

O-934-21

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION NUMBER 3643288
BY PANAYIOTIS THEOKLITOU
TO PROTECT THE FOLLOWING TRADE MARK IN CLASSES 32 AND 33:**

DRINK SOCIALLY RESPONSIBLY

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Background

1. On 18th May 2021, PANAYIOTIS THEOKLITOU ('the applicant') applied to register the above mark
2. Registration was sought in classes 32 and 33 for the following goods:
Class 32: Non-alcoholic beverages; non-alcoholic drinks; non-alcoholic spirits; non-alcoholic aperitifs; non-alcoholic preparations for making beverages; non-alcoholic cocktail mixes; non-alcoholic cocktails; tonic water; carbonated soft drinks; non-carbonated soft drinks; cola drinks; soda water.
Class 33: Alcoholic beverages (except beer); spirits; gin; vodka; rum; bourbon; whisky; whiskey; rye whiskey; absinthe; vermouth; ouzo; tequila; cachaça; pre-mixed alcoholic beverages; alcoholic cocktails; liqueurs.
3. On the 14th of July 2021, the Intellectual Property Office ('IPO') issued an examination report in response to the application. In that report, an objection was raised under section 3(1)(b) of the Trade Marks Act 1994 ('the Act') which reads as follows:

Absolute grounds for refusal

Section 3(1)(b)

The application is not acceptable in Classes 32 and 33. There is an objection under Section 3(1)(b) of the Act as the mark consists of the non-distinctive phrase 'DRINK SOCIALLY RESPONSIBLY' which would be perceived by the average consumer as a plain and ordinary message reminding them not to overconsume the goods.

Therefore, the average consumer would simply perceive the phrase as a banal cautionary statement on the goods and not as a distinct badge to denote brand origin.

When a sign is devoid of distinctive character it is considered that it cannot function as a trademark, whose purpose is to guarantee the commercial origin of the goods. Further information detailing what

constitutes a distinctive trade mark can be found on our website by following [this link](#).

4. On the 19th of July 2021 the appointed representative of the applicant, Dr Christopher G Pike of Sterling IP Ltd, filed written submissions in favour of the application. He opened these submissions by giving a brief summary of the concept of “social responsibility”. He stated that it is an ethical framework that suggests that an individual or organization has an obligation to work and cooperate with others for the benefit of society at large. In a commercial context, the term is applied to an individual or organization that takes active steps to create a positive impact on society while doing business. The concept is further discussed at https://en.wikipedia.org/wiki/Social_responsibility.
5. Dr Pike continued these submissions by stating that the applicant’s business fully embraces the concept of “social responsibility” and intends to be a leader in the drinks industry in this respect. Accordingly, the applicant has developed a proprietary distillation method for spirits that uses substantially less water and energy than traditional distilling methods. Local ingredients are used to minimize food miles and harvested rainwater is used as a water source. No single use plastic packaging is used for any goods and all glass bottles are recycled and/or recyclable. Other packaging is made from sustainable sources and is fully compostable. A tree planting programme off-sets any carbon inputs. Overall, the intention is to work towards being a carbon negative business. Dr Pike stated that it is for these reasons that the Applicant has selected its mark, DRINK SOCIALLY RESPONSIBLY to convey to consumers its strong commitment to “social responsibility” in a distinctive and memorable way.
6. Next, Dr Pike argued that the mark consisted of two known phrases (listed below) that had been playfully and unexpectedly juxtaposed.
 - “Drink responsibly”, which may be perceived as an ordinary message not to overconsume the goods; and
 - “Drink socially” which may be perceived as an ordinary message to consume the goods in a social context.

Dr Pike stated that the mark ‘DRINK SOCIALLY RESPONSIBLY’ is submitted to playfully transcend these two known phrases by indirectly and unexpectedly also alluding to the concept of “social responsibility” in relation to drink. He added that in essence, the mark is submitted to be one of those, which may at first appear to have an ordinary meaning. However it gives rise to a playful and unexpected underlying (even, hidden) meaning that in this case, is submitted to powerfully and memorably convey the “social responsibility” commitment of the applicant’s business and provide an invitation to consumers to share in (‘drink to’) that commitment. He accordingly submitted that the mark is far from being a “banal cautionary statement” on the goods, as suggested by the Examiner. To the contrary, the mark is submitted to be distinctive, playful and memorable and thus, fully capable of distinguishing the applicant’s goods and business from those of another.

