

**TRADE MARKS ACT 1994
IN THE MATTER of Trade Mark No 2054886
in the name of H Young (Operations) Ltd**

and

**IN THE MATTER OF consolidated proceedings,
application for invalidity No 11643
and application for revocation No 11640
by Jacques Andre Germain RUC**

Background

1. On 2 February 1996, Animal Limited applied under the Trade Marks Act 1994 to register the trade mark ANIMAL for a specification of goods which, following amendment, reads:

Class 09:

Protective headwear, spectacles, sunglasses, retainers for spectacles, retainers for sports spectacles and sunglasses.

Class 14:

Jewellery, watch straps, watches, clocks and horological instruments, keyrings; but not including goods in the form of animals.

Class 16:

Printed matter, photographs, books, leaflets, adhesive stickers, labels, posters, stationery, cardboard articles; but not including goods bearing representations of, or relating to, animals.

Class 18:

Bags, backpacks, rucksacks, wallets and purses, straps, belts, keycases.

Class 20:

Display stands, display boards, picture frames, cabinets, dispensers, frames, shelves, keyboards for hanging keys, boxes and packaging containers.

Class 25:

Clothing, footwear, headgear, baseball caps, sweatshirts, t-shirts.

2. The application was accepted, and allowed to proceed to publication on the basis of honest concurrent use with various registrations. The application proceeded to registration. On 10 March 1999, H. Young (Operations) Ltd were recorded as registered proprietor.

3. On 25 May 2000, Jacques Andre Germain RUC filed an application for revocation of the registration and on the same day, filed an application for invalidity. The actions were filed on behalf of the applicants by E Eder & Co. The statement of grounds accompanying the applications each set out a single ground of action. These can be summarised as:

- (a) an application for invalidity under section 47(1) of the Trade Marks Act 1994 in that, in so far as the registration covers goods in class 25, the application for the trade mark ANIMAL failed to satisfy the requirements of section 1(1) of the Act and was therefore registered in breach of section 3(1)(a) of the Act. The applicants claim that in relation to goods in class 25 the word ANIMAL on its own in ordinary lettering is not capable of distinguishing any goods that fall within class 25; and
- (b) an application for revocation under section 46(1)(d) of the Act in that in so far as the registration covers goods in class 25, the use that has been made by the proprietor of the registration or with his consent is and has been liable to mislead the public particularly as to the nature and/or quality of the goods.

4. The registered proprietors filed counterstatements denying the ground of invalidity and the ground of revocation. Both sides seek an award of costs. During the course of these proceedings the invalidity and the revocation actions were consolidated. The consolidated proceedings came to be heard before me on 22 January 2002. The applicants were represented by Mr Maguire of A. T. Maguire & Co and the registered proprietors were represented by Mr Hume of Fitzpatrick's.

Evidence

5. The proceedings were not consolidated until near the end of the evidence rounds and so, the evidence is by and large duplicated. There are two statutory declarations on behalf of the applicants for invalidity from Mr Anthony Maguire, both are dated 28 February 2001. Mr Maguire is a trade mark attorney at A T Maguire & Co, the applicants' representatives in these matters. The registered proprietors' evidence consist of two statutory declarations by Mr Alasdair Hume, both are dated 11 May 2001. Mr Hume is a trade mark attorney with Fitzpatrick's, the registered proprietors' representatives in this matter. For ease of reference I will use the declarations of Mr Maguire and Mr Hume directed to the invalidity action. The reason for this will become clear later in the decision. The registered proprietors also filed a statutory declaration by Mr Thomas Stathis Redfern, dated 21 May 2001. Mr Redfern is the company secretary of Animal Limited and also H Young (Operations) Limited.

Applicants' Evidence

6. Mr Maguire at exhibit ATM.01 attached copies of entries in Webster's Third New International Dictionary and the Concise Oxford Dictionary for the word ANIMAL. He draws

attention to the adjectival definitions of the word and in particular, from Websters “A: of, relating to, resembling, or having the qualities of animals.....b: derived from animals as distinguished from vegetable or mineral sources”. In the Concise Oxford Dictionary he notes that the reference is “1. Characteristic of animals. 2 of animals as distinct from animals”. Thus, in his view, “animal clothing” is a natural use of the English language to describe clothing of, produced from or having some characteristic of an animal or animals.

7. Mr Maguire notes that the registered proprietors in their counter-statement deny that the expression “animal clothing” is used in the manner claimed by the applicants. At ATM.02 he exhibits excerpts from a search of the world wide web undertaken by himself by means of the “Google” search engine. Mr Maguire notes that in the case of the company Whales and Friends, the terms “animal clothing” and “animal t-shirts” are used to describe clothing, having an animal print appended.

