

O-775-19

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3302233
BY LOWLIFE PRODUCTS LTD
TO REGISTER AS A TRADE MARK:**

STEALTH

IN RESPECT OF GOODS IN CLASS 12 AND SERVICES IN CLASS 37

AND

**IN THE MATTER OF THE OPPOSITION THERETO UNDER NO. 413959
BY THE HILO ROOF COMPANY LTD**

Background and pleadings

1. LowLife Products Ltd (“**the Applicant**”) applied to register the plain text word “STEALTH” as a UK trade mark in respect of the goods and services listed below. The application was filed on 7 April 2018 (and that is “**the relevant date**” for the purposes of these opposition proceedings).

Class 12: *Parts and fittings for land vehicles; parts and fittings for vehicles; roof linings for vehicles; hard roofs for vehicles; textile roofs for vehicles; roof panels for land vehicles; folding roofs for motor vehicles; elevating roofs for motor vehicles; sliding roofs for motor vehicles; convertible roofs being parts of cars; articulated support frames adapted for use with vehicles; vehicle body modification parts for sale in kit form; parts, fittings and accessories for all the aforesaid goods.*

Class 37: *Converting motor vehicles into campervans and motor caravans; vehicle roof restoration; vehicle roof repair; vehicle roofing installation; application of waterproof coatings for vehicle roofs; vehicle roof installation services; vehicle roofing repair; raising roofs for motor vehicles; maintenance and repair of motor vehicle roofs; vehicle roof installation services; installation of vehicle roofing; installation of parts for vehicles; repair of vehicle roofs; advice, information and consultancy services relating to all of the aforesaid services.*

2. The application was published for opposition purposes on 6 July 2018, and on 5 October 2018, The Hilo Roof Company Ltd (“**the Opponent**”) filed a Form TM7 to oppose registration.¹ The opposition is based on grounds under sections 3(1)(c) and 3(1)(d) of the Trade Marks Act 1994 (“the Act”).² The Opponent seeks rejection of the whole of the application, claiming as follows:

- (i) Based on section 3(1)(c): “The word STEALTH is descriptive of a characteristic of the goods and services in the application. “Stealth” means “designed in accordance with technology which make detection difficult” and it therefore describes the characteristic of the goods concerned of not being immediately visible, e.g. vehicle roofs not being visible when closed or other parts and fittings of vehicles not normally being visible. As

¹ The opposition period had been extended by the Opponent’s filing on 17 July 2018 a notice of threatened opposition.

² The notice of opposition also included a claim of bad faith under section 3(6) of the Act, but the Opponent withdrew that ground during the evidence rounds.

the services claimed in Class 37 are strictly related to the goods in Class 12, the sign is also descriptive of these services.”

(ii) Based on section 3(1)(d): “The word STEALTH has become commonly used among the relevant public to indicate vehicle roofs and other parts and fittings of vehicles that are not visible unless used or otherwise not normally visible. In particular, the term ‘stealth’ is used in connection to vehicles that have some parts fitted in a way that would make them not visible, so that the vehicle would not be recognisable as a camper van, so enhancing the security of its users.”

3. The Applicant filed a **notice of defence** in which both grounds were denied and/or not admitted. In respect of the section 3(1)(c) claim, the Applicant stated: “‘Stealth’ is not a descriptive word in relation to campervan roofs or other goods associated with campervans. Furthermore, all campervan roofs are clearly visible whether open or closed. In respect of the section 3(1)(d) the Applicant stated that the term ‘stealth’ has not become common among the relevant public to describe any other goods associated with campervans other than in reference to its own product.” It also stated that the Applicant has branded and marketed its product as the “Stealth” elevating roof since 2016.

Representation, papers filed and the hearing

4. The Applicant is a litigant in person in these proceedings, acting without legal representation. It filed evidence during the evidence rounds, relating to its use of the mark applied for. The Applicant also chose to file a skeleton argument as submissions in lieu of attending a hearing, and filed a costs pro-forma outlining its time spent undertaking various tasks in defence of the opposition.

5. The Opponent is represented by WP Thompson, who, during the evidence rounds, filed both evidence and submissions. Ms Rigel Moss McGrath attended a hearing that took place by telephone conference on 23 September 2019, having duly filed in advance a skeleton argument on behalf of the Opponent. I have read all the papers filed in these opposition proceedings. Given the extent to which the claims in this case turn on what may be concluded from the evidence filed, I summarise the parties’ evidence in some detail below and refer to it, and to any points made in submissions, where I consider it warranted to do so elsewhere in this decision.

