

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2026289
BY GOLDENGLOW INTERNATIONAL
TO REGISTER A TRADE MARK IN CLASS 3**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO 47740
IN THE NAME OF SLIM IMAGES LIMITED**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2026289
by Goldenglow International
to register a trade mark in Class 3**

And

**IN THE MATTER OF Opposition thereto under
No 47740 by Slim Images Limited**

DECISION

On 7 July 1995, Goldenglow International of 137 Feckenham Road, Headless Cross, Redditch, Worcs, B97 5AG, applied to register a trade mark in Class 3 for the following specifications of goods:

Tanning accelerator preparations in spray form.

The mark applied for is as follows:



The mark comprises the colours yellow and red applied to the two separate layers of the product consisting of two immiscible liquids, the mark being visible through a clear container, as illustrated in the representation on the form of application.

The application proceeded on the basis of distinctiveness acquired through use, and Honest Concurrent Use with registration numbered 2003103A, 2003103B and 2003103C.

The application, numbered 2026289 was published for opposition purposes on 6 August 1997 and on 6 November 1997 Slim Images Limited filed notice of opposition to the application. The opponents say that they are the proprietors of trade mark registrations numbered as 2003103A, 2003103B and 2003103C filed in Class 3. The grounds on which the opposition is based are, in summary:

1. **Under Section 1(1)** Because the mark is not graphically represented.
2. **Under Section 3(1)** Because the mark is not distinctive.
3. **Under Section 5(2)(b)** Because of there exist a likelihood of confusion with the opponents' earlier trade mark.
4. **Under Section 39** Because the representation of the mark originally filed has been amended in such a way as to affect its identity.

Particulars of the trade mark registration relied upon in the grounds of opposition are set out as an annex to this decision.

The opponents ask that the Registrar refuse the registration and that costs be awarded in their favour.

The applicants filed a counterstatement in which they deny all of the grounds on which the opposition is based, and ask that costs be awarded in their favour.

Both sides filed evidence in these proceedings although neither party has requested a hearing. Acting on the Registrar's behalf and after a careful study of the evidence filed I now give this decision.

The opponents' evidence

This consists of two Statutory Declarations. The first is dated 3 August 1998 and comes from Philip Reuben Abbott, Managing Director of Slim Images Limited, a position he has held since 1988. Mr Abbott confirms that the facts contained in his Declaration come from his personal knowledge and from his company's records to which he has full access.

Mr Abbott confirms that since 1988 his company has been involved in the manufacture and distribution of tanning lotions and sun block preparations. He says that the idea of a two phase, two colour liquid tanning preparation was devised by an associated company in 1990 and went on sale in the United Kingdom in January 1991 using the colour combinations purple/red, purple/blue and orange/purple. He says the product has been supplied to over 1,750 outlets, and that his company also employs 12 sales representatives who regularly visit hairdressing and beauty salons and chemists.

Mr Abbott contests the applicants' claim to have used the trade mark since 1990. He says that he first became aware of the applicants' business in 1991 when they bought a box of his company's "DUDE LUBE" product which he says was the name given to the purple/red product,

and refers to exhibit PRA1 which is an invoice dated 16 April 1991 for the supply of the said goods. Mr Abbott says that in November 1991 his company discovered that the applicants were selling a similar red/yellow coloured product and recounts his company's attempts to contact the applicants, and to give his conclusions why the applicants had purchased his company's product. Mr Abbott refers to and comments on the evidence filed in support of the application in suit and in a second trade mark application filed by the applicants for a similar mark.

The second Statutory Declaration is dated 3 August 1998 and comes from Huw Evans, a Patent Attorney employed by Urquhart-Dykes & Lord, the opponents' representatives in these proceedings.

Mr Evans refers to his inspection of the trade mark file for the opposed application, and a co-pending application from the applicants for a similar mark. He comments on the representation of the trade mark on each file and also the evidence filed by Mr Garry Allbutt, and gives his view that both applications relate to the same product.

Applicants' evidence

This consists of an undated Statutory Declaration from Mr Garry Allbutt, the proprietor of Goldenglow International.

Mr Allbutt says that his company has been trading since 1986 and that the business resides in the manufacture, marketing and sale of beauty products, saunas, toning tables, sunbeds, sun tanning, sun screening and suntan accelerator preparations and substances. He refers to the application which is the subject of these opposition proceedings, referring to the colours of the mark as orange and yellow.