8. He also refers to the companies Coyote Graphics and Senior Store.Com, making similar use of the term “animal clothing”. The international on-line auctioneers Gunbroker.com, he states, features two examples of “African wild animal clothing”, being hunting coats made of animal hide. Finally, he refers to the Link-up Web guide which assists interested parties in the search for inter alia “non-animal clothing” which in his view, clearly refers to clothing produced from non-animal sources.

9. At ATM.03, Mr Maguire exhibits further disclosures from the web. He says that these examples show that in the field of animal rights, veganism and vegetarianism, the terms “animal” and “non-animal” clothing are commonly used in the manner described by the applicants.

10. At ATM04, Mr Maguire refers to further disclosures from the web search which he says reveals the term used in; a system for codifying clothing advertisements; two examples from academic works; two examples of studies of indigenous peoples manufacturing and/or wearing clothing from animal skins; two extracts from literary works; and an example of popular humour.

11. Mr Maguire contends that these examples disclosed from the world wide web indicate that the expression is used by a broad cross-section of the public at large, including other traders, to describe clothing made from materials of animal origin, or to which animal images have been appended or material for clothing decorated with animal skin prints.

Registered Proprietors’ Evidence

12. Mr Thomas Redfern’s statutory declaration is a short one introducing exhibit TR1 which is a copy of his declaration of 6 March 2001 in relation to parallel opposition proceedings between the parties. In that declaration Mr Redfern states that the trade mark “ANIMAL” was first used in the United Kingdom in March 1988 by Animal Limited, the predecessor-in-title to H Young (Operations) Limited. At TSR1 he exhibits a copy of a statutory declaration of Mr Ian Richard Elliot who was the Marketing Director of Animal Limited during the period from 1988 until January 1999. The exhibits from Mr Elliot’s declaration are also included.

Mr Redfern states that he understands that this declaration was filed with the registry and taken into account by the registrar in the acceptance of that application.

13. The declaration of Mr Elliot gives details of the goods in respect of which the trade mark has been used and the date of first use as follows; from March 1988 in respect of watchstraps, clothing display stands and printed matter; from April 1999 for caps, headgear, wallets, keyrings and retainers for spectacles. Watches were supplied from October 1994.

14. Mr Elliot then provides various exhibits which he states demonstrates use of the mark. These include:

- -at AN1- a selection of promotional material showing some of his company's product range, together with a copy of the Autumn/Winter 1996 Clothing Collection Catalogue;
- at AN2 - a brochure from 1990 together with a wallet from 1993, keyring and stickers and printed matter;
- at AN3 - turnover figures and copy invoices. The turnover figures are given for 1991-1995 (see below)
- at AN4 - copies of advertisements showing ANIMAL watches
- at AN5 - some packaging material

15. Mr Elliot states that the trade mark has been used throughout the United Kingdom with products being supplied through specialist active sports shops. He gives a list of the goods on which the trade mark has been used. These are the goods for which the trade mark in suit is registered.

16. Mr Elliot states that promotional spend in 1993 was approximately £67,000; in 1994 approximately £184,000 and in 1995 £300,000. This included sponsorship of major sporting events, TV promotions, use on vehicle livery and in the press as well as promotion through trade fairs and exhibitions.

17. Mr Elliott states that the ANIMAL trade mark together with their distinctive ANIMAL logo are trade marks which have been in use in the United Kingdom for over 8 years as at July 1996 and available on a wide range of products.

18. Mr Redfern in his declaration, states that Animal Limited was purchased by H Young (Operations) Limited in January 1999. The annual turnover figures for products sold under the ANIMAL brand in the years from 1995 are as follows, figures for 1991-95 are taken from exhibit AN3 to Mr Elliot's declaration:

Year	Amount in £
1991	353,707

1992	575,920	
1993	1,065,919	
1994	1,740,522	
1995	3,880,760	
1996	6,390,802	
1997	7,299,793	
1998	8,098,972	
1999	5,942,108	the figure for 1999 is up to September

19. Mr Redfern then refers to the trade mark the subject of opposition proceedings; these are not relevant to the invalidity action and I need not summarise them.

20. At TSR3, Mr Redfern exhibits a range of catalogues and brochures which he says shows the trade mark ANIMAL in use in relation to a wide range of products including clothing, socks, headgear, hats, baseball caps, sweatshirts, t-shirts, dresses, jumpers, jackets, shirts, shorts, trousers and various other items.

