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**[2015] EWHC 1588 [CH]**

**Case No. CH/2014/0564**

**IN THE HIGH COURT OF JUSTICE**

**CHANCERY DIVISION**

**(APPEAL FROM THE INTELLECTUAL PROPERTY OFFICE**

**TRADE MARKS REGISTRY)**

**Rolls Building**

**7 Rolls Buildings**

**London EC4A 1NL**

**Date: 8th June 2015**

**Before** :

Iain Purvis QC sitting as a Deputy Judge of the High Court

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**Between :**

**CANARY WHARF GROUP PLC**

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| --- | --- | --- |
|  |  | Appellant |
|  | **- and –**  **THE COMPTROLLER GENERAL OF PATENTS, DESIGNS AND TRADE MARKS** |  |
|  |  | Respondent |

**Mr Simon Malynicz** (instructed by **Clifford Chance LLP**) for the **Appellant**

**Mr Nicholas Saunders** (instructed by **the Treasury Solicitor**) for the **Respondent**

Hearing dates: 6 May 2015

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APPROVED JUDGMENT

**Iain Purvis QC:**

Introduction

1. This Appeal concerns trade mark application 2655156 (‘the Application’) which was filed by the Appellant, Canary Wharf Group Plc (‘CWG’) on 6 March 2013.
2. The Application was to register the sign ‘CANARY WHARF’ in relation to the following goods and services:

Class 16 Printed matter, printed publications, printed reports and circulars

Class 36 Real estate affairs; real estate investment; financing services for real estate development; real estate management; real estate appraisal and valuation; real estate leasing; real estate rentals; information, consultancy and advisory services relating to the aforesaid services

Class 37 Building construction services; construction project management services; on-site building project management; property development and maintenance services; information, consultancy and advisory services relating to the aforesaid services

Class 39 Car parking services; parking place rentals; information and advisory services relating to the aforesaid services

Class 42 Building design services; advisory services relating to building design; information, consultancy and advisory services relating to the aforesaid services

Class 44 Landscape design; information, consultancy and advisory services relating to the aforesaid services

Class 45 Security services; information, consultancy and advisory services relating to the aforesaid services

1. The examiner took issue with the registrability of the Application on the basis of the ‘absolute grounds’ of objection set out in s3(1)(b) and s3(1)(c) of the Trade Marks Act 1994. He considered that the mark should be refused in its entirety on both grounds. CWG asked for an oral hearing which took place before the Hearing Officer Mr Edward Smith. The Hearing Officer handed down his decision O-423-14 on 3 October 2014 which confirmed the position taken by the examiner and directed that the mark be refused in its entirety.
2. It was common ground on this appeal that the grounds for objection under s3(1)(b) were co-extensive with those raised by the s3(1)(c) objection. I shall therefore consider the appeal on the basis of s3(1)(c) only. For convenience, I set out the relevant terms of s3(1)(c) below:

*s3 (1) The following shall not be registered:*

*(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the … geographical origin … or other characteristics of goods or services*

1. The Hearing Officer refused the application insofar as it covered ‘services’ (classes 36, 37, 39, 42, 44, 45) on the grounds that it designated the geographical origin of the services, and insofar as it covered goods (printed matter, publications etc. in class 16) on the grounds that it designated another ‘characteristic’ of the goods namely their ‘subject matter’.