7. Dr Pike's final written submission argued that it is highly unusual to combine two adverbs side-by-side in an English language expression. He referred to a recent Google search that he had conducted on the words 'SOCIALY RESPONSIBLY' (included in an appendix to Dr Pike's submissions) which uncovered not a single instance of this combination, and instead the search engine only showed results for the phrase "socially responsible", which does not place two adverbs side-by-side.
8. On the 21st of July 2021, a response was issued maintaining the objection. The examiner disagreed that the mark would be perceived as having a playful and unexpected meaning, as well as disagreeing with the assertion that the combination of two adverbs in a sentence is unusual enough to imbue the sign with distinctive character.
9. The examiner also reiterated their original objection by stating that in their opinion the sign would simply be perceived by the average consumer as a banal statement on the goods, reminding them to consume the products in a responsible manner. He continued by providing the dictionary definitions of the words 'Socially' and 'Responsibly'. He stated the term 'socially' is defined in Cambridge dictionary as 'in or relating to a social situation' and the term 'responsibly' is defined as 'in a way that shows that you have good judgment and the ability to act correctly and make decisions on your own'. The examiner concluded by expressing that in his view the term 'DRINK SOCIALY RESPONSIBLY' when viewed in relation to the goods in question would simply be seen as a cautionary statement and not as a distinctive brand to denote trade origin. A video conference hearing was requested as a result of this response from the examiner.
10. On the 6th of September 2021 the hearing was held with Dr Pike of Sterling IP Ltd, with the applicant, Mr Panayiotis Theoklitou, also in attendance. Dr Pike reaffirmed the applicant's passion for Social Responsibility and provided further insight into what this concept actually is. I attended as the hearing officer. He argued that the mark itself is a forward looking, adventurous mark, that triggers a cognitive process in the mind of the average consumer to make them think about social responsibility in a clever way i.e. by purchasing the applicant's goods, the consumer is contributing to the concept of social responsibility. Dr Pike did acknowledge that this message is not immediately perceptible, however, when the consumer analyses the mark, or researches the applicant's company ethos, they would eventually make the connection, and would understand it as a clever and original mark. As a result, the mark does not convey a mere ordinary message but actually possesses a certain resonance that requires at least some interpretation by the relevant consumer, as quoted in paragraph 57 of the 'VORSPRUNG DURCH TECHNIK' decision of the CJEU (C-398/08 P). Dr Pike submitted that consequently, the mark cannot be said to be devoid of any distinctive character.
11. Dr Pike reiterated his written submission relating to the highly unusual use of two adverbs next to one another. He submitted that by doing so, the overall phrase resulted in a quirky sounding mark that further adds to the originality of the sign. Dr Pike relied on the appendix to his submission of 19th July 2021

to demonstrate that when the words 'Socially Responsibly' were entered into a Google search, the algorithms that power the search engine actually showed results for 'Socially Responsible' instead. Dr Pike claimed that this backs up his assertion that in the English language it is unusual to use two adverbs next to one another.

12. Dr Pike continued his submissions by stating that the mark was actually quite odd and thought provoking. He submitted that in the drinks industry the phrase 'Drink Responsibly' is well established and the meaning behind it is readily understood by the average consumer as an encouragement to consume alcohol sensibly. This being the case, when the consumer is confronted with the present mark, they would perceive it as a brand-new phrase that differs from the established and accepted phrase, making them think 'why?'. Dr Pike argued that at this point a cognitive process is triggered in the mind of the average consumer and as a result the mark takes some interpretation to gain a meaning from it. Subsequently, Dr Pike argued that this will get the consumer thinking about the message behind the mark and would encourage them to think about their own social responsibility.
13. Finally, Dr Pike expressed that he had anecdotally tested the mark on friends, family, and colleagues to gauge their reactions to the mark. He stated that whilst not all made the connection between the mark and the concept of social responsibility, a large proportion did. However, those that didn't, once the idea behind the mark had been explained to them, did see the connection, and found it to be somewhat clever.
14. On the 09th of September 2021 the hearing report was issued. In it I confirmed that the Section 3(1)(b) objection had been maintained on the basis that I did not consider the sign to possess distinctive character. Rather, I found it to simply give the non-distinctive message that encouraged a sensible drinking culture in social environments i.e. drink socially responsibly. I expressed my opinion that the average consumer, who I considered to be the general public in this case, would immediately understand the ordinary and natural meanings of the words contained within the mark, and would instantly extract a non-distinctive, promotional message from it, and nothing more. I submitted that in my view and taking into account the nature of the goods, that this would be a test of immediacy and disagreed that the average consumer would analyse the sign to any significant degree in which they would notice any other possible meaning, other than the obvious promotional message being conveyed.
15. I continued by stating that I disagreed with Dr Pike's submission surrounding the notion that an already existing and established phrase, that encourages sensible alcohol consumption, would result in the applicant's mark being considered unusual in the marketplace. I submitted that it was my opinion that instead they would just think that the sign is simply another non-distinctive, promotional phrase to raise awareness around the subject of sensible, social drinking and would not perceive it as a trade mark.
16. Finally, I disagreed with Dr Pike's submission that placing two adverbs side-by-side is odd in the English language. I stated that the Oxford English

