

O-139-04

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2306992
BY AVON COSMETICS LIMITED
TO REGISTER THE TRADE MARK
CLEAN CREAM
IN CLASS 3

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 91479
BY JOHNSON & JOHNSON

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BACKGROUND

1) On 1 August 2002, Avon Cosmetics Limited of Nunn Mills Road, Northampton, NN1 5PA applied under the Trade Marks Act 1994 for registration of the trade mark **CLEAN CREAM** in respect of the following goods in Class 3:

Non-medicated toilet preparations; powders, creams and lotions, all for the face, hands and body; nail polish; nail polish remover; cosmetics; soaps; shower and bath preparations; preparations for the hair; preparations for cleaning the teeth; shaving and aftershave preparations; perfumes, colognes, toilet waters, eau de colognes; deodorants and anti-perspirants for personal use; toilet articles; essential oils; all the aforesaid being alone, in combination and/or in gift sets comprised of some or all of these items.

2) On 12 February 2003 Johnson & Johnson of One Johnson & Johnson Plaza, New Brunswick, New Jersey, 08933-7001, United States of America filed notice of opposition to the application. The grounds of opposition are in summary:

a) The mark in suit consists of the ordinary dictionary words **CLEAN** and **CREAM** combined without stylisation or additional matter and seeks registration in a wide range of non-medicated toilet preparations and products. The mark applied for is not capable of distinguishing the goods of one undertaking from those of another. In the alternative it is devoid of distinctive character, and is a combination of words which have a direct meaning for the goods applied for. Alternatively the mark applied for consists of two words which are common and normal ways of describing the type of goods applied for, for example, personal cleaning preparations in cream form or which have a creamy nature. Alternatively, the mark consists of words which are used in everyday language by members of the trade and public to refer to goods such as those claimed in the mark applied for.

b) The mark applied for therefore offends against Sections 3(1)(a), 3(1)(b), 3(1)(c) and 3(1)(d) of the Trade Marks Act 1994.

3) The applicant subsequently filed a counterstatement denying the opponent's claims.

4) Only the opponent filed evidence and written submissions in these proceedings. Both sides ask for an award of costs. Neither side wished to be heard on this matter.

OPPONENT'S EVIDENCE

5) The opponent filed a witness statement, dated 28 August 2003, by Jane Harlow the opponent's Trade Mark Attorney. At exhibit JH1 she provides a selection of Internet material which she claims, shows that the words 'CLEAN CREAM' or close variations thereof are in common usage in the UK in relation to goods in Class 3. All the Internet material carried a search date of 20 August 2003. She cites the following examples:

- \$ NEUTROGENA Deep Clean Cream Cleanser; Deep Clean Cream Wash.
- \$ AMARANTH CLATE=POSER Clean massage Cream; Cucumber Cleaning Cream.
- \$ ECOVER Cream Cleaner.
- \$ CLEAN & CLEAR Deep Action Cleanser.
- \$ ESTEE LAUDER Tender Creme Cleanser.
- \$ CLINIQUE Comforting Cream Cleanser.
- \$ ELCO Cooktop Clean Cream.
- \$ LAUDAMAY Cream Cleaner.
- \$ NATURALLY HOME Cream Cleaner.
- \$ BB BRUTE Cream Cleaner.
- \$ ORANGE CLEAN Pro Cream Cleanser.
- \$ TC-613 CD/LD Protective Cleaning Cream.

6) Not all of the above were used in relation to products within the specification applied for. For instance the ELCO, LAUDMAY, NATURALLY HOME, BB BRUTE & ORANGE CLEAN marks are all used on general purpose kitchen, cooker and bathroom cleaners; whilst TC613 is a CD Cleaner.

7) Ms Harlow states that these examples show that the words 'CLEAN' and 'CREAM' are readily adapted for descriptive use in relation to Class 3 products. She also refers to the opinion of Advocate General Jacobs in case C-191/01P (Doublemint) in particular she refers to paragraphs 61-66. The Advocate General puts forward a three part test to determine whether a trade mark may be used to designate products or their characteristics or whether such a term is merely suggestive of such characteristics. Ms Harlow claims the mark in suit would fall on the wrong side of the line, being a descriptive designation in relation to the products of interest.

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

DECISION

9) In its written submissions the opponent withdrew its opposition based upon Sections 3(1)(a) & 3(1)(d) of the Trade Marks Act 1994. I shall refer to the written submissions when

relevant.