EVIDENCE

The Opponent's evidence

6. The Opponent's evidence comprised a **Witness Statement** dated 4 March 2019 by **Francesco Simone**, together with **Exhibits FS1 – FS2**. Mr Simone is a trade mark attorney with WP Thompson.
7. **Exhibit FS1** provides a definition of "Stealth", taken from the Oxford Living Dictionary, which states that the word is a "modifier (chiefly of aircraft)", meaning "designed in accordance with technology which makes detection by radar or sonar difficult."
8. Mr Simone explains that in support of the Opponent's claims - both that the word "stealth" is descriptive in relation to the goods concerned, and that it has become customary in the current language of trade - he researched the internet for relevant references. **Exhibit FS2** shows the results of Mr Simone's research, and consists of 11 separate items, amounting to 70 pages; I shall identify these as **Items A-K**.
9. **Item A** (pages 1-8 of Exhibit FS2) is identified by the URL beginning "reddit.com/r/vandwellers/comments" and is a discussion from an R/vandwellers forum dated "2 years ago". It is illustrative of the context of the stealth theme, and since both parties commented specifically on this item, I note the following points from it. Someone identifying themselves as "AJEM_RoundTheWorld" is looking for advice on the viability of converting a Luton van (which he clarifies are called Box vans in the USA) for use by a family of four on a year-long world tour. The reddit R/vandwellers discussion contains the following (total) references to "stealth", "stealthy" or "stealthiness" [as highlighted by my added emphasis by way of the underlining throughout this evidence summary].
 - Page 3 – One of the replies in the thread states that Luton vans "*are as stealthy as any other van, in fact the roof being so high helps hide your solar panels, skylights etc. Also stealth doesn't really matter in the UK.*"
 - Page 6 – "... they lack in stealthiness. But aside from that, they seem ok to me."
 - Page 7 – AJEM_RoundTheWorld – replies that "*hiding in plain sight might be an effective form of stealth. If everyone sees a delivery van, they may not be too confrontational. Having said that, a UK delivery van in USA or China might not be so stealthy!*"

I note that it some of the contributors may likely be based in the USA, and there may be a degree to which references to 'stealth' and its derivatives may have been adopted from the language used in a particular conversational chain.


10. **Item B** (pages 9-28) is an extract from "Build Your Van: The Ultimate Van Build Guide" from the website Gnomad Home, where the word "stealth" is used to refer to a surreptitious form of camping. For example, page 17 advises that "if you want to do a lot of stealth camping in cities, a cargo van is your best choice"; page 18 suggests a way to lay out the bed and kitchen areas in a van to achieve "increased privacy and stealthiness". The guide appears to originate from the USA, there being references to dollars. There is no indication of the UK reach of Item B. Its front page shows a number social media icons (FaceBook, Pinterest etc) and includes reference to "2.2k shares", which does not seem an especially high figure.
11. **Item C** (pages 29-32) is a discussion, shown to date from 2013, entitled "Do you really need a roof vent?" from the forum CheapRVLiving.com. It includes a URL referring to "boondocking and Stealth Parking" and the observation by one forum contributor that with the roof vent open "you loose [sic] some stealth". This item seems clearly US-focused and its geographical reach is entirely unclear.
12. **Item D** (pages 33-34) shows a printout from the online Ford Transit Forum (with a ".org" suffix) where a contributor started a discussion headed "Stealth camper – ventilation". He announces "I'm planning to convert my van into a 'stealth camper'" and then seeks advice on appropriate ventilation. The thread is shown to date from February 2011 and although its geographical context is not fully clear, the thread includes reference to North Wales.
13. **Item E** (pages 35-49) shows a printout of an article called "Make a stealthy camper van", which contains several references to a "stealthy camper van" to be able to go unnoticed. The article is a guide that appears (seemingly in May 2017) on a website called "That Adventurer", which has a ".co.uk" suffix, although, as the Applicant notes in its submissions, the article appears to be American in origin, containing references such as to "RV" (meaning "road vehicle"), Walmart and "Louisiana humidity". Again, social media icons are shown, noting 298 shares.
14. **Item F** (pages 50-57) shows a printout of a forum article called "My Stealth Camper Van Project" on a website called www.housepricecrash.co.uk and the forum posts are shown to

date from February 2017. The discussion thread appears to be initiated by a senior user of the forum (with nearly 4000 posts). The piece refers to the author's budget in pounds sterling and puts emphasis on: "STEALTH! It mustn't look like a motor home so I can potentially park it anywhere residential without drawing attention". The Applicant, in its submissions highlights one of the comments in the response to the post: "The stealth idea is a good one. I'd never thought of that." That respondent appears to have over 6000 posts.

15. **Item G** (page 58) shows an extract from an article entitled "SsangYong Turismo Tourist - is this the ultimate 4x4 stealth camper?". The article appeared in the online version of *The Telegraph* newspaper on 23 August 2017. It shows a picture of that car model complete with its elevated sloped roof space.
16. **Item H** (pages 59-61) appears to be an extract from a short article headed "Stealth camper vans" from the website Campervan Life – date unknown. The article includes pictures of the exterior of a typical looking white transit van with no side windows and a picture showing the interior as featuring, for example, a sink and sleeping area. The opening line of the article reads: "Stealth camper vans are home made camper vans that do not look like a camper van from the outside". The website has a ".com" suffix, which reveals little as to its target audience, but I note that the UK (alone) is referenced in the exhibit, where it identifies as a disadvantage of such a vehicle that it is "not possible to register the vehicle as a camper van in the UK. Camper vans must have windows in the side".
17. **Item I** (pages 62-63) shows an article – date unknown - entitled "Turn a car into a campervan - Berlingo stealth camping", which is from a website called campfiremag with a .co.uk suffix. The article includes the caption "Testing out the stealth camper ... in the Lake District". It includes tips on "how to turn your everyday car or van into an affordable, part-time camper". It indicates no modifications to the car itself (such as a raiseable roof), rather it involves less physically interventionist ideas such as storage boxes and self-inflating mattresses.
18. **Item J** (pages 64-66) shows a discussion thread on a website called UKCampsite.co.uk. The discussion topic is headed "Van To (Stealth) Camper Conversion" and the thread is dated September 2015. The initiating message explains that the poster would like to convert his Fiat Ducato van "to a stealth camper" and he enquires about where on a vehicle vents may feasibly be positioned. One of the respondents gives his view that "it would be easier to make it discreet rather than completely stealthy."

