

O-020-15

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION NUMBER 3020263
BY SELF CARE CORPORATION PTY LTD
TO REGISTER THE FOLLOWING MARK
IN CLASS 3:**

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Background

1. On 31 August 2013, Self Care Corporation Pty Ltd ('the applicant') applied to register trade mark application number 3020263 consisting of the words 'TINT&GROW' for the following goods in class 3:

Cosmetic preparations; cosmetics; make-up.
2. On 16 September 2013, the Intellectual Property Office ('IPO') issued an examination report in response to the application. In that report, an objection was raised under sections 3(1)(b) and (c) of the Trade Marks Act 1994 ('the Act'), on the basis that the mark consists exclusively of a sign which may serve in trade to designate the intended purpose of the goods e.g. cosmetic preparations for the purpose of tinting and growing. In addition to being granted a period of two months for submitting a response, the applicant was also invited under Rule 62 of the Trade Marks Rules (2008) to provide examples showing how the mark is used, or is intended to be used.
3. On 18 November 2013, the applicant responded electronically, providing examples of how it uses the mark. Additionally the applicant argued that there is no requirement that a mark be "un-suggestive" of the goods it is used on. Moreover, the mark is not the word 'TINT' or 'GROW' but a combination of these words together with an ampersand symbol between them. Thus, the mark is a trade mark as demonstrated by the use submitted. The applicant also indicated that it has used the sign since May 2013 in Australia and intended to commence use of the sign in the UK 'very shortly'.
4. On 27 November 2013, the IPO issued its response by maintaining the objection. This was because, in the examiner's words, "*the mark 'TINT&GROW' does not act to denote any origin of trade for a consumer and it is deemed the consumer would merely expect the product to tint and grow ones eyelashes, therefore not complying with Section 3(1)(c)*". Additionally, the references to the applicant's use of the mark were not taken into account as the evidence was not submitted in the correct format.
5. On 24 January 2014, the applicant submitted formal evidence of the use it has made of the mark. The evidence demonstrates that the sign has been used in the UK since August 2013 in respect of cosmetics, namely, buildable eyelash tint and growth serum. Before the date of filing the application a total of 36 units were sold with a retail value of £1,438. The evidence also details use the applicant has made of the sign in Australia and New Zealand.

6. On 31 January 2014 the IPO issued a further report maintaining the objection. The examiner was not persuaded that the application should proceed on the basis of distinctiveness acquired through use as the applicant has not had substantial use of the mark before the filing of the application. However, a period of two months was granted for the applicant to respond further.
7. No response was received from the applicant within the date set, and so the application was subsequently refused by way of letter dated 10 April 2014.
8. On 8 May 2014, the IPO received form TM5 requesting a statement of reasons for the Registrar's decision.

Section 3(1)(c)

9. 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.”

10. There are now a number of judgments from the CJEU which deal with the scope of Article 3(1)(c) of First Council Directive 89/104 (recoded and replaced by Directive 2008/95/EC on 22 October 2008) and Article 7(1) (c) of the Community Trade Mark Regulation (the 'CTMR'), whose provisions correspond to section 3(1) (c) of the UK Act. The following main guiding principles which are relevant to this case are 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 or services in question. It is sufficient that it could be used for such purposes (*Doublemint*, paragraph 32);
- It is irrelevant whether there are other, more usual signs or indications designating the same characteristics of the goods or services. The word ‘exclusively’ in paragraph (c) is not to be interpreted as meaning that the sign or indication should be the only way of designating the characteristic(s) in question (*Koninklijke KPN Nederland NV v Benelux Merkenbureau*, C-363/99 (*Postkantoor*), paragraph 57);
- An otherwise descriptive combination may not be descriptive within the meaning of Article 3(1)(c) of the Directive provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements. In the case of a word trade mark, which is intended to be heard as much as to be read, that condition must be satisfied as regards both the aural and the visual impression produced by the mark (*Postkantoor*, paragraph 99).

11. In *Matratzen Concord AG v Hukla Germany SA*, C-421/04 (*Matrazen*), the CJEU stated that:

“...to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say in trade and or amongst average consumers of the said goods or services, who are reasonably well informed and reasonably observant and circumspect, in the territory in respect of which registration is applied...”

12. I am also mindful of the decision of the General Court (formerly the Court of First Instance) in *Ford Motor Co v OHIM*, T-67/07 where it was stated that:

“...there must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the category of goods and services in question or one of their characteristics”.

13. It is clear from the aforementioned case law that, assuming notional and fair use, I must determine whether or not the mark applied for will be viewed by the average consumer as a means of directly designating essential characteristics of the goods being provided. It is reasonable to assume that the average consumer is likely to consist of those wishing to enhance or maintain their appearance by the application of cosmetics. Cosmetic products vary greatly in cost and, at least in part, the average consumer would apply a reasonably high level of attention to the goods being sought out.

14. In assessing the mark applied for, I have taken account dictionary definitions of the individual words contained within the mark. The following definitions are both taken from Collins English Dictionary:

Tint: To colour or tinge.