21. Mr Redfern states that the approximate annual amounts spent on promoting the mark ANIMAL during 1997, 1998 and 1999 are:

1997	£678,531
1998	£775,058
1999	£553,710

22. Mr Redfern comments on the applicants' assertions concerning the use of the mark ANIMAL in relation to clothing in class 25. In his opinion these are absurd. He gives his view that clothing items made from the skins of animals are not referred to as animal clothing but would be described by the material or by reference to the particular animal from which they are made. It would in his view be natural to refer to leather shoes or belts; sheepskin jackets; a fur coat.

23. Mr Hume's statutory declaration refers to exhibit TR2 to Mr Redfern's evidence. He notes that the trade mark under attack is registered in a number of classes in addition to class 25 and that these include protective headwear in class 9, watch straps in class 14, bags, backpacks, rucksacks, wallets and purses, straps, belts and keycases in class 18. He notes however from clause 4 of the applicants' statement of grounds that the application for invalidity is directed only against goods in class 25. Mr Hume also notes that the applicants have only relied upon section 3(1)(a) but in any case, he contends that the registered proprietors are entitled to rely upon the use that has been made of their mark.

24. Mr Hume makes various comments concerning the application for revocation, for reasons set out below I need not summarise these. In turning to the assertion that the word ANIMAL in relation to clothing means that such goods are made from the skins of animals Mr Hume submits that the information contained in the declaration of Mr Maguire should not be taken into account. He notes that Mr Maguire has confirmed that the information was taken by him from the worldwide web, presumably in February 2001. Mr Hume states that he does not believe that this is a reliable indicator as to the possible meaning of the term "animal clothing" in the United Kingdom as at March 1988 when the ANIMAL brand was first used

or at 2 February 1996 when the application for the trade mark was filed. Mr Hume states that there is no justification for believing that this is even a reliable indicator as to the meaning of the term “animal clothing” in the United Kingdom in either May or June 2000 when the invalidity and revocation proceedings were launched. In this connection, Mr Hume notes that from the spelling of many of the words contained within the documents and the currencies referred to the vast majority of the material contained in the exhibits relates to the United States and Canada.

25. Mr Hume refers to paragraph 5 of Mr Maguire’s declaration and draws particular attention to the material from the company “Whales and Friends” and its use of the terms “animal clothing” and “animal t-shirts”. Mr Hume said he had difficulty finding these references but the reference to “animal clothing” is in the first page of the 7 pages included with the exhibit ATM.02. He notes that this is in fact a directory page under the name Galaxy. He states that if anything, the Whales and Friends web site confirms the assertion made by Mr Redfern where he says that clothing items would be either described by the material or by reference to a particular animal. For example he notes that it promotes its “Wolves oversized T-shirt; Ladybug T-shirt; Parrots T-shirt” etc. In the “GO Vegan” pages he states that it is clear that this is from an animal rights group based in Rochester New York. Even in that document, he notes that the term animal clothing has had to be further defined by the bracket entry which immediately follows the words namely “animal clothing (leather, silk and wool) and products tested on animals.”

26. Mr Hume notes that by his own admission, Mr Maguire acknowledges that the information contained in exhibits ATM.03 and ATM.04 has been taken from articles in the field of animal rights, veganism and vegetarianism as well as from documents codifying clothing advertisements and examples of academic work and studies of indigenous peoples. In ATM.04 Mr Hume submits that some of the references which are claimed to be references to Animal Clothing are headed “Women and Animal - Clothing”. In this context he states it would simply refer to images of women and animals which relate to clothing.

27. On subsequent pages, Mr Hume notes the reference to “Women in Animal-Print Clothing”, he states that these are not references to “animal clothing”. Mr Hume states that in his view, none of the evidence filed by the applicants supports the premise that traders of clothing products in the United Kingdom use the term “animal clothing” to describe goods which are made from the skins of animals. Nothing in his view has been filed to show that as at the date of the application for the mark in suit, the term “animal clothing” was in use in the United Kingdom. On the other hand, Mr Hume submits that use of the trade mark ANIMAL by the registered proprietors both before the date of application and subsequently has reinforced the reputation which the registered proprietors have in the distinctive mark “ANIMAL”.

28. That concludes my review of the evidence

Decision

29. The grounds of opposition set out in the applicants’ statements of grounds refer to section 47(1) by reference to sections 1(1) and 3(1)(a) and section 46(1)(d) of the Trade Marks Act 1994. The relevant provisions read as follows:

“47.- (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.”