Mr Allbutt states that his company has used the trade mark since 1990 in respect of a tanning accelerator preparation in spray form and that the mark has no technical function, its sole purpose being to distinguish his company's products from other traders. He sets out the turnover figures for goods sold under the trade mark, which are as follows:

1991	£690
1992	£3,350
1993	£9,990
1994	£20,860
1995	£46,700
1996	£27,989

Mr Allbutt notes that these figures are different from those provided in his Statutory Declaration of 24 September 1996 filed as part of the evidence in support of the application.

He says that sales of sun accelerator creams under the mark have been made throughout the United Kingdom, and refers to exhibit A1 which consists of lists of outlets stocking the product, one list being dated 14 April 1997, the other is undated. He says that his company spends approximately £7,000 per annum on advertising and promoting the products sold under the trade mark, and refers to a number of magazines and exhibitions. He refers to exhibits A2 and A3

which consist of a photograph of two clear spray bottles, each containing a two colour liquid combination and bearing the words SOL-RAPIDE, and a number of advertisements for, inter alia this product each being endorsed as originating from the years 1998 and 1999.

5 Mr Allbutt goes to the Declaration by Mr Abbott, challenging the opponents' claim to have originated the two colour product which he says is a concept well known in the cosmetics industry, and by way of example he refers to exhibit A4 which consists of bottles of bath preparations and an eye cleanser, the contents of which are in two coloured layers. He explains that his company purchased products from the opponents to fulfil an order from one of his customers. Mr Allbutt confirms the accuracy of the turnover figures which he says relate solely to sales of the tanning accelerator under the mark, and that his company only sells such goods in the red/yellow and orange/yellow colour combinations.

15 That concludes my review of the evidence insofar as it is relevant to these proceedings, and I turn to consider the respective grounds upon which the opposition has been brought.

Decision

20 I will turn first to the objections founded under Section 3(1) and Section 1(1). Those sections read as follows:

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

- 25 (a) signs which do not satisfy the requirements of section 1(1),
- (b) trade marks which are devoid of any distinctive character,
- 30 (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,
- 35 (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:

40 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:

45 **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.

A trade mark may, in particular, consist of words (including personal names), designs,

letters, numerals or the shape of goods or their packaging.

In the Ty Nant trade mark case (2000) RPC 2, Geoffrey Hobbs QC sitting as the Appointed Person said:

5 “The degree of precision with which a sign is represented must be sufficient to permit full and effective implementation of the provisions of the Act relating to absolute unregistrability (Section 3), relative unregistrability (Section 5), infringement (Section 10) and public inspection of the Register (Section 63). These provisions call for a fixed point of reference: a graphic representation in which the identity of the relevant sign is clearly and unambiguously recorded.”

15 With this in mind the first matter I will look at is whether the trade mark is “represented graphically” for if the answer to that question is that it is not, I do not consider that I will be able to determine the other grounds in relation to a sign which has not been clearly and unambiguously identified in a form capable of being examined in accordance with the statutory provisions.

20 In the Ty Nant case, Geoffrey Hobbs QC referred to a decision in Case R7/97-3 Orange Personal Communications Ltd’s application [1998] ETMR 460 in which an application to register the colour orange was found to be deficient because “an uncountable number of different colour shades” would fall under the description, and consequently, that the application did not qualify for a filing date until it (the mark) had been particularised by the filing of a graphic representation of a particular shade of the colour orange.

25 In this application the form of application contains a colour photograph of a clear bottle with a spray top with the upper and lower sections showing that the contents consist of two different coloured layers. The text accompanying the photograph makes it clear that the mark comprises the two colour liquid combination and as the actual colours are known I have no difficulty in finding the mark to be graphically represented.

30 I turn next to the ground founded under Section 39(1). That section reads as follows:

35 **39.-(1)** The applicants may at any time withdraw his application or restrict the goods or services covered by the application.

If the application has been published, the withdrawal or restriction shall also be published.

40 **(2)** In all other respects, an application may be amended, at the request of the applicant, only by correcting-

(a) the name or address of the applicant,

(b) errors of wording or copying, or

45 (c) obvious mistakes,

and then only where the correction does not substantially affect the identity of the trade

mark or extend the goods or services covered by the application.

The objection founded under Section 39 is linked to the question of the graphic representation of the mark. When applied for the mark was described as follows:

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“The trade mark comprises two different colours applied to two separate layers of the product consisting of two immiscible liquids and the product is visible through a clear container. The colours claimed are orange and yellow.”

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A colour photograph was provided to show the actual colours.