19. **Item K** (pages 67-70) is an article entitled "How to create a stealth van dwelling and stealth van living on a budget". The article is dated September 13 2013 and has a URL Stealthvardovan.wordpress.com/tag/ventilation-for-living-in-a-stealth-van. The article clearly originates from the USA, with references to that country and pricings given in dollars.

The Applicant's evidence

20. The Applicant's evidence comprised a **Witness Statement** dated 5 June 2019 by **Andrew John Gosling**, together with **Exhibits AJG1 – AJG11**. The skeleton argument filed by the Applicant explains that these materials are intended as evidence of use and reputation of the sign STEALTH for the goods and services applied for; the Applicant submits that the materials support its position that if the sign were found to be inherently descriptive (denied by the Applicant) then the sign has become distinctive through use.
21. Mr Gosling has been a Director at the Applicant company, since its incorporation on 13 April 2016. Mr Gosling states as follows:
- i. by the time of the Applicant's incorporation he had designed a "new, state-of-the-art elevating roof for vehicles and particularly for camper vans";
 - ii. the roof was initially marketed from around July 2016, leading up to the official launch of the product at the 2016 Busfest trade exhibition in early September 2016;
 - iii. Stealth was first adopted as a trade mark in June 2016 and was advertised as such on the Applicant's website and Facebook page from 2016.
22. **Exhibit AJG1** shows pages said to be from the Applicant's website as from 3 September 2016. The exhibit shows the Applicant's name prominently rendered in stylised form:
-  and beneath various picture of vans with an elevating roof, are the plain words "LOW LIFE STEALTH ROOF", with the information "£4500 Fitted Price Inc VAT" and the invitation to "come and see us at Busfest 2016". (I note that **Exhibit AJG7** shows a Wikipedia entry describing the Busfest Festival – shown to have last edited on 30 April 2018. The entry states that it is a 3-day event held in Worcestershire, and which is the largest VW Transporter festival in the world, with over 350 trade stands and up to 45,000 people and 9000 vans attending.)


23. Page 2 of **Exhibit AJG1**, said to date from July 2016, shows a web page including various tab headings eg “HOME”; “ABOUT US”; “GALLERY”; “SHOP”; “INSTALLERS”; “CONTACT” – and one headed “STEALTH ROOF”. The page shows the gallery page with a sub-heading ELEVATING ROOF, with references to ”T5 Pop Top” and “T5 Stealth Roof”.

24. Page 3 of **Exhibit AJG1** shows pictures (from the Applicant’s Facebook) of the Applicant in attendance at Busfest 2016, along with a VW van. The branding on the sail signage in the photos appears to relate exclusively to the stylised version of the Applicant’s name,



(), with no reference to “stealth”. The text accompanying the posted photos (on 9 September 2016) refers to the opportunity to see “the first Stealth roof to be fitted and our Full carbon t5 1 bonnet skin and Carbon Bonnet”. The capitalisation indicates to me use as a trade mark.

25. Page 4 is said to show a post from 3 September 2019, again with the stylised version of the Applicant’s name, the plain text “LOW-LIFE STEALTH ROOF READY FOR BUSFEST

2016”, and the following sign:  , involving the word “stealth”, albeit not in plain text as applied-for. The reference to “LOW-LIFE STEALTH ROOF” is ambiguous as to whether it would be perceived as use of the word as a trade mark, but the stylised presentation of the word would be perceived as a trade mark.

26. Page 6, 7 and 8 show promotional flyers, which feature references to the Applicant’s name


in stylised form and again to  , above smaller text reading “the low profile, carbon composite elevating roof” and a URL as follows: “www.thestealthroof.co.uk”. Mr Gosling states that these flyers were distributed in 2016 and they refer to that year in the form of a URL “www.facebook.com/2016low”.

27. **Exhibits AJG2** and **AJG3** shows pages from the Applicant’s websites at “www.low-life.co.uk” and at “www.thestealthroof.co.uk” respectively. Mr Gosling states that those pages were printed in April 2019. This is clearly a year after the relevant date, but for the sake of completeness I note the following points. Page 2 of Exhibit AJG2 includes a review by someone named Mike, who describes himself as “no Pop Top expert” and whose review opens with the statement that “It was a hard decision to pick a Stealthy pop top roof that

minimised the change to the van profile, in the end I chose Low Life and I am now very glad I did.” The website exhibits state that “Low-Life started as an idea to design a new state-of-the-art elevating roof” and is now designing products “to complement T4-T5 & T6 vehicles” and that the relevant teams have brought together their aeronautical experience “to the design and development of the stealth roof”. Elsewhere there is reference to “the Low-Life product range including the new Stealth Roof”, and to “customisation of camper vans with an entire range of LowLife VW T5 and T6 Products so if it’s the ultra-sleak LowLife ‘stealth’ carbon fibre composite elevating roof you are after...”. There are also depictions of a stylised rendering of the word “**STEALTH**” above the word “BULLET” and (separately) the word “PRIME”.

