, puddings, pies and tarts, pastries, cakes, puddings, pies and tarts containing and/or flavoured with alcohol, biscuits, shortbread, shortbread containing and/or flavoured with alcohol, confectionery, flavoured confectionery, flavoured sugar confectionery, confectionery containing and/or flavoured with

alcohol, fudge, toffee and tablet, fudge, toffee and tablet containing and/or flavoured with alcohol, chocolates, chocolates containing and/or flavoured with alcohol, liqueur chocolates, edible ices, flavoured edible ices, edible ices containing and/or flavoured with alcohol, honey, honey containing and/or flavoured with alcohol, sauces, sauces containing and/or flavoured with alcohol, cooking sauces, food dressings, savoury sauces, chutneys and pastes, savoury sauces, chutneys and pastes containing and/or flavoured with alcohol, mustard, mustard containing and/or flavoured with alcohol, flavourings, sugar, treacle, yeast, baking-powder, salt, vinegars, vinegars containing and/or flavoured with alcohol, ice-cream, ice-cream confections, ice-cream and ice-cream confections containing and/or flavoured with alcohol, spices, ice, raw and unprocessed agricultural, aquacultural, horticultural and forestry products, raw and unprocessed grains and seeds, fresh fruits and vegetables, fresh herbs, natural plants and flowers, bulbs, seedlings and seeds for planting, live animals, foodstuffs and beverages for animals, malt, printed matter, printed publications, books, guidebooks, leaflets, newsletters, brochures, posters, photographs, decalomania, stickers, labels, cards, postcards, greeting cards, stationery, office requisites, gift vouchers, instructional and teaching materials, tableware, cookware, household or kitchen utensils and containers, glasses, tumblers, shot glasses, whisky glasses, drinking vessels, glassware, porcelainware, earthenware, coolers, cool bags, beverage coolers, bottle coolers, ice buckets, trays, drinking flasks, hip flasks, drinks measures, jewellery, cufflinks, bracelets, pendants, necklaces, earrings, cooling stones for drinks, gift boxes, textiles and textile goods, table covers, towels, bar towels, bar cloths, flags, bunting, banners, tea towels, furniture, mirrors, picture frames, household linen, cushions, curtains, carpets, rugs, Christmas decorations, toys, books, clothing, footwear, headgear, T-shirts, sweatshirts, jackets, rainwear, waterproof jackets, fleeces, shirts, underwear, aprons, caps, visors, belts, key rings, magnets, notebooks, tiepins, cuff links, toys, games and playthings, CDs, DVDs, audio and video recordings, software, phone accessories and covers, mouse mats and computer hardware accessories; arranging and conducting of talks and tastings for promotional and advertising purposes; arranging of competitions for trade, commercial and business purposes; organising and conducting volunteer programmes and community service projects; promotional services; promoting public awareness; dissemination of information for promoting public awareness; information, advisory and consultancy services relating to all of the aforementioned services.

Class 40: Spirits distillery services (for others); distilling services; information, advisory and consultancy services relating to all of the aforementioned services.

Class 41: Education services; training services; entertainment services; sporting and cultural activities; provision of museum, presentation and exhibition

facilities including visitor centres; arranging and providing courses of instruction for tourists; arranging, organising, conducting and providing facilities for talks, tastings, conferences, seminars, exhibitions, symposiums, concerts, parties, shows, events, spectacles, competitions, quizzes and games; corporate hospitality (entertainment); wine, spirit and whisky tasting services; organisation of wine, spirit and whisky tastings; entertainment relating to wine, spirits and whisky tastings; private members club services; provision of club recreation services; arranging and organising competitions for educational, entertainment and cultural purposes; cultural facilities; provision of music and entertainment facilities; provision of live entertainment; publication of books, texts and newsletters; publication of tasting notes and bottling lists; publication of books; organisation and hosting of musical events; party, conference and function planning; information, advisory and consultancy services relating to all of the aforementioned services.