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

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

“3.- (1) The following shall not be registered -

(a) signs which do not satisfy the requirements of section 1(1)

(b).....

(c).....

(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.”

30. The relevant provisions of section 46(1) read:

“46(1) The registration of a trade mark may be revoked on any of the following grounds:-

(a).....

(b)....

(c)....

(d) that in the consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public particularly as to the nature, quality or geographical origin of those goods or services.”

Preliminary Matter

31. The day before the hearing, 21 January 2002, I received skeleton arguments from both parties. The registered proprietors’, filed by Mr Hume, set out the grounds on which the

applications appeared to be based, that is, under sections 3(1)(a) and 46(1)(d) of the Act. He proceeded to outline the registered proprietors' arguments in support of the registration and their contention that the grounds pleaded disclosed no case. He concluded his skeleton by requesting that both applications be dismissed and a 'substantial award of costs' be made in favour of his clients. The applicants' also filed a skeleton argument, paragraph 1 of which stated:

'1. The applicant's evidence demonstrates that the subject trade mark consists solely of a word that may serve in the relevant trade, to describe characteristics of goods and thus offends paragraphs a, b, and c of sub-section 1 of section 3 of the Trade Marks Act 1994.

32. It continues in paragraph 3:

'As a consequence, the evidence of the registered proprietor does not establish sufficient use of the mark as registered to satisfy section 7 of the Act in relation to honest concurrent use, much less, the proviso to section 3(1).

33. These submissions in the applicants' skeleton argument took me by surprise for two reasons. Firstly, they do not refer to the ground of revocation under section 46(1)(d). Secondly, and of more importance in my view, they mentioned grounds of invalidity under section 3(1)(b) and (c) which were not pleaded in the statement of grounds.

34. At the commencement of the hearing, I raised both points with Mr Maguire. On the first point, the failure to deal with section 46(1)(d), Mr Maguire informed me that it was very much a secondary line of argument and that his primary ground of objection fell under section 3(1)(c) and that the examiner was incorrect in accepting the mark on the basis of honest concurrent use. On this last point, it should be noted that the provisions for honest concurrent use permit the registrar to accept an application for registration and allow a mark to proceed to advertisement if the applicant can show that, despite a ground for objection being present under section 5, the provisions of section 7 have been made out. The provisions of section 7 concern conflict with existing earlier trade marks on the register. There are no relative grounds of invalidity before me. It was open to the proprietors of the earlier marks or third parties to oppose this registration on relative grounds at the time the application was published (or to seek to invalidate the mark on such grounds), that was and is not the case and such issues are not before me in these proceedings. I need say no more honest concurrent use.

35. As for the issue of section 3(1)(b) and (c), Mr Maguire was unaware that they had not been pleaded. His firm had not been responsible for the filing of these applications and he was not aware that the only ground of invalidity was that under section 3(1)(a). A T Maguire & Co filed a TM33 informing the Office of the change in representative on 31 January 2001. Mr Maguire suggested that the inclusion of (a) in section 3(1)(a), might have been a typographical error and that the original agent may have intended to plead all the grounds under section 3(1). But that in my view is not the case, the language of the statement of grounds refers to section 3(1)(a) by reference to section 1(1). It was also clear from the evidence put in by the registered proprietors that in their view, the only grounds being pursued were those under sections 3(1)(a) and 46(1)(d). In paragraph 4 of Mr Hume's declaration dated 11 May 2001 he states,

“ I note from clause 3 of the aforementioned statement of grounds that the basis for the Application for a Declaration of Invalidity is restricted to section 1(1) of the Trade Marks Act 1994 and section 3(1)(a) of the Act. There is no assertion that the trade mark was registered in breach of the provisions of section 3(1)(b) or section 3(1)(c) or section 3(1)(d) of the Trade Marks Act 1994.”

36. Mr Maguire sought leave to amend the statement of grounds to include sections 3(1)(b) and (c). Not surprisingly, this request was opposed by the registered proprietors. Initially, I gave my view that the request was refused and that the hearing would proceed on the grounds as pleaded, section 3(1)(a) and 46(1)(d). It seemed to me that any reading of the statement of grounds would indicate that it was only those grounds that had been pleaded and, as outlined above, this fact was also brought to the attention of the applicants in the registered proprietors’ evidence, filed after Mr Maguire’s company had taken over as representative. It was therefore, open to the applicants to seek leave to amend their statement of grounds earlier in the proceedings, to leave it until the day of the hearing is in my view unacceptable.

