



OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET  
(TRADE MARKS AND DESIGNS)

Cancellation Division

**DECISION  
of the Cancellation Division  
of 26/11/2012:**

**IN THE PROCEEDINGS FOR A DECLARATION OF INVALIDITY**

OHIM reference number: 5927 C

Community trade mark: 8 820 292



Language of the proceedings: English

**APPLICANT**

**Alfie Hincks**  
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Liverpool, L10 4UF

**COMMUNITY TRADE MARK  
PROPRIETOR**

**The Liverpool Football Club and  
Athletic Grounds Limited**  
Anfield Road  
Liverpool L4 0TH

**REPRESENTATIVE**

**Addleshaw Goddard LLP**  
100 Barbirolli Square  
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### THE CANCELLATION DIVISION

composed of Richard Thewlis, Dafydd Collins, and Kim Pagels has taken the following decision on 26/11/2012:

- 1. The request for a declaration of invalidity of Community trade mark No 8 820 292 is rejected in totality.**
- 2. The applicant shall bear the fees and costs of the Community trade mark proprietor.**
- 3. The amount of costs to be paid by the applicant to the Community trade mark proprietor shall be EUR 450, corresponding to representation costs.**

### FACTS AND ARGUMENTS

- (1) The Community trade mark No 8 820 292 (figurative mark) ("the CTM"), as depicted on the cover page, was filed on 19/01/2012 and registered on 05/07/2012 for the following goods and services:

Class 6: Small articles of metal hardware; articles of common metal; bins of metal; badges; pins; vehicle badges; keys and key blanks; key-rings, key fobs and key chains; locks; ornaments; trophies; plaques; monuments; statues and statuettes; figurines; boxes; money boxes; tool boxes; all being made of common metal

Class 14 : Precious metals and their alloys; jewellery, costume jewellery, precious stones; horological and chronometric instruments, clocks and watches; cufflinks; tie-clips and pins; earrings; rings; pendants; pins and brooches; charms; bracelets; chains; coins; medals and medallions; key-rings and key chains; trophies; ornaments; figurines; models; badges and bars for use therewith.

Class 16 : Paper, cardboard and goods made from these materials; printed matter; book binding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; packaging materials; printed publications; paint boxes for children; cheque book holders; flags (of paper); books; pictures; posters; folders; pencils; pens; pencil cases; geometry sets; wrapping paper; greetings cards; stickers; postcards; calendars; newspapers; periodical publications; instructional and teaching materials (other than apparatus); albums; autograph sheets; diaries; writing implements; programmes; book marks; place mats of paper; beer mats of paper or cardboard; gift vouchers; plastic bags; geographical map.

Class 18 : Leather and imitations of leather; animal skins, hides; trunks and travelling bags; handbags, rucksacks, purses; umbrellas, parasols and walking sticks; whips, harness and saddlery; clothing for animals; bags; wallets; holdalls; duffel bags; money belts; leather shoulder belts; saddle belts; money and credit card holders; briefcases; garment carriers.

Class 21 : Household or kitchen utensils and containers; combs and sponges; brushes; brush-making materials; articles for cleaning purposes; steel wool;

articles made of ceramics, glass, porcelain or earthenware which are not included in other classes; electric and non-electric toothbrushes; mugs; cups; beakers; plates; bowls; drinking glasses; lunchboxes; flasks and hip flasks; bottles; decanters; glasses; tankards; glassware, earthenware, porcelain and china; domestic utensils and containers; ceramic articles; crockery; coasters; money boxes; water bottles; brushes; oven mitts; shoe horns; silver and gold tankards.

Class 25 : Clothing; footwear; headgear; shirts; socks; gloves; T-shirts; tracksuits; coats; jackets; jogging trousers; scarves; hats and caps; wristbands; gloves; slippers; pyjamas; bathrobes; baby wear; underwear; aprons; ties; shorts; trainers; dresses; jerseys; football shirts; football kits; football boots; sports shoes; stockings; singlets; briefs; anoraks

Class 28: Games and playthings; playing cards; gymnastic and sporting articles; decorations for Christmas trees; children's toy bicycles; soft toys; teddy bears; puzzles; jigsaw puzzles; hand held computer games; balloons; footballs; playballs; golf balls; shin guards; goalkeepers' gloves; football nets.

Class 36: Insurance; financial affairs; monetary affairs; real estate affairs; credit and debit card services; financial services.