Following examination of the trade mark by the Trade Marks Registry the description of the mark was clarified to read as follows:

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“The mark comprises the colours yellow and red applied to the two separate layers of the product consisting of two immiscible liquids, the mark being visible through a clear container, as illustrated in the representation on the form of application.”

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It is clear that in both cases the mark consists of the stated colours applied to the liquid and a photograph was provided as an illustration of the mark in use. Although the colour combinations were stated as being orange/yellow, and subsequently yellow/red, for the reasons given in the Orange case above, such a description on its own would be too imprecise and the mark would not be graphically represented. The mark applied for, however, is not the text alone or the photograph alone, but the two in combination. The text defines that the mark is the specified colours used in a particular way and the photograph serves as an illustration of the mark in use and also defines the actual colours claimed. As said in the Orange case, the colour orange describes “an uncountable number of different colour shades” which must include those bordering on the colour red; it is a matter of perception. Although the colours stated in the text may have changed, the colours on the photograph have not and for that reason I take the view that even after the clarification the mark was still the same mark originally applied for. Accordingly, I dismiss the objection founded on Section 39.

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I turn next to the question of “capable of distinguishing under Section 3(1)(a) and Section 1(1) and begin by looking at how the law stands. In the British Sugar Plc v James Robertson & Sons Ltd (TREAT) trade mark case, (1996) RPC 9, Mr Justice Jacob said:

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“...I begin by considering the “not a trade mark” point. Section 1(1) has two parts, *sign*, and *capable of distinguishing*. *Sign* is not an issue: a word is plainly included within the meaning of *sign* as the remainder of Section 1 indicates. But what about *capable of distinguishing*? Does this add any requirement beyond that found in section 3(1)? Section 3(1)(b) bars the registration of a mark which is *devoid of any distinctive character* unless it has *in fact acquired a distinctive character*. I cannot see that the closing words of the first sentence of section 1(1) add anything to this. If a mark on its face is non-distinctive (an ordinary descriptive and laudatory words fall into this class) but is shown to have a distinctive character in fact then it must be *capable of distinguishing*. Under section 10 of the old Act, for a mark to be registerable in Part B, it also had to be *capable of distinguishing*. But the Pickwickian position was that some marks, even though 100%

distinctive in fact, were not regarded as *capable of distinguishing* within the meaning of that provision. I do not think the Directive and the 1994 Act takes a more limited meaning over.

5 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
10 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-
15 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 indicates that the correct approach is to start with the premise that a trade mark is
capable of distinguishing insofar as it is not incapable. A trade which is found to have sufficient
inherent distinctive character to be able to distinguish must be capable of distinguishing. A trade
mark which does not have any inherent distinctive character may nonetheless acquire
distinctiveness through the use made of it, and in doing so it must, by inference, be capable of
distinguishing.

25 The opponents say that the mark is not capable of distinguishing although they have not given any
indication as to why they believe this to be so, nor have they provided any evidence which goes
to this point. I do not think that the mark is such that I can say that the applicants will never be
able to educate the public to regard the colour combination as a trade mark, a view which is
supported by the opponents own evidence in which they express their concerns over possible
30 confusion with their own two colour combination product which they appear to consider as
distinctive of them. It would also be illogical to maintain a position that the applicants’ mark is
not capable of distinguishing when the opponents’ earlier registrations have been accepted as
such. Consequently, I dismiss the grounds founded under Section 1(1) and Section 3(1)(a).

35 I turn next consider the grounds under Section 3(1)(b), (c) and (d). In the TREAT trade mark
case (1996) RPC 281, Jacob J provided guidance on the meaning of Section 3(1)(b), saying:

40 “Next is “Treat” within Section 3(1)(b). What does *devoid of any distinctive character*
mean? I think the phrase requires consideration of the mark on its own, assuming no use.
Is it the sort of word (or other sign) which cannot do the job of distinguishing without
first educating the public that it is a trade mark? A meaningless word or a word
inappropriate for the goods concerned (“North Pole” for bananas) can clearly do. But a
common laudatory word such as “Treat” is, absent from use and recognition as a trade
45 mark, in itself (I hesitate to borrow the word *inherently* from the old Act but the idea is
much the same) devoid of any distinctive character.”

I also have regard to the comments of Aldous LJ in the Phillips Electronics NV v Remington
Consumer Products Limited case (1999) RPC 23 in which he stated:

“The more the trade mark describes the goods, whether it consists of a word or shape, the less likely it will be capable of distinguishing.”

