

O-131-07

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2342909
BY NICHOLAS ANDREW CLARKE & LESLEY ANNE GALE CLARKE
TO REGISTER THE TRADE MARK
GODDESS
IN CLASS 3**

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 93658
BY GODDESS INTERNATIONAL LIMITED**

BACKGROUND

1) On 9 September 2003, Nicholas Andrew Clarke & Lesley Anne Gale Clarke, of 130 Mount Street, London, W1K 3NU applied under the Trade Marks Act 1994 for registration of the trade mark GODDESS in respect of the following goods:

In Class 3: “Soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; toilet preparations; preparations for the care of the skin, scalp and the body; suntanning preparations; preparations for reinforcing and strengthening nails; preparations for use in the bath; oil, gel and foam preparations for use in the shower and the bath; preparations for toning the body; all being non-medicated; aftershaves, milks, oils, creams, gels, powders and lotions; shaving foams; toilet waters; shampoos; preparations for use on or in connection with the hair; anti-perspirants; deodorants for personal use; depilatories, cleansing masks for the face, reconditioning phials; eyestylers, eye make-up remover; nail polish, nail base coat, nail varnish remover, cuticle lotions, nail revitalising lotions, bronzing creams, cosmetic products for make-up, foundations, powders, blushers, eye shadows, eye crayons, mascara, lipsticks; conditioners, dyes, colourants, tints, bleaching preparations; preparations for the care and beauty of the hair, hair waving and hair-setting preparations.”

2) On 12 August 2005 Goddess International Limited of Harden Park, Alderley Edge, Cheshire, SK9 7QN filed notice of opposition to the application. The grounds of opposition are in summary:

- a) The mark offends against section 3(1)(b) as the term GODDESS is a word in the English language identifying a Supreme Being/ an idol/ an object of excessive devotion of (in each case) the female sex, and there is an English-language expression “to feel like a goddess”: accordingly, GODDESS for goods in Class 3 lacks distinctive character as the message to the purchaser is that the use of the goods will result in the user “feeling like a goddess”.
- b) The mark offends against section 3(1) (c) as the word GODDESS is a word in the English language identifying a Supreme Being/ an idol/ an object of excessive devotion of (in each case) the female sex, and there is an English-language expression “to feel like a goddess”: accordingly, GODDESS for goods in Class 3 designates both a quality and an intended purpose as the message to the purchaser is that use of those goods will result in the user “feeling like a goddess”.
- c) GODDESS was the business name of GODDESS 2000 Limited on its incorporation in 1995 and the business of that company was transferred to GODDESS INTERNATIONAL limited following the latter’s incorporation in 2002. Goods and services have been sold using the GODDESS name to customers throughout the UK since 1995 in particular sales of cosmetics, cleansers, oils, creams, lotions and gels. The mark in suit therefore offends against Section 5(4)(a).

3) The applicants subsequently filed a counterstatement denying the opponent's claims and also puts the opponent to proof of reputation and goodwill.

4) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 11 April 2007 when the opponent was not represented but supplied written submissions which I shall refer to as and when they are relevant. The applicant was represented by Mrs Turnbull of Messrs Prentice & Matthews.

OPPONENT'S EVIDENCE

5) The opponent filed a witness statement, dated 10 May 2006, by Rosalind McCall the owner and Managing Director of Goddess International Limited. She states that she is also the owner and Managing Director of Goddess 2000 Limited. She states that Goddess 2000 Ltd was incorporated on 21 July 1995 and that she has been the Managing Director since this time. At exhibit RM1 she provides a copy of a print out from Companies House which states that the company manufactures electrical equipment. The print out states that the company is now dormant and that it changed its name on 9 October 1995 from Deershade Limited. She states that Goddess 2000 made its first sale using the word Goddess as part of its trade name and trade mark on 27 September 1995. She states that trading was continuous up to 31 August 2002. At this date, the entire business of Goddess 2000, including the reputation and goodwill in the trade name and trade mark Goddess was transferred to the opponent company Goddess International Limited. However, no documents attesting to this transfer were provided as corroborative evidence. The opponent company was incorporated on 27 June 2002, a copy of the certificate of incorporation is provided at exhibit RM2. She states that on 5 September 2002 the opponent made its first sale under the mark Goddess. She states that the opponent "is in all respects the successor in title to Goddess 2000 and is relying in this opposition no 93658 on trading over a period of eight years commencing on the 27th September 1995 and ending on the 9th September 2003".