- (2) On 14/10/2011, the applicant filed a request for a declaration of invalidity against the registration of the CTM in its entirety on the basis of absolute grounds pursuant to Article 52(1) of Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark ("CTMR"), namely that the CTM was registered in breach of Article 7 CTMR.
- (3) By official communication of 25/10/2011, the CTM proprietor was notified of the request. In the course of the proceedings, the parties filed observations within the time limits set pursuant to Article 57(1) CTMR.
- (4) In its opening submissions, the applicant argues that the image used in the CTM is a Liver bird, which has been used by the people of the city of Liverpool since the 1350's as a corporate seal. The Liver Bird serves to designate the geographical origin of various businesses and organisations as being from Liverpool. The Liver Bird is used by both individuals and companies to represent the business and culture of the city of Liverpool, and is used in conjunction with a huge array of various categories of goods and services. As such, the image of the Liver Bird does not distinguish one organisation from another.
- (5) In support of its arguments, the applicant filed a large amount of evidence in no discernible order and without utilising exhibit headers and references. The evidence consists of, *inter alia*, the following documentation:
  - An extract from Wikipedia, which states that the Liver Bird is the symbol of the city of Liverpool. The extract explains that the bird has been portrayed in many forms to represent the city, and that the bird's species has long been the subject of confusion. The extract also refers to a BBC News article relating to the fact that Liverpool Football Club attempted to register the version of the Liver Bird represented on the club's badge in November 2008. At the time, the deputy council

- leader, Flo Clucas said; “The Liver Bird belongs to all the people of Liverpool and not one company or organisation.”
- An extract from Liverpoolmuseums.org, which begins by mentioning that: “The Liver Bird is part of Liverpool’s modern...folklore”. No date is available on the extract.
  - A page from liverlaunderettes.co.uk, which has a graphical representation of a Liver bird. The page appears to be dated 2007.
  - An apparent extract from Ben Johnson’s book *City Scape Liverpool*. Page number 17 represents the engraving of “The South West Prospect of Liverpoole in the County Palatine of Lancaster, 1728”. The engraving has on it a Liver Bird.
  - A copy of the front cover of the magazine *MerseyAle*, February/March 2011 edition. It has a depiction of a Liver Bird.
  - An image of the First Division Champions medal won by Everton FC in 1881. The medal has a depiction of a Liver Bird.
  - Several pages from an unnamed publication, celebrating 100 years of the Royal Liver Building. The pages frequently refer to the twin Liver Bird statues on the building, and the connection between the building and the city of Liverpool. In particular, on page 30 is an article entitled *Crest worn with pride by Liverpool’s finest*. The article states: “The association between the city and its Liver Bird is perhaps felt most passionately on the red shirts of Liverpool Football Club. Although there have been several versions of the bird, the one used now is quite similar to those seen atop the Royal Liver Building.” The entire publication is dated 19/07/2011.
  - A magazine entitled, 100 years of the *Liver Birds, Pride of the City*. It includes articles which explain the affiliation of the Liver Bird with the city of Liverpool.
  - A book entitled *The Little Book of Liver Birds*, David Cottrell, The Breeden Books Publishing Company Limited [2006]. The book has numerous examples of where the Liver Bird is represented in a variety of ways and on a variety of buildings and monuments in Liverpool.

The applicant also requested consideration to be made to the evidence that was previously submitted in relation to submissions between the two parties, in Cancellation proceedings 4782C.

The evidence filed by the applicant in those proceedings is often duplicated by the evidence filed in these proceedings, and was summarised as follows:

- Wikipedia entry for Liver Bird, stating that it is the symbol of the city of Liverpool and tracking back the history and the myths surrounding it.
- Article “The Origins of the Liver Bird” by Mr Frank Carlyle.
- Google extracts from the University of Liverpool, showing the logo also on merchandising products.
- Web extracts from City of Liverpool Gymnastics, showing the logo.
- Web extracts from Home of Liverpool Pilotage Services, showing the logo.
- Photographs of restaurant and bar signs in Liverpool, including the logo.
- Images of the logo on taxi and greeting cards.
- Images of the logo on JMU (John Magnus University of Liverpool) building.
- Web page “A brief history of the liver bird”.

