

# In-cider scoop: descriptive vs distinctive trade marks

By [Karen Kitchen](#)

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In order for a trade mark to be registrable, it must be distinctive and capable of distinguishing one party's products from another party's operating in a similar field of trade. Ideally trade marks should not be descriptive of the goods they apply to, or of the inherent qualities or characteristics of the goods. What we often see, particularly in the alcohol industry, is, for example, certain ciders, named after the variety of apple used to make the cider itself. But we need to ask is if this name can be considered distinctive or descriptive?



Karen Kitchen

*Disclaimer: the examples used in this article are purely for illustration purposes, and for purposes of research and study.*

The Katy apple is a Swedish dessert apple variety which is not commonly used to make cider, but has been recognised by cider makers as an interesting varietal to use in cider making. Thatchers, a renowned cider maker in the UK, grows about 460 different apple varieties at its orchards, including the Katy variety. In the early 2000s, it launched its Thatchers KATY cider, and has since secured registered trade mark rights in the UK for THATCHERS KATY (2001) and KATY (2006) in class which includes cider – a depiction of this product is found below.

Now that Thatchers has secured registered trade mark rights for the word KATY, cider makers are faced with a dilemma. If they use the Katy variety of apple in their ciders, can they refer to the word “Katy” on their cider labels?

There are a few issues at play. How did Thatchers manage to secure registered trade mark rights for the word KATY in class 33 on cider in the first place, given that it is a descriptive term for a specific variety of apples AND that Katy apples are used in that particular cider itself?

'Katy' was a descriptive term for a specific variety of apples when Thatchers filed their trade mark KATY. At the time it probably wasn't and still isn't considered a descriptive term when used as a trade mark in relation to cider per se. A question arises as to whether cider and apples used in cider-making are similar goods.

In terms of South African case law, in particular in *Alexander Anatole Theodor Mettenheimer & Zonquasdrift Estates (Pty) Ltd v Zonquasdrif Vineyards CC & Others*, the Supreme Court of Appeal found that wine grapes and wine were not similar goods. Through a process of deduction in a local context, one can similarly argue that apples used in cider, and cider as an end product, are not similar goods.

Given that Thatchers likely uses Katy apples in its KATY cider, they run the risk of encountering an objection to their registered KATY trade mark. An interested third party can claim the KATY mark is indicative of the qualities and characteristics of its cider which is made from Katy apples.

Thatchers could defend its position by showing substantial use of the trade mark KATY on cider prior to when the name was registered, showing that the word had gained a secondary meaning of a distinctive nature, apart from as a descriptor for a specific variety of apples (irrespective of whether or not these apples are used in its cider).

As a result, cider makers can use the Katy variety of apple in their ciders and they can also make reference to the word “Katy” on their cider labels.

We suggest that the use of KATY as a trade mark be avoided, particularly in the UK where Thatchers has a monopoly right in the form of a registered trade mark that is valid and enforceable against third parties. Cider makers should restrict use of the term “Katy” to descriptive use only. Examples of descriptive references to an apple varietal used in a cider include:



No. 2



**The Newt**

in Somerset

DABINETT CYDER

2018



Notably the references to “Dabinett Cyder” and “Golden Delicious Apple” appear to be descriptive as they are subsidiary elements that lie beneath the primary trade marks (which in the above examples would be THE NEWT and SXOLLIE), and are cited in smaller font.

## ABOUT THE AUTHOR

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