

O-149-04

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2294643  
BY ERIC PETERSON  
TO REGISTER THE TRADE MARK:**

**NATURAL\*WHITE**

**IN**

**CLASS 3**

**AND**

**THE OPPOSITION THERETO  
UNDER No 90855**

**BY**

**HENKEL KOMMANDITGESELLSCHAFT AUF AKTIEN**

## **Trade Marks Act 1994**

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**by Henkel Kommanditgesellschaft auf Aktien**

### **BACKGROUND**

1) On 7 March 2002 Eric Peterson applied to register the above trade mark (the trade mark). The application was published for opposition purposes in the “Trade Marks Journal” on 24 April 2002 with the following specification:

*toothpaste, mouthwash, dentifrices, cosmetics, cleaning, soaps, and polishing.*

The above goods are in class 3 of the “International Classification of Goods and Services”.

2) On 19 July 2002 Henkel Kommanditgesellschaft auf Aktien, which I will refer to as Henkel, filed a notice of opposition to this application.

3) Henkel claims that the trade mark:

i) is devoid of any distinctive character;

ii) consists exclusively of signs and indications which may (and do) serve in trade to designate the kind, quality and intended purpose of the goods of the application;

iii) consists exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.

Henkel, therefore, submits that the application should be refused under sections 3(1)(b),(c) and/or (d) of the Trade Marks Act 1994 (the Act).

4) Henkel claims that WHITE is the natural colour of most of the articles which would be treated by the goods of the application and is the colour to which it is hoped that the articles will be returned to by treatment with the goods in question. Henkel claims that NATURAL adds nothing, other than to indicate that the resulting white colour achieved is natural white ie the original colour of the articles in question.

5) Henkel states that stars are commonplace and non-distinctive and merely indicate in a customary fashion that the product produces a sparkle or that the product is a good (or star)

product.

6) Henkel states that it advised Mr Peterson of its objections to the application but the application has not been withdrawn. It requests that this be taken into account in any award of costs.

7) Henkel requests the refusal of the application, an award of costs and any alternative or additional relief as may be appropriate.

8) Mr Peterson filed a counterstatement. He denies that the trade mark is devoid of any distinctive character because it consists of the words NATURAL and WHITE in a stylised manner combined with a distinctive device element. He claims that the trade mark in its entirety has a distinctive character.

9) Mr Peterson denies that the trade mark consists exclusively of signs that may serve in trade to designate the kind, quality and intended purpose of the goods of the application. He states that the trade mark consists of a number of separate elements. He denies that the words NATURAL and/or WHITE are descriptive of either the characteristics of any of the goods covered by the application or their intended purpose. Mr Peterson claims that the words NATURAL and WHITE are depicted in a stylised manner and that the trade mark incorporates a distinctive device.

10) Mr Peterson denies that the trade mark consists exclusively of signs or indications that have become customary in the current language or the bona fide and established practices of the trade.

11) Mr Peterson denies that the word WHITE is the natural colour of the articles covered by the application nor the colour to which it is hoped such articles will be returned by treatment with the goods. Mr Peterson denies that NATURAL WHITE is an appropriate term to describe the colour of any of the goods of the application.

12) Mr Peterson denies that stars are commonplace and non-distinctive and merely indicate in a customary fashion that the product produces a sparkle or that the product is a good (or star) product.

13) Mr Peterson states that in the alternative registration of the trade mark should not be refused as it has acquired a distinctive character as a result of the use made of it before the date of application for registration.

14) Mr Peterson requests that the opposition is rejected and seeks an award of costs.

15) Both sides filed evidence. A hearing was held in respect of this opposition on 20 May 2004. Mr Peterson was represented by Michael Bilewycz of Markforce. Henkel was represented by Doug McCall of WP Thompson & Co.

## **EVIDENCE**

16) In the evidence of both sides there are parts that can be characterised as representing submission or a critique of the other's evidence, rather than evidence of fact. I will only summarise those elements which represent evidence of fact.

### **Witness statement of Rigel Kate Moss-McGrath of 21 February 2003 – for Henkel**

17) Ms Moss-McGrath is a trainee trade mark attorney of WP Thompson & Co. Ms Moss-McGrath purchased various brands of toothpaste from shops in the centre of Liverpool. She exhibits the packaging for the toothpaste. The details of the exhibits are as follows:

- RMM1. Packet for AQUAFRESH MULTI-ACTION + WHITENING toothpaste. Star devices appears at least seventeen times on the packaging. On three occasions a star device appears on graphic representations of teeth or the mouth. Included on the packaging is the following: "Bring teeth back to their natural whiteness". The toothpaste was purchased from John Lewis on 19 December 2002.
- RMM2. Packet for TESCO WHITENING tooth paste. A star device appears at least four times on the packet. The toothpaste was purchased from Tesco Metro on 19 December 2002.
- RMM3. Packet for TESCO TOTAL CARE KIDS toothpaste. A star device appears on at least four occasions. The toothpaste was purchased from Tesco Metro on 19 December 2002.
- RMM4. Packet for CREST EXTRA WHITENING toothpaste. Star devices appear at least twelve times, including three times over stylised pictures of teeth. The toothpaste was purchased from Tesco Metro on 19 December 2002.
- RMM5. Packet for COLGATE WHITENING toothpaste. Star devices appear on numerous occasions, including over stylised pictures of teeth. Included on the packaging is the following: "Advanced formula with microcrystals restores the natural whiteness of teeth twice as effectively as an ordinary toothpaste" and "RESTORES NATURAL WHITENESS". The toothpaste was purchased from Boots the Chemist Ltd on 19 December 2002.
- RMM6. Packet for MACLEANS ICE WHITENING gel. Star devices appear at least six times. Included on the packaging is the following: "HELPS RESTORE NATURAL WHITENESS" and "FOR A NATURAL WHITE SMILE AND ICE COOL BREATH". The toothpaste was purchased from Boots the Chemist Ltd on 19 December 2002.
- RMM7. Packet for ARM & HAMMER EXTRA WHITENING toothpaste. Star devices appear at least three times, including once on the picture of a stylised tooth. Included on the packaging is the following: "Use twice a day to gently restore natural whiteness". The toothpaste was purchased from Boots the Chemist Ltd on 19 December 2002.
- RMM8. Packet for BOOTS ADVANCE TOTALCARE WHITENING toothpaste. A star device appears at least three times. The toothpaste was purchased from Boots the Chemist Ltd on 19 December 2002.
- RMM9. Packet for NATURAL WHITE BRILLIANT TOOTH WHITENING SYSTEM. Two star devices appear above the word BRILLIANT on at least four occasions.