28. Mr Gosling states that the approximate annual sales turnover relating to the sale of the Applicant’s STEALTH elevating roofs since September 2016 is:

2016	Approx. £20,000
2017	Approx. £54,000
2018	Approx. £240,000

29. **Exhibit AJG4** shows various invoices headed . Most show invoice dates from 2018 that are later than the relevant date. All pricing figures are redacted. Only two invoices are shown as falling ahead of the relevant date – one from October 2016, the other from November 2017 which relate, inter alia to “SWB t5/T6 STEALTH ROOF IN PLAIN CARBON” and to “Trade Stealth Caravelle Kit”. It is impossible to gauge from the evidence presented a clear figure of the turnover before the relevant date, especially as the 2018 figure is given as a total for that year, whereas the relevant date is 7 April 2018.

30. Mr Gosling states that the Applicant’s STEALTH elevated roofs have been the subject of significant media attention. Mr Gosling illustrates that claim by reference to **Exhibit AJG5**, which shows the cover of Issue 59 (October 2017) of a magazine called VWt, whose strapline declares it “The only VW Transporter magazine you need!”. It shows two pages of an article headed “Pop-top guide – a selection of what’s out there if you want to add some additional space to your Campervan”. Among eleven short profiles is one headed “Low Life” and the text includes: “Brand new to the market, the Low Life Stealth roof ... As the name

suggests, its biggest selling point is its low profile, making it barely indistinguishable [sic] from a standard roof.”

31. Mr Gosling states that the Applicant does not incur significant advertising costs since “much of its promotion is generated by third parties on social media”. He states that the Applicant has advertised in “VW Bus T4&T5 Magazine” and **Exhibit AJG6** shows copies of such advertisements and related invoices for several issues of the magazine from October 2016 to January 2018. Each advert appears to have cost around £275. Each refers to



and to



and one includes the text “INSTALLERS

OF STEALTH ROOFS, AUSTOP ROOF, DIESEL HEATERS, WINDOWS ..”. Mr Gosling estimates the Applicant’s advertising spend on STEALTH elevating roof products throughout the UK as £1000 in 2016 and £2400 both in 2017 and 2018.

32. **Exhibit AJG8** presents website analytical data for the low life website for the period April 2018 – April 2019. This shows a total of 579 hits over that 12-month period, but clearly the period is very largely after the relevant date.

33. Mr Gosling states that the Applicant has attended various exhibitions or trade shows to exhibit its “Stealth Elevating roof” and at **Exhibit AJG 9** provides copies of invoices for the pitch spaces at Busfest 2016, Camperjam 2017, VW Camper & Bus Show 2017, Busfest 2017 and Busfest 2018. Mr Gosling also refers to the Applicant advertising on various Volkswagen-specific internet forums. He states that between May 2017 and May 2018 the Applicant paid for its own dedicated 'classified' page on the Volkswagen VW T4 T5 Forum, which he states is the UK's largest online community forum and is visited around 225,000 times each month. He states that it is especially popular with people who are looking to convert their vans into campers, and who are looking for information and advice on available products etc. before beginning their conversion project. Mr Gosling states that the Applicant’s dedicated classified page gave it commercial access and exposure to the forum visitors, and that all content was posted organically on Google, giving good SEO (search engine optimization) presence. **Exhibit AJG11** shows a screenshot of that forum, where one of the links, updated in May 2017, has the title “Introduction to Stealth Roof” and had received 1019 views.

34. As to the use of “STEALTH” as a trade mark, Mr Gosling states as follows:

- i. he is not aware of any third parties using the word STEALTH as a trade mark for their elevated vehicle roofs;
- ii. nor is he aware that STEALTH is a descriptive word to describe 'elevating roofs';
- iii. as far as he is aware the Applicant was the first to adopt the trade mark STEALTH in relation to elevating vehicle roofs;
- iv. the word "Stealth" is perceived by the UK public in relation to aircraft or to 'stealth' technology which makes detection by radar or sonar difficult (e.g. a 'stealth bomber'). However, the word 'stealth' has no meaning in relation to "elevating vehicle roofs";
- v. at no point prior to the Applicant's product being first marketed in 2016 did the Opponent or any other elevating roof manufacturer describe their products using the word 'Stealth'. The Opponent's roof was known as the "Hilo roof" and the Applicant's roof as the "Stealth."

THE LEGISLATION

35. Section 3 of the Act deals with the so-called "absolute grounds" for refusal of registration, based on the inherent characteristics of the trade mark concerned, and provides as follows:

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

(a) [...]

(b) [...]

(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.

CASE LAW (AND A NOTE ON CITATION)

36. The principles to be applied in determining whether a trade mark is open to objection under sections 3(1)(c) and/or (d) of the Act and, if it is, whether or not it has acquired distinctive character by virtue of the use that has been made of it, are well- established and have been

restated many times by courts at varying levels. I refer below to such case law principles, drawn from a range of sources.

37. Noting that the Applicant has no legal representation, it may be helpful to explain at the outset why this decision includes as the basis of its findings various judgments of the Court of Justice of the European Union (“**the CJEU**”), which refer not to sections of the UK’s Trade Marks Act 1994, but instead to various “articles”. The reason is that the laws relating to trade marks are very largely harmonised across all countries in the EU. References to articles of the Regulation are concerned with the framework legislation (the Regulation) that governs the EU-wide Community Trade Mark (or EUTM as it is now known). References to articles of the Directive are concerned with the framework legislation (the Directive) that sets the requirements that all countries in the EU must reflect in their own legislation – such as the Trade Marks Act 1994 in the case of the UK. Given the very close harmonisation across all those various frameworks, articles find equivalent provisions in the Act, and since the CJEU is the highest court on trade mark matters, its rulings are directly relevant.