dictionary defines ‘Adverb’ as ‘*a word or phrase that modifies or qualifies an adjective, verb, or other adverb or a word group, expressing a relation of place, time, circumstance, manner, cause, degree, etc.*’ (my emphasis). This shows that adverbs can be, and are, used next to or in conjunction with other adverbs in the English language. It does not appear to be grammatically unusual or grammatically incorrect therefore to use adverbs together. It was for these reasons that I refused the application.

17. On the 09th of October 2021 the applicant filed a Form TM5 requesting a statement of grounds. As such 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 for my decision and the materials used in arriving at it. No formal evidence of use has been put before me for the purposes of demonstrating acquired distinctiveness. Therefore, in respect of the goods listed in paragraph 1 above, I only have the prima facie case to consider.

The Law

18. 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) ...

(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)(b)

19. The Court of Justice of the European Union (‘CJEU’) has emphasised the need to interpret the grounds for refusal of registration listed in Article 3(1) of Directive 2008/95/EC (‘the Directive’, being the codified version of the original Directive 89/104/EEC) and Article 7(1) of Council Regulation (EC) No 207/2009 (‘the Regulation’, being the codified version of original Council Regulation 40/94), in the light of the general interest underlying each of them (Case C-37/03P, *Bio ID v OHIM*, para 59 and the case law cited there and, e.g. Case C-273/05P *Celltech R&D Ltd v OHIM*).
20. The general interest to be taken into account in each case must reflect different considerations according to the ground for refusal in question. In relation to section 3(1)(b) (and the equivalent provisions referred to above upon which section 3(1)(b) is based) the Court has held that “...*the public*

interest... is, manifestly, indissociable from the essential function of a trade mark” (Case C-329/02P Satelliten Fernsehen GmbH v OHIM ‘SAT.1’). The essential function thus referred to is that of guaranteeing the identity of the origin of the goods or services offered under the mark to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin (see paragraph 23 of the above mentioned judgment). Marks which are devoid of distinctive character are incapable of fulfilling that essential function. Moreover, the word ‘devoid’ has, in the UK at least, been paraphrased as meaning ‘unpossessed of’ from the perspective of the average consumer.

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

“A trade mark’s distinctiveness within the meaning of Article 3(1)(b) of the Directive must be assessed, first, by reference to those goods or services and, second, by reference to the perception of the relevant public, which consists of average consumers of the goods or services in question, who are reasonably well informed and reasonably observant and circumspect (see inter alia Joined Cases C-53/01 to C-55/01 Linde and Others 5 [2003] ECR I-3161, para 41, and Case C-104/01 Libertel [2003] ECR I-3793, paras 46 and 75).”

22. So, the question of a mark being devoid of any distinctive character is assessed by reference to the goods and/or services applied for, and by reference to the perception of the average consumer for those goods and/or services. I should also add that being ‘devoid of any distinctive character’ does not represent an objective standard, but is based upon an assessment which concludes that the sign presented for registration is ‘unpossessed’ of distinctive character from the perspective of the average consumer. Since, in the relevant authorities’ assessment, the sign is unpossessed of distinctive character (this has been, in turn, paraphrased as being ‘origin-neutral’ as distinct from ‘origin-specific’), the sign is not considered capable of performing the essential function of a trade mark.
23. In addition to considering the objection in respect of all the goods claimed I then need to assess whether promotional slogans can fulfil the function of a distinctive trade mark. Following from the CJEU guidance on cases such as *Sykes Enterprises v OHIM (Real People Real Solutions) [2002] ECR II-5179*, there had been a tendency to assume that promotional statements cannot possess the necessary distinctive character to indicate trade origin. This sort of assessment was based on the assumption that consumers are not in the habit of regarding slogans as trade marks, but instead regard them as purely promotional, non-distinctive material. Following the CJEU decision in Case C-398/08P *Audi AG v OHIM (‘Vorsprung Durch Technic’)* we now know that this

is only part of the consideration that must be made. In paragraph 44 of that decision, the Court stated:

“... while it is true... that a mark possesses distinctive character only in so far as it serves to identify the goods or services in respect of which registration is applied for as originating from a particular undertaking, it must be held that the mere fact that a mark is perceived by the relevant public as a promotional formula, and that, because of its laudatory nature, it could in principle be used by other undertakings, is not sufficient, in itself, to support the conclusion that the mark is devoid of distinctive character.”