Grow: (Of an organism or part of an organism) to increase in size or develop (hair, leaves, or other structures).

15. The word 'tint' has an obvious descriptive meaning in relation to cosmetic products which provide colour, such as mascara, for instance. As regards the word 'grow', it is common to market such mascara products which not only tint eyelashes but also actively promote their growth (I refer to Annex A demonstrating such use by third parties in trade). Indeed, the literature provided by the applicant also makes reference to the goods for which the mark is used on, namely, buildable eyelash tint and growth serum, as having such an intended purpose i.e. providing a gradual eyelash tint that makes eyelashes grow longer.
16. I do not believe that the combination of these two words with an ampersand inbetween can lay claim to any grammatical or linguistic imperfection or peculiarity such as might help to escape its inherent descriptiveness. In particular, both of the words 'tint' and 'grow' can be used to describe an intended purpose of the goods as demonstrated by the applicant's own use. The average consumer of the goods, who I have identified as being those wishing to enhance or maintain their appearance by the application of cosmetics, would find it desirable that cosmetic products such as mascara can both tint and grow one's hair. Thus, the sign 'TINT&GROW' would be perceived by the relevant consumer as nothing more than the sum of its parts, and an expression which describes the intended purpose of the goods, namely cosmetic preparations which tint and grow hair. In this respect, I refer to comments made in *Postkantoor* where the CJEU held that:

"98. As a general rule, a mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics for the purposes of article 3(1)(c) of the Directive. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned."
17. Taking all the above into account, I have concluded that the mark applied for consists exclusively of a sign which may serve, in trade, to designate the intended purpose of the goods, and are words that should be kept free for other traders to use in describing their own goods. They are therefore excluded from registration in the *prima facie* case by section 3(1)(c) of the Act.
18. Having found that to be the case, it effectively ends the matter. However, in case I am found to be wrong in this regard, I will go on to determine the matter under section 3(1)(b) of the Act. I should at this point stress that since an objection has been made under section 3(1)(c), this automatically engages section 3(1)(b). However, it can be useful to also consider section 3(1)(b) in its own right - the scope of the two provisions is not identical, and marks which are not descriptive under section 3(1)(c) can nonetheless be devoid of any distinctive character.

Section 3(1)(b)

19. I approach this ground of objection on the basis of the following principles derived from the CJEU cases referred to below:

- An objection under section 3(1)(b) operates independently of objections under section 3(1)(c) - (*Linde AG (and others) v Deutsches Patent-und Markenamt*, Joined Cases C- 53/01 to C-55/01, paragraphs 67 to 68);
- For a mark to possess a distinctive character it must identify the product (or service) in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product (or service) from the products (or services) of other undertakings (*Linde* paragraphs 40-41 and 47);
- A mark may be devoid of distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive (*Postkantoor* paragraph 86);
- A trade mark's distinctiveness is not to be considered in the abstract but rather by reference to the goods or services in respect of which registration is sought and by reference to the relevant public's perception of that mark (*Libertel Group BV v Benelux Merkenbureau*, Case C-104/01 paragraphs 72-77);
- The relevant public must be deemed to be composed of the average consumer who is reasonably well-informed and reasonably observant and circumspect (*Libertel* paragraph 46 referring to Case C-342/97 *Lloyd Schuhfabrik Meyer*).

20. Furthermore, in relation to section 3(1)(b) it was held in *Postkantoor* that:

"In particular, a word mark which is descriptive of characteristics of goods or services for the purposes of Article 3(1)(c) of the Directive is, on that account, necessarily devoid of any distinctive character with regard to the same goods or services within the meaning of Article 3(1)(b) of the Directive. A mark may none the less be devoid of any distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive." (Paragraph 86)

21. I do not consider that an application should necessarily escape objection if it is considered too imprecise a term to indicate a direct and specific relationship with the goods at issue without further thought, but is, in some sense, more generally non-distinctive. I have indicated in paragraph 14 how I feel the average consumer will perceive the mark. I do not believe that the sign is capable of performing the essential function of a trade mark as I consider consumers would not, without further education, consider the phrase 'TINT&GROW' to be that of any particular provider of cosmetic products.

22. Anna Carboni, sitting as the Appointed Person in *COMBI STEAM*, O-363-09, conveniently summarised the leading case law in respect of this part of the Act:

"It has been said that lack of distinctive character is the essence of any objection under section 3(1)(b), (c) or (d) of the Act and that, despite its position in the list, section 3(1)(b) performs "a residual or sweeping-up function", backing up the other

two provisions, which contain specific and characteristic examples of types of marks that lack distinctive character: Procter & Gamble Ltd's Trade Mark Application [1999] RPC 673 (CA) per Robert Walker LJ at 679. If a trade mark is entirely descriptive of characteristics of goods or services (and thereby prohibited from registration under section 3(1)(c)), it will also be devoid of any distinctive character under section 3(1)(b): Koninklijke KPN Nederland BV v Benelux-Merkenbureau Case C-363/99 (POSTKANTOOR) [2004] ETMR 57 (ECJ) at [86]".