18) Ms Moss-McGrath exhibits at RMM10 a page downloaded from the Thane UK website

on 17 February 2003. A description of a dental product called RAPID WHITE includes the following: “As our teeth lose their natural white color we may even start to avoid.....” Finally Ms Moss-McGrath exhibits at RMM11 pages downloaded from the Nature Publishing Group website on 14 February 2003. Ms Moss-McGrath states that the Nature Publishing Group publishes the “British Dentistry Journal”. Three “hits” on the pages are highlighted:

- “Clinpro sealant goes on pink for easy-to-see application and cures to a natural white” – “British Dental Journal” 13 October 2001.
- “...as tooth whitening products. Most appear to contain ingredients that might remove extrinsic stains rather than change natural tooth colour” – “British Dental Journal” 1 January 1970.
- “...specially formulated for people with sensitive teeth and gums to gently, yet effectively, restore teeth to their natural whiteness while still offering an effective level of fluoride (1400 ppm F) - British Dental Journal” 1 January 1970.

**Witness statement of Eric Peterson of 20 May 2003 – for Mr Peterson**

19) Mr Peterson is the applicant. He states that the trade mark is used by Purity Laboratories as licensee. He is the proprietor and managing director of Purity Laboratories.

20) Mr Peterson states he first marketed products under the trade mark NATURAL WHITE in the United Kingdom in December 1993. He states that the trade mark is used on a range of products; initially on toothpaste and teeth whitening products and then also for mouthwashes and rinses. He lists various jurisdictions in which he states that registrations of the trade mark NATURAL WHITE have been obtained. No details of the actual registrations are given. Mr Peterson exhibits a printout of a Community trade mark application for the trade mark NATURAL WHITE which covers *perfumes, essential oils, mouthwash, hair lotions*, all these goods are in class 3 of the “International Classification of Goods and Services”. Mr Peterson states that although the legal status of the application is shown as “opposition pending” the opposition has been dismissed.

21) Mr Peterson gives the following turnover figures for products sold under the NATURAL WHITE trade mark in the United Kingdom:

1994	£452,810
1995	£470,686
1996	£883,000
1997	£2,026,629
1998	£2,292,672
1999	£2,374,201
2000	£3,287,528
2001	£3,869,188
January to February 2002	£194,059

22) Mr Peterson states that “the product range is directed primarily at the higher end of the market, and is not intended to compete with ordinary everyday toothpaste and mouthwash products etc”.

23) Mr Peterson states that products under the trade mark NATURAL WHITE have been extensively advertised in the United Kingdom throughout the period 1994 to 2003. He

exhibits at EP2 a selection of promotional material. A number of the pieces do not refer to NATURAL WHITE at all but products such as BEVERLY HILLS FORMULA WHITENING MOUTHRINSE and BEVERLEY HILLS FORMULA ENAMEL + PLUS. All of the pieces refer to BEVERLEY HILLS FORMULA. One finds references, as in “Cosmopolitan” for January to February 2002 as follows:

“...by switching to a whitening toothpaste. Try Beverly Hills Formula, £3.99 for 125ml or £1.99 for 50ml”.

Certain of the pieces are comparisons between whitening toothpaste and give amongst other things prices. So for instance a piece from the “Peterborough Evening Telegraph” of 18 August 2001 gives prices of 99p for 50ml of MACLEANS WHITENING, £7.95 for 50ml of REMBRANDT LOW ABRASION, £2.40 for 50ml of ARM & HAMMER, £3.99 for 125ml of BEVERLY HILLS FORMULA and £3.95 for 50ml of COLGATE PLATINUM. Various references are made not just to BEVERLY HILLS FORMULA NATURAL WHITE toothpaste but to BEVERLY HILLS FORMULA TOTAL PROTECTION NATURAL WHITE toothpaste (see for instance “Rosemary Conley Diet & Fitness Magazine” for August/September 2000 and “The Advertiser” of Enfield of 19 July 2000).

24) Mr Peterson states that a selection of copy invoices is exhibited at EP3. In fact there is one invoice addressed to Farillon Ltd. This is headed sales for March 1994 and dated 23 April 1994. It identifies the goods as FRESH BREEZE spray, FRESH BREEZE tablets and NATURAL WHITE toothpaste. It gives total sales figures for these products and so does not identify the sales for NATURAL WHITE toothpaste. Mr Peterson states that detailed sales figures relating to NATURAL WHITE toothpaste in the United Kingdom for January 1995 to April 1996 are shown in a document exhibited at EP4. This document is headed Purity Laboratories. It identifies the goods as United Kingdom toothpaste sales. There is no reference in the document to NATURAL WHITE. The various goods are identified as 125ml (illegible), 100ml baking soda and 100ml original.

25) Mr Peterson exhibits at EP5 a copy of a facsimile transmission from John Bell & Croyden dated 30 July 1994 which refers to sales of NATURAL WHITE and is addressed to Mr Peterson at NATURAL WHITE.

26) Mr Peterson exhibits at EP6 a letter from a GE Hardwick of Grafton International. This letter is dated 7 March 2003 and is addressed to “to whom it may concern”. Hardwick states that Grafton International is the exclusive distributor of REMBRANDT WHITENING toothpaste in the United Kingdom. Hardwick states that Mr Peterson telephoned him on 28 February 1996 and asked him to give an “independent appraisal” of which of the NATURAL WHITE products was first launched in the United Kingdom; that of Purity Laboratories or that of Shemmer. Hardwick states:

“I first heard of the proposed launch of Beverly Hills Formula Natural White Toothpaste when I saw artwork copy samples in Lloyds Chemist Head Office in approximately October 1993. A few months later my sales people reported sightings of this product in independent pharmacies.

Jurgen Schemmer’s Natural White Toothpaste was first sighted much later in 1994.

Since our company was the only major company to distribute a specialist whitening toothpaste before Beverly Hills Formula Natural White, we feel that we are qualified to make the above statements.”