37. On that basis, Mr Maguire saw no mileage in proceeding to make submission on his remaining grounds and he indicated that he would re-file a properly constituted statement of grounds. As I will set out further below, I was not surprised by the view that the applicant held little prospect of success under the grounds as pleaded, sections 3(1)(a) and 46(1)(d). At this point, the registered proprietors’ representative took instructions and indicated that if I was minded to change my mind and allow the amendment, they would be prepared to proceed with a hearing based on the objections under section 3(1)(b) and (c).

38. Whilst I was of the view that the applicants’ request should be refused, I saw some benefit in adopting the registered proprietors’ pragmatic approach. There were parallel opposition proceedings in which the registered proprietors here are opposing an application made in the name of the applicant. This was due to be heard in the near future. Presumably, this registration is one of the primary grounds of opposition to the applicants’ mark and so, whilst there is some doubt over the validity of the registered proprietors’ mark, the opposition proceedings cannot be brought to a definite conclusion.

Substantive Issues

39. On the basis of the registered proprietors’ agreement and for no other, I allowed an amendment to the statement of grounds. Thus, the invalidity action proceeded on the basis of the following sections of the Act

- “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,
 - (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.”

Section 3(1)(a) and 46(1)(d)

40. Mr Maguire did not address me on the provisions of section 3(1)(a) nor did he address me on the provisions of section 46(1)(d). When I pointed out that he had not made submissions on section 46(1)(d) Mr Maguire stated that he, ‘found it difficult to find any reasonable argument on that ground’. I agree, both in my view held no prospect of success, the mark is clearly capable of being represented graphically and of distinguishing the goods and services of one trader from another. Mr Maguire was right not to burden the hearing with submissions on these grounds. That said, as noted above, these were the only grounds pleaded in the original statement of grounds and the registered proprietors, quite properly, felt obliged to deal with them in their skeleton. I will deal with this issue when I consider the question of costs at the conclusion of my decision. **The ground of invalidity under section 3(1)(a) is dismissed, as is the ground of revocation under section 46(1)(d).**

Section 3(1)(c) and 3(1)(b)

41. Objection is, therefore, said to arise under sections 3(1)(b) and (c). It has long been stated that:

“Wealthy traders are habitually eager to enclose part of the great common of the English language and to exclude the general public of the present day and of the future from access to the enclosure”; per Sir Herbert Cozen-Hardy MR in *Joseph Crosfield & Son’s Application* (1909) 26 R.P.C. 837 at page 854.

42. After quoting this passage, Mr Justice Jacob in *British Sugar Plc v. James Robertson & Sons Ltd* [1996] R.P.C. 281 continued:

“The trade mark registration Acts up until 1994 stood firmly in the way of wealthy traders. Where they adopted marks which other traders were likely to want to use descriptively they found it either difficult or impossible to register their marks.....In some cases their policy may have gone too far: registration was denied even to marks which were “100% distinctive” ie those which had, through both use and recognition as trademarks, come to be taken by all concerned as denoting the proprietor’s goods. The Trade Marks Act 1994, implementing an E.C. Directive, has swept away the old law.”

43. In this case, the registered proprietors obtained registration for the trade mark ANIMAL in class 25. In a decision of the First Board of Appeal of OHIM, *MAXIMA* (Case 51/1998) the First Board referred to the provisions of Articles 7(1)(b) and (c) of the Regulation, the equivalent to sections 3(1)(b) and (c) of the Trade Marks Act 1994. They found that:

“No undertaking may be given an exclusive right to use in the course of trade a sign which does no more than describe in ordinary language, the nature, quality or intended purpose of the goods or services in respect of which it is to be used.

As a general rule, there are compelling reasons for not allowing an individual trader to monopolise the use of ordinary words, or obvious adaptation of ordinary words, which imply that a product possesses exceptional characteristics as regards quality, power, performance, size, fitness for purpose and so forth.”

44. Part of any objection under this grounds is based on the premise that the registrar should have regard to the principle that honest traders should not have to look for a defence in section 11 of the Act in relation to use of descriptive marks and that the first line of defence for such traders should be the refusal of registration for such marks. Mr Geoffrey Hobbs QC in AD2000 [1997] R.P.C. 168, at page 176, lines 9 to 23, stated:

“Although Section 11 of the Act contains various provisions designed to protect the legitimate interests of honest traders, the first line of protection is to refuse registration of signs which are excluded from registration by the provisions of section 3. In this regard, I consider that the approach to be adopted with regard to registrability under the 1994 Act is the same as the approach adopted under the old Act. This was summarised by Robin Jacob Esq Q.C., in his decision on behalf of the Secretary of State in the *Colorcoat Trade Mark* [1990] R.P.C. 511 at 517 in the following terms:

“That possible defences (and in particular that the use is merely a bona fide description) should not be taken into account when considering registration is very well settled, see e.g. *Yorkshire Copper Works Ltd’s trade mark application* (1954) R.P.C. 150 at page 154 lines 20 to 25 per Viscount Simonds LC. Essentially the reason is that the privilege of a monopoly should not be conferred where it might require “honest men to look for a defence”.”