23. For reasons already given, the Registrar considers the sign to be descriptive of specific characteristics of the goods. The words comprising the mark are descriptive of cosmetic products, and are words that others are using to describe such goods. It is clear from the above guidance that if a mark is entirely descriptive of characteristics of goods, it will also be devoid of any distinctive character under section 3(1)(b). As I have found that the mark in question is open to objection under section 3(1)(c) of the Act, it follows that it is also open to objection under section 3(1)(b) of the Act.

Evidence of acquired distinctiveness

24. As stated above, on 24 January 2014 the applicant submitted formal evidence of the use it has made of the mark 'TINT&GROW'. The evidence is comprised of a Witness Statement of Tatiana Agafonova (Marketing Co-ordinator of the applicant) together with exhibits showing how the mark is used on, for example, packaging artwork. The statement confirms that the mark was first used in the United Kingdom in August 2013 for 'cosmetics namely buildable eyelash tint and growth serum'. Prior to filing of the application on 31 August 2013, the applicant sold 36 units of the goods with a retail value of £1,438.. Additionally, the statement confirms use the applicant has made of the mark outside the UK in Australia and New Zealand.
25. The question to be determined is whether, through the use made of it, the sign applied for has acquired a distinctive character in respect of the goods for which registration is sought. In doing so, this question must be asked through the eyes of the average consumer who is reasonably well informed, observant, and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel BV*, C-342/97[1999] ECR I-3830 paragraph 26). In this case, I have identified the average consumer as being someone seeking to enhance or maintain his or her appearance by the application of cosmetics.
26. The key authority for acquired distinctiveness is *Windsurfing Chiemsee Produktions Und Vertriebs GMBH v. Boots-Und Segelzubehor Wlater Huber*, C109/97 (*Windsurfing*); the relevant test being set out in paragraph 55:

"...the first sentence of Article 3(3) of the First Directive 89/104/EEC is to be interpreted as meaning that:

- A trade mark acquires distinctive character following the use which has been made of it where the mark has come 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 goods of other undertakings;

- In determining whether a trade mark has acquired distinctive character following the use which has been made of it, the competent authority must make an overall assessment of the evidence that the mark has come to identify the product concerned as originating from a particular undertaking and thus to distinguish that product from goods of other undertakings;

- If the competent authority finds that a significant proportion of the relevant class of persons identify goods as originating from a particular undertaking because of the trade mark, it must hold the requirement for registering the mark to be satisfied;

- Where the competent authority has particular difficulty in assessing the distinctive character of the mark in respect of which registration is applied for, Community law does not preclude it from having recourse, under the conditions laid down by its national law, to an opinion poll as guidance for its judgment.”

27. I am also mindful of the CJEU decision in *Bovemj Verzekeringen NV v Benelux Merkenbureau (Europolis)*, C-108/05 where it was held that a trade mark may be registered on the basis of acquired distinctiveness “...only if it is proven that the trade mark has acquired distinctive character through use throughout the territory of a member state”.
28. As detailed in previous paragraphs, the expression ‘TINT&GROW’ must rate as an entirely descriptive and grammatically-correct sequence, of words when used in the context of cosmetic products. The effect of this analysis is that the ‘educative’ burden on the applicant to show that these apt and descriptive words have transformed themselves into an indicator of origin of a single undertaking is especially acute and burdensome. In order to have acquired distinctiveness, the relevant consumer must regard the words as indicating commercial origin, as opposed to merely denoting and/or describing ‘any’ cosmetic product that tints and grows hair. Any possible descriptive meaning must be displaced by the material trade mark meaning.
29. The applicant commenced use of the sign in August 2013 (the same month in which the application was filed) and sold a total of 36 units at a value of £1,483. prior to filing. Although this was not contextualised in terms of demonstrating market share, I think it fair to say that this can be regarded as a relatively insignificant amount, given the size of the cosmetic industry, and that it has been accrued over a very short period of time. Indeed, it is difficult to conclude from this evidence that the sign has been exposed to a significant proportion of the relevant consumer base. Furthermore, whilst I note that the sign has been used in Australia and New Zealand, this cannot assist in proving that the relevant UK consumer has been exposed to the mark since it is outside the relevant territory.

Conclusion

30. Taking into account guidance set out in relevant case law and the documents and exhibits filed, I consider the evidence has failed to show that, at the date of application, the average consumer had been educated into seeing the sign as indicating the trade

origin of the goods. The mark is therefore excluded from acceptance because it fails to qualify under sections 3(1)(b) and (c) of the Act.

Dated this 14th day of January 2015

**Lee Scott
For the Registrar
The Comptroller-General**

Annex A

Evidence of third party use demonstrating that the goods intended for protection are used to actively promote the growth of eyelashes.

<http://www.beautybay.com/skincare/talika/lipocilseyelashreatmentgel/>

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