Mr Peterson exhibits at EP7 a letter from Paul WD Morgan of The Brand Development Company. This letter is undated and headed “to whom it may concern”. Mr Morgan writes that his company was retained by Mr Peterson in 1994 to, with limited resources, develop the awareness and trial of the NATURAL WHITE brand of toothpaste. Mr Morgan attaches an outline of the first advertisement from 1994. There is no indication of where it was published, if indeed it was published. Nothing similar to it is exhibited at EP2. Mr Morgan goes on to write about what he considers to be the success of the product. Mr Morgan writes that NATURAL WHITE is synonymous with Purity Laboratories and Mr Peterson. Mr Peterson goes on to give his views as to why Mr Peterson should be granted a trade mark registration.

27) Mr Peterson exhibits at EP8 pictures of packaging of NATURAL WHITE products. Certain of the pictures are of a very poor quality and lack definition and detail. However, the pictures do show the trade mark in a prominent position and show BEVERLY HILLS FORMULA with considerably less prominence. Similar use is also shown for instance from the extracts from “The Sun” of 16 March 2001, exhibited at EP2.

28) Mr Peterson states that he is the proprietor of United Kingdom registration no 1530537 of the trade mark:



This trade mark was advertised before acceptance by reason of trade evidence and disclaims the separate use of the words NATURAL and WHITE. The specification is for *essential oils included in class 3*. Mr Peterson states that a number of companies have registered star devices. He exhibits various of these at EP9, the examples encompass United Kingdom and Community trade marks. I have copied them below:





**Witness statement of Bernd Carlos Jäcker of 28 August 2003 – for Henkel**

29) Mr Jäcker is head of the trade mark department of Henkel. Mr Jäcker exhibits at BCJ1 a printout of the details of Community trade mark application no 331546 for the trade mark NATURAL WHITE. The specification of the trade mark is: *perfumes, essential oils, mouthwash, hair lotions*. The trade mark is in the name of Mr Peterson.

30) Mr Jäcker exhibits at BCJ2 a further witness statement made by Ms Moss-McGrath. Ms Moss-McGrath states that she went to a Superdrug shop in Liverpool. She exhibits a grid showing the positioning of BEVERLY HILLS FORMULA products in relation to other toothpastes. Ms Moss-McGrath states that the BEVERLY HILLS FORMULA products were not positioned in a prominent fashion but were displayed amongst other brands of toothpaste. The grid exhibited at BCJ2 shows the following details:

Display of Toothpaste Products In  
 Superdrug, 11 Parker Street, Liverpool, L1 1DJ  
 20 August 2003

	<b>Row 1</b>	<b>Row 2</b>	<b>Row 3</b>
<b>Top Shelf</b>	Colgate '2-in1' Whitening	Colgate '2-in1' Icy Blast	Colgate '2-in1' Freshmint
<b>Shelf no 2</b>	Beverley Hills Formula 'Gold' 125ml	Beverley Hills Formula 'Silver' 125ml	Beverley Hills Formula 'Blue' 50ml
<b>Shelf no 3</b>	Superdrug own brand Whitening toothpaste	Aquafresh Whitening	Beverley Hills Formula 'Blue' 125ml
<b>Shelf no 4</b>	Macleans Whitening	Crest Whitening	Arm & Hammer Whitening
<b>Shelf no 5</b>	Macleans Fresh Mint	Macleans Complete Care	Empty shelf
<b>Bottom shelf</b>	Pear Drops 'Smokers'	Clinomyn	Euthymol

31) Ms Moss-McGrath states that the product called NATURAL WHITE BRILLIANT

TOOTH WHITENING SYSTEM, which she referred to in her witness statement of 21 February 2003, was purchased in July 2003 as part of research that she was undertaking for filing an opposition to United Kingdom trade mark application no 2294643. She states that the receipt for the product has been mislaid but she can confirm that it was purchased in July 2003 in Liverpool. I assume there is an error in the date as the exhibit is dated 21 February 2003. However, nothing turns upon this exhibit or this apparent error.

32) Mr Jäcker exhibits at BCJ3 a printout of all the toothpastes available from the on-line shopping website belonging to Asda. He states that 25% of the products are defined as whitening products. The printout was downloaded on 26 August 2003. Exhibited at BCJ4 is a printout downloaded on 26 August 2003 of all the toothpastes available from the on-line shopping website belonging to Tesco. Mr Jäcker states that 30% of the toothpastes are defined as whitening products.

33) Mr Jäcker exhibits at BCJ5 a printout downloaded on 19 August 2003 from the Purity Laboratories website; a company referred to by Mr Peterson in his first witness statement as the licensee for the trade mark and of which he is the managing director. The printout lists the following retailers in the United Kingdom of BEVERLY HILLS FORMULA products: Asda, Co-op, Harrods, Graham's Toiletries, John Bell & Croyden, Safeway, Sainsburys, Savers, Shoprite, Somerfield, Superdrug, Tesco and Wilkinsons.

34) Mr Jäcker states that major distributors in the United Kingdom refer to the products of the application using the trade mark BEVERLY HILLS FORMULA, rather than NATURAL WHITE. He exhibits at BCJ6 an extract from the Tesco on-line shopping website, downloaded on 20 August 2003, which refers to BEVERLY HILLS BREATH CONFIDENCE TOOTHPASTE, BEVERLY HILLS SENSITIVE MAX TOOTHPASTE and BEVERLY HILLS TOTAL PROTECTION TOOTHPASTE. Exhibited at BCJ7 is an extract from the Asda on-line shopping website, downloaded on 20 August 2003, which refers to BEVERLY HILLS SENSITIVE PASTE, BEVERLY HILLS WHITENING FORMULA and BEVERLY HILLS FORM WHITENING. Exhibited at BCJ8 is a further extract from the Purity Laboratories website, again downloaded on 19 August 2003. The two pages of the extract refer to the BEVERLY HILLS FORMULA range of goods. Included on one page is a picture of the packaging of a product which shows the use of BEVERLY HILLS FORMULA and underneath it what appears to be the trade mark (the quality of the print is not very good).