45. I will deal first with the applicants’ ground of objection under section 3(1)(c), this was said by Mr Maguire to be his primary ground of objection.

46. There has been recent guidance from the European Court of Justice in relation to Article 7(1)(c) of Council Regulation 40/94 on the Community Trade Mark in *BABY-DRY* Case C-383/99P. Article 7(1)(c) is equivalent to Section 3(1)(c) of the Trade Marks Act 1994. The findings of the Court are set out in paragraph 35 et seq of the judgment.

47. The provisions of section 3(1)(c) state that trade marks which consists exclusively of signs or indications which may serve in trade to designate certain characteristic of the goods or services shall not be registered. The ECJ in *BABY-DRY* stated that the provisions in Article 7(1) of the Regulation (section 3(1)) and those in Article 12 (section 11) taken together prevent registration as trade marks, signs which are no different from the usual way of designating the relevant goods or services or their characteristics; paragraph 37. Thus, the ECJ concluded that the provision of Article 7(1)(c), (section 3(1)(c)) excluded signs which may serve in normal usage from a consumer’s point of view to designate an essential characteristic of the goods or services concerned. Registration should not be refused unless it

comprises no other sign or indication; paragraph 39. Further, the Court found that in relation to trade marks composed of words, descriptiveness must be determined not only in relation to each word taken separately but also in relation to the whole which they form; paragraph 40.

48. In considering whether a mark consists exclusively of matter covered by the provisions of section 3(1)(c) the ECJ indicated that any perceptible difference between the combination of words submitted for registration and the terms used in the common parlance of the relevant class of consumer to designate the goods or services or their essential characteristic is apt to confer distinctive character on the word combination enabling it to be registered as a trade mark; paragraph 40.

49. The mark in issue is the word ANIMAL in plain block capitals, it is registered in various classes but it is only in so far as the application covers goods in class 25 that an objection is raised. As noted above, the applicants' main ground of objection is that the mark ANIMAL is a word that consist exclusively of a sign or indication which may serve, in trade, to designate a characteristic of the goods.

50. What is the result if I assess the mark ANIMAL against the criteria set out above? The question is to be assessed as at the date of the application for the trade mark, but the words "*may serve*" in section 3(1)(c) indicate that one should consider not only whether the sign in question was already in normal usage for descriptive purposes, but whether at the date of application it could have naturally lent itself to such usage in future.

51. Applying the reasoning of the ECJ, I should declare it invalid if I find that as at the date of application, it was **no different** from the usual way of designating a characteristic of the goods in question, clothing, headgear and footwear. Did it, or was it foreseeable that it could, **serve in normal usage** from a consumer's point of view to designate a characteristic of the goods? The onus is on the applicant to show that the mark should not have been accepted for registration.

52. In answering this question I have assessed the prima facie case for registration. If I found that the mark should not have been accepted, the registered proprietors could have sought to rely on the use that they have made of the mark before and after the date of registration; section 47(1). However, for the reasons that I will now give I find that they need not rely on their use and I make no comment about their evidence.

53. The applicants' for invalidity filed some evidence in support of their contention that the mark ANIMAL is descriptive of a characteristic of the goods. They came up with three alternatives which they say show that the mark is and/or could be used to describe a characteristic of the goods. In their view, the word ANIMAL could be used by a legitimate trader to describe clothing:

- (a) made from materials of animal origin; or
- (b) to which animal images have been applied, for example pictures of whales; or
- (c) made from cloth decorated with animal skin prints.

54. As such, it is their contention that the registration in so far as it covers goods in class 25, ought to be declared invalid. Mr Hume took me through their evidence and was critical of it in terms of quantity, quality, date and jurisdiction. I think that there is force in all of the criticisms made by Mr Hume.

The Evidence

55. I will consider each of the applicants' contention in turn by reference to their evidence, details of which I have already summarised above.

56. Is ANIMAL no different from the normal way of describing clothing, footwear or headgear made from animal products? Does it, or could it, serve in normal usage to describe such goods? I think the answer must be no. It seems to me that the most the applicants' evidence shows is that at the date when the website search was carried out, the term animal clothing was used on a small number of sites to describe clothing made from animal products. There is an auction site advertising "African Wild Animal Clothing". It advertises a hunting coat made from antelope leather and zebra inlays. The other examples seem, as Mr Maguire acknowledges, to be from vegan and vegetarian website. There is the LINK-UP site offering cruelty-free shopping on the internet and states "non-animal clothing is not as difficult to find". There is an entry on a site under ANIMAL RIGHTS where it is stated, "I am not a supporter of violence to change violence. I do chose non-violent options to animal testing, animal eating and animal clothing production and consumption."

57. I note that this does not tell me what the position was as at the date of the application. Further, the websites are either clearly from the US, examples include Go Vegan which gives an address of Rochester New York and Vegan Resources which gives several addresses all in the US or the origin cannot be ascertained. Mr Maguire submitted that if the term is in use in US then use here will follow. I reject that line of reasoning. Firstly the reference in "Go Vegan" has to explain the term animal clothing by including in brackets the words (leather, silk, and wool). This to me would imply that its meaning is not obvious even in the US. Secondly, there are many words and phrases that are used in various jurisdictions, it does not follow that those phrases will enter the language of the average consumer in the United Kingdom. It seems to me that, considered from the view point of the average consumer of the goods in question, that is ordinary members of the public, the word ANIMAL was not and indeed is not the normal way of describing such goods. Nor in my view is it the most apt term to describe goods made of leather, wool, fur or other product derived from an animal. The word ANIMAL when applied to the goods is ambiguous, without further information it does not in my view tell you about a characteristic of the goods. The word ANIMAL would function as a trade mark, and would be seen as such by the relevant public.

58. Is ANIMAL no different from the normal way of describing clothing, footwear or headgear to which images of animals have been applied? Here, the applicants point to their evidence including the Whales and Friends website. I agree with Mr Hume that the first page of exhibit ATM.02 is entitled GALAXY, there seems to be a hypertext link to the Whales and Friends site which states "Whales and Friends - Clothing, Animal clothing, t-shirts, sweatshirts.....". However, on the Whales & Friends website itself, the page is headed "Nature T-shirts". Various t-shirts are then listed as "Wolves Oversized T-shirt", "Ladybug,

Ladybug T-Shirt”, “Close Encounter T-Shirt”, after several pages showing 1-30 there is another link which states “more Animal T-shirts”. It seems to me that given the spelling of the words ‘color’ and ‘ladybug’, and that the prices are listed in US dollars, this site is directed at the US market. There is another site at www.primates-online.com. The page shows “UNIQUE PRIMATE AND ANIMAL CLOTHING”. There is another at www.seniorstore.com. This has “Dog themed animal clothing for teens or older children.” It appears again to be a US site. This evidence suffers from the same deficiencies as identified above, it appears to be pre-dominantly from the US and it does not tell me what the position would have been at the date of application. Again, it seems to me that this evidence is insufficient to show that ANIMAL could, **serve in normal usage** from a consumer’s point of view to designate clothing, footwear or headgear to which an image of an animal had been applied. Again I am left with the view that such goods would be described by reference to the image that appears on them.

59. Finally, I consider whether the word ANIMAL is the normal way of describing the goods which are made from animal print material. Mr Maguire refers to a website print out for “Directions for Coding Advertisements, Fashion Layouts and Front Covers”. This includes a checklist. Appearing on it is the term ANIMAL PRINT and ANIMAL CLOTHING. However, the meaning of ANIMAL CLOTHING in this context is not in my view obvious, there is no definition in the instructions which would indicate that such goods were made from animal products. As for ANIMAL PRINT, the instructions explain that this term applies “if a model is wearing clothing which contains an animal print”. The following pages which are entitled “Women and ANIMAL-CLOTHING”, show women wearing clothing made from material which carry a variety of animal prints. The last shows an advert which describes “the new sheer stretch lingerie this season is animal print: A collection of five pieces in white cheetah print...purple cheetah print.....black python print...” This again suffers from defects in that it does not tell me the position at the relevant date. The term animal print appears here to be being used descriptively but it seems to me that the word ANIMAL on its own is insufficient to describe a characteristic of clothing, footwear or headgear made from material which has an animal print theme. Appropriate terms might be snake skin or cheetah.