Class 43: Provision of food and drink; temporary accommodation; hotel, motel, restaurant, bar, wine bar, cafe; bistro, brasserie, cafe and cafeteria services; cocktail bar services; banqueting and catering services; organisation and provision of facilities for conferences, weddings, meetings and events; private members club services; provision of museum, presentation and exhibition facilities; hiring of rooms for social functions; catering services; arranging of wedding receptions (venues); arranging of wedding receptions (food and drink); restaurants; corporate hospitality (provision of food and drink); whisky tasting services (provision of beverages); information, advisory and consultancy services relating to all of the aforementioned services.

2. On 2 October 2018 the Intellectual Property Office (“IPO”) issued an examination report in response to the application. In that report the following objection was raised under sections 3(1)(b) & (c) of the Trade Marks Act 1994 (“the Act”):

“The application is not acceptable in classes 33, 40 and 43. There is an objection under Section 3(1)(b) and (c) of the Act. This is because the mark consists exclusively of a *sign which may serve in trade to designate the geographical origin of the goods and services e.g. spirits, distilling services and bar services which emanate from a distillery in Northumberland. The Oxford English Dictionary defines ‘Northumbrian’ as:*

‘A native or inhabitant of Northumberland’ and ‘of, relating to, or characteristic of, Northumberland...’

The sign is also devoid of any distinctive character. This is because it consists solely of the word ‘Northumbrian’ and the non-distinctive word ‘Distillery’ in normal text. The sign would not be perceived by the average consumer as a brand denoting a single commercial origin.”

The examiner went on to state that the objection had been raised because of a change in practice following the deregulation of the Gin industry and that the

objection could be overcome by removing 'Gin' from class 33 and limiting class 40 to the distilling of whisky.

3. On 12 October 2018 Murgitroyd & Company ("the agent") requested a hearing. At the hearing, which was held on 4 December 2019 with Ms McKay of the agents, Ms McKay submitted that 'Northumbrian' was an historical term used to describe a native or inhabitant of the ancient Anglo-Saxon kingdom of Northumbria. She added that although the term had more recently been used to describe a native or inhabitant of Northumberland, it was mostly used in relation to a person. Ms McKay went on to argue that as 'Northumbria' was an historical kingdom, there was no such place as 'Northumbria' today and the term could not be said to be exclusively descriptive of the geographical origin of the goods and services. Ms McKay added that she was confused over the suggestion to remove 'gin' from the class 33 specification and to limit the class 40 specification to 'the distilling of whisky'. She stated that it has not been made clear to her why the gin regulations were relevant to the objection raised and that there are previous acceptances of geographical marks accepted for alcoholic beverages at large.

4. I maintained the objection at the hearing as the sign 'NORTHUMBRIAN DISTILLERY' would merely be perceived as a description of goods and services emanating from a distillery in Northumberland and therefore would not be perceived as a trade mark for the goods and services applied for. Whilst the mark contains the word 'Northumbrian' rather than 'Northumberland' the Oxford English dictionary defines the term 'Northumbrian' as meaning 'of, relating to, or a characteristic of Northumberland'. 'Northumberland' is a county in the north-east of England. The term 'Northumbrian' is currently used by the police force (Northumbrian Police) and for water services (Northumbrian Water). Ms McKay pointed out that the Registry has accepted many geographical marks for alcoholic beverages. I advised Ms McKay that the registry has recently refused geographical place names for gin e.g. Manchester, Oxford, Leeds, Orkney, Canterbury, Cardiff, Yorkshire, Bristol and Bath. I consider these geographical locations to be on a par with 'Northumberland' in relation to how well known they are throughout the UK and their size.

5. Regarding the gin regulations referred to by the examiner I explained to Ms McKay that prior to 2009 HM Revenues & Customs (HMRC) legislation prohibited the production of gin for quantities of less than 300 litres. The legislation changed in 2009 and consequently gin production in the UK continues to rise. It is thought that the examiner believed that the distilling of whisky is more regulated than gin and there are likely to be less distilleries producing whisky in Northumberland than there would be those producing gin, and therefore the sign may be able to function as a trademark on whisky related goods and services. I disagree with the examiner on this point, regardless of the type of alcoholic beverage being distilled. I believe the sign would be perceived, upon first impression, by the average consumer as a description of goods and services produced in a Northumbrian distillery and I maintained the objection for all the goods and services applied for. As such I formally refused the application under Section 37(4) of the Trade Marks Act 1994 at the hearing.