#### **Witness statement of Rigel Kate Moss-McGrath of 4 September 2003 – for Henkel**

35) Ms Moss-McGrath purchased a copy of "New!" magazine from WH Smith in Liverpool on 2 September 2003. She exhibits at RMM1 the cover of the magazine, dated 8 September 2003. The back of the magazine comprises of an advertisement for BEVERLY HILLS FORMULA. A picture of the packaging of a dental care product is shown in the advertisement. The packaging shows use of the trade mark BEVERLY HILLS FORMULA and underneath this the trade mark the subject of this application.

#### **Witness statement of Eric Peterson of 1 December 2003 – for Mr Peterson**

36) Mr Peterson comments on the relative price of his goods and those of others. He states that THER-MED sells for £1.59, COLGATE has whitening products with prices ranging from 99p to £2.49, SENSODYNE has a whitening product on sale at £2.45 and MCCLEANS has a whitening product for sale at £2.37. Mr Peterson states that his product sells at £3.99. Mr

Peterson exhibits at EP2/1 a selection of photographs of shelves taken at a Superdrug shop in Hammersmith on 15 September 2003. These photographs show BEVERLY HILLS FORMULA NATURAL WHITE products in proximity to toothpastes under the brand names of COLGATE, TOTALCARE, SENSITIVE, SENSODYNE, ULTRAFRESH, ULTRABRITE, AQUAFRESH, SIGNAL, ARM & HAMMER and CREST. Mr Peterson has annotated the picture with the price of the products. However, there is no indication as to the amount of the product in each packet. He indicates that all the products were cheaper than his products. The illustration of his products show the words BEVERLY HILLS FORMULA prominently above the trade mark the subject of this application. The pictures of rival packaging shows wording such as anti-tartar and whitening, whitening, sensation deep clean whitening, herbal white, milk teeth, family protection, tartar control and original coolmint appearing prominently, and sometimes dominantly, next to the brand names. Star devices can also be seen on various of the packaging.

37) Mr Peterson exhibits at EP2/2 exhibits a pump dispenser for his product. The dispenser has BEVERLY HILLS FORMULA at the top on both the front and the reverse. On both sides it is written horizontally. On the front the trade mark appears vertically. On the reverse it appears horizontally beneath BEVERLY HILLS FORMULA. On the reverse there is also reference on four occasions to BEVERLY HILLS FORMULA NATURAL WHITE TOTAL PROTECTION. The nature of the pump is such that it is designed to stand up and so the consumer would see the words BEVERLY HILLS FORMULA on the front horizontally and the trade mark running vertically, with the word NATURAL at the bottom.

**Witness statement of Bernd Carlos Jäcker of 5 February 2004 and supplementary witness statement of Bernd Carlos Jäcker of 1 March 2004 – for Henkel**

38) There is no evidence of fact in either of these witness statements. They consist of submission and a critique of the evidence of Mr Peterson. Consequently, I will say no more about them.

**DECISION**

**Preliminary issue – “To whom it may concern evidence”**

39) Exhibits EP6 and EP7 consist of “to whom it may concern evidence”. Both these exhibits came into existence after these proceedings commenced. Rule 55 of the Trade Marks Rules 2000 (the Rules) states:

“(1) Where under these Rules evidence may be admitted by the registrar in any proceedings before her, it shall be by the filing of a statutory declaration or affidavit.

(2) The registrar may in any particular case take oral evidence in lieu of or in addition to such evidence and shall, unless she otherwise directs, allow any witness to be cross-examined on his statutory declaration, affidavit or oral evidence.

(3) Where these Rules provide for the use of an affidavit or statutory declaration, a witness statement verified by a statement of truth may be used as an alternative; the Registrar may give a direction as she thinks fit in any particular case that evidence must be given by affidavit or statutory declaration instead of or in addition to a witness statement verified by a statement of truth.

(4) The practice and procedure of the High Court with regard to witness statements and statements of truth, their form and contents and the procedure governing their use are to apply as appropriate to all proceedings under these Rules.

(5) Where in proceedings before the registrar, a party adduces evidence of a statement made by a person otherwise than while giving oral evidence in the proceedings and does not call that person as a witness, the registrar may, if she thinks fit, permit any other party to the proceedings to call that person as a witness and cross-examine him on the statement as if he had been called by the first-mentioned party and as if the statement were his evidence in chief.”

This rule is clear. There is a stipulated method of adducing evidence. Letters are addressed to someone, these are not. They were born of the proceedings and clearly solicited for the proceedings. If Mr Peterson wished Hardwick and Mr Morgan to make statements he should have got them to complete witness statements, in which they would have made declarations of truth. He elected not to. These letters represent evidence that should have been adduced as per rule 55. To take cognisance of these exhibits would be to countenance and sanction the circumvention of rule 55. Consequently, I will take no cognisance of exhibits EP6 and EP7.

40) If exhibits EP6 and EP7 were in acceptable form I do not consider that they would have any effect upon the decision in this case. Hardwick only advises which of two products he knew first. He also refers to BEVERLY HILLS FORMULA NATURAL WHITE. Mr Morgan has taken it upon himself to state how the trade mark is perceived. I do not know on what basis he can do so. Even if he was an expert in the market, which he is not, this is not something that he could take upon himself without the adducing of survey evidence. It is my decision to decide upon the basis of the evidence before me if “the name Natural White is totally synonymous with Purity Laboratories and its principal Mr Eric Peterson”. Mr Morgan also opines as to why the trade mark should be granted a trade mark. This is again a matter for me to decide on the basis of the facts of the case within the parameters of the statute and case law. (See *Dualit Ltd's (Toaster Shapes) Trade Mark Applications* [1990] RPC 890 and *European Ltd v Economist Newspaper Ltd* [1998] FSR 283.)

### **Distinctiveness - opposition under sections 3(1)(b), (c) and (d) of the Act**

41) Section 3(1) of the Act reads as follows:

“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) 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:

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.”

### **Devoid of any distinctive character - section 3(1)(b) of the Act**

42) The first matter to be established is what devoid of any distinctive character means. Fortunately, there is now a tranche of case law in respect of this issue. In *British Sugar Plc v. James Robertson & Sons Ltd* [1996] RPC 281 Jacob J stated that:

“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 use and recognition as a trade mark, in itself (I hesitate to borrow the word from the old Act but the idea is much the same) devoid of any distinctive *inherently* character.”