Conclusion on 3(1)(c) & (b)

60. Taking the evidence as a whole it seems to me that it has failed to show that as at the relevant date, the word ANIMAL simpliciter was or was likely to be used to describe a characteristic of the goods. More needs to be added to the word before the meaning is clear. To the extent that the applicants’ evidence does show some use of the word ANIMAL it shows that it is capable of a number of meanings. In my view, the word ANIMAL applied to the goods for which the mark is registered would not from the average consumers’ point of view serve any purpose other than indicating the origin of the goods. Those who wish to use the word in a descriptive sense, to describe goods made from animal products, bearing animal images or animal prints can do so without detracting from its role as a trade mark of the registered proprietor. **The ground of invalidity under section 3(1)(c) is dismissed.**

61. It could be argued that as I have found that the registered proprietors’ mark should not be declared invalid under section 3(1)(c) this leads inevitably to the view that it should not be

refused under section 3(1)(b). This argument is based on the premise that as the mark does not consist exclusively of signs or indications which may serve in trade, the mark cannot be devoid of distinctive character. I do not agree. A mark which does not consist exclusively of such matter may, nevertheless, be devoid of distinctive character if it cannot perform the function of a trade mark, that of identifying the origin of the goods or services in question. To use the words of Mr Hobbs Q.C. sitting as the Appointed Person in *Joe Boxer Holdings Inc Trade Mark Application* SRIS 0-313-01, such signs may be origin neutral. However, this is not such a case, it seems to me that given my finding that the mark ANIMAL is not one that may serve in trade to designate a characteristic of the goods it is one that is not devoid of distinctive character and as such, **the ground of invalidity under section 3(1)(b) is dismissed.**

Costs

62. The registered proprietors have been successful and are entitled to a contribution towards their costs. These proceedings were launched on 25 May 2000. As such, the new scale of costs as set out in Annex A of the Tribunal Practice Notice TPN 2/2000 applies. In the normal course of events, a registered proprietor who has successfully defended his registration against an application for invalidity would, from the scale at Annex A, expect an award in the region of £2450-00. In this case, I must also consider the fact that until recently, the proceedings were not consolidated and thus the registered proprietor had to consider both the invalidity and revocation action and file counter-statements in both proceedings. As noted above, the evidence was to an extent duplicative. Taking this into account I would be minded to increase the award to £3000-00.

63. However, in addition, Mr Hume drew my attention at the hearing to two further factors which in his view pointed towards a higher award. In his view, the applications under 3(1)(a) and 46(1)(d) were unarguable and bound to fail, as such he suggested that the applicants should be penalised for raising these grounds of objection. Secondly, the applicants' request to amend the grounds of opposition should, Mr Hume argued, be taken into account when assessing costs.

64. I have some sympathy with the views expressed by the registered proprietors. Both the original grounds of objection, 3(1)(a) and 46(1)(d) were not even argued before me at the hearing, they were I think accepted by Mr Maguire as bound to fail. It is only because of the amendment to the grounds that the hearing even took place. It is incumbent upon a party when launching proceedings that they consider their grounds of objection carefully. At the hearing, I referred to the recent decision of Mr Simon Thorley, Q.C. sitting as a Deputy High Court Judge in *Re Anheuser-Busch Inc* [2001] All ER (D) 08 (Dec). Where he stated:

“38.....In the Tribunal Practice Note [TPN 2/2000] it is stated:

‘It is vital that the Comptroller has the ability to award costs off the scale, approaching full compensation, to deal proportionately with wider breaches of rules, delaying tactics or other unreasonable behaviour.’

39. I believe this is correct. In particular I believe it will be correct for the hearing officer to consider seriously departing from the usual scale where he concludes that a case is unarguable. Equally the costs involved in preparing, considering and replying to evidence are generally significant and it is right that awards of costs off the usual scale should be made in circumstances where the hearing officer is satisfied that a party has unreasonably failed to consider what evidence is relevant before filing a large amount of irrelevant evidence.”

65. It seems to me that this case most come close to the first of the examples given by Mr Thorley, and as such, warrant an award outwith the normal scale. However, it seemed to me that in allowing the grounds under section 3(1)(b) and (c) to be ventilated at the hearing, the registered proprietor was not unduly prejudiced; he was able to rely on the evidence that he had already filed in response to the other grounds. That said, for that inconvenience and for the preparation which was undertaken to rebut the grounds that were not pursued I will make an award from the upper end of the scale. Taking all these factors into account, I order that the applicants pay the registered proprietors the sum of £4000-00 as a contribution towards their costs. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 21 day of February 2001

**S P Rowan
For the Registrar
the Comptroller General**