Case law on section 3(1)(c) of the Act

38. The principles to be applied under Article 4(1)(c) of the Directive/Article 7(1)(c) of the Regulation, which correspond to the provisions of section 3(1)(c) of the Act, were summarised by the CJEU in Case C-51/10P *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market* [2011] ECR I-1541 as follows (citations omitted)³:

"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 ...

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

³ See Arnold J at paragraphs 66 – 76 in LNDR case: Frank Industries Pty Ltd v Nike Retail BV [2018] EWHC 1893 (Ch) (25 July 2018)

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

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM⁴ 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

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 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

...

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.

⁴ OHIM stood for the "Office for Harmonisation in the Internal Market" which was the body whose functions included the registration of EU-wide trade marks, and which is now known as the EUIPO.

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 ...".

39. In addition, a sign is excluded from registration by Article 4(1)(c)/Article 7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned.⁵

40. The Applicant's skeleton argument referred to the statement of the law by Floyd LJ in *JW Spear & Sons Ltd and Others v Zynga Inc.* [2015] EWCA Civ 290:

"79 Thus it is the presumed perception of the average consumer which is relevant. It is not of course enough if the connection between the signs and a characteristic of the goods does not dawn immediately on the average consumer. If it requires any thought or explanation it is not "easily recognisable".

...

82 It is nevertheless the case that signs which are candidate trade marks lie on a continuum between the entirely generic, through the descriptive to the inherently distinctive. Not every word which alludes to or is suggestive of some aspect of the goods or services is necessarily unregistrable. It is of course trite that it is not an objection to registration that the word has a dictionary meaning, or is an ordinary English word. The objection bites on relationships between the word and the characteristics of the goods or services for which it is sought to be registered which the average consumer will immediately perceive."

41. Floyd LJ agreed with the analysis of the Advocate General in his opinion in *Doublemint*⁶, which provided the following helpful guidance:

⁵ See Case C-191/01 Office for Harmonisation in the Internal Market v Wm Wrigley Jr Co [2003] ECR I-12447 at [32] and Case C-363/99 Koninklijke KPN Nederland BV v Benelux-Merkenbureau [2004] ECR I-1619 at [97].

⁶ Case C-191/01 P Office for Harmonisation in the Internal Market (Trade Marks and Designs) v Wm Wrigley Jr Company.

“61. It seems obvious that there is no clear-cut distinction between indications which designate a characteristic and those which merely allude suggestively to it. There is no precise point at which a term suddenly switches from one category to the other, but rather a sliding scale between two extremes and an element of subjective judgment will often be required in order to determine to which extreme a term is closer. In the light of existing practice and case-law, and with a view to establishing a slightly greater degree of objectivity, I would suggest that a proposed trade mark should be assessed from three points of view, although I would not claim that list to be final or exhaustive.

62. The first point of view concerns the way in which a term relates to a product or one of its characteristics. The more factual and objective that relationship, the more likely it is that the term may be used as a designation in trade, so that registration will be precluded by Article 7(1)(c); conversely, the more imaginative and subjective the relationship the more acceptable the term will be for registration.

63. The second point of view concerns the way in which a term is perceived: how immediately is the message conveyed? The more ordinary, definite and down-to-earth a term is, the more readily a consumer will apprehend any designation of a characteristic and the more likely the term thus is not to qualify for registration as a trade mark. Where at the other extreme the skills of a cryptic crossword enthusiast are needed in order to detect any connection with the designated characteristic, the grounds for refusing registration are very weak indeed.

64. The third point of view concerns the significance of the characteristic in relation to the product, in particular in the consumers mind. Where the characteristic designated is essential or central to the product, or is of particular importance in a consumer's choice, then the case for refusing registration is compelling; where the designation is of a characteristic that is purely incidental or arbitrary, the case is considerably weaker.

65. I would stress however that the question of precision, accuracy or factual correctness is not normally relevant to the examination from any of those points of view. As I have stated above, practically any designation of a product characteristic can be rendered more precise, and it is obvious that descriptions used in trade may be

untruthful whilst still serving to designate product characteristics indeed, it is for that very reason that misleading descriptions are generally prohibited.

66. Once a proposed trade mark has been assessed separately from each of the three proposed points of view, a final decision must be taken. It is impossible to lay down absolute rules, but in general it would seem plausible that a mark should be refused registration under Article 7(1)(c) if, overall, it appears to be nearer the 'non-registrable end of the scale taking the three points of view into account or if, from even one point of view, it is particularly near that end of the scale.”

Decision of the section 3(1)(c) ground

42. Having set out the relevant law and legal principles, I now take stock in light of the claims and evidence in this case. My task is to decide, whether, on 7 April 2018, when the Applicant applied for its mark, the word “stealth” was descriptive of any characteristic of the goods and services applied for. For any such goods and services where that is the case, the mark’s registration would be objectionable under section 3(1)(c), since descriptive words should be kept available to be freely used by all traders in the marketing of such goods and services.
43. **The average consumer** – The CJEU has made clear that to assess whether a national trade mark is descriptive of the goods or services in respect of which its registration is sought, “it is necessary to take into account the perception of the relevant parties, that is to say in trade and / or amongst average consumers of the said goods or services, reasonably well-informed and reasonably observant and circumspect, in the territory in respect of which registration is applied for ...”.⁷ Ms Moss McGrath submitted at the hearing that the average consumer for the goods and services at issue, would be a self-selecting sub-set of the general public, who have an interest in creating a vehicle that may be used for touring and sleeping in. In my view, the evidence indicates that that is a reasonable conception of the average consumer in this instance, although I do not cast such a member of the public as having specialist knowledge.
44. The Applicant’s defence to the opposition has two limbs. The first, is that its trade mark is acceptable prima facie; if that defence fails, it relies on the use that has been made of the