In *Cycling Is...TM* [2002] RPC 729, Mr Hobbs QC, sitting as the appointed person, describes trade marks as being origin neutral and origin specific ie those which act as an indicator of origin and those which do not. In *Philips Electronics NV v Remington Consumer Products Ltd* Case C-299/99 [2003] RPC 2 the European Court of Justice (ECJ) stated:

“First, it is clear from Article 2 of the Directive that a trade mark has distinctive character if it serves to distinguish, according to their origin, the goods or services in respect of which registration has been applied for. It is sufficient, as is clear from paragraph 30 of this judgment, for the trade mark to enable the public concerned to distinguish the product or service from others which have another commercial origin, and to conclude that all the goods or services bearing it have originated under the control of the proprietor of the trade mark to whom responsibility for their quality can be attributed.”

The Court of First Instance (CFI) in *Rewe Zentral v OHIM (LITE)*, Case T-79/00, stated:

“The signs referred to in Article 7(1)(b) of Regulation No 40/94 are signs which are regarded as incapable of performing the essential function of a trade mark, namely that of identifying the origin of the goods or services, thus enabling the consumer who acquired them to repeat the experience, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent acquisition.”

All in all, it comes down to whether a sign will be seen as an indication of the provenance of the goods; as an indicator of origin. That assessment has to be based upon the perceived perception of the average consumer, it is after all the perception of the consumer that decides whether a sign acts as an indicator of origin or not. The registrability of the trade mark also has to be considered in relation to the goods or services for which protection is sought. Both of these points were dealt with by the ECJ in *Koninklijke KPN Nederland NV v Benelux-Merkenbureau*, Case C-363/99:

“As regards the second part of the question, whether a mark has distinctive character must be assessed, as has been observed in paragraph 34 of this judgment, first, by reference to the goods or services in respect of which registration of the mark has been sought, and, second, by reference to the way in which it is perceived by the relevant public, which consists of average consumers of those goods or services, reasonably well informed and reasonably observant and circumspect.”

It is also necessary to bear in my mind in the assessment that the average consumer is not likely to undertake an in depth analysis of a sign to decide whether it is a trade mark or not. In *Sykes Enterprises, Incorp v OHIM (Real People Real Solutions)* Case T-130/01 the CFI stated:

“Since the relevant consumer is not very attentive if a sign does not immediately indicate to him the origin and/or intended use of the object of his intended purchase, but just gives him purely promotional, abstract information, he will not take the time either to enquire into the sign's various possible functions or mentally to register it as a trade mark.”

43) Mr Bilewycz submitted that Henkel had divided the trade mark up rather than dealing with it in its entirety. The trade mark does have to be considered in its entirety. However, any consideration of a trade mark is inevitably going to require an analysis of its parts. How else can the relevant authority come to a reasoned conclusion? The CFI was criticised by the appellant in *Procter & Gamble Company v OHIM*, Joined Cases C-468/01 P to C-472/01 P, for such an approach. This argument was dismissed by the ECJ:

“44 As the Court has consistently held, the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (see *SABEL*, paragraph 23, and *Lloyd Schuhfabrik Meyer*, paragraph 25). Thus, in order to assess whether or not a trade mark has any distinctive character, the overall impression given by it must be considered (see *SABEL*, paragraph 23, and, in relation to a word mark, *DKV v OHIM*, paragraph 24).

45 That does not mean, however, that the competent authority, responsible for ascertaining whether the trade mark for which registration is sought - in this instance the graphic representation of a combination of the shape of a washing machine or dishwasher tablet and the arrangement of its colours - is capable of being perceived by the public as an indication of origin, may not first examine each of the individual features of the get-up of that mark in turn. It may be useful, in the course of the competent authority's overall assessment, to examine each of the components of which the trade mark concerned is composed.

46 In this instance, the Court of First Instance, having examined each of those components separately, then assessed - as is clear from paragraphs 59 to 67 of the judgment in Case T-118/00 and the corresponding paragraphs of the judgments in Cases T-117/00 and T-119/00 to T-121/00 - the overall impression deriving from the shape of the tablets concerned and the arrangement of their colours, as is required by the case-law referred to in paragraph 44 of this judgment.

47 It follows that there is nothing in the judgments under appeal to suggest that the Court of First Instance failed to base its assessment of the distinctive character of the

trade marks for which registration is sought on the overall impression which they produce.”

44) Non-distinctive elements can form a distinctive whole. This was the position in *Diamond T Motor Car Co, Re* (1921) 38 R.P.C. 373. More recently it was a proposition that was accepted by the CFI in *Eurocermex SA v OHMI* Case T-399/02:

31 Il ressort de la jurisprudence que le fait qu'une marque complexe n'est composée que d'éléments dépourvus de caractère distinctif par rapport aux produits ou services concernés permet de conclure que cette marque, considérée dans son ensemble, est également susceptible d'être communément utilisée, dans le commerce, pour la présentation de ces produits ou services [arrêt SAT.2, point 18 supra, point 49]. Une telle conclusion ne saurait être infirmée que dans l'hypothèse où des indices concrets, tels que, notamment, la manière dont les différents éléments sont combinés, indiqueraient que la marque complexe, considérée dans son ensemble, représente davantage que la somme des éléments dont elle est composée (voir, en ce sens, conclusions de l'avocat général M. Ruiz-Jarabo Colomer sous l'arrêt de la Cour du 12 février 2004, *Koninklijke KPN Nederland*, C-363/99, non encore publiées au Recueil, point 65).

(Unfortunately the judgment is not available in English.)

45) Mr Bilewycz submitted that both the elements of the trade mark were distinctive. I must admit to having difficulty in seeing how the words NATURAL WHITE are anything other than descriptive of the purpose or the nature of the goods. They are ordinary words of the English language, in normal configuration, with an obvious meaning. The words NATURAL WHITE describe goods that are designed to give or restore a white that is natural in colour, or goods that are natural white in colour. The idea of NATURAL WHITE strikes me as obvious, a white that does not appear artificial, false or excessive. I can see nothing in the words other than this. In relation to the dental products this view is supported by actual use. Exhibit RMM6, carton for MACLEANS ICE WHITENING, includes the following wording: “For a natural white smile and ice cool breath”. The toothpaste was purchased in December 2002, and so after the material date, however, this exhibit simply exemplifies the obvious. Other references to NATURAL WHITE can be found in the evidence of Ms Moss-McGrath, as summarised at paragraph 18 of this decision, most of which emanates from before the material date. The issue of the combination of word elements and resultant neologisms was dealt with in respect of Article 3(1)(c) of the Directive by the ECJ in *Campina Melkunie BV v Benelux-Merkenbureau*, Case C-265/00:

“39 As a general rule, the mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics within the meaning of Article 3(1)(c) of the Directive even if the combination creates a neologism. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned.