6. On 18 January 2019 the agent submitted a form TM5 requesting a statement of reasons for the Registrar's decision. I am now asked under Section 76 of the Trade Marks Act 1994, and rule 69 of the Trade Mark Rules 2008, to state in writing the grounds of my decision and the material used in arriving at it. No formal evidence has been put before me for the purposes of demonstrating acquired distinctiveness, therefore I only have the *prima facie* case to consider.

The *prima facie* case for registration under Section 3

The Law

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

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

(a) ...

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

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

(d) ...

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

The relevant legal principles - section 3(1)(c)

8. There are a number of judgments of the Court of Justice of the European Union ('CJEU') which deal with the scope of Article 3(1)(c) of the Directive and Article 7(1)(c) of the Regulation, whose provisions correspond to section 3(1)(c) of the UK Act. I derive the following main guiding principles from the cases noted below:

- Subject to any claim in relation to acquired distinctive character, signs and indications which may serve in trade to designate the characteristics of goods and services are deemed incapable of fulfilling the indication of origin function of a trade mark (*WM Wrigley Jr & Company OHIM, C-191/01P (Doublemint), paragraph 30*);
- Article 7(1)(c) (section 3(1)(c)) 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. The provision therefore prevents such signs or indications from being reserved to one undertaking alone because they have been registered as trade marks (see judgment of 4 May 1999 in Joined cases C-108/97 and C-109/97 *Windsurfing Chiemsee Produktions-und Vertriebs GmbH (WSC) v*

Boots-und Segelzubehör Walter Huber and Franz Attenberger (Chiemsee) [1999] ECR I-2779, at paragraph 25).

- It is not necessary that such a sign be in use at the time of application in a way that is descriptive of the goods or services in question. It is sufficient that it could be used for such purposes (*Doublemint*, paragraph 32);
- It is irrelevant whether there are other, more usual signs or indications designating the same characteristics of the goods or services. The word 'exclusively' in paragraph (c) is not to be interpreted as meaning that the sign or indication should be the only way of designating the characteristic(s) in question (*Koninklijke KPN Nederland NV v Benelux Merkenbureau, C-363/99 (Postkantoor, paragraph 57)*);
- When determining whether a sign is devoid of distinctive character or is descriptive of the goods or services in respect of which registration is sought, it is necessary to take into account the perception of the relevant consumer who is reasonably well-informed and reasonably observant and circumspect (*Matratzen Concord AG v Hukla Germany SA, C-421/04*);
- There must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the relevant consumer immediately to perceive, without further thought, a description of the category of goods and services in question or one of their characteristics (*Ford Motor Co v OHIM, T-67/07*);
- A sign which fulfils functions other than that of a trade mark is only distinctive if it may be perceived immediately and on first impression as an indication of the commercial origin of the goods or services, so as to enable the relevant consumer to distinguish, without any possibility of confusion, the goods and services of the owner of the mark from those of a different commercial origin (*Sykes Enterprises v OHIM (Real People Real Solutions) [2002]. ECT 11-5179*).
- As regards signs or indications which may serve to designate the geographical origin of the categories of services in relation to which registration of the mark is applied for, especially geographical names, it is in the public interest that they remain available, not least because they may be an indication of the quality and other characteristics of the categories of services concerned, but they may also, in various ways, influence consumer tastes by, for instance, associating the services with a place that may give rise to a favourable response (see *Chiemsee*, cited above, at paragraph 26: judgment of 25 October 2005 in Case T-379/03 *Peek & Cloppenburg KG v OHIM ('Cloppenburg')* [2005] ECR II-4633, at paragraph 33).
- The registration of geographical names as trade marks is excluded under section 3(1)(c) not only where they designate specified geographical locations which are already famous or known for the category of services concerned, and which are, therefore, associated with those services in the minds of the relevant consumers; it is equally excluded if the geographical name is liable to

be used by other traders and must remain available to them as indications of the geographical origin of the category of services concerned (see *Chiemsee*, at paragraphs 29 and 30).