5 To establish an objection under Section 3(1)(d) in inter-parte proceedings requires evidence to establish that the term is in use, although not necessarily showing the mark being used in the course of trade. There is no such evidence and I dismiss this ground. The wording of sub-section (c) imposes a less stringent test than under sub-section (d) going to whether the mark is sufficiently descriptive of a characteristic of the goods/services for there to be a reasonable likelihood that it will be used by other traders. As the mark consists of the actual colours of the goods themselves there cannot be any doubt that it describes a characteristic of the goods, and absent from use is unlikely to be recognised as a trade mark and is devoid of any distinctive character. Consequently, I find the objections under Section 3(1)(b) and (c) succeed.

15 My findings under Section 3(1)(b) and (c) do not decide the matter for the applicants claim the benefit of the proviso to Section 3(1) which allows for registration of a mark found to be devoid of any distinctive character where it has in fact acquired a distinctive character as a result of the use made of it.

20 The applicants state that they have used the trade mark since 1990 in relation to a tanning accelerator preparation although there is no evidence to substantiate the claim. The date is disputed by the opponents although they do accept that the applicants have used the mark from November 1991, which to the date of application would give them approaching 5 years use. Turnover figures for the years 1991 to 1996 have been provided and show modest sales for the first two years although increasing year on year to what has to be considered to be significant level for a one product mark and although the opponents dispute that the figures relate to the product sold under the mark only, the applicants have confirmed this to be the case.

30 The applicants say that there are over 2,000 outlets throughout the United Kingdom that stock their sun tanning accelerator products, although do not say whether this is in respect of the mark applied for, or the dates from which the products were first stocked. However, given the increasing yearly sales it seems reasonable to infer that the use has been widespread.

35 A sign which consists of a feature of the product it is to be used in connection with requires careful consideration and in my view the onus is clearly on the applicants to show that it has come to be regarded as a trade mark. Given the nature of the mark the subject of this application I consider the length and extent of use to be insufficient to demonstrate that this two colour of immiscible liquids will be taken by the public as the applicants’ badge of origin. In particular, it concerns me is that the evidence shows the colour combination being used but this is in conjunction with the words SOL-RAPIDE. While these words have an obvious reference to the goods themselves I take the view that they are capable of being regarded as a trade mark by the average consumer, and is the way that the goods are referred to in exhibit A3 of the applicants’ evidence. I am therefore not satisfied that the evidence establishes that the sign tendered for registration has become distinctive by virtue of the use made of it, and my findings under Section 3(1)(b) and (c) stand.

45 That leaves the objection founded under Section 5(2)(b) of the Act, which reads:

5.-(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected

5 (2) A trade mark shall not be registered if because-

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

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there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

An earlier right is defined in Section 6 the relevant parts of which state:

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6. (1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks

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(2) References in the Act to an earlier trade mark include a trade mark in respect of which an Application for registration has been made and which, if registered would be an earlier trade mark by virtue of subsection 1(a) or (b), subject to it being registered.

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In my determination of the likelihood of confusion I look to the approach adopted by the European Court of Justice in *SABEL v. PUMA* 1998 RPC 199 at 224, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc.* Case C-39/97 and in *Lloyd Schufabrik Meyer & Co GmbH v Klijsen Handel BV* (1999 ETMR 690 at 698). It is clear from these cases that:

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(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

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(b) the visual, aural and conceptual similarities of the marks must be based upon the overall impressions created by the marks bearing in mind their distinctive and dominant components;

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(c) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

(d) the matter must be judged through the eyes of the average consumer, who normally perceives a mark as a whole and does not proceed to analyse its various details;

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(e) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it.

In respect of the first point, the ECJ's decision in *Lloyd Schufabrik* (at page 198) is of assistance and is re-produced below.

5 "26. For the purposes of that global appreciation, the average consumer of the category
of products concerned is deemed to be reasonably well-informed and reasonably observant
and circumspect (see, to that effect, *Case C-210/96 Gut Springenheide and Tusky* [1968]
E.C.R.I-4657, paragraph 31). However, account should be taken of the fact that the
10 average consumer only rarely has the chance to make a direct comparison between the
different marks but must place his trust in the imperfect picture of them that he has kept
in his mind. It should also be borne in mind that the average consumer's level of attention
is likely to vary accordingly to the category of goods or services in question."

15 The opponents rely on three trade mark registrations, all of which are registered in respect of
goods which are identical to those for which the applicants seek to register their mark. The matter
therefore falls to be determined by a comparison of the respective marks taking into account any
other relevant factors.