⁷ For example, see paragraph 24 *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04.
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trade mark, invoking the proviso to section 3(1) of the Act.⁸ The Applicant's submissions included the following:

“Just because the Opponent has managed to locate a handful of Internet extracts from as long ago as 2011 (some of which clearly relate to the US market and are therefore not relevant) that supposedly show STEALTH being used to describe a form of undetectable camping falls an extremely long way short of supporting its assertion that the relevant public would immediately perceive STEALTH to be a description of a characteristic of the goods/services at issue in the present case. If such an association were really immediate in the minds of the consumers then the evidence would be plentiful and the Opponent would have been able to confine the examples it chose to recent pages that clearly relate to the UK market”

45. In making my decision I fully recognise the difficulty of determining whether the Applicant's mark occupies such a point on the scale of descriptiveness that its use in relation to the goods and/or services at issue would fall foul of section 3(1)(c). I note that in its skeleton argument the Applicant provided a fall-back position limited to permit the deletion of the terms “*Parts and fittings for land vehicles; parts and fittings for vehicles*” from its Class 12 goods. (In my view if the opposition were to fail in relation to raiseable roof goods, there were be still less possibility of success in relation to other parts and fittings for vehicles.)
46. I bear in mind that is necessary to consider whether there is a sufficiently direct and specific relationship between “stealth” and the goods or services concerned that enables the relevant public immediately to perceive, without further thought, a description of those goods or services, or of one of their characteristics. The premise of the objection under section 3(1)(c) is that the word that is the Applicant's mark is directly descriptive in relation to camper vans that are deliberately designed not to look like camper vans, such that they offer a discreet vehicle with added security and privacy, suitable for urban camping. Ms Moss McGrath acknowledged at the hearing that the characteristic of “stealth” in this context is not one in common reference in society at large. However, she submitted that the term is well used and understood within the relevant consumer group i.e. those looking to convert vehicles into camper vans and therefore seeking out the niche goods and services of the Applicant.

⁸ This was foreshadowed in its notice of defence and made clear from its skeleton argument.

47. The Applicant is fair to observe that a good deal of the evidence from the Opponent appears to originate from or focus on the USA and is thus of very limited relevance in disclosing the situation in the UK. That said, the Opponent's evidence does show the term deployed in the UK, before the relevant date, by those with an interest in such matters, although the items of evidence that clearly connect to the UK are limited to **Items D, F, G, H and J** in the Opponent's **Exhibit FS2**.
48. Perhaps the high point of that evidence is **Item G** drawn from the online version of *The Telegraph* newspaper, where the headline refers to "the ultimate 4x4 stealth camper". Ms Moss McGrath submitted at the hearing that such an article would be read by the public at large, and while the goods and services may be somewhat niche, the meaning of the term would be understood by readers of the article and the headline does not resort to placing inverted commas around the word "stealth". Indeed, Ms Moss McGrath referred elsewhere in her submissions to the fact that nowhere in the evidence does anyone express that they do not understand the term. While that is true, it is also true that in several instances the term is effectively explained in context. Moreover, the evidence of the Opponent's **Item F** indicates that even for the seemingly veteran forum contributor, the "stealth idea" was not one that they had ever thought of. On the other hand, I also note that one of the two reviews on page 2 of **Exhibit AJG2** of the Applicant's own evidence (from after the relevant date) uses the word "Stealthy" in relation to his selection of raiseable roof "that minimised the change to the van profile" and that that reviewer considers himself "no Pop Top expert".
49. Considering the evidence in the round, I recognise that the concept of a 'stealth campervan' may be one that has some currency for at least some among the relevant consumer. However, the evidence is very scant and is bolstered by related references to 'stealthiness', 'stealthy' and to 'stealth camping'. To the extent that the exact word "stealth" is used, it relates almost exclusively to the van entire. Notwithstanding that a central aspect to the "stealth" quality or characteristic of a "stealth camper" may be the nature of the roof⁹, the evidence shows no reference to the use of the contested word directly in relation to any of the specific goods and services under the application, on which I must focus my determination of the claims. That said, I do not overlook that, according to case law, there is no need for the word "stealth" to have actually been in use on the relevant date in a way

9 I note here **Exhibit AJG5** – although I also note that no such roof featured under **Item I**.

that describes a characteristic of all or some of the goods or services to be registered under that mark – it would be enough that those words could be used in that way.¹⁰

50. In the appeal case BL O-281-04, Professor Ruth Annand, sitting as the Appointed Person, examined the evidence filed to support claims under sections 3(1)(b), (c) and (d) of the Act, including a claim that the word “stash” was descriptive in relation to items of sports clothing. In that case the Applicant had conceded that there was some descriptive use amongst a small group of persons (albeit those linked to the Opponent or the Applicant on a professional or personal level); indeed, the number of instances of such use in evidence were more numerous than in the present case before me. I note in particular that in contrast to the present (stealth) case, the contested word “stash” was used directly in relation to goods under the Applicant’s specification – the clothing was described as the “stash”. Professor Annand admitted at paragraph 36 of her decision that she had not found the issue easy to determine, but concluded that the evidence (which included “a few random Google hits of possibly descriptive uses”) did not sustain an objection under section 3(1)(c) of the Act. Professor Annand also noted, at paragraph 35 of her decision, that it is sufficient if the trade mark, when used in relation to the goods or services, is likely to be viewed as an indication of origin by at least a significant proportion of the relevant buying public, citing C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779 para. 52, and Case C-299/99 *Koninklijke Philips Electronics NV v. Remington Consumer Products Ltd* [2002] ECR I-5475, paras. 59 – 61.
51. **Exhibit FS1** gives a definition of “stealth” as a “modifier (chiefly of aircraft)”, meaning “designed in accordance with technology which makes detection by radar or sonar difficult.” Application of the term to the context of land vehicles is a departure from that, all the more so with the removal of the radar or sonar evasion aspect. Such departure from an archetypal/original meaning of the term diminishes the degree to which the relationship vis-à-vis road vehicles may be considered “factual and objective” and “down to earth”; the degree is still further diminished vis-à-vis the specified goods and services, where the meaning of the word becomes all the more “imaginative and subjective” (to quote Floyd LJ in *Doublemint* supra).

¹⁰ See para 38 of Case C-51/10P *Agencja Wydawnicza Technopol* above.

52. While I have acknowledged at paragraph 45 above the difficulty of gauging the proper placement of words on a scale of descriptiveness/allusiveness, I conclude that the word 'stealth' is not inherently apt to describe concealed roofs in camper vans, nor the associated services. The General Court, in Case T-215/16, rejected a similar argument that AMPHIBIAN was descriptive of waterproof watches by analogy with use of that term (and amphibious) to designate vehicles for use on land and water. The court held that was a particular use and did not alter the basic meaning of the word amphibian as indicated in the dictionary. I am not satisfied that "stealth" is sufficiently descriptive of the goods and services to fall foul of the section 3(1)(c). In my view, the relevant public, reasonably well informed and reasonably observant and circumspect, may perceive an allusive aspect to the mark (some may not) and the mark would likely to be viewed as an indication of origin. **The claim under the section 3(1)(c) ground fails.**

Case law on section 3(1)(d) of the Act

53. The case law position under the equivalent of s.3(1)(d) of the Act was summarised in *Telefon & Buch Verlagsgesellschaft GmbH v OHIM*, Case T-322/03 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, 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).”

Decision of the section 3(1)(d) ground

54. “Customary” is defined in the Oxford English Reference Dictionary, 1995 as: “usual; in accordance with custom”. Whereas the phrasing of section 3(1)(c) – “may serve” – allows for potential future use, a section 3(1)(d) claim is necessarily more dependent on the cogency of the evidence filed.

55. At paragraph 30 of STASH, Professor Annand noted her view that “there are two separate limbs of section 3(1)(d). A mark must be refused registration if, in relation to the goods or services applied for, it has become customary: (a) in the current language; or (b) in the bona fide and established practices of the trade.” In the present case, there is no evidence of (b). As to (a), the small number of relevant internet hits identified prior to the relevant date is insufficient; I do not find that the Opponent has made out its claim that the word STEALTH has become commonly used among the relevant public to indicate vehicle roofs and other parts and fittings of vehicles that are not visible unless used or otherwise not normally visible. Nor is there such evidence in relation to the services. **The section 3(1)(d) claim therefore fails.**

Acquired distinctiveness

56. In the circumstances, it is unnecessary for me to consider the Applicant's claim that it has a defence arising out of the proviso under section 3(1) that a mark shall not be refused registration by virtue of sections 3(1)(c) or (d) 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. However, for the sake of completeness, I note below my considerations and findings on the defence.

Case law principles on acquired distinctiveness

57. The following propositions are settled by the case law of the CJEU.¹¹ First, for a trade mark to possess distinctive character, it must serve to identify the goods or services in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish the goods or services from those of other undertakings.

58. Secondly, the distinctive character of a trade mark must be assessed by reference to (i) the goods or services in respect of which registration has been applied for and (ii) the perception of the average consumer of those goods or services, who is deemed to be reasonably well-informed and reasonably observant and circumspect.

59. Thirdly, the criteria for assessment of distinctive character are the same for all categories of trade marks, but nevertheless the perception of the relevant public is not the same for all categories of trade marks and it may therefore be more difficult to establish distinctive character in relation to some categories (such as shapes, colours, personal names, advertising slogans and surface treatments) than others.

60. Fourthly, in assessing whether a trade mark has acquired a distinctive character the competent authority must make an overall assessment of the relevant evidence, which in addition to the nature of the mark may include (i) the market share held by goods bearing the mark, (ii) how intensive, geographically widespread and long-standing the use of the mark has been, (iii) the amount invested by the proprietor in promoting the mark, (iv) the proportion of the relevant class of persons who, because of the mark, identify the goods or services as emanating from the proprietor, (v) evidence from trade and professional associations and (vi) (where the competent authority has particular difficulty in assessing

¹¹ As summarised by Arnold J (starting at paragraph 69) in LNDR (Frank Industries Pty) cited above.

the distinctive character) an opinion poll. If the relevant class of persons, or at least a significant proportion of them, identifies goods or services as originating from a particular undertaking because of the trade mark, it has acquired a distinctive character.

