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**TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION NUMBER 3786435  
BY RHODES EA LTD  
TO REGISTER THE FOLLOWING TRADE MARKS IN CLASS 43:**

The word 'GYROS' is written in a bold, black, stylized font. The letters are thick and blocky, with a slightly irregular, hand-drawn appearance. The 'G' and 'R' have a unique shape, and the 'O's are also stylized.

## **Background**

1. On 10 May 2022, Rhodes EA Limited ('the applicant') applied to register the above marks as a series for the following services in Class 43:

*Class 43: Business catering services; canteens; catering (food and drink); catering for the provision of food and drink; fast food restaurants; food and drink catering.*

2. On 25 May 2022, the Intellectual Property Office ('IPO') issued an examination report in response to the application, allowing Bromhead Johnson LLP ('the representative') a period of two months to respond. In that notification an objection was raised under sections 3(1)(b) and (c) of the Trade Marks Act 1994 ('the Act') on the basis the mark consists exclusively of a sign which may serve in trade to designate the nature of the services e.g. food and catering services providing gyros and similar dishes. A deadline for response was set as 25 July 2022.
3. On 22 July 2022, the representative requested an extension of time under the provisions of Rule 77(4) of the Trade Marks Rules 2008. No reasons for the request were submitted, nevertheless, the examiner accepted and confirmed the extension of time had been granted in correspondence of 02 August 2022.

The deadline for response was reset to 03 October 2022, allowing the representative further time to address the objection.

The correspondence confirmed, that in accordance with standard procedure, failure to reply within the stipulated response period would result in the designation being refused under section 37(4) of the Act.

4. No response was received to the previous correspondence, therefore following the expiry of the response period, the examiner issued a letter on 11 October 2022. The letter confirmed that the objections taken under sections 3(1)(b) and (c) remained and as such the application was being refused under section 37(4) of the Act.
5. On 10 November 2022, the representative filed a Form TM5, requesting a written statement of reasons for the Registrar's decision to refuse the application.
6. Whilst the representative has submitted no formal submissions in favour of acceptance of the application, or to counter the position adopted by the examiner, I have considered it prudent to consider the primary section 3(1)(b) and (c) objection. Thus, this statement of grounds will include the purely administrative failure to respond within the time frame and the validity of the substantive objection under section 3(1)(b) and (c).

## **Decision**

7. In both the examination report of 25 May 2022 and the letter of 02 August 2022, it was stated that failure to reply to the sections 3(1)(b) and (c) objection by the set date would result in the application being refused in totality and in accordance with section 37(4) of the Trade Marks Act 1994.
8. Section 37 of the Act sets out provisions which govern the examination of Trade Mark applications, with sub-section (4), in particular, providing the Registrar with grounds for refusing such an application where it fails to meet the requirements for registration. The provision reads as follows:  
  
*"If the applicant fails to satisfy the registrar that those requirements are met, or to amend the application so as to meet them, or fails to respond before the end of the specified period, the registrar shall refuse to accept the application."*
9. The Registrar is consequently of the view, and in full accordance with section 37(4) of the Act, that the examiner's decision to mandatorily refuse the mark on 11 October 2022 as a result of the representative's failure to respond within a clearly communicated deadline was correct and is upheld.

10. Whilst there was no response from the representative in support of the application, received within the communicated time frame, for the avoidance of any doubt, and in the interests of legal certainty and completeness, as stated above, I will go on to consider below a brief review and confirmation of the examiner's original objection taken under sections 3(1)(b) and (c).

### **The Law - Sections 3(1)(b) and (c)**

11. The relevant parts of section 3 of the Act read 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)**

12. 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 or services are deemed incapable of fulfilling the indication of origin function of a trade mark (Wm Wrigley Jr & Company v OHIM, C-191/01P ‘Doublemint’, paragraph 30);
- Article 7(1)(c) (section 3(1)(c)) pursues an aim which is in the public interest that descriptive signs or indications may be freely used by all (Doublemint, paragraph 31);

- 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 and services in question; it is sufficient that it could be used for such purposes (Doublemint, paragraph 32);
- I have also taken 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”

### **Application of the legal principles**

13. From the aforementioned case law it is clear I must determine whether or not the mark applied for will be perceived by the relevant consumer as a means of directly designating characteristics of the services being provided. In order to do this, I must assess who I consider the relevant consumer to be and if they may have any particular characteristics, in terms for example of levels of attention in the purchasing process.
14. The application has been applied for in Class 43 covering a range of catering services including fast food restaurant services. I therefore consider the relevant consumer of these services to be the UK general public at large. In relation to any particular levels of attention or unique features of the purchasing process, my view would be that availing oneself of restaurant or catering services such as fast food, would be an everyday experience which would not be subject to higher levels of attention or an otherwise unique purchasing act.
15. Having established the relevant consumer, I must assess the mark applied for and how the relevant consumer would, in normal and fair use, perceive the

word 'GYROS'. The series of marks comprise the word 'GYROS', presented in black on a white background and alternatively, white on a blue background, both written in a stylised font. For the purposes of my assessment my conclusions will apply to both marks save where I make an express distinction.