20 Both the applicants' and the opponents' trade marks are purely visual marks and I do not consider
that the question of aural similarity has much part to play in this comparison. Both consist of a
combination of two colours applied to immiscible liquids which are visible through a clear bottle
and in that respect alone must share some visual and conceptual similarity. That said, two of the
opponents' earlier trade marks have only one colour in common with the mark applied for, the
25 other has none. There is little inherent distinctiveness in either the applicants' or the opponents'
marks, and if there is a dominant component it would in my view exist in the concept of two
immiscible and coloured liquids.

30 The applicants have provided some examples of cosmetics preparations to show that use of two
immiscible coloured liquids is not unique to the opponents, claiming that these are indicative of
widespread use throughout the industry. In my view the evidence falls well short of establishing
this to be the case.

35 It seems probable that the respective goods are relatively inexpensive but given the importance
of protection from the harmful effects of the sun will nonetheless be selected with a degree of
care. The purchase of such goods is most likely to be by self selection from shelves and I take the
view in assessing the likelihood of confusion it is the the visual similarity which is of most
significance. In this respect I believe it is relevant to take into account that the opponents have
40 three earlier trade marks for three different colour combinations which in my view increases the
potential for a consumer familiar with these to assume that the applicants' goods are another in
the range.

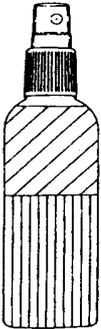
45 On the basis of the above I find that I come to the view that there is a real likelihood of confusion,
and accordingly, the opposition is successful under Section 5(2)(b). In reaching this decision I
am not saying that the opponents' mark should be considered to be likely to be confused with any
other mark which consists of two colours applied to immiscible liquids. In this particular case,
that the respective goods are identical and that the opponents use three similar marks in respect
of such goods are the significant factors.

5 This leaves the matter of the applicants' claim to Honest Concurrent Use. In my consideration of the grounds under Section 3(1), I came to the view that the evidence did not warrant acceptance of the application on the basis of distinctiveness acquired through use. For the same reasons I find that the evidence does not substantiate a claim to Honest Concurrent Use and the claim is dismissed.

10 The opposition having been successful I order that the opponents pay the applicants the sum of £635 as a contribution towards their costs. This sum to be paid within one month of the expiry of the appeal period or within one month of the final determination of this case if any appeal against this decision is unsuccessful.

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Dated this 23 day of March 2000

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**Mike Foley
for the Registrar
The Comptroller General**

Number	Mark	Class	Specifications
2003103A		3	Tanning enhancers, amplifiers and accelerators.

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The mark comprises the colours purple and red applied to the two separate layers of the product consisting of two immiscible liquids, the mark being visible through a clear container, as illustrated in the representation on the form of application.

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2003103B		3	Tanning enhancers, amplifiers and accelerators.
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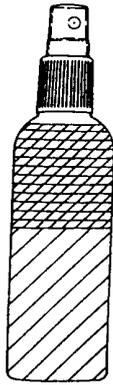
The mark comprises the colours purple and blue applied to the two separate layers of the product consisting of two immiscible liquids, the mark being visible through a clear container, as illustrated in the representation on the form of application

2003103C

3

Tanning enhancers, amplifiers and accelerators.

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The mark comprises the colours orange and purple applied to the two separate layers of the product consisting of two immiscible liquids, the mark being visible through a clear container, as illustrated in the representation on the form of application

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TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2026289
BY GOLDENGLOW INTERNATIONAL
TO REGISTER A TRADE MARK IN CLASS 3**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO 47740
IN THE NAME OF SLIM IMAGES LIMITED**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2026289
by Goldenglow International
to register a trade mark in Class 3**

And

**IN THE MATTER OF Opposition thereto under
No 47740 by Slim Images Limited**

SUPPLEMENTARY DECISION

My written decision in these proceedings, dated 23 March 2000 contained a clerical error. It has been brought to my attention that the opponents have been ordered to pay costs to the applicants. That is incorrect. The opponents having been successful the award should have been made for the applicants to pay costs to the opponents. The necessary power to correct this is provided I believe by Order 20 Rule 11 of the Rules of the Supreme Court which states:

"Clerical mistakes in judgments or orders, or errors arising therein from any accidental slip or omission, may at any time be corrected by the Court on motion or summons without an appeal."

I therefore correct the final paragraph of my written decision in these proceedings to read as follows:

"The opposition having been successful I order that the applicant pay the opponent the sum of £635 as a contribution towards their costs. This sum to be paid within one month of the expiry of the appeal period or within one month of the final determination of this case if any appeal against this decision is unsuccessful."

Dated this 30 March 2000

**Mike Foley
For the Registrar
the Comptroller General**