24. It is also a well-established principle these days that the Registrar’s role in examination will involve a full and stringent examination of the facts, underlying the Registrar’s frontline role in preventing the granting of undue monopolies, see, to that effect, CJEU Case *C-51/10 P, Agencja Wydawnicza Technopol sp. z o.o. v OHIM* [2011] ECR I 1541. Whilst this case was, technically speaking, in relation only to section 3(1)(c) or its equivalent in European law, the principle about the ‘prevention of undue monopolies’ must hold good whether section 3(1)(b) and/or (c) applies.

Application of legal principles - section 3(1)(b)

25. In arriving at my decision, I first have to identify who the average consumer for the goods covered by the application is. The specification covers a range of beverage products in classes 32 and 33. I consider it reasonable to assume the relevant consumer to be the general public. The level of consumer attention for the goods covered by the application is likely to be moderate to low. It might be argued that the level of consumer attention for goods such as spirits may be higher, however in my opinion, the precise level of attention given to the purchase of these goods by the relevant consumer will not have a material impact on how they perceive the words of the application.
26. I now have to decide whether the sign applied for, used in relation to the goods claimed, would be seen as one which lacks any capacity *prima facie* to distinguish the products of one trader from those of another. I must consider the perception of the average consumer when seeing the words ‘DRINK SOCIALLY RESPONSIBLY’ in normal and fair use in relation to the goods claimed. Taking into account the fact that all of the goods claimed are those to be consumed I feel that the objection is valid in respect of all the goods. Some of the goods are alcoholic products and the sign ‘DRINK SOCIALLY RESPONSIBLY’ would be considered as a non-distinctive statement that encourages a sensible drinking culture in social environments. The objection is equally valid however in respect of the non-alcoholic products that can be used as mixers with alcoholic beverages and therefore the perception of the average consumer in this instance would be the same. One must be aware that the test is one of immediacy or first impression, as confirmed in the decision of ‘Real People Real Solutions’ referred to above, where it was stated:

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

27. It is necessary to start with a linguistic analysis of the words appearing in the mark in order to assess whether or not they are capable of performing the essential function of a trade mark. Although it is essential that any assessment of distinctiveness takes into account the mark's totality, it is also necessary to take into account the meaning of the individual parts of the mark.
28. The mark applied for consists of the phrase 'DRINK SOCIALLY RESPONSIBLY'. The Oxford dictionary defines 'DRINK' as a verb meaning '*consume or be in the habit of consuming alcohol*'. The same dictionary defines the word 'SOCIALLY' as an adverb meaning '*in the company of others, especially for pleasure; in a social manner*' and the word 'RESPONSIBLY' is defined as an adverb meaning '*in a sensible or trustworthy manner*'.
29. Used in respect of the goods intended for protection, I do not believe that consumers would perceive the phrase 'DRINK SOCIALLY RESPONSIBLY' as being anything other than a non-distinctive expression that encourages a responsible attitude to consuming alcohol in social settings. In this application, the sign appears in plain word type and has no stylisation, device elements or unusual grammatical juxtaposition, in my opinion, to give it any distinctive character enabling it to be registered. It is highly unlikely that the words alone would indicate, to consumers, the trade origin of the goods.
30. During the hearing I expressed my initial thoughts of the sign to Dr Pike and stated that in my opinion it would be perceived by the average consumer as a non-distinctive statement that would promote a sensible drinking culture, when in a social setting i.e. drink socially responsibly. I am fully aware that is inappropriate to base an objection solely around the promotional nature of the mark. In the VORSPRUNG DURCH TECHNIK decision (referred to in paragraph 10 above), the Court acknowledged that the fact that a slogan-type mark carries a promotional message does not, in and of itself, constitute a basis for refusal, i.e. a slogan can still denote commercial origin even if it is simultaneously performing a promotional purpose. This recognises that a promotional statement can also function as a trade mark. In paragraph 47 of that decision, the court confirmed that characteristics such as having a number of meanings, being a play on words, or being perceived of as imaginative, surprising and/or unexpected are, as a rule, likely to endow a sign with distinctive character (whilst also noting that such characteristics are not essential pre-requisites for a finding of distinctive character). The message to be taken from such comments is that one should avoid deeming a sign as being devoid of any distinctive character simply because it performs a promotional function. The question, however, is whether the particular mark applied for ONLY performs a promotional function and there is no possibility

of it ever, in the prima facie, performing the function of being a trade mark as well.