- Web site of Outhwaite & Litherland, showing the logo.
  - Images of the logo used by the Liverpool City Council.
  - Website extract with history of the Liverpool Flying School, showing the logo.
  - Website extract of the Liver Laundry Equipment, showing the logo.
  - Wikipedia entry for the St. Margaret's C of E High School Liverpool, showing the logo.
  - Extract "Liverpool Masons", showing the logo.
  - Extract of Liverpool Maritime Graduates & Masters Association, showing the logo.
  - "Liverpool Echo Letters, September 13 2010".
  - Google search images for "Liver Birds".
  - Extracts from Flickr showing use of the logo on city coat arms and symbols, on monuments and in streets.
  - Image of the logo at the Liverpool John Moores University.
  - Liver Bird images.
  - Images from the Liverpool City Council reception.
  - Images of the logo on paper and stone crests.
- (6) The CTM proprietor's response begins with the accusation that the applicant has not made clear which provision of Article 7 CTMR has allegedly been breached, but it is assumed to be Article 7(1)(c) CTMR relating to a trade mark which consists exclusively of a sign or indication which may service in trade to designate the geographical origin of the goods or services. The CTM proprietor sets out that a geographical term should be considered to be the recognised name of a country, region, landscape, city, lake or river, whereas the CTM is a stylised representation of a bird that makes no obvious or immediate reference to the name of the city of Liverpool. Although the CTM may carry connotations of the city of Liverpool to certain consumers, just as many consumers would see the mark simply as a stylised representation of a bird, and would take no geographic meaning from it. The applicant has not proven that the bird device is recognised as a geographical indicator. Even if the CTM is recognised as a geographic term referring to Liverpool, it must also be recognised as such in association with the goods and services in question. The CTM does not have the required reputation for said goods and services.
- (7) The CTM proprietor submits that should the CTM be found to indicate geographical origin of the goods and services, then it invokes Article 7(3) as the CTM has become distinctive through its use by Liverpool Football Club since the 1950s. In support of this, the CTM proprietor has submitted a Witness Statement by Jonathan Bamber, a solicitor within the Legal Department of the Liverpool Football and Athletic Grounds Limited. The Witness Statement confirms the earlier submissions and further argues that the particular representation of the Liver Bird used in the CTM is unique to Liverpool Football Club. Mr Bamber states that it is important to consider the relevant public, who, in this instance, are supporters of Liverpool Football Club, or Football in general. This public will be aware that the CTM refers to Liverpool Football Club, and not the city of Liverpool in general. According to Mr Bamber, the subject Liver Bird of the CTM has been used in various formats since the 1950s, and the reason that it registered the CTM is to protect its interest from financial problems as a result of counterfeit goods relating to the Liverpool Football Club.

- (8) In order to support its claim that the CTM has acquired distinctiveness in accordance with Article 7(3) CTMR, the CTM proprietor filed, inter alia, the following documents:
- JB1 consists of representations of various club badges used by Liverpool Football Club, as well as tickets and brochures alleged showing identical or similar representations of the Liver Bird in the CTM. The exhibit also includes several trade mark registration containing a Liver Bird from the United Kingdom Intellectual Property Office, as well as OHIM.
  - JB2 consists of examples of merchandising and branding used by Liverpool Football Club, all of which apparently show use of the CTM.
  - JB3 consists of examples where the representation of the Liver Bird in the CTM is used on unofficial publications, fan sites, internet forums and home-made banners etc.
- (9) In the submissions in reply, the applicant states that the declaration of invalidity is actually on the basis of Article 7(1)(b), (c) and (d) CTMR. As shown in the evidence, the Liver Bird is used by many businesses, and so cannot function to identify one trade origin. The mark has been used by many people and will continue to do so, contrary to the submissions of the CTM proprietor, and so it has become customary in trade. As a result it should remain to be used freely by undertakings and not registered to one. The mark does consist of a geographical indicator, and the very reason Liverpool Football Club have incorporated the Liver Bird is because of its historical significance with the city of Liverpool. It is unreasonable to presume people would associate the Liver Bird with such a long list of products and services, as registered by Liverpool Football Club. The applicant argues that the representation of the Liver Bird in the CTM is not sufficiently different from the many other versions and so does not distinguish it from others. The evidence submitted in accordance with Article 7(3) does not show the CTM device used on its own, but in conjunction with other elements such as "Liverpool FC". Also, the representation of the Liver Bird used by Liverpool Football Club has in fact changed over the supposed 50 years of use. Regardless of the CTM proprietor's use, there is significant use of the Liver Bird device by other businesses and organisations so it cannot be considered to be distinctive for Liverpool Football Club alone.
- (10) In support of its arguments, the applicant filed as Exhibit A a survey carried out in 3 different locations in Liverpool, on the 20<sup>th</sup> and 21<sup>st</sup> of June 2012. The question of the survey is "What does this image indicate to you?" The image used is the CTM in these proceedings. According to the applicant, the result was that 55.6% of people recognised it as denoting the city of Liverpool, whilst only 16.8% recognised it as indicating Liverpool Football Club.
- (11) The CTM proprietor's rejoinder argues that as the applicant did not expressly state the specific grounds he was seeking to rely on in the original application for a declaration of invalidity, he cannot be allowed to do so at this stage of the proceedings. The fact that other entities have used a Liver Bird does not mean that the CTM proprietor is not capable of gaining acquired distinctiveness through its own use. Also, despite the fact that the CTM registration has sometimes been used in conjunction with other elements, it has still become inextricably linked to Liverpool Football Club. The fact that the CTM registration covers a large number of classes is irrelevant when