Factual and historical background

1. Before considering the relevant legal principles and the scope of the dispute before me, it will be of assistance to set out the factual background.
2. In 1982, as part of a policy to develop run-down post-industrial parts of the country, the government agency known as the London Docklands Development Corporation (‘LDDC’) established the Isle of Dogs area of London as an Enterprise Zone. In the North of the Isle of Dogs was the former dockland area known as West India Docks. A large part of West India Docks, referred to as ‘Canary Wharf’, was sold in 1987 for the purposes of development to a company controlled by Olympia & York, who in turn leased it to a related company called the Canary Wharf Development Co. Limited (‘CWDC’).
3. Precisely how and why the area sold to CWDC came to be called ‘Canary Wharf’ is not entirely clear. The name itself seems to date back to the 1930s when it was given to a shed and quay within the West India Docks controlled by the Fred Olsen shipping company and used for the importation of fruit from (inter alia) the Canary Islands. The first use of the name in respect of the proposed development, which of course covers a greater area than the Fred Olsen quay, seems to date from around 1985. It is used for example in a News Release from the LDDC dated 18 October 1985 headed *‘Corporation Board Committed to Achieving Canary Wharf Financial Centre Development’.* From that time, it seems to have been used consistently.
4. By 1992 Olympia & York had completed the construction of a number of buildings on the site including One Canada Square, then the UK’s tallest building. The development became a symbol of post-industrial regeneration. Unfortunately, the development coincided with a world-wide economic downturn and a recession in the UK in the early 1990s. CWDC went into administration. The Canary Wharf development was purchased from the adminstrators by another consortium of investors led by Paul Reichmann in December 1995. The freehold of the property was purchased by a company called Canary Wharf Investments Limited in March 1998, and was then transferred to CWG. Ownership of CWG has since changed hands. It now refers to itself as a *‘wholly owned joint venture between the Qatar Investment Authority and Brookfield Property Partners’.*
5. The present situation is as follows. The area originally purchased by CWG, which they refer to as the ‘Canary Wharf Estate’, comprises some 14 million square feet of office and retail space divided into around 35 different properties. 18 of these properties are leased by CWG on short leases to third parties. The rest have been sold off, either on long leaseholds (13) or by selling the freehold (4). There are, not surprisingly, a number of contractual covenants in the various forms of lease (and indeed with the purchasers of freeholds) which place restrictions on the activities which can be carried on in the Estate.
6. The name Canary Wharf has been adopted not only for the commercial development on the Estate itself, but also for transport links to the area – there is presently a Canary Wharf station on the Jubilee Line and on the Docklands Light Railway, and a Canary Wharf Crosslink station is being built. It is also the name of a political ward, part of Tower Hamlets, which comprises both the Estate itself and its surrounding area.

The law

1. The guiding principles to be applied in relation to a s3(1)(c) objection, and specifically one relating to geographical names, are set out in the decision of the CJEU in Windsurfing Chiemsee Produktions v Huber [1999] ETMR 585 [joined cases C-108/97 and C-109/97]. The context of the questions asked by the Munich Landgericht in that case was the registration by the Claimant of marks for sportswear including the name CHIEMSEE, a lake in Bavaria popular with tourists and apparently used for surfing. The answers given by the CJEU were as follows [paragraph 37]:

*‘Article 3(1)(c) is to be interpreted as meaning that:*

* *It does not prohibit the registration of geographical names as trade marks solely where the names designate places which are in the mind of the relevant class of persons, currently associated with the category of goods in question; it also applies to geographical names which are liable to be used in future by the undertakings concerned as an indication of the geographical origin of that category of goods*
* *Where there is currently no association in the mind of the relevant class of persons between the geographical name and the category of goods in question, the competent authority must assess whether it is reasonable to assume that such a name is, in the mind of the relevant class of persons, capable of designating the geographical origin of that category of goods*
* *In making that assessment, particular consideration should be given to the degree of familiarity amongst the relevant class of persons with the geographical name in question, with the characteristics of the place designated by that name, and with the category of goods concerned*
* *It is not necessary for the goods to be manufactured in the geographical location in order for them to be associated with it’*

1. Other paragraphs of the judgment in Windsurfing Chiemsee which may be regarded as giving useful guidance are as follows:
2. Paragraphs 25-26:

*‘25…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 categories of goods or services in relation to 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*

*26. As regards, more particularly, signs or indications which may serve to designate the geographical origin of the categories of goods in relation to which registration of the mark is applied for, especially geographical names, it is in the public interest that they remain available, not least because they may be an indication of the quality and other characteristics of the categories of goods concerned, and may also, in various ways, influence consumer tastes by, for instance, associating the goods with a place that may give rise to a favourable response.’*

