

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 2116722  
BY PARISMIT & CO LIMITED TO REGISTER  
A TRADE MARK IN CLASS 21**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 48406  
BY SMITHKLINE BEECHAM PLC**

## **TRADE MARKS ACT 1994**

**IN THE MATTER OF Application No. 2116722**

**By Parimit & Co Limited to register**

5 **a trade mark in Class 21**

**and**

**IN THE MATTER OF Opposition thereto**

10 **under No. 48406 by Smithkline Beecham PLC**

### **BACKGROUND**

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On 25 November 1996 Parimit & Co Limited of PO Box 771, 200A High Road, London N22 4HG applied to register the trade mark EASY FLOSSING for a specification of goods of "Toothpick with floss holder".

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The application, numbered 2116722, was published for opposition purposes on 21 January 1998 in Trade Marks Journal No. 6209 which indicated it was proceeding because of distinctiveness acquired through use.

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On 16 April 1998 Smithkline Beecham PLC filed notice of opposition to this application. In summary, the grounds of opposition are:

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1. Under Section 3(1)(a) because the mark is not capable of distinguishing the goods of the applicant from those of other undertakings.
2. Under Section 3(1)(b) because the trade mark is devoid of any distinctive character.
3. Under Section 3(1)(c) because the mark consists exclusively of signs or indications of characteristics of the goods applied for.
- 35 4. Under Section 3(1)(d) because the mark is commonplace in the current language for the goods applied for.
- 40 5. Under Section 3(3)(a) on the grounds it would be contrary to public policy that the expression be the subject of monopolistic rights and should be left freely available for use in the course of trade.
6. Under Section 3(3)(b) because the mark is of such a nature as to deceive the public as to the nature and quality of the goods.
- 45 7. Under Section 3(6) in that the mark has been filed in bad faith.

On 22 July 1998 the applicants filed a counterstatement denying the grounds of opposition.

Both sides seek an award of costs.

5 Both the applicants and the opponents have filed evidence but neither party has asked to be heard. Acting on behalf of the Registrar and after a careful study of the papers I give this decision.

### **OPPONENTS' EVIDENCE**

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This consists of a statutory declaration, dated 11 November 1998, by Marjon Esfandiary, Trade Marks Manager in the Corporate Intellectual Property Department of Smithkline Beecham PLC, the opponents in this case. The evidence reiterates the criticisms under Section 3(1)(a). It also goes on to claim that the mark is descriptive for toothpicks and dental floss and consists exclusively of words which serve to describe the kind, quality and intended purpose of the goods stating that its registration would be contrary to Sections 3(1)(b) and (c) of the Act. No evidence is filed in support of these statements and no mention is made of the objections under Section 3(1)(d) 3(3)(a) and (b), or Section 3(6).

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The opponents also criticise the evidence filed in support of the application at the examination stage - a Statutory Declaration by Trilochan Kantilal Pujara, the Director of the applicant's company, dated 20 June 1997 together with various exhibits. It is said by the opponents that the sales and advertising figures are not such that the words would be recognised as a trade mark by a large percentage of the population. The words of Jacob J. in the "TREAT" case (British Sugar PLC v James Robertson & Sons Ltd) are referred to - 1996 RPC 281 at page 302, lines 23-24, 25-26 and 42-45:

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"It was really no more than evidence of use..... There is an unspoken and illogical assumption that use equals distinctiveness..... It is precisely because a common laudatory word is naturally capable of application to the goods of any trader that one must be careful before concluding that merely its use, however substantial, has displaced its common meaning has come to denote the mark of a particular trader."

### **APPLICANTS' EVIDENCE**

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This consists of a Statutory Declaration dated 10 March 1999 by Helene Michelle Whelbourn of Trade Mark Owners Association Limited, the applicant's trade mark agent. She says that the applicants have already demonstrated that the trade mark EASY FLOSSING has become distinctive by virtue of the evidence given in the Statutory Declaration and exhibits of Trilochan Kantilal Pujara referred to above by the opponents, provided in support of the application - a copy being exhibit "HMW1" to Ms Whelbourn's declaration.

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Ms Whelbourn also refers to the fact that the opponents are reiterating the objections raised in their Notice of Opposition with regard to Sections 3(1)(a) (b) (c) and (d) in their evidence. The points, it is claimed were answered in their counterstatement of 22 July 1998 which referred to the evidence filed in support of their application.

Criticism is also made of Marjon Esfandiary's Declaration where it states "The sales and advertising figures are not such that the words would be recognised as a Trade Mark by a large percentage of the population". Ms Whelbourn says that the sales volumes are "not insignificant" considering the nature of the product and the relatively low unit cost. Exhibit "HMW2" of Ms Whelbourn's declaration consists of a packet of the goods purchased at Tesco's for £1.65.