assessing whether or not it has become distinctive for such goods and services. The applicant argues that the survey evidence submitted by the applicant should be disregarded as no information has been provided as to the scope or extent of the survey or its methodology. The applicant reiterates that the average consumer is aware of football clubs and sports in general. Even if the CTM is likely to be seen as indicating geographic origin, the city of Liverpool does not have a reputation for the goods and services of the CTM in these proceedings. Also, the CTM is not customary in trade for the specific goods and services.

## **GROUNDINGS FOR THE DECISION**

### *On the admissibility*

- (12) The request complies with the admissibility requirements prescribed in the CTMR and of the Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing the CTMR ("CTMIR"), in particular with Article 56(1) CTMR and Rule 37 CTMIR, and is therefore admissible.
- (13) For the sake of completeness the Office at this juncture clarifies that that the applicant's application can be interpreted as being, from the beginning, aimed to invoke Article 7(1)(b), (c) and (d) CTMR.
- (14) It is true that each application filed with OHIM must be interpreted, as far as possible, according to the intentions of the applicant, i.e. without limiting the examination to the statement it has made in the application form. Indeed, the Office has to examine a request as a whole, thus also on the basis of the statement of grounds submitted by the applicant, without limiting itself to the application form (see judgment of 24/03/2011, T-419/09, "AK 47", para 21-27). This is because the application form does not exclusively define the scope of the application and the whole of the facts and arguments put forward by the applicant must be taken into consideration, provided that the other party and the Office can reasonably understand them.
- (15) However, the facts and arguments submitted by the applicant must still be contained in its first submission, i.e. in what it has submitted an argued at the stage of the request. Furthermore, these facts and evidence must be put forward and illustrated in a clear and unambiguous manner.
- (16) In its reasoned statement the applicant clearly makes reference to the fact that it considers the Liver Bird to designate the geographical origin of the city of Liverpool. Article 7(1)(c) therefore is indicated. The applicant also states that the Liver Bird sign is used by individuals and companies in a huge array of goods and services, and does not distinguish one organisation from another. Article 7(1)(b) is therefore indicated. Finally, the applicant states that many organisations use the Liver Bird in several industries. It is assumed that this refers to Article 7(1)(d).
- (17) These indications confirm that, at least initially, the applicant was intending to invalidate the CTM using Article 7(1)(b), (c) and (d) CTMR.

*On the substance*

- (18) The request is not well-founded. The Cancellation Division considers that the CTM has not been registered in breach of Article 7(1)(b), (c) or (d) CTMR.
- (19) Pursuant to Article 52(1)(a) and (3) CTMR, a Community trade mark shall be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings, where the Community trade mark has been registered contrary to the provisions of Article 7 CTMR. Where the ground for invalidity exists in respect of only some of the goods or services for which the Community trade mark is registered, it shall be declared invalid as regards those goods or services only.
- (20) As regards the assessment of the absolute grounds of refusal pursuant to Article 7 CTMR, which had been subject to the *ex officio* examination previous to the registration of the CTM, it should be noted first that the Cancellation Division will not carry out its own research but confine itself in principle to an analysis of the facts and arguments presented by the parties (see also Manual, Part D, Section: Cancellation Proceedings, Substantive Provisions, Chapter 4.1.).
- (21) These facts and arguments must relate to the time of the application for the CTM. However, facts concerning the time thereafter might give an indication also as to time of the application (see order of 23 April 2010, C-332/09 P, 'Flugbörse', para 41 and 43).
- (22) It is settled case-law that each of the grounds for refusal to register listed in Article 7(1) CTMR is independent and requires separate examination. Moreover, it is appropriate to interpret those grounds for refusal in the light of the general interest which underlies each of them. The general interest to be taken into consideration must reflect different considerations according to the ground for refusal in question (see judgment of 16 September 2004, C-329/02 P, 'SAT.2', para 25).