61. Fifthly, with regard to the acquisition of distinctive character through use, the identification by the relevant class of persons of the product or service as originating from a given undertaking must be as a result of the use of the mark as a trade mark. The expression "use of the mark as a trade mark" refers solely to use of the mark for the purposes of the identification, by the relevant class of persons, of the product as originating from a given undertaking.
62. Sixthly, a trade mark may acquire a distinctive character in consequence of the use of that mark as part of, or in conjunction with, another trade mark (which may itself be a registered trade mark).
63. Seventhly, it is not possible to state in general terms, for example by referring to predetermined percentages relating to the degree of recognition attained by the mark within the relevant section of the public, when a mark has acquired a distinctive character through use. Nor can the results of a consumer survey be the only decisive criterion to support the conclusion that a distinctive character has been acquired through use.
64. Eighthly, the trade mark applicant or proprietor must prove that the relevant class of persons perceive the goods or services designated exclusively by the mark applied for, as opposed to any other mark which might also be present, as originating from a particular company. It is not sufficient for the applicant or proprietor to show that a significant proportion of the relevant class of persons recognise and associate the mark with the applicant or proprietor's goods.

Application of the principles in this case

65. Had the Opponent succeeded in making out a *prima facie* case on its section 3 objections (if, for example, I had concluded that the mark fell on the descriptive side of the spectrum, not the allusive), the onus would have shifted to the Applicant to make out its defence under the proviso. In assessing the Applicant's evidence of use, I note the following points favourable to the Applicant's defence:

- The evidence shows that the Applicant has used the sign as a trade mark in relation to its elevating roof (and related fitting services). The plain word “stealth” is used, as well as the stylised version, which I consider an acceptable variant use in line with fair and normal use of the plain word. The sign is also shown used in combination with the name of the Applicant company, but that the sign has been used alongside another mark is not a fundamental objection to acquired distinctiveness. There are one or two instances where the Applicant itself has put inverted commas around the word, or where the word is deployed with its “S” sometimes uppercase, sometimes and lowercase, but, overall, the evidence is clear on the trade mark usage.
- The Applicant has provided evidence of promotion of its mark via various targeted avenues, including: (i) in early September 2016 in the run-up to Busfest, which event is a significant festival for those interested in the relevant vehicles. The extent of the promotion is not fully clear, but it included flyers and use of a website URL “thestealthroof.co.uk”; (ii) in various relevant trade publications, both by way of regular advertising (**AJG6**) and by article content (**AJG5**); (iii) the goods / services have been regularly promoted at relevant trade shows (**AJG9**) (iv) by paid-for online insertions targeting relevant audiences (**AJG11**).
- The Applicant has achieved rapidly growing sales in the relevant period.

66. As against the above, I note the following weaknesses:

- there is no evidence on the size of the market for the registered goods and services or the share held;
- the duration of use by the relevant date is relatively limited; Mr Gosling refers to first adoption as a trade mark in June 2016, but the evidence is clearer in establishing use from July 2016, thus showing approximately 19 months of use up to 7 April 2018;
- actual expenditure on promotion and advertising is modest in absolute terms (not more than £2400 annually);
- sales in the months of use are not numerous in absolute terms – for example, based on the installation of each roof costing £4500 (as the evidence states), there would have been 4-5 installations in 2016, 12 in 2017 and around 53 in 2018 (some of which – presumably most - will have been after the relevant date).

67. Taking account of all relevant factors (including the nature of the mark), I would have had to conclude that the Applicant could not claim to have attained acquired distinctiveness in the mark for its goods and services: the market size and the evidenced reach of the Applicant's promotional activities are too uncertain and the Applicant's level of sales too modest.

Outcome

68. The application may proceed in full to registration, as indicated below:

Class 12: *Parts and fittings for land vehicles; parts and fittings for vehicles; roof linings for vehicles; hard roofs for vehicles; textile roofs for vehicles; roof panels for land vehicles; folding roofs for motor vehicles; elevating roofs for motor vehicles; sliding roofs for motor vehicles; convertible roofs being parts of cars; articulated support frames adapted for use with vehicles; vehicle body modification parts for sale in kit form; parts, fittings and accessories for all the aforesaid goods.*

Class 37: *Converting motor vehicles into campervans and motor caravans; vehicle roof restoration; vehicle roof repair; vehicle roofing installation; application of waterproof coatings for vehicle roofs; vehicle roof installation services; vehicle roofing repair; raising roofs for motor vehicles; maintenance and repair of motor vehicle roofs; vehicle roof installation services; installation of vehicle roofing; installation of parts for vehicles; repair of vehicle roofs; advice, information and consultancy services relating to all of the aforesaid services.*

COSTS

69. The opposition has failed and the Applicant is entitled to a contribution towards its costs of defending its application. As a litigant in person, the Applicant is entitled to £19 per hour according my assessment of the tasks undertaken. In the costs proforma submitted during the proceedings the Applicant claimed as follows:

Considering the other side's statement and preparing a counterstatement - 6.5 hours

Preparation of written submissions - 16 hours

Preparation of skeleton arguments - 3.5 hours

70. The Applicant would have had to research the area of law to prepare the written materials as it did and to gather and file its evidence. I consider the 26 hours claimed in total to be fair. At £19 per hour this totals £494.

71. I order The Hilo Roof Company Ltd to pay LowLife Products Ltd the sum of £494 (four hundred and ninety four pounds) which, in the absence of an appeal, should be paid within 21 days of the expiry of the appeal period

Dated this 17th day of December 2019

**Matthew Williams
For the Registrar**