- However, section 3(1)(c) does not preclude the registration of geographical names which are unknown to the relevant class of persons (or at least unknown as the designation of a geographical location), or of names in respect of which, because of the type of place they designate, such persons are unlikely to believe that the category of services concerned originates there (see *Chiemsee* at paragraph 33).
- In light of all the foregoing, a sign's descriptiveness cannot be assessed other than by reference to the goods or services concerned, on the one hand, and by reference to the understanding which the relevant persons have of it, on the other (see judgment of 15 October 2003 in Case T-295/01 *Nordmilch eG v OHIM* ('*Oldenburger*') [2003] ECR - 4365, at paragraphs 27 to 34).

9. I also have to take into account the consequences for third parties of granting the applicant a monopoly. In *Linde A.G. v Rado Uhren A.G.* Case C-53/01 the following guidance was given at paragraphs 73 - 74:

"73. According to the Court's case-law "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 characteristics 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 (see to that effect, Windsurfing Chiemsee, paragraph 25).

74. The public interest underlying Article 3(1)(c) of the Directive implies that, subject to Article 3(3) any trade mark which consists exclusively of a sign or indication which may serve to designate the characteristics of goods or a service within the meaning of that provision must be freely available to all and not be registrable."

10. It is clear from the aforementioned case law that, assuming notional and fair use, I must determine whether or not the mark applied for will be viewed by the average consumer as a means of directly designating essential characteristics of the goods and services being provided. I therefore have to consider who the average consumer for the goods and services covered by the application is. I believe consumers for the goods and services will be both specialist and non-specialist consumers. For goods such as alcoholic beverages and entertainment services the average consumer will be the general public. These goods and services are not likely to be highly considered purchases and the attention of the average consumer will not be high. Whereas those who are purchasing services such as business services, distilling services, advertising and corporate hospitality, for example, are likely to be highly aware in their consideration and selection of these higher cost services.

11. The mark consists of the geographical word 'Northumbrian' together with the word 'Distillery'. Collins English Dictionary defines a distillery as; *noun 'a place where whisky or a similar strong alcoholic drink is made by a process of distilling.* In taking into account the average consumer's perception of the mark I must consider the geographical reference 'Northumbrian' and whether this name is likely to be associated in the mind of the relevant class of persons with the categories of goods and services concerned, or whether it is reasonable to assume that such an association may be established in the future. In doing so I must ascertain the average consumers familiarity with the geographical name in question, the characteristics of the place designated by that name and with the goods and services concerned As stated in the *Chiemsee* decision (Joined Cases C-108/97 and (C-109/97)

"where there is currently no association in the mind of the relevant class of persons between the geographical name and the category of goods in question, the competent authority must assess whether it is reasonable to assume that such a name is, in the mind of the relevant class of persons, capable of designating the geographical origin of that category of goods:

in making that assessment, particular consideration should be given to the degree of familiarity amongst the relevant class of persons with the geographical name in question, with the characteristics of the place designated by that name, and with the category of goods concerned"

12. As I have stated, above the Oxford English dictionary defines the term 'Northumbrian' as meaning 'of, relating to, or a characteristic of Northumberland'. Ms McKay argued that as 'Northumbria' was an historical kingdom, there is no such place as 'Northumbria' today and the term could not be said to be exclusively descriptive of the geographical origin of the goods and services. I do not agree with this. I believe consumers would know that 'Northumbria' relates to 'Northumberland'. The fact that the police force and the water services in that area use the word 'Northumbria' to describe the geographical area covered by their services confirms that the word 'Northumbria' is a known geographical location.

13. Although Northumbria does not have a particular reputation for alcoholic beverages, the area covered by Northumbria includes agricultural areas and is known for tourism and as a holiday destination. In view of the size of Northumbria it is reasonable to assume that there could be more than one distillery within that area, or there could be in the future.