31. Thus, and based on normal and fair use, I have to decide whether the mark, which in my view would be considered to possess promotional overtones in that it would be seen as raising public awareness of sensible drinking in social situations, has any qualities over and above that, and which could raise this promotional message into a distinctive indicator of trade origin. It is clear from the comments of the court that where a sign (whether used in a promotional capacity or not) possesses 'originality' and 'resonance', and is capable of being remembered because of qualities arising from inter alia word-play, imagination, creativity or unexpectedness, then it cannot be considered to be completely devoid of distinctive character. This has been paraphrased or represented as 'leading the relevant consumer into some form of cognitive process whereby the message conveyed has to be interpreted in some form and is not merely obvious'. Having made a full semantic analysis of this sign, without pre-conception or pre-emption, and taking into account all known and relevant surrounding circumstances, I do not consider it to have any of the qualities that would enable this sign to be seen as a trade mark. The mark is not, in any way, imaginative, surprising or unexpected. Used on or in respect of beverages, it merely encourages the consumer to drink socially responsibly. In this respect, I have considered the comments made by the Appointed Person in BL O-353-10 BRING THE WORLD CLOSER where, at page 15, the following is stated:

"The expression... is caught by the exclusion from registration in section 3(1)(b) because it is liable to be perceived and remembered by the relevant average consumer as nothing more than an origin-neutral statement about the [goods] concerned. It appears to me to involve no verbal manipulation or engineering of the kind which, in other cases, has been recognised as sufficient to turn explanatory phraseology into a sign possessed of a distinctive character."

32. I do not believe that the sign in question has any features that would render it memorable in the eyes of the average consumer such that it would possess the duality of function acknowledged by VORSPRUNG DURCH TECHNIK. I consider it to be nothing more than an origin neutral phrase that encourages and advocates a sensible approach to consuming alcohol in social environments.
33. Additionally, I believe that Dr Pike's argument that it is grammatically unusual to place two adverbs together, as well as a Google search that in his opinion confirms this, is inherently flawed. I have established that the Oxford English Dictionary definition of the word 'Adverb' undermines this argument. For completeness, the Cambridge English Dictionary, the Collins English Dictionary, and the Merriam-Webster Dictionary all define 'adverb' in a similar way as shown below:

Cambridge English Dictionary - *a word that describes or gives more information about a verb, adjective, adverb, or phrase.*

Collins English Dictionary - *a word or group of words that serves to modify a whole sentence, a verb, another adverb, or an adjective*

Merriam-Webster Dictionary - *a word belonging to one of the major form classes in any of numerous languages, typically serving as a modifier of a verb, an adjective, another adverb, a preposition, a phrase, a clause, or a sentence, expressing some relation of manner or quality, place, time, degree, number, cause, opposition, affirmation, or denial, and in English also serving to connect and to express comment on clause content.*

In light of these consistent definitions from reputable sources, it is my opinion that the average consumer would not perceive two adverbs side by side as unusual or grammatically quirky in any way, but would instead simply gain a non-distinctive message from the sign as a whole.

34. It is also my view that Dr Pike's submission that he 'tested' the mark anecdotally on friends, family and colleagues holds little to no weight in the assessment of the sign. As is well established, and as cited above, a sign must be assessed first, by reference to those goods or services applied for and, second, by reference to the perception of the relevant public. Notwithstanding this principal, and by way of Dr Pike's own acknowledgement, a number of people that the sign was 'tested' on had to be prompted to make the intended link between the sign in question and the applicant's passion for social responsibility and ethical concern for the environment. In my opinion, this strengthens the argument that average consumer would not immediately, without further thought, perceive the sign as anything other than an obvious, origin neutral statement that encourages sensible drinking attitudes in social situations.
35. Finally, whilst it is noticeably clear that the applicant is a sincere and genuine business with a concern for social responsibility, I do not believe this to mean that the average consumer would understand the sign as having distinctiveness such that it functions as a trade mark.

Conclusion

36. Having given due care and attention to all of the arguments put forward during the proceedings, the application is refused under Section 3(1)(b) for all goods in classes 32 and 33.

Dated this 22nd day of December 2021

**Oliver Rose'Meyer
For the Registrar
The Comptroller-General**