1. Paragraph 33:

*33…Article 3(1)(c) of the Directive does not in principle preclude the registration of geographical names which are unknown to the relevant class of persons – or at least unknown as the designation of a geographical location or of names in respect of which, because of the type of place they designate (say a mountain or lake), such persons are unlikely to believe that the category of goods concerned originates there.’*

1. Paragraph 35:

*35. Finally it is important to note that, whilst an indication of the geographical origin of goods to which Article 3(1)(c) of the Directive applies usually indicates the place where the goods were or could be manufactured, the connection between a category of goods and a geographical location might depend on other ties, such as the fact that the goods were conceived and designed in the geographical location concerned.’*

1. In the course of argument I was referred to two decisions of the General Court (or Court of First Instance of the European Communities, as it was then called in both cases). Neither appears to me to be anything other than a straightforward application of the guiding principles of Windsurfing Chiemsee, but they illustrate the kinds of factors which the Court may take into account when carrying out the necessary assessment.
2. The first case is Nordmilch v OHIM (T-295/01) [2004] ETMR 70. This concerned the registrability of the name OLDENBURGER for various foods. Oldenburg is a town which is well known in Germany as being the capital of an agricultural region, and specifically for producing livestock, dairy and meat products. The word ‘Oldenburger’ is the adjectival form of the name Oldenburg, and a large number of agricultural products already contained the designation ‘Oldenburger’ or ‘Oldenburg’ together with the name of the producer. Not surprisingly, the General Court had little difficulty in upholding the decision of OHIM to reject the application. Some of the goods for which application was made were already known by the public to be produced in the Oldenburg region, so there could be no doubt that the mark should be rejected. So far as the rest (such as fish) were concerned, the Board of Appeal had rightly found *‘that it is reasonable to assume that those goods will in future be associated with the word in question in the minds of the reasonable person.’*
3. The second case is Mineralbrunnen v OHIM (T 226/08). This concerned the registrability of the name ALASKA. It was applied for in respect of a number of classes of non-alcoholic beverage. The Court of First Instance upheld the decision to allow the registration. So far as ‘fruit drinks and fruit juices, syrups and other preparations for making beverages’ were concerned, *‘it must be assumed that the relevant groups of people also do not associate Alaska with [their] production’* since *‘these fruit and aromatic plant based beverages are not produced there, in particular due to the prevailing climate’.* The position with mineral water was more difficult because it was clear on the evidence that mineral water was in fact produced in Alaska, a region known for its natural abundance of resources including water. However (paragraph 30):

*‘Even if one assumes that the relevant groups of people associate Alaska with a natural abundance of water, it must be pointed out that it cannot be reasonably assumed that the relevant groups of people were expecting at the time of the registration of the mark in suit that mineral water from Alaska would be imported into the Community in the future.’*

This was because of the

*‘high costs of transportation of mineral waters originating in Alaska and their distribution in Europe…where…there is a very competitive market with a large number of local mineral waters of high quality’* (paragraph 33).

1. The decision is therefore a relatively unusual application of the Windsurfing approach. It was not ‘reasonable’ to assume that the mark is *‘capable of designating geographic origin’* because the public was considered to be economically sophisticated enough to realise that it would be too costly and uncompetitive for a trader to import mineral water from Alaska.

s3(1)(c) – geographical origin of the services

1. Before the Hearing Officer in the present case, CWG’s main argument was that the name ‘CANARY WHARF’ was not a place name or geographical area at all. Rather it was a private estate and no different in principle from (say) Battersea Power Station (Decision BL O/063/04). The Hearing Officer

considered this point between paragraphs 36 and 48 of his Decision. He looked at the evidence provided by CWG and at his own research as to the way the area was referred to in Wikipedia and the Guardian newspaper. He directed himself to what was in my view the right question, namely:

*‘how then does the public, at the material date of filing, perceive the area known as Canary Wharf – as an estate/development or as a business district?’*