Ms Whelbourn then criticises the opponents' reference to the TREAT case as being incomplete in that the quotation continues (at lines 45-47) by saying "This is all the more so when the mark has been used in conjunction with what is obviously taken as a trade mark" and also to lines 36-38 on page 285 in that the word TREAT was always used in conjunction with the house mark SILVER SPOON and in a non-trade mark manner in advertising and promotion e.g. "Treat yourself to a complete range", "We have a Treat in store for you." Advertising was directed mainly to the trade rather than the public in that case. Whereas, it is said, EASY FLOSSING has been used in a trade mark manner since 1984 and the exhibits demonstrate prominent use of the mark on the packaging, not used in conjunction with other words and "TM" is placed adjacent to the words. Ms Whelbourn sought to further distance the cases by referring to the differences in the nature of the goods and also that the mark applied for consists of a laudatory adjective and an adverb which describes the action it produces but not the product itself.

A further Statutory Declaration by Trilochan Kantilal Pujara, dated 9 March 1999 is also provided. This criticises the opponents' declaration in that it merely reiterates paragraphs 3, 4 and 5 of the Notice of Opposition. It was also argued that the evidence filed in support of the application was significant and demonstrated the mark has become distinctive by virtue of the evidence set out in his previous declaration. It also adds sales figures for the years 1996-8. The sales figures are:

<u>Year</u>	<u>Retail Sales Value</u>		
1989	215,000	)	
1990	225,000	)	
1991	245,000	)	
1992	260,000	)	
1993	270,000	)	
1994	290,000	)	
1995	312,000	)	
1996	345,000	)	
1997	390,000	)	
1998	445,000	)	

From the statutory declaration of 20 June 1997

From the statutory declaration of 9 March 1999. NB. The years 1997 and 1998 are after the filing date.

Mr Pujara refers to the low unit cost of £1.65 (at 1999 prices) and argues that such low unit cost indicates significant numbers have been sold and that the mark "would be recognised as a Trade Mark by a large percentage of the population". The evidence also provides, at Exhibit "TKP2" a lengthy list of towns and cities in the UK where the product is sold.

## OPPONENTS' EVIDENCE IN REPLY

This consists of a further Statutory Declaration by Marjon Esfandiary dated 24 June 1999. This disputes that the evidence filed demonstrates that EASY FLOSSING has become  
5 distinctive, and that for a mark considered to be so descriptive and which designates the quality and intended purpose of the goods a greater degree of recognition is required. It further states that "the Applicants have produced no evidence that the words are recognised as a trade mark by a substantial majority of persons".

10 Further reference is made to the TREAT case in which it is argued that the judgment of Jacob J. does not preclude its application to descriptive words used without a house mark. Additionally, the applicants had claimed that the goods are specialised, unlike the goods in the TREAT case. However, this is challenged given the low unit cost and that it is a product  
15 which can be found in major supermarkets such as Tesco's (where the applicants' agent bought their exhibit). Reference was also made to what were considered to be low advertising figures up to 1989 and no figures being provided for subsequent years. The statement also refers to the list of cities provided in the applicant's second Statutory Declaration and that it includes cities outside the UK including Republic of Ireland, France, Hungary, Poland, Czech Republic, Slovakia. (For the record, the list provided to the Registrar did not include such  
20 entries!)

## DECISION

25 The grounds of the Opposition originally included reference to Section 3(1)(d), 3(3)(a) and (b), 3(6). No evidence was filed in support of these grounds, therefore they are dismissed. The grounds remaining are, therefore, Section 1(1), 3(1) (a) (b) and (c).

Section 3.1 of the Act reads as follows:

- 30                   **3.(1)** The following shall not be registered -
- (a) signs which do not satisfy the requirements of section 1(1),
  - (b) trade marks which are devoid of any distinctive character,  
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  - (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,  
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  - (d) trade marks 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:  
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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.

Section 1(1) in turn reads:

5           **1(1)** In this Act “trade mark” means any sign capable of being represented graphically which is capable of distinguishing the goods or services of one undertaking from those of other undertakings.

10           A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.

The meaning of Sections 1(1) and 3(1)(a) of the Act, and in particular the words “capable of distinguishing” were considered by Jacob J in *British Sugar PLC v James Robertson & Sons Ltd* 1996 RPC 281 (the TREAT case). He said:

15           Thus, *capable of distinguishing* means whether the mark can in fact do the job of distinguishing. So the phrase in Section 1(1) adds nothing to section 3(1) at least in relation to any sign within sections 3(1)(b)-(d). The scheme is that if a man tenders for registration a sign of this sort without any evidence of distinctiveness then he cannot have it registered unless he can prove it has a distinctive character. That is all. There is no pre-set bar saying no matter how well it is proved that a mark has become a trade mark, it cannot be registered. That is not to say that there are some signs which cannot in practice be registered. But the reason is simply that the applicant will be unable to prove the mark has become a trade mark in practice - “Soap” for “Soap” is an example. The bar (no pun intended) will be factual not legal.”