14. In for example the *Canary Wharf* decision ([2015] EWHC 1588 (Ch), the Court concluded that given the nature and in particular, extent of the area and the nature of goods and services it seemed reasonable to assume that the relevant consumer could see the words as designating a characteristic (geographical location or origin) of the goods or services. Applying this to this mark, I do not think it irrelevant to take account of the fact that the distilling of gin in particular, and in recent years, has assumed some at least of the characteristics of a cottage industry, such as being on a small scale and without geographical constraint. The decision in *Canary Wharf* therefore confirms the consideration of public interest in marks incorporating a geographical location, whether or not there currently exists, or in the future is likely to

exist, an association between that location and the goods or services on offer. I find that, on seeing the mark, consumers will perceive immediately a descriptive message indicating that the goods and services are provided from a distillery in Northumbria and other providers of goods and services from a distillery in Northumbria should be free to use those words in the course of trade.

15. At the hearing I maintained the objection against all the goods and services claimed, including those not objected to by the examiner i.e. those of class 41, as it is clear from the actual wording of Article 3(1)(c), which refers to '*...indications which may serve ... to designate ... geographical origin*', that geographical names which are liable to be used by undertakings must remain available to such undertakings as indications of the geographical origin of the category of goods and services. However, on reconsideration I do not consider the mark to be unacceptable for all of the services claimed.

16. It is reasonable to assume that services such as retail services, catering services, functions, tours of the distillery and education services relating distilling are such services that might be typically provided in addition to the core business of distillery. The mark is therefore unacceptable for alcoholic beverages, the retail of goods within a distillery, distilling services, education, training and entertainment services, provision of museum, presentation and exhibition facilities including visitor centres, arranging and providing courses of instruction for tourists, arranging, organising, conducting and providing facilities for talks, tastings, conferences, seminars, exhibitions, symposiums, concerts, parties, shows, events, spectacles, competitions, quizzes and games, corporate hospitality, wine, spirit and whisky tasting services, private members club services, provision of club recreation services; arranging and organising competitions for educational, entertainment and cultural purposes, cultural facilities, provision of music and entertainment facilities, provision of live entertainment; publication of newsletters and publication of tasting notes and bottling lists, organisation and hosting of musical events, party, conference and function planning services, the provision of food and drink, accommodation and catering services, the provision of facilities for conferences, weddings, meetings and event, private members club services, provision of museum, presentation and exhibition facilities, hiring of rooms for social functions, arranging of wedding receptions, corporate hospitality and whisky tasting services as it is not unreasonable to assume that all of these services can be provided at a distillery. However, on reconsideration I would be prepared to accept the mark for advertising services, business management services and business administration, sporting activities and publication of books.

17. Having maintained the objection under Section 3(1)(c) for the goods and the majority of the services this effectively ends the matter. However, in case I am found to be wrong in this regard, I will go on to determine the matter under section 3(1)(b) of the Act. I should at this point stress that since an objection has been made under section 3(1)(c), this automatically engages section 3(1)(b). However, it can be useful to also consider section 3(1)(b) in its own right - the scope of the two provisions is not identical, and marks which are not descriptive under section 3(1)(c) can nonetheless be devoid of any distinctive character.

Section 3(1)(b)

18. I have fully considered in this case whether there is a separate or independent objection under section 3(1)(b). In the circumstances I do not consider that there is; the objection under 3(1)(b) co-exists and is co-extensive with the objection under section 3(1)(c). In other words, the mark is devoid of all distinctive character by virtue only of it designating a characteristic under section 3(1)(c).

19. I have concluded that the mark applied for will not be identified as a trade mark without first educating the public that it is an indication of trade origin. In this decision I have considered all the documents filed by the applicant, and all the arguments submitted to me in relation to this application. Having done so, and for the reasons given above, the application is refused under sections 3(1)(b) and 3(1)(c) of the Act for those goods listed in paragraph 15 above and can be accepted for advertisement purposes for advertising services, business management services and business administration, sporting activities and publication of books.

26 September 2019

**Rebecca Thomas
For the Registrar
The Comptroller-General**