40 However, such a combination may not be descriptive within the meaning of Article 3(1)(c) of the Directive, provided that it creates an impression which is sufficiently far

removed from that produced by the simple combination of those elements. In the case of a word mark, which is intended to be heard as much as to be read, that condition will have to be satisfied as regards both the aural and the visual impression produced by the mark.

41 Thus, a mark consisting of a neologism composed of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, is itself descriptive of those characteristics within the meaning of Article 3(1)(c) of the Directive, unless there is a perceptible difference between the neologism and the mere sum of its parts: that assumes that, because of the unusual nature of the combination in relation to the goods or services, the word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts.”

The sum of the parts of the words NATURAL WHITE does not give rise to a distinctive whole. It has been argued that there is also a degree of stylisation of the words NATURAL WHITE. In my view the words are presented in an ordinary typeface and the presentation adds nothing to them.

46) There is a star device also in the trade mark. Mr Peterson in his evidence referred to other trade marks including or consisting of star devices that had been registered. I have to consider the merits of this application and not other registrations, the history of which I do not know. However, even if this was not the case, I cannot see that the examples that Mr Peterson gives would assist him. I have reproduced all of these in paragraph 28. I cannot see that any of the examples are on a par with Mr Peterson’s trade mark. Henkel has put in evidence that shows that use of various star devices is common for dental products. Sometimes the star is in conjunction with a representation of a tooth. Star devices have no doubt been used in relation to products that clean or polish as their astronomical equivalents are synonymous with shining and brightness. The evidence of Henkel convinces me that a star device is so common, at least for dental products, that on its own it is likely to be seen as either mere decoration or an indication of the purpose of the goods or as merely part of the common language of the get-up of such goods. I am of the view that such a position can be linked to any goods in the cleaning and polishing line. The packaging that Henkel has exhibited emanates from December 2002, after the material date. However, I do not think that it is likely that star devices started to be commonly used only after the material date. Mr Peterson has certainly not argued that the use of star devices in relation to class 3 products only started after the material date.

47) In respect of the goods I consider that the word and device elements are devoid of distinctive character. As a combination, taking into account the position of the star device, are they devoid of any distinctive character? Would the average consumer seeing the trade mark upon the goods of the application see it as indicator of origin? I am of the view that the average consumer for the goods will see the trade mark as an indication of the purpose or the nature of the goods of the application and not an indication of trade origin. It is also to be noted that the evidence of use only relates to *toothpaste* and *mouthwash* which have a whitening function, reinforcing the descriptive nature of the trade mark. **I find, therefore, that the trade mark is devoid of any distinctive character.**

48) In reaching my decision I note that Mr Peterson has referred to an earlier United Kingdom

trade mark registration and to a Community trade mark application which has passed beyond the opposition procedure. He also refers to other jurisdictions where he states the trade mark NATURAL WHITE has been registered. Although he lists the names of the jurisdictions he gives no further details of the registrations. In the case of the two where there are details, the United Kingdom and the Community, the registration/application are not on a par with the current registration. The United Kingdom registration is for a different trade mark and is for *essential oils* which are not in the current specification. The Community trade mark only coincides in respect of *mouthwash* with the current specification. I note that in *Henkel KGaA v Bundespatentgericht*, Case C-218/01, the ECJ held:

“The fact that an identical trade mark has been registered in one Member State for identical goods or services may be taken into consideration by the competent authority of another Member State among all the circumstances which that authority must take into account in assessing the distinctive character of a trade mark, but it is not decisive regarding the latter's decision to grant or refuse registration of a trade mark.

On the other hand, the fact that a trade mark has been registered in one Member State for certain goods or services can have no bearing on the examination by the competent trade mark registration authority of another Member State of the distinctive character of a similar trade mark for goods or services similar to those for which the first trade mark was registered.”

The fact that an identical trade mark had been registered for identical goods in another member state may be taken into account by the competent authority but is not determinative of the outcome of the consideration. In this case the only issue of identity relates to one set of goods in the Community trade mark application. (I have assumed that as it has passed the opposition process that it will go on to be registered, although this is not inevitable.) In considering this issue I take into account the comments of Geoffrey Hobbs QC in *Telewest Communication Plc's Trade Mark Application* [2003] RPC 26:

“21. I am not persuaded otherwise by the fact that the Applicant has applied successfully under number 001432780 for registration of SURFUNLIMITED as a Community trade mark in respect of a wide range of services in Classes 38, 41 and 42 (including services of the kind specified in the Application that is now before me).

22. The Community Office may or may not have been aware that the Applicant was seeking to register SURFUNLIMITED and SURF UNLIMITED in series in the United Kingdom on the basis that the two marks “differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark” (Section 41(2) of the Act). It is in any event clear that each national authority is entitled to assess distinctiveness in the light of circumstances prevailing in its own territory, it being recognised and accepted that assessments are liable to vary as a result of linguistic, cultural and social differences between Member States: see the cases referred to in paragraph 61 of the CYCLING IS decision.

23. In paragraph 39 of its Judgment in the COMPANYLINE case (above) the ECJ held that nothing in the Community Trade Mark Regulation required the Community Trade Marks Office to come to the same conclusions as those arrived at by national authorities in similar circumstances. Directive 89/104/EEC of 21st December 1988 similarly appears to permit the national authorities in the Member States to conclude

that the outcome of an application for registration in the Community Trade Marks Office is not necessarily determinative of a parallel application for registration under the harmonised law of trade marks at the national level: see paragraph 58 of the Judgment of Lloyd J. in *Dualit Ltd's Trade Mark Application* [1999] RPC 890.