*Article 7(1)(c) CTMR*

- (23) Under Article 7(1)(c) CTMR, trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, intended purpose or other characteristics of the goods or services, shall not be registered. Thus Article 7(1)(c) CTMR pursues the aim, which is in the common interest, of ensuring that signs or indications which describe the categories of goods or services in respect of which registration is applied for remain available. Hence, this provision does not permit such signs or indications to be reserved for use by one undertaking as a result of their registration as a trade mark (see judgment of 12 February 2004, C-265/00, 'Biomild' para 31).
- (24) The signs and indications referred to in Article 7(1)(c) CTMR are those which may serve in normal usage from a consumer's point of view to designate, either directly or by reference to one of their essential characteristics, the goods or services in respect of which registration is sought. Accordingly, a sign's descriptiveness can only be assessed by reference to the goods or services concerned and to the way in which it is understood by a specific intended public.

- (25) Both parties have provided arguments as to who the average consumer of the goods and services will be. The CTM proprietor has argued that the average consumer will be a supporter of Liverpool Football Club or football and sport in general. The applicant has argued that the relevant class of people is in fact much larger, and includes local people, national and international tourists, workers and commuters, and people interested in history, culture, music, theatre, comedy, sport and art.
- (26) The goods and services in question are directed primarily at the average consumer at large. Neither the goods nor the services are particularly specialist, nor have they been identified as being so through a limitation to the list of goods and services registered in the CTM. The goods are available to, and regularly purchased by, the average consumer in retail outlets. The attention of the average consumer in relation to the goods can vary greatly, depending for instance on their cost. The goods in general are relatively low in price, and even though certain goods may be more expensive than others, the level of attention is considered to be at least average. In relation to the services in class 36, although their purpose is to assist with financial matters and so more attention may be paid than when purchasing a basic good, they are still available to a non-specialist consumer and so the level of attention in general will be no higher than average.
- (27) As the CTM is not a word mark, there is not the need to take into consideration a relevant public with certain command of a specific language. As such, and in accordance with Article 7(2), the trade mark shall not be registered if the grounds of non-registrability obtain in any part of the Community.
- (28) The applicant has argued that the CTM falls foul of Article 7(1)(c) in so far as it designates the geographical origin of the goods or services. This is based on the fact that the trade mark consists of a Liver Bird, which, according to the applicant, is synonymous with Liverpool dating back to the 1350s as a corporate seal.
- (29) Article 7(1)(c) CTMR does not exclude geographic indications per se, but trademarks which consist exclusively of signs or indications which may serve to designate the geographical origin of the goods and services. As with all descriptive terms (Article 7(1)(c) CTMR) the test is whether the geographic term describes objective characteristics of the goods and services. This must then be assessed with reference to the goods and services claimed and with reference to the perception by the relevant public.
- (30) When ascertaining whether a trade mark which consists of a geographical place name will be perceived as an indication of origin, it is necessary to consider several factors. It is firstly necessary to discover whether or not the term will be understood as a geographical term by a reasonably well informed consumer with a sufficient common knowledge; i.e. not a specialist in geography. An objection does not apply in respect of representations of towns, cities, villages etc., which are not readily understood as being a geographic indicator. Secondly, it is not only necessary that the relevant public recognises the term or representation as a geographical place, but also understands it in connection with the goods. Thirdly, it is not enough that the goods can theoretically be produced in the geographical place, but it must be

proven that the geographical place is currently associated with the goods, or will be liable to future association.