1. He noted that, so far as the public were concerned, the factual position on ownership of the area was *‘obscure’* save perhaps that it had emerged out of a publicly subsidised development zone*.* What was perceived was an area of London with a wide variety of business usage and with its own transport links. It was not surprising that both Wikipedia and the Guardian referred to it as a *‘business district’*.
2. Before me, Mr Malynicz (who did not appear below) accepted that the Hearing Officer was correct to find that Canary Wharf was, in the perception of the public, a geographical area. However, he contended that the Hearing Officer had made a number of other errors in carrying out the assessment required by Windsurfing Chiemsee. These errors, he said, undermined the decision to refuse registration.
3. His first objection was to a passage in paragraph 50 of the Hearing Officer’s Decision which states as follows:

*‘The case* [Windsurfing Chiemsee] *was, and is, important because it plainly identified the ‘need to keep free’ principle to be applied in the specific instance of geographical names or locations. But such a principle can apply, notwithstanding that a particular location may not have a current or likely UK-wide ‘association’ with particular goods or services. Thus, if those goods or services may be considered to be ones which could be considered ‘local’ in nature, such as, say, hairdressing, the provision of meeting places for worship or other activities, garage services and so forth, then the name of any small town or even village may need to be ‘kept free’.’*

Mr Malynicz attacked this on the basis that the Hearing Officer was effectively identifying a ‘blacklist’ of goods or services (ones which could be considered ‘local’ in nature) for which any place name would always be refused registration.

1. It seems to me that the basic point being made in this passage is a perfectly valid one. A large number of services falling with the Nice Classification (possibly most services), including those listed by the Hearing Officer, are of a kind that one would expect to be available locally in any major centre of population in the UK. The names of most cities and towns would therefore be capable, when used in the UK, of designating the geographical origin of those services and therefore would be excluded from registration under s3(1)(c) in the absence of acquired distinctiveness.
2. However, the Hearing Officer may have been guilty of over-generalisation. First of all, the mere fact that services are of a kind which one would expect to be provided ‘locally’ does not mean that there is a blanket ban on the registration of all place names in respect of such services. Locally-provided services may be of a kind which one simply would not expect to be provided in all parts of the country. For example, an application for the name of a city far inland such as ‘Coventry’ might be allowed for ‘lobster pot repair services’ (unless of course the evidence was that the public would expect lobster pots to be sent away to inland industrial areas to be repaired).
3. Secondly, there may be issues connected with the obscurity of the place-name in question. The Hearing Officer’s reference to *‘the name of any small town or village’* would cover many place names which are unknown to the majority of potential consumers of the services in question in the UK. Such names are capable of designating geographic origin to people living in or near the town or village in question, but perhaps not to the ‘average consumer’. The CJEU in Windsurfing Chiemsee noted in paragraph 33 that names which were *‘unknown to the relevant class of persons’* were not *‘in principle’* prohibited from registration. On the other hand, it could be said in the Hearing Officer’s favour that the public policy underlying the restriction on registration of geographical terms is not served by allowing monopolies to be obtained over the names of small towns for the kind of services already being provided by numerous traders in those towns. This seems to me to raise a difficult question of policy.
4. In my view, however, neither of the potential difficulties I have identified with the Hearing Officer’s general statement in paragraph 50 is capable of affecting the outcome of this case. So far as the first point is concerned, the services for which CANARY WHARF is sought to be registered are precisely the kind of services one would expect to be provided in, from or to the geographical area of Canary Wharf. So far as the second is concerned, it is accepted by the Applicant that Canary Wharf is famous throughout the UK.
5. Mr Malynicz’s second point was that the Hearing Officer had failed to carry out the Windsurfing Chiemsee assessment in any structured way, or in respect of each of the categories of goods and services for which the application was made. I do not agree with this criticism.
6. The Hearing Officer recorded at paragraph 49 of his Decision CWG’s argument that there was no Windsurfing type of ‘association’ between the area and the goods and services specified. His answer can be broken down into three steps. First of all he considered the nature of Canary Wharf as a geographical area. He noted that it was known as a ‘business district’. Secondly, he considered the services which the mark was applied for. He summarised them as comprising *‘rental, development, construction, design and security’* services. Thirdly, he considered the relationship between these kinds of services and Canary Wharf, concluding that the various services for which the application was made were *‘perfectly natural to reside in or service a business district’*.It seems to me to follow inevitably from this finding that the sign CANARY WHARF is likely to be taken by consumers as indicating the geographical origin of all the services in question, or at least is capable of doing so. I cannot fault the Hearing Officer’s legal or factual approach to this issue and I agree with his conclusion.
7. In particular I do not consider that it was necessary for the Hearing Officer to deconstruct the application into each individual service and carry out the Windsurfing Chiemsee assessment for each separately. His broad characterisation of the services was perfectly adequate to the task before him. Mr Malynicz did not identify any particular service as raising some exceptional issue which undermined the Hearing Officer’s general conclusion.
8. Mr Malynicz further argues that CANARY WHARF is *‘known for professional services, banking, shopping malls and restaurants. It is not known for the high quality of its real estate practices, or its building developers or for the number or quality of its landscape design practices.’* But the ‘need to keep free’ principle is not limited to the use of a geographic name in respect of the goods or services for which a particular area is already famous. On the contrary it can cover the use of the name in respect of services for which it has never been used before. The question is simply whether it is reasonable to assume that the name is capable of indicating geographic origin. Where the sign is the name of a general business district, and the services are precisely the kind of services one would expect to be offered by or to businesses in that district, the sign is in my view obviously so capable.
9. Mr Malynicz also suggested that this is all *‘too vague and theoretical’*, rather like the argument rejected in Mineralbrunnen that because Alaska was a clean natural environment it was reasonable to suppose that it might in the future become associated with mineral water. I do not agree. The problem with the registration of Alaska for mineral water in Mineralbrunnen was an unusual one. It was not theoretical or speculative to suppose that mineral water would be produced in Alaska – indeed there was evidence that it was produced there. It was however regarded as most unlikely that someone would go to the cost and trouble of importing it thousands of miles into Europe. That was why it was not regarded as capable of indicating geographic origin to the relevant consumer (who appears to be deemed to experience the use of the sign within the EU). No such problem arises here. Canary Wharf is within the United Kingdom.
10. Finally, Mr Malynicz contended that the Windsurfing assessment always had to be tested against the ‘touchstone’ of the ‘public interest’. In the present case, he claimed, there was no relevant public interest in the ‘freedom to use’ CANARY WHARF to designate the geographic origin of the services in question because CMG (as freeholder) controls the whole geographical area properly called CANARY WHARF and no-one other than CMG is entitled to provide those services on CMG’s land without CMG’s permission.
11. Having reviewed the evidence of Mr Garwood on behalf of CMG which is said to support the factual premise for this submission, I am not persuaded that CMG does operate the kind of feudal control over the services provided on the CANARY WHARF estate suggested by Mr Malynicz. Indeed, it is very difficult to see how it could operate such control, particularly when many of the properties on the estate are in fact owned either on long leasehold or freehold basis by third parties.
12. In any event, I fail to see how the existence of such control could have anything to do with the public interest in the freedom to use a geographic term to indicate a geographic connection. It may serve CMG’s private interest to restrict the freedom to provide services on the estate, but it hardly serves the public interest.
13. Finally, on this point, I would note that geographic terms commonly involve a certain ‘penumbra’, and in those circumstances the ‘freedom to use’ principle applies to both the literal area and the penumbra - see Windsurfing paragraph 34 where the CJEU refer to the name of a lake being understood to include *‘the shores of the lake or the surrounding area’.* It is unreasonable to suppose that the term CANARY WHARF would only be understood by the public as indicating the geographic area covered by the Canary Wharf Estate and no more. Indeed, there is evidence in this case of traders using the geographical term CANARY WHARF to designate services in the immediate vicinity of the estate. Since it is not suggested that CWG has any monopoly in or right to control the provision of services outside the literal boundaries of the estate itself, the argument that ‘freedom to use’ is trumped by factual control must fail on the facts.
14. It follows that I consider that the Hearing Officer was right to reject the application to register CANARY WHARF for the various services in classes 36, 37, 39, 42, 44, 45 on the grounds that it may serve in trade to designate the geographical origin of those services.

s3(1)(c) – subject matter of the goods

1. Turning to the class 16 application, the Hearing Officer rejected this because the name CANARY WHARF may serve in trade to designate the ‘subject matter’ of *‘printed matter, printed publications, printed reports and circulars’.* His reasoning on this point was brief and is set out at paragraph 54 of the Decision:

*‘I very much doubt if there is a person in this country, whether resident in London or elsewhere, who has not heard of it* [Canary Wharf]*. They are most unlikely to regard a book (or other form of printed publication), either entitled or otherwise containing the words ‘Canary Wharf’, as inevitably derived from a single source.’*

1. Mr Malynicz criticised this passage. He contended that the correct test was that set out by the CJEU in Case No. C-51/10P Agencja Wydawnicza Technopol v OHIM [2011] ETMR 34 at [50]:

*‘…the signs referred to in art.7(1)(c) of Regulation 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 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’*

He said that the Hearing Officer had not applied this test. It was not enough that everyone in the country had heard of Canary Wharf. The correct question was whether it was reasonable to believe that the sign Canary Wharf on a printed publication would be recognised as indicating that the publication was about Canary Wharf. As part of that inquiry, the Hearing Officer should have asked himself whether Canary Wharf was already ‘a common subject’ for printed publications. The ‘theoretical possibility’ that Canary Wharf might in the future be the subject of a book or publication was not sufficient.

1. It is fair to say that the Hearing Officer was somewhat curt in the way he addressed the class 16 application and did not expressly consider the correct question. However, it seems to me that he clearly reached the right conclusion.
2. The general approach to be taken by a tribunal dealing with a ‘subject matter’ or ‘theme’ objection under s3(1)(c) or s3(1)(b) was recently considered by Geoffrey Hobbs QC sitting as the Appointed Person in NMSI Trading Ltd’s Trade Mark Application (Flying Scotsman) [2012] RPC 7 by reference to a number of authorities including the General Court in Danjaq v OHIM (Dr No) [2009] ECR II-2097, Mr Richard Arnold QC (as he then was) sitting as the Appointed Person in Linkin Park [2006] ETMR 74, the First Board of Appeal of OHIM in Ferrero OHG v FIFA [2008] ETMR 76 and Mr Allan James in Diana Princess of Wales Trade Mark [2001] ETMR 25.
3. Following, in general terms, the approach of Mr Hobbs as set out in particular in paragraph 18 of Flying Scotsman, I believe that at least three matters need to be considered where a ‘subject matter’ or ‘theme’ objection arises under s3(1)(c) or (b):
4. The nature of the goods or services for which the application is made. Are they in principle apt to provide or convey information about (or imagery relating to) the subject matter of the sign?
5. The nature of the sign. Is it something which it is reasonable to believe would be recognised by the relevant class of persons (that is to say average consumers of the goods or services in question) as indicating a particular subject matter or theme?
6. Is the subject matter or theme of a kind which (in the context of the goods or services in question) the average consumer would consider was controlled by a single economic undertaking, as opposed to something which was free to be used and exploited by anyone. See for example Psytech International v OHIM [2011] ETMR 46 at [34]-[43] and the concept of ‘official merchandise’ recognised in Arsenal Football Club v Reed [2003] RPC 9 (CJEU) and [2003] RPC 39 at [50]-[69] (Court of Appeal).
7. So far as (a) is concerned, *‘printed matter, printed publications, printed reports and circulars’* is the paradigm case of goods which are apt to convey information. So far as (b) is concerned, it is common ground that the name Canary Wharf would be recognised by the great majority of people in the United Kingdom as designating a business district of London. It seems to me therefore inevitable that if the words ‘Canary Wharf’ were used in the name of a local newspaper or business directory, in the name of a book on modern architecture, or in a printed report on urban development strategy, the public would understand it as designating the Canary Wharf business district. As for (c), there is no reason to believe that the public would assume that books or publications about a business district of London were controlled by a single economic undertaking.
8. I therefore agree with the Hearing Officer that the class 16 application falls to be rejected under s3(1)(c) on the basis that it is reasonable to believe that the sign CANARY WHARF would be recognised by the relevant class of persons as a description of the subject matter of printed matter, printed publications, printed reports and circulars to which it was applied.