10) The remaining grounds of opposition are under Section 3(1)(b) & (c) which read:

A3.-(1) The following shall not be registered -

- (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,

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.@

11) It is clear from the views expressed by the European Court of Justice in *Companyline* [2003] E.T.M.R. 20 and the High Court in *Have a Break* [2002] EWHC 2533 (Ch) that Section 3(1)(b) has separate and independent scope from Section 3(1)(c). Therefore, I have to consider each section separately.

12) I shall first consider the position under Section 3(1)(c). In considering this ground I look to the guidance given by 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* [2001] ETMR 75. 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 judgement. Paragraphs 37, 39 and 40 serve to illustrate the approach adopted by the Court.

A37. It is clear from those two provisions taken together that the purpose of the prohibition of registration of purely descriptive signs or indications as trade marks is, as both Proctor & Gamble and the OHIM acknowledge, to prevent registration as trade marks signs or indications which, because they are no different from the usual way of designating the relevant goods or services or their characteristics, could not fulfil the function of identifying the undertaking that markets them and are thus devoid of the distinctive character needed for that function.

39. The signs and indications referred to in Article 7(1)(c) of Regulation No 40/94 are thus only those which may serve in normal usage from a consumer's point of view to designate, either directly or by reference to one of their essential characteristics, goods or services such as those in respect of which registration is sought. Furthermore, a mark composed of signs or indications satisfying that definition should not be refused registration unless it comprises no other signs or indications and, in addition, the purely descriptive signs or indications of which it is composed are not presented or configured in a manner that distinguishes the resultant whole from the usual way of

designating the goods or services concerned or their essential characteristics.

40. As regards marks composed of words, such as the mark at issue here, descriptiveness must be determined not only in relation to each word taken separately but also in relation to the whole which they form. Any perceptible difference between the combination of words submitted for registration and the terms used in the common parlance of the relevant class of consumers is apt to confer distinctive character on the word combination enabling it to be registered as a trade mark.®

13) I also take into account the comments of Advocate General Jacobs in the *Doublemint* case, dated 10 April 2003, where he said:

¶91. That last consideration leads me to the question of the extent to which Article 7(1)(c) of the Trade Mark Regulation must be interpreted in the light of the aim referred to in the *Windsurfing Chiemsee* judgment, namely that descriptive signs and indications should be freely available to be used by all traders in relation to the relevant goods.

92. In my opinion in *Baby-Dry*, (39) I took the approach that in the scheme of the Community Trade Mark Regulation a trade mark could include signs or indications designating product characteristics but could not consist exclusively of them. By virtue of Article 12(b), the trade mark cannot prevent other traders from using such signs for descriptive purposes. The aim of Article 7(1)(c) is to avoid the registration of descriptive brand names for which no protection could be available rather than to prevent any monopolising of ordinary descriptive terms. A very similar view was taken by the Court at paragraph 37 of its judgment.

93. In the present case, both the Office and the United Kingdom Government have expressed reservations about that approach, which has also been criticised in the literature. (40) It appears, they have pointed out, to represent a departure from the Courts statement in *Windsurfing Chiemsee* that Article 7(1)(c) of the Trade Marks Directive pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the categories of goods or services in respect of which registration is applied for may be freely used by all and that Article 6(1)(b) (which corresponds to Article 12(b) of the Regulation) does not have a decisive bearing on that interpretation.®

94. It may be feared that the approach in question is liable to shift the balance of power in favour of a trade mark owner with monopolistic ambitions who may assert, or threaten to assert, his rights against an alleged infringer who merely seeks to use descriptive terms descriptively and honestly.® In the real world, a defence under Article 12(b) might be worth rather less than its ostensible value in law.

95. That danger cannot be ignored. A trade mark owner wishing to monopolise not only his trade mark but the area around it may threaten unmeritorious proceedings

against a competitor, who may capitulate rather than incur the costs of litigation as well as risk an adverse outcome.

96. However, for the reasons already given, I do not think that the *Baby-Dry* case, properly understood, does shift the balance in the way that has been suggested. And the danger mentioned will be obviated if the criterion of *Aperceptible difference* in paragraph 40 of the *Baby-Dry* judgment is applied as I have suggested above, so that a mark is accepted for registration only when it is apparent to both traders and consumers that as a whole it is not suitable, in the ordinary language of trade, as a designation of characteristics of the product in question.

97. In any event, it seems clear that there was no intention, in the *Baby-Dry* judgment, to depart from the view in *Windsurfing Chiemsee* that it is in the public interest that descriptive signs may be freely used by all. Very recently, in *Linde*, (42) the Court has expressly reaffirmed that position.®

14) This opinion was confirmed by the European Court of Justice in *Doublemint* Case C191-01 (*Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr* [2003] WL101985) which said:

¶31. By prohibiting the registration as Community trade marks of such signs and indications, Article 7(1)(c) of Regulation No 40/94 pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all. That provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks.®

15) It is clear from the above that I must determine whether, assuming notional and fair use, the mark in suit, CLEAN CREAM, will be viewed by the average consumer to directly designate the essential characteristics, *Akind* and *Aintended purpose*, of the goods for which registration is sought. Only if the mark is no different from the usual way of designating the relevant goods/services or their characteristics can it be debarred from registration.

16) It is well established that if a trade mark consists of two words which by themselves are both descriptive it does not necessarily mean that the mark which they form is also descriptive. The mark must be viewed as a whole. The opponent has filed some evidence from the internet. Only three of the marks have the words *AClean* and *ACream* in the same order as the mark in suit. These are *ANeutrogena Deep Clean Cream Cleanser*, *AAmaranth Clate=Poser Clean Massage Cream* and *AElco Cooktop Clean Cream*. The latter clearly relates to unrelated goods and the word *Acooktop* has a significant impact on the word clean. Similarly, the Neutrogena product is a *Adeep clean* *ACream cleanser*. The words before and after alter the meaning of the phrase. The final use shown has the word *Amassage* between the words *AClean* and *ACream* which, again, has a significant effect. It should also be noted that the Internet searches are dated after the relevant date. I also note that Section 3(1)(c) excludes

descriptions which are not in common usage at the date of registration but where it is reasonably foreseeable that they will come into descriptive use (*Cycling Is* [2002] R.P.C. 37 and *Windsurfing Chiemsee*). However, I do not believe that the mark in suit falls into this category.

17) To my mind the mark in suit alludes to the product and its characteristics but it is not a normal way of describing the types of goods, or their characteristics, included in the specification and therefore the public could distinguish them from those provided by other undertakings. The ground of opposition under Section 3(1)(c) fails.

18) I now move to consider the ground of opposition under Section 3(1)(b). When considering the opposition under this section I adopt the approach taken by the European Court of Justice in its judgment in Joined Cases C-53/01 to C-55/01 *Linde AG, Windward Industries Inc. and Radio Uhren AG* (8 April 2003) at paragraphs 37, 39-41 and 47 which state:

A37. It must first of all be observed that Article 2 of the Directive provides that any sign may constitute a trade mark provided that it is, first, capable of being represented graphically and, second, capable of distinguishing the goods and services of one undertaking from those of other undertakings.

.....

39. Next, pursuant to the rule 1 Article 3(1)(b) of the Directive, trade marks which are devoid of distinctive character are not to be registered or if registered are liable to be declared invalid.

40. For a mark to possess distinctive character within the meaning of that provision it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from products of other undertakings (see *Philips* [2002] ECR I-5475, paragraph 35).

41. In addition, a trade mark's distinctiveness must be assessed by reference to, first, the goods or services in respect of which registration is sought and, second, the perception of the relevant persons, namely the consumers of the goods or services. According to the Court's case-law, that means the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and circumspect (see Case C-210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 31, and *Philips*, paragraph 63).

47. As paragraph 40 of this judgment makes clear, distinctive character means, for all trade marks, that the mark must be capable of identifying the product as originating from a particular undertaking, and thus distinguishing it from those of other undertakings. @

19) It is clear from the above that I must assess the mark's distinctiveness in relation to the goods for which the applicant seeks registration. Broadly the specification is for toiletries, cosmetics, perfumes and similar goods. I must also take into account the perception of the relevant consumer of the goods which, to my mind, means the general public.

20) In my opinion, CLEAN CREAM whilst consisting of two standard English words exhibits a syntactically unusual juxtaposition of those words. Consequently, I believe that the mark CLEAN CREAM can be distinctive of a particular trader. In my view the average consumer would see the mark as being origin specific due to its unusual nature. I have no difficulty in finding that the words CLEAN CREAM are not devoid of any distinctive character in relation to the goods for which it is sought to be registered.

21) The opposition has failed. I order the opponent to pay the applicant the sum of , 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 18th day of May 2004

George W Salthouse
For the Registrar,
The Comptroller-General