6) Ms McCall provides at exhibits RM3-RM10 copies of selected sales invoices during each of the financial years 1995/96 to 2002/03. These all show use of a stylised "Goddess 2000" heading along with a device element of a statue of a female's head. The invoices show items, *inter alia*, such as "Goddess 2000 kits", "Pads (for Goddess 2000)", "Goddess 2000 cream", "jar of collagen gel", "cream", "leads", "(pad) connectors", "cleanser", "toner", "gel", "leaflets", "mouth shields", "DIANA leaflets", "DIANA facial pads", "microcrystals", "Pre-lotion", "cooling spray", "probes with wires", "ceromone Age Control Intensive Cream", "Hyaluron Ampoules", "Skin firming Serum", "facial leads", "facial probes", "adaptor", "Godess Royal Firming Serum", "Goddess Royal Silk", "Goddess Diana Record Cards", "Diana system", "Trolley for Diana", "Oxyjet system", "Royal silk cleanser", "Royal Supreme Tonic", "Royal Appeeling Mask" and "Royal Silk". In October 2002 when the items were being sold by Goddess International Limited the headed paper changed to show the word "Goddess" with the name of the company underneath. The only time the word "goddess" is used with regard to the products is for "goddess facial pads". In 2003 there is a mixture of old and new headed paper, although all have the name "Goddess International Limited" shown on them. Just as the previous years

there is a lack of consistency with the term “goddess” appearing before products on occasion and the same items without the term “goddess” before them. In later years there is less use of the term “goddess” prior to items such as creams than in the early years.

7) Ms McCall states:

“4. The principal activity of the Opponent, and its predecessor Goddess 2000, is the sale of what can generally be described as “electronic beauty equipment”, of the kind described in the Opponent’s UK Trade Mark registration no. 236978A dated 3 August 2004 for the word “GODDESS” being:

In Class 10: “Cosmetic apparatus and instruments; beauty cosmetic apparatus and instruments; lymphodrainage apparatus; cellulite removal apparatus; apparatus for electropolysis; skin peeling apparatus; skin-cleaning apparatus; skin moisturising apparatus; apparatus promoting skin-toning and skin-tightening; muscle-stimulating apparatus; apparatus promoting muscle-toning; parts and fittings for all of the foregoing.”

and “beauty preparations”, for use with the aforesaid “electronic beauty equipment”, of the kind described in the Opponent’s UK Trade Mark application no. 2369678B for the word “GODDESS” (currently opposed) being:

In Class 3: “Cosmetics; cosmetic preparations; skin care preparations; skin regeneration preparations; anti-ageing preparations; anti-wrinkle preparations; cleansing preparations for the skin; cosmetic masks; cleansing facial masks; cosmetic facial scrubs; skin moisturisers; facial moisturisers; body moisturisers; skin care oils, creams, lotions and gels; skin toners; skin tonics.”

8) At exhibit RM11 Ms McCall provides some brochures which detail the opponent’s products. All the brochures were issued by Goddess International Limited and are not dated. These show use of the “Goddess” and device mark in relation to electronic beauty aids and associated products such as creams and gels for use with the machines. Ms McCall states that her customers are from all over the UK and include colleges. At exhibits RM12 and RM13 she provides client lists which support this claim. She states that typically a customer purchases a starter pack of the machine and various preparations for use with it. Subsequently, they then replenish their stocks of these consumables. She also provides the following figures:

Financial Year	Sales “A”	Sales “B”	Sales “C”	Advertising and marketing
Sept 1995-Sept 1996	96,874	9,680	2,855	10,741
Sept 1996-Aug 1997	135,241	13,520	4,530	28,643
Sept 1997-Aug 1998	155,107	15,500	3,315	10,349
Sept 1998-Aug 1999	145,594	14,560	4,915	4,160
Sept 1999-Aug 2000	144,545	14,450	7,768	14,427
Sept 2000-Aug 2001	396,077	39,607	13,223	18,776
Sept 2001-Aug 2002	617,577	61,757	25,973	35,310
Sept 2002-Aug 2003	400,531	40,000	10,995	17,296

9) Ms McCall provides the following explanations for the above figures:

“Each figure in the column headed Sales ‘A’ represents the total annual sales of all of the Opponent’s goods, that is both ‘electronic beauty equipment’ and ‘beauty preparations’, for the financial year indicated.

Each figure in the column headed Sales ‘B’ represents the approximate value of the total annual sales of all of the Opponent’s ‘beauty preparations’, sold as part of the starter-pack mentioned in paragraph 6 above.

Each figure in the column headed Sales ‘C’ represents the total annual sales by the Opponent of the additional supplies of ‘beauty preparations’ mentioned in paragraph 6 above.”

10) I note that the company name changed to ‘Goddess International Limited’ in 2002 and that Ms McCall has not stated that all the sales relate to sales within the UK. Nor is it confirmed that all the products were sold under the “Goddess” label, although they were invoiced on “Goddess 2000” and device headed invoices for the years 1995-2002 inclusive. I assume that the figures provided relate to UK£. Ms McCall states that the companies advertised from 1996-2003 in trade publications such as *Health & Beauty*, *Guild News (The Journal of The Guild of Professional Beauty Therapists)*, *Salon Plus*, *Vitality (The Journal of The British Association of Beauty Therapy & Cosmetology)* *Professional Beauty and Creative Link South*. At exhibit RM15 she provides copies of some of these advertisements. These offer for sale either the ‘Oxyjet’ or ‘Diana’ or ‘Beauty Peeling’ machines from Goddess 2000 Ltd or Goddess International Ltd. The advertisements change in 2004, after the relevant date, and show use of the term ‘Goddess’ as a trade mark. Ms McCall also states that her company has attended a number of trade exhibitions and at exhibit RM17 she provides evidence of such appearances. She then gives her opinion that due to the use made of the mark that the opponent has reputation amongst members of the public who are buyers and users of electronic beauty equipment and beauty preparations.

APPLICANTS’ EVIDENCE

11) The applicants filed a witness statement, dated 9 August 2006, by Claire Victoria Turnbull the applicants’ Trade Mark Attorney. She states that she carried out an Internet search for details of the annual turnover figures for the sales of cosmetics, fragrances and toilet articles in the UK. At exhibit CVT1 she provides a copy of a report issued by Business Link Devon & Cornwall which states that “The health and beauty treatment market was worth £1,500m in 2004, up from £1,050m in 1998”. Also that “Key note reports that in 2004 the UK cosmetics and fragrances market was worth £1,600m at retail selling prices (rsp), an estimated increase of 3.2% from 2003”.

12) She states that the mark has been licensed to Lever Faberge Ltd who has used the mark GODDESS on their ‘Impulse’ range of body fragrances since 2004. She also states that the applicants have used the mark BLONDE GODDESS which they have

already registered. She states that no use of the mark GODDESS (solus) has been made by the applicants.

OPPONENT'S EVIDENCE IN REPLY

13) The opponent filed a witness statement, dated 8 November 2006 by Ms McCall who has previously given evidence in this case. She states that the sales figures are with regard to a niche market rather than competing with the cosmetics industry as a whole. They are aimed at beauty salons, hairdressers with beauty salons, independent beauty therapists and beauty therapy departments of colleges. She points out that at page one of exhibit CVT1 of the applicant's evidence it states that "in 2004 21,551 VAT registered enterprises were engaged in hairdressing and other beauty treatments", and "there are approximately 40,000 hairdressing salons and over 5,000 beauty salons". She states that only a proportion of the hairdressers will also offer beauty treatments. She states that the applicants are hairdressers and currently use BLONDE GODDESS to which the opponent has no objection. She also states that the products are clearly marked as being NICKY CLARKE products.