Acquired distinctiveness

1. Finally, Mr Malynicz contended that the Hearing Officer ought in any event to have allowed the registration on the grounds of acquired distinctiveness.
2. This part of the Appeal can be dismissed quite quickly. The Hearing Officer set out the relevant principles to be applied in paragraph 56 of his Decision. No challenge was made to his statement of the law. Ultimately the question he had to decide, based on the evidence before him, was whether, due to the extensive use of the sign as a trade mark by the proprietor or its predecessors in title, the descriptive meaning of the sign had been displaced amongst a significant proportion of the relevant class of persons, such that they had come to recognise the sign as identifying the goods and services originating from the proprietor.
3. The Hearing Officer considered the evidence filed on behalf of CWG and concluded that acquired distinctiveness had not been shown. Having considered the evidence myself, I find his conclusion entirely unsurprising. The evidence of Mr Garwood shows some use of the mark in the course of CWG’s running of the Canary Wharf estate, but this use is limited to services provided within the very limited geographical area of the estate. There is no evidence of trade more generally within the United Kingdom or even the advertising or promotion of the relevant services outside the boundaries of the estate. The only evidence of wider advertising relates to the promotion of the Canary Wharf shopping centre, but, as the Hearing Officer points out, ‘retail services’ are not actually included within the specification of services of this Application.
4. Mr Malynicz’s main criticism of the Hearing Officer on this point was that he had *‘taken no account’* of the evidence of Mr Garwood that CWG had been providing a range of services under the mark for many years. I do not accept this. He had plainly read Mr Garwood’s evidence, and he deals with this particular point in paragraph 59 of his Decision:

*‘As for the other goods and services, it is not sufficient in my opinion to demonstrate that the applicant may provide or be responsible for those services in connection with the area. What matters is whether that provision and responsibility translates into a significant proportion of relevant consumers across the UK regarding the words ‘Canary Wharf’ as a trade mark.’*

1. His other criticism concerned the comment by the Hearing Officer at paragraph 59 of his Decision that CWG’s evidence was not

*‘the kind* *of evidence normally required by the legal authorities on acquired distinctiveness and to which I have referred.’*

Mr Malynicz says that if the Hearing Officer was concerned about a lack of survey evidence, he was wrong because there was no need for such evidence. He cites Lewison LJ in Interflora v M&S [2013] FSR 1 at [54] in support of the proposition that such evidence should not be regarded as ‘routine’ even in a case requiring proof of acquired distinctiveness.

1. The Hearing Officer was not referring to survey evidence specifically. He was referring back to his summary of the law on acquired distinctiveness at paragraph 56 of his Decision and in particular to the fifth bullet point in that paragraph, as follows:

*‘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 and services as emanating from the proprietor; (v) evidence from trade and business associations; and (vi) (where the competent authority has particular difficulty in assessing the distinctive character) an opinion poll.’*

1. This summary is taken from the well-known passages on acquired distinctiveness in Windsurfing Chiemsee at [51] and [53]. It seems to me to have been entirely appropriate and legitimate for the Hearing Officer to point out that such evidence was missing from the present case.
2. I therefore believe that the Hearing Officer was perfectly justified in rejecting the argument for acquired distinctiveness in the present case.

Conclusion

1. I conclude that the Hearing Officer was correct to reject the application in its entirety under s3(1)(c) and s3(1)(b) of the Trade Marks Act 1994 and I dismiss the appeal.