16. In my view, the word 'GYROS', when viewed in the context of the services listed in Class 43, would be understood by the average consumer as referring to a kind of consumable offered, namely a food item, akin to a donner kebab. The following definitions for 'GYRO' have been taken from the Collins English Dictionary:

1. *a sort of loaf consisting of layers of lamb or lamb and beef, roasted, as on a vertical spit, and sliced*
2. *a sandwich consisting of slices of this meat, onions, tomatoes, etc. wrapped in a pita*

*plural 'gyros*

17. It is clear from the aforementioned case law that I must determine, assuming notional and fair use in trade, whether the marks in suit will be viewed by the average consumer as designating a characteristic of the services for which registration is sought. I am aware, from my own personal knowledge, that the term 'gyros' is Greek. In determining whether the mark would be seen as purely descriptive, I must therefore be satisfied that the relevant, mostly English-speaking UK public would be familiar with the term and recognise it as a characteristic of the services claimed. I have demonstrated that the word 'gyro' has a dictionary definition and is used to refer to a Greek foodstuff, similar to a kebab. The word 'gyros' is merely the pluralisation of that word and also appears in the Collins English Dictionary.

18. The term appears in a well-known English dictionary and I am aware that Greek restaurants are, for example, commonly found in many towns and cities in the UK. Greece is also a popular holiday destination for UK travellers, the combination of these factors would on balance indicate to me that a large proportion of the English speaking population in the UK would readily recognise the term. I have identified the relevant consumer in this case is an ordinary member of the public and it is my opinion that the mark would be seen by them as nothing more than a descriptive term. If the mark 'GYROS' were to become registered it would result in the applicant having a monopoly in that word thereby preventing any other party from using it in their own catering services.

19. Although I have found the word 'GYROS' to be descriptive, I will for clarity comment on the stylisation of the marks. The first mark in the series contains the word 'GYROS' and has the appearance of Greek-styled lettering in black against a white background. The second mark contains the word, 'GYROS', in the same Greek-styled lettering but is in white and is shown against a blue background. The stylisation within the marks does not, in my view, affect the identify of them and therefore my assessment of them is the same. It is well established in case-law that the distinctiveness of a sign must be assessed, first, by reference to services in respect of which registration is sought and, second, by reference to the perception of the relevant public. It is important for me to consider the impact of the marks as a whole, that being the combination of the word GYROS in the Greek-styled lettering. My view would be that the word 'GYROS' as a descriptive term would overwhelm any stylised elements and the overall impact would be that the marks designate a characteristic of the services. The mark therefore, to my mind, is nothing more than descriptive in relation to the services upon which it is to be used. As a result, the objection under section 3(1)(c) of the Act is therefore maintained.
20. My view that the mark would be seen as nothing more than a descriptor is supported by the decision in *Hormel Foods Corp. v Antilles Landscape Investments NV* [2005] RPC 28 Arnold J where it was concluded that minimal stylisation adds nothing of substance:

*"147... In saying this, I recognise that a possible justification for regarding the Defendant's Mark free from objection under section 3(1)(c), and hence registrable if free from objection under the remainder of section 3, is that such a registration would confer narrower rights than a registration of the word per se. I am not convinced, however, that this justification is constant with the public interest which the Court of Justice has held underlies section 3(1)(c). If descriptive words are to be free for use by all, then the public should be able to use them without having to search to see if any particular representation of such words has been registered. Furthermore, the practical effect of registering a mark like the Defendant's Mark would be to give the proprietor rights in the word extending beyond the specific representations.*

*148. In my judgement this conclusion is consistent with the wording of section 3(1)(c) and Article 3(1)(c) because the Defendant's Mark does not consist exclusively of a prohibited sign. Nothing has been added to that sign. It is merely that the Defendant has selected one particular visual representation of the prohibited sign out of many possible visual representations. Despite the fact that a particular visual representation has been selected, the mark remains wholly descriptive.*

21. I note there is an absence of any submissions in favour of the application, therefore; from the limited materials available to me, including the dictionary definition of the word GYROS, I find that the objection under section 3(1)(c) to be validly made at the outset in the sense that GYROS would or could designate the food items being sold. As a consequence of that the objection under section 3(1)(b) is also and inevitably made out.
22. To summarise, an absolute grounds objection was raised and a subsequent, extension of time request was acceded to, allowing the applicant sufficient time in which to respond. That deadline was not adhered to, subsequently resulting in a mandatory refusal under section 37(4) of the Trade Marks Act 1994.

### **Conclusion**

23. It is found for the reasons given above, the application is refused due to failure to respond to the section 3(1)(b) and (c) objection under section 37(4), for all services claimed. Furthermore, the objections under section 3(1)(b) and (c) were justified in the circumstances.

**Dated this 14<sup>th</sup> day of December 2022**

**Jonathan Hayward  
For the registrar**