14) That concludes my review of the evidence. I now turn to the decision.

DECISION

15) At the hearing the grounds of opposition under Sections 3(1)(b) & (c) were withdrawn. The only ground of opposition being pursued is under Section 5(4)(a) which reads:

"5. (4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark."

16) In deciding whether the mark in suit (GODDESS) offends against this section, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the *WILD CHILD* case [1998] RPC 455. In that decision Mr Hobbs stated that:

"The question raised by the grounds of opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the applicant from those of other undertakings (see section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Article 4(4)(b) of the Directive and section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the applicant in accordance with the law of passing off.

A helpful summary of the elements of an action for passing off can be found in Halsbury's Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731 is (with footnotes omitted) as follows:

'The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

- (1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and
- (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.'

Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

'To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

17) The date at which the matter must be judged is not entirely clear from Section 5(4)(a) of the Act. This provision is clearly intended to implement Article 4(4)(b) of Directive 89/104/EEC. It is now well settled that it is appropriate to look to the wording of the Directive in order to settle matters of doubt arising from the wording of equivalent provisions of the Act. The relevant date may therefore be either the date of the application for the mark in suit (although not later), or the date at which the acts first complained of commenced – as per the comments in *Cadbury Schweppes Pty Limited v. The Pub Squash Co Pty Ltd* [1981] RPC 429. The applicant has not provided any evidence of use and so the relevant date must be regarded as 9 September 2003.

18) The applicant referred me to the comments of Pumfrey J. in *South Cone Inc. v. Jack Bessant, Dominic Greensmith, Kenwyn House, Gary Stringer (a partnership)* [2002] RPC 19 when considering an appeal from a decision of the Registrar to reject an opposition under Section 5(4)(a) he said:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent’s reputation extends to the goods comprised in the applicant’s specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd’s Application (OVAX)* [1946] 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus, the evidence will include evidence from the trade

as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date.”

19) This cannot be interpreted in a prescriptive fashion. There will be occasions when the evidence does not fall within the above parameters but still establishes goodwill for passing off purposes - see the decision of Professor Annand, sitting as the Appointed Person, in *Loaded* BL 0/191/02. This point was also made by Mr Arnold QC sitting as the Appointed Person in *Aggregate Industries UK Limited v Cooper Clark Group Limited* BL O/178/06. It is clear that the opponent needs to establish, on the balance of probabilities, that at the material date it enjoyed a protectable goodwill.

20) With these considerations in mind I turn to assess the evidence filed on behalf of the parties in the present proceedings as set out earlier in this decision. I only have to determine whether, at the relevant date, the opponent or its predecessor enjoyed goodwill in the mark GODDESS, as at the hearing Ms Turnball accepted that if I found that the opponent or its predecessor enjoyed such a reputation then misrepresentation and damage were a foregone event and the opponent would succeed under this ground. She also accepted that the applicant’s use of BLONDE GODDESS would not assist the applicant overcome the opposition. Therefore, the outcome rests solely on the question as to whether the opponent or its predecessor enjoyed goodwill in the mark GODDESS at the relevant date.

21) The opponent states that they first began trading in 1995 with Goddess 2000 Limited. It is also stated that on 31 August 2002 the entire business including the goodwill was transferred to a new company Goddess International Limited. The statement regarding the transfer of goodwill has not been corroborated in the evidence. Given the importance surrounding this transfer it is not something which should be accepted without it being backed up with clear documentary evidence. Therefore, I cannot consider the opponent to be the successor in business to the original user of the Goddess 2000 mark. I must therefore consider the companies as two separate unconnected opponents. Although the opponent is Goddess International Limited there is no requirement of *locus standii* under Section 5(4)(a) and so the use under Goddess 2000 Limited can be considered, albeit as a separate issue.

22) I will first consider the position of Goddess 2000 Limited which traded from September 1995 to August 2002. I note that Goddess 2000 Limited was registered with Companies House as a manufacturer of electrical equipment. It is also clear from the opponent’s evidence that the company’s primary business was the sale of electrical beauty equipment. The invoices provided at exhibit RM3-RM9 all have “Goddess 2000” and a device element of a female head at the top of each invoice. There are a variety of descriptions used for the products, these include, *inter alia*, “Goddess 2000 kits”, “Pads (for Goddess 2000)”, “Goddess 2000 cream”, “jar of collagen gel”, “cream”, “leads”, “(pad) connectors”, “cleanser”, “toner”, “gel”, “leaflets”, “mouth shields”, “DIANA leaflets”, “DIANA facial pads”, “microcrystals”, “Pre-lotion”, “cooling spray”, “probes with wires”, “ceromone Age Control Intensive Cream”, “Hyaluron Ampoules”, “Skin firming Serum”, “facial

leads”, “facial probes”, “adaptor”, “Goddess Royal Firming Serum”, “Goddess Royal Silk”, “Goddess Diana Record Cards”, “Diana system”, “Trolley for Diana”, “Oxyjet system”, “Royal silk cleanser”, Royal Supreme Tonic”, “Royal Appeeling Mask” and “Royal Silk”.

23) No photographs of the products or their packaging has been supplied so one must assume that the products carried the names as set out on the invoices. It is clear that the opponent sold beauty therapy machines under the Goddess 2000 mark. It is also clear that they sold items such as gels, creams, cleansers and toners to use with these machines. These were initially sold as part of the package with the machine and then the machine owner could replenish their stocks of these ancillary items. What is also clear from the invoices is that the opponent was linking its machines and accessories with the Princess of Wales and/or Diana the goddess of hunting. Hence the use of the term “Royal”. They also had another machine system known as “Oxyjet”.

24) Typically these machines are sold to salon owners. The advertisements show use of “Oxyjet”, “Diana” or “Beauty Peeling” machines under the banner of Goddess 2000. Therefore, the only ones who would be aware of the Goddess 2000 label would be the purchasers of the machines. The public who are treated on these machines would see the trade marks “Oxyjet”, “Diana” and “Beauty Peeling”. The salon owners, whilst aware of the Goddess 2000 mark would, in my view, regard the mark as relating to the providers of electrical equipment and various accessories for this equipment. The accessories would include cosmetic items such as gels, creams etc for use with the machines but these were clearly sold under a very large variety of other trade marks (see paragraph 22 above) and would have been viewed as consumables for the machine just as the pads and electrical leads were. I do not accept that these sales provided Goddess 2000 Limited with any goodwill in relation to goods in Class 3 only to goods in Class 10 and then only in relation to the mark “Goddess 2000” and not “Goddess” *solus*. Given the differences between the terms “Goddess” and “Goddess 2000” and also the differences between the goods of the two parties I do not accept that misrepresentation would occur.

25) I now move on to consider the position under the use as shown by Goddess International Limited. The same arguments apply here as with Goddess 2000 Limited with the difference that the opponent was only trading for 12 months prior to the relevant date. There was a minor change to the heading of the invoices in that they, for the most part had the term “Goddess” *solus* on them. However, I do not accept that this is enough to get the opponent further than having goodwill in the mark “Goddess” for electrical beauty equipment and accessories for use with the electrical equipment. To my mind there is no likelihood of misrepresentation and so the opposition under Section 5(4)(a) fails.

COSTS

26) As the opponent was unsuccessful the applicant is entitled to a contribution towards its costs. I order the opponent to pay the applicant the sum of £1,500. This sum 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 16th day of May 2007

**George W Salthouse
For the Registrar,
the Comptroller-General**