- (31) As to the first factor, it is necessary to discover whether or not the representation of the Liver Bird in the CTM is recognised as a sign which may serve in trade to designate the city of Liverpool. The survey evidence provided by the applicant in this regard is considered to be insufficient to justify this. In order for survey evidence to be considered sufficient it has to adhere to certain criteria, and provide particular information regarding the methodology. For example, it should be stated how the interviewees have been selected, and it is important that the persons questioned are not limited to the class who may be likely to purchase the goods or services. The number of interviewees and their geographical spread is not considered sufficient to establish a convincing survey, particularly as only people within Liverpool city were asked, and coupled with the fact that of those questioned only 55.6% recognised the CTM a symbol of Liverpool, the outcome is insufficient to conclude that CTM is recognised as a geographical indicator.
- (32) The applicant also provided evidence showing different representations of a Liver Bird appearing on buildings throughout the city of Liverpool. Many of the articles and images of Liver Birds, although from different sources, reference the same representation and location of a particular example of the Liver Bird. For example, although there are a number of articles referring to the Liver Birds on top of the Royal Liver Building, they are all still referring to one location. As a result, any claims relating to the widespread prevalence of this particular representation of the Liver Bird are misleading. Of the articles referring to an image of a Liver Bird, a number have been published after the relevant date.
- (33) Perhaps the most compelling piece of evidence is the book entitled *The Little Book of Liverbirds*, by David Cottrell, as it provides many representations of apparent Liver Birds in different locations in the city of Liverpool. However, this is only one book, and one source of evidence. As a result, it cannot be considered to support the argument that locations of Liver Bird representations throughout the city or Liverpool are well known and recognised, nor does one source of evidence justify the conclusion that said representations lead to the conclusion that the Liver Bird acts as a geographical indicator. The Office does not find the evidence provided by the applicant to prove that not just any image of a Liver Bird, but the representation of the Liver Bird in the CTM, would be recognised by the average consumer of the goods and services in the European Union as denoting the geographical location of Liverpool. It must be borne in mind that the Liver Bird is not a state emblem for the city of Liverpool.
- (34) In regards to the second and third assessment, had the CTM been recognised as a geographical indicator of the city of Liverpool, then it would have had to be associated with the particular goods and services of the city in not just a theoretical capacity, but in a real and current or future sense. Although the evidence of the applicant provided images of a Liver Bird in the city of Liverpool, they were not as represented in the CTM, and furthermore, they were not sufficiently linked or proven to be used in conjunction with the goods and services of the CTM.

- (35) Both parties have referenced the judgment of 25/10/2005, T-379/03, Peek & Cloppenburg KG v OHIM in relation to these proceedings. The Office finds that the conclusion of this judgment has relevance for these proceedings, and favours the argument of the CTM proprietor. Although the applicant has argued that it has proven that the public perceive the Liver Bird to be associated with the city of Liverpool, in particular through its survey evidence, the Office finds this not to be the case, and even if it had been proven to be so, then it does not automatically mean that consumers would associate the representation (in T-379/03 it is town name) with the goods and services.
- (36) It follows from the above that the CTM was not registered contrary to Article 7(1)(c) CTMR.

*Article 7(1)(b) CTMR*

- (37) For a trade mark to possess a distinctive character within the meaning of Article 7(1)(b) CTMR, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings.
- (38) Whilst Articles 7(1)(b) and 7(1)(c) CTMR call for a separate examination on account of the specific public interest pursued by each ground of refusal, both grounds have a certain overlap, in particular as regards descriptive terms, which might not only designate a characteristic of the goods and services in question pursuant to Article 7(1)(c) CTMR, but for the same reason also do not serve to distinguish the goods and services as regards their commercial origin pursuant to Article 7(1)(b) CTMR. It is also apparent from settled case-law that distinctive character must be assessed, first, by reference to the relevant goods and, second, by reference to the perception of the relevant public (see judgment of 8 May 2008, C-304/06, 'Eurohypo', para 66 and 67), i.e. in a similar fashion as the designation of a characteristic. As follows from the assessment above, the CTM did not fall foul of this provision on account of a descriptive meaning for the goods and services.
- (39) Furthermore, the required distinctive character of a Community trade mark can also be missing where the sign in question is commonly used in connection with the marketing of the goods concerned. In this respect, the applicant has provided insufficient evidence to support the argument that the representation of the Liver Bird in the CTM was commonly used in trade at the time of filing of the CTM.
- (40) The applicant has provided evidence of different images of a Liver Bird. The representation of a Liver Bird appears to vary quite constantly and drastically, and this assessment is supported by the extract from Wikipedia which explains that the Liver Bird has been portrayed in many forms throughout the city. The evidence provided by the applicant has been reviewed and summarised at length. It is apparent that although there is evidence of images of a Liver Bird appearing on some of the goods and services of the CTM, the extent of use is not sufficient to prove that a) a Liver bird in general is non-distinctive for these goods and services, as well as the other goods and services, and b) the representation of the actual Liver Bird in the CTM is non-distinctive for these goods and services. In order for the use of the trade mark to be considered non-distinctive it has to have been used on the goods and

services of the CTM at the time it was registered. This has not been sufficiently proven by the applicant.

- (41) As has been mentioned previously, the evidence provided by the applicant indicates that the majority of representations of the Liver Bird appear in masonry and on buildings, or in the form of statues. *Stonemasonry and statues of stone* are goods in class 19, whilst *statues of wood* are in class 20. The CTM is not registered for either of these classes. Although the CTM is registered for *statues and statuettes; all being of common metal* in class 6, and *articles made of ceramics, glass, porcelain or earthenware which are not included in other classes* in class 21, the evidence provided by the applicant is insufficient to conclude that the CTM has been used to the extent that it is non-distinctive for these goods and services. Also, the evidence shows that due to the number of different styles of Liver Bird, it is not possible to argue that the representation in the CTM is not sufficiently stylised to be considered unique and therefore distinctive.
- (42) It follows from the above that the CTM was not registered contrary to Article 7(1)(b) CTMR.

*Article 7(1)(d) CTMR*

- (43) Under Article 7(1)(d) CTMR, trade marks shall not be registered 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. The marks are therefore 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 judgment of 23 October 2008, T-133/06, 'Past perfect', para 52.
- (44) The applicant has essentially argued that because the Liver Bird is recognised as symbol of the city of Liverpool, and is used plentifully by a variety of different organisations and business etc., it is therefore customary in trade. The onus is on the applicant to prove through evidential format that the actual CTM, and not a different representation of a Liver Bird, has been and is being used currently so frequently in particular trade sectors, that it is now considered to be customary in trade. This equates to the requirement of evidential proof that the CTM has been used to such an extent on the actual goods and services of the CTM registration that its presence would not denote trade origin.
- (45) The majority of the evidence of examples of a Liver Bird filed by the applicant are not the same as the representation in the CTM, nor are they on the actual goods and services of the CTM. There are limited examples of a Liver Bird on a key-ring or tie or paperweight for example, but not in sufficient number. Furthermore, the evidence does not show examples of a Liver Bird on the registered goods and services. Whilst it is acknowledged that the applicant filed a number of different representations of a Liver Bird, they are not identical to that of the CTM, and are in the majority examples that are found in the form of statues, or on masonry, architecture, or in art form.
- (46) The applicant has not presented sufficient evidence showing common usage of the trade mark as filed in relation to the goods and services at the time of the application for the CTM.

- (47) It follows from the above that the CTM was not registered contrary to Article 7(1)(d) CTMR.

*Conclusion*

- (48) As the registration has not been found to be registered contrary to Article 7(1)(b), (c) or (d), it is not necessary to consider the evidence filed by the CTM proprietor for the purposes of Article 7(3).
- (49) It follows from above that the invalidity request is to be rejected as unfounded.

**COSTS**

- (50) Pursuant to Article 85(1) CTMR and Rule 94 CTMIR, the party losing cancellation proceedings shall bear the fees and costs of the other party. The applicant, as the party losing the cancellation proceedings shall bear the fees and costs of the CTM proprietor.
- (51) The amount of costs to be paid by the applicant to the CTM proprietor pursuant to Article 85(6) CTMR in conjunction with Rule 94(3) CTMIR shall be EUR 450, corresponding to representation costs.



**THE CANCELLATION DIVISION**

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Richard Thewlis

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Dafydd Collins

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Kim Pagels

**Notice on the availability of an appeal:**

Under Article 59 CTMR any party adversely affected by this decision has a right to appeal against this decision. Under Article 60 CTMR notice of appeal must be filed in writing at the Office within two months from the date of notification of this decision and within four months from the same date a written statement of the grounds of appeal must be filed. The notice of appeal will be deemed to be filed only when the appeal fee of EUR 800 has been paid.

**Notice on the review of the fixation of costs:**

The amount determined in the fixation of the costs may only be reviewed by a decision of the Cancellation Division on request. Under Rule 94(4) CTMIR such a

request must be filed within one month from the date of notification of this fixation of costs and shall be deemed to be filed only when the review fee of EUR 100 (Article 2 point 30 of the Fees Regulation) has been paid.