24. I do not doubt that there is a need for consistency of approach to the registration of trade marks under the applicable provisions of Community law. However, differences of approach may result from the fact that the correct approach continues to be the subject of analysis in the case law of the supervising courts in Luxembourg. And tribunals adopting the correct approach may nevertheless arrive at different conclusions as to the registrability of a particular trade mark on an overall assessment of the circumstances prevailing in the territory to which their jurisdiction extends.”

49) It is also to be noted that this application was accepted by the examiner. The acceptance has been queried in this opposition. There is no facility to oppose a Community trade mark on absolute grounds, it is purely a matter for cancellation. Consequently, that an application has passed through the opposition stage does not necessarily say a lot about the merits of the trade mark on absolute grounds. I have to consider this trade mark on the basis of the market in the United Kingdom and the evidence presented.

50) The trade mark can, of course, benefit from the proviso ie that by the date of application, 7 March 2002, it had acquired a distinctive character as a result of the use made of it. The evidence furnished by Mr Peterson relates to *toothpaste* and *mouthwash* which have a whitening function. There is also evidence of use on a tongue scraper.

51) Mr Bilewycz referred to the copy of the facsimile transmission from John Bell & Croyden dated 30 July 1994 which refers to sales of NATURAL WHITE and is addressed to Mr Peterson at NATURAL WHITE, exhibited at EP5. As far as evidence of use of the words NATURAL WHITE on their own or the trade mark on its own, this would seem to be the high point of Mr Peterson's evidence. However, it is evidence relating to persons in the trade and not to use before the average consumer. The issue of the average consumer was dealt with by Jacob LJ in *Reed Executive plc and Reed Solutions plc v Reed Business Information Ltd and Reed Elsevier (UK) Ltd, totaljobs.com Ltd* [2004] EWCA Civ 159:

“82. Next the ordinary consumer test. The ECJ actually uses the phrase "average consumer" (e.g. *Lloyd* paragraphs 25 and 26). The notion here is conceptually different from the "substantial proportion of the public" test applied in passing off (see e.g. *Neutrogena v Golden* [1996] RPC 473). The "average consumer" is a notional individual whereas the substantial proportion test involves a statistical assessment, necessarily crude. But in the end I think they come to the same thing. For if a "substantial proportion" of the relevant consumers are likely to be confused, so will the notional average consumer and vice versa. Whichever approach one uses, one is essentially doing the same thing – forming an overall ("global") assessment as to whether there is likely to be significant consumer confusion. It is essentially a value judgment to be drawn from all the circumstances. Further conceptual overelaboration is apt to obscure this and is accordingly unhelpful. It may be observed that both approaches guard against too "nanny" a view of protection – to confuse only the careless or stupid is not enough.”

This relates to likelihood of confusion. However, the average consumer is the average

consumer, whether in respect of issues of confusion or distinctiveness. The average consumer represents a substantial proportion of the users of the products. The evidence submitted in this case indicates that there are toothpastes which as well as having the prime function of cleaning the teeth have specialist or secondary functions. A lot of this evidence relates to whitening products but it also shows toothpaste specially for children (see exhibit RMM3), smokers' toothpaste (see exhibit BCJ2), anti-tartar toothpaste, toothpaste for sensitive teeth/gums, tooth paste for milk teeth (all to be seen in exhibit EP2/1). Exhibit EP2/1 also shows that the various types of toothpaste sit on the shelves together. I am of the view that the average consumer is the average consumer for toothpaste. Mr Peterson needs to establish that a substantial proportion of the teeth cleaning population have been educated to see his trade mark as an indicator of origin.

52) Mr Peterson makes much of the cost of his product. The purpose of exhibit EP2/1 is to show this. However, the cost of a product is irrelevant if one does not know the amount of the product being sold. The prices of the products and the volume they contain are given in the copy of a piece from the "Peterborough Evening Telegraph" of 18 August 2001, part of exhibit EP2. If one breaks down the price by volume one arrives at the following figures:

MACLEAN'S WHITENING	1.98p per ml
REMBRANDT LOW ABRASION	15.9p per ml
ARM & HAMMER	4.8p per ml
BEVERLY HILLS FORMULA	3.16p per ml
COLGATE PLATINUM	7.9p per ml.

These figures clearly contradict Mr Peterson's claim to the cost of his product. However, even if the product was particularly expensive or not, I cannot see that this would have any particular effect on establishing acquired distinctiveness. The cost of the product is Mr Peterson's choice, the fact of acquired distinctiveness is based upon the perception of the average consumer for the product. It is not appropriate for the terms of acquired distinctiveness to start dividing the goods up into niche markets because of marketing strategy. As the CFI, in *Daimlerchrysler AG v. Office for Harmonisation In the Internal Market (Trade Marks and Designs)* [2003] ETMR 61, pointed out the marketing strategy of a proprietor cannot be taken into account when considering the descriptiveness of a trade mark:

"46 However, contrary to what the Office argues, the Court finds that a sign's descriptiveness must be assessed individually by reference to each of the categories of goods or service listed in the application for registration. For the purposes of assessing a sign's descriptiveness in respect of a particular category of goods or service, whether the applicant for the trade mark in question is contemplating using or is actually using a particular marketing concept involving goods and services in other categories in addition to the goods and services within that category is immaterial. Whether or not there is a marketing concept is of no consequence to the right conferred by the Community trade mark. Furthermore, since a marketing concept is purely a matter of choice for the undertaking concerned, it may change after a sign has been registered as a Community trade mark and it cannot therefore have any bearing on the assessment of the sign's registrability."

The same must apply for deciding as to whether a trade mark has acquired distinctiveness through use. Of course, there will be goods that through their very nature will be costly. When considering such goods one is still only considering the average consumer within that

market. Is Mr Peterson only claiming rights in expensive dental products? He is claiming rights with subsequent infringement rights in all the goods of his specification.

53) Henkel in its evidence gives percentage figures for whitening toothpastes. I agree with Mr Peterson that this tells me little. That there are a certain percentage of whitening toothpastes does not tell me how much of the toothpaste market they enjoy. However, Mr Peterson fails to contextualise his sales figures. He does not relate them to market share for either toothpastes at large or whitening toothpastes. Figures outside a context tell me very little. Especially when the goods are products which are in every household.