20           The above remarks indicate that there are some signs which cannot in practice be registered because the applicants will be unable to prove the mark has become a trade mark in practice. The example he gave was ‘Soap’ for soap. It seems to me that just as the name of the goods is a type of sign which falls into this category so too may be wholly apt terms, ‘scented’ for soap say or ‘wide-angle’ for lenses. Other words where they are either allusive or at least not wholly descriptive can be said to have the capability of distinguishing for the purposes of Section 3(1)(a). As this case has not been the subject of a hearing I have not had the benefit of submissions on behalf of the parties as to where the mark applied for stands. Nor does the opponents’ evidence develop the basic claim set out in the statement of grounds.

35           For reasons which will become apparent when I go on to consider the Section 3(1)(b) and (c) grounds the mark applied for seems to me to be at the margins of what is capable of distinguishing. However in the absence of evidence or argument on the point I do not propose to make a formal finding under Section 1(1) and 3(1)(a).

40           It follows from the above that I propose to consider the Section 3(1)(b) and (c) grounds on the basis that the words EASY FLOSSING were, at the date of application capable of meeting the basic requirements of Section 1(1).

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The applicants have filed use of the mark. With regard to this evidence I note that while use is claimed from 1984, sales are only quantified from 1989. Furthermore, the advertising expenditure only occurred in the early years and seems to me to be at a fairly modest level. The use appears to be fairly moderate, all the more so when the wide geographical coverage is taken into account. This makes the impact of the mark all the more difficult to assess since the sales appear to be spread quite thinly.

I now turn to the way the mark is used. I note from the exhibits filed that the words EASY FLOSSING are used in a number of forms, including with the company name Parimit & Co Ltd with varying degrees of prominence. It is also used with the words SWORD FLOSS, such as in the item bought from Tesco's (copy attached as Annex A). When used with other potentially trade mark matter in phrases such as EASY FLOSSING WITH SWORD FLOSS (see examples in Exhibit HMW1 of Ms Whelbourn's declaration) it must, to my mind place doubt as to what, if any, trade mark is being used. (Likewise, the article/advertisement from "Dental Health" which is headed "New dental products from Parimit"). This difficulty is further demonstrated by the applicant's own advertisements which contain text such as "Flossing made easy with EASY FLOSSING". The applicants have attempted to alert the purchasing public to their intended use of EASY FLOSSING as a trade mark by the addition of the TM indicator and by using the words alone in some instances. In my view, this in itself cannot render an otherwise descriptive mark distinctive.

The advertising has been directed at both the trade and the public (unlike the facts commented on in the TREAT case). However, as the opponents state, "I do not think the evidence shows that before the date of application the mark had acquired a distinctive character as a result of the use made of it. A greater degree of recognition is required for a descriptive mark. The applicants have produced no evidence that the words are recognised as a trade mark by a substantial majority of persons." In view of my earlier comments on the applicants' evidence, I find that I agree with this statement and also the further observation by the opponents, "I don't think the judgement of Jacob J in the TREAT case precludes its application to descriptive words used without a house mark e.g. SOAP as a purported trade mark for soap. I don't think the Applicants have shown that their use of EASY FLOSSING has displaced the common meaning of the words and come to denote the mark of a particular trader."

The product is a floss holder which suspends a piece of floss across a curved holder, rather like the string of an archer's bow (see Annex A). It is designed to be easy to use - the applicants' advertising uses such terms as "you only need two fingers rather than two hands with conventional floss" to highlight this characteristic. As Jacob J. said in the TREAT case at page 302, lines 25-26 "There is an unspoken and illogical assumption that "use equals distinctiveness". For the goods at issue it seems to me that more than use alone will be required to demonstrate that such a descriptive mark has come to indicate the goods of one trader. Therefore I find that the mark is devoid of any distinctive character and describes the kind, quality and intended purpose of the goods and should be free for all traders in the oral healthcare field to use. Therefore, I find that the opposition succeeds under Section 3(1)(b) and (c) of the Act.

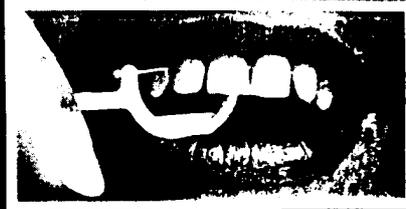
The opposition having succeeded, the opponents are entitled to an award of costs in their favour. I therefore direct the applicants to pay the opponents the sum of £635 as a contribution towards their costs.

5     **Dated this     9     day of February     2000**

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**R A JONES**  
**For the Registrar**  
15     **The Comptroller General**

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