54) In exhibit EP2 to the statement of Mr Peterson, there are many copies of promotional material, however, nothing that could be described as a conventional advertisement. The only conventional advertisement for the product, if not necessarily for the trade mark, is exhibited at RMM1 to the statement of Ms Moss McGrath. This is the rear cover of “New” of 8 September 2003, well after the material date.

55) An analysis of all the material is inhibited as many of the cuttings have been decontextualised; the material is not presented in the context of the publication., so it could have been lost amidst other matter. This is relevant as virtually all of the contextualised promotional material shows the product amongst other products. Examples of this decontextualisation can be seen in the extracts from “Reading Central” of 10 January 2002, “The Citizen” for both Newent and the City of Gloucester of 7 November 2001, “Newcastle Chronicle” of 5 November 2001 and “The Citizen” of 7 November 2001. Promotion is made in the form of comparisons with other products, articles that relate to giveaways of various products and competitions, and articles that deal with a variety of goods. In some of the pieces the promotion is more “stand alone” eg a competition in the competition page of the “Gateshead Herald” of 13 October, year unknown, and giveaway offer in “The People’s Friend” of 9 February 2002. However, in both of these cases the identification of the product is BEVERLY HILLS or BEVERLY HILLS FORMULA NATURAL WHITE (TOOTHPASTE) or BEVERLY HILLS FORMULA NATURAL WHITE SENSITIVE.

56) The product(s) are promoted very much by reference to BEVERLY HILLS and BEVERLY HILLS FORMULA. The NATURAL WHITE element, within the context of the bulk of the promotion, will in my view, be perceived by the relevant public as a descriptor. One of the clearest examples of this is in the piece reproduced from the “Bradford Telegraph & Argus” of 12 September 2000:

“The name says it all – Beverly Hills Formula toothpaste – for that whiter than white we all crave.”

Certain of the pieces indicate that the writer views NATURAL WHITE as a descriptor eg in “Telegraph Magazine” of 19 August 2000 NATURAL WHITE is in brackets, in “The News” of 15 August 2000 the reference is made to “Beverly Hills Formula total protection natural white toothpaste”, all the five last words being in lower case. In “Cheshire Life” for July 2000 there is reference to “Beverly Hills formula total protection natural white toothpaste”. Mr Peterson might argue that the control of these promotions is out of his hands; from the common language in various of the pieces this is doubtful. However, even if this was the case that is not relevant. What is relevant is the actual nature of the promotion and its effect. The overwhelming effect is to promote the BEVERLY HILLS and BEVERLY HILLS FORMULA brand. This is what, in my view, the relevant public will see as the indicator of

origin. This is all the more so taking into account the nature of the product(s) and the way they are branded and publicised to the public. The evidence of both sides shows that in the market it is common for a descriptor element to completely outweigh in size the brand element eg RMM2, RMM3, RMM7 and RMM8. Even if the public had not been “trained” in this way I do not see that the nature of the trade mark and the way it has been promoted would lead it to perceive the trade mark as an indicator of origin. This perception of the relevant public is key to the issue, it is what decides whether prima facie a trade mark is registrable. In *Henkel KGaA v Deutsches Patent – und Markenamt* C-218/01 the ECJ stated:

“50 That distinctive character of a trade mark within the meaning of Article 3(1)(b) must be assessed by reference, first, to the goods or services in respect of which registration is sought and, second, to the perception of the relevant persons, namely the consumers of the goods or services. That means the presumed expectations of an average consumer who is reasonably well informed and reasonably observant and circumspect (see, to that effect, Case C-210/96 *Gut Springenheide and Tusky*, paragraph 31, *Philips*, paragraph 63, and *Linde and Others*, paragraph 41).”

On the basis of the mark and the promotion in relation to it I do not consider that the average consumer’s presumed expectation will be to see the trade mark as an indicator of origin. Indeed, the very opposite, owing to the nature of the promotional material, the nature of the goods, the highly descriptive nature of the trade mark and the omnipresence of BEVERLY HILLS or BEVERLY HILLS formula.

57) The issue of whether a trade mark can pray in aid to the proviso, where it is used as part of another trade mark, is currently before the ECJ (*Société des Produits Nestlé SA v Mars UK Ltd* [2004] FSR 2). I do not consider that the evidence for Mr Peterson gets him off the ground factually to go on to the legally theoretical. There is no evidence from the public to support the claim that the trade mark is indeed seen as a trade mark. The nature of the promotional material and the trade has in my view the very opposite effect. The actual usage makes it appear even more as a descriptor rather than an indicator of origin. Even if one was to limit the area of investigation to whitening toothpastes I do not consider that the evidence of Mr Peterson would get him off the ground, owing to the nature of the usage.

**58) I do not consider that Mr Peterson has established that the trade mark, at the date of application had acquired a distinctive character as a result of the use made of it. The trade mark application is to be refused in its entirety.**

59) Jacobs AG in his opinion in *Procter & Gamble v. Office for Harmonization In the Internal Market* [2001] ETMR 75 stated:

“As the Court of First Instance rightly noted, it is sufficient for one of the absolute grounds for refusal to apply for a sign to be ineligible for registration as a trade mark. Moreover, I cannot envisage any circumstances in which, in practice, it might be important to determine whether more than one absolute ground might apply.”

As the application is to be refused under section 3(1)(b) of the Act I see no need to consider the grounds of opposition under sections 3(1)(c) and (d) of the Act.

## **COSTS**

60) Henkel Kommanditgesellschaft auf Aktien having been successful is entitled to a contribution towards its costs. Mr Bilewycz submitted that consideration should be taken into account that there were no relative grounds of opposition. I do not see that the compensation through costs should be affected by whether the grounds of opposition are relative, absolute or a combination of the two. The costs award should primarily reflect the success of one side and the nature of the evidence submitted, by both sides. Mr McCall requested that I take into account the additional evidence that Henkel had had to file owing to the evidence of Mr Peterson. As I have indicated above the witness statement of Bernd Carlos Jäcker of 5 February 2004 and his supplementary witness statement of 1 March 2004 do not represent evidence of fact but submission. Consequently, I do not consider it appropriate to award costs in respect of these witness statements. These witness statements illustrate with clarity what happens when parties to proceedings do not confine themselves to evidence of fact. Mr Peterson brought in submission into his first statement, Mr Jäcker reacted to this to some extent in his first statement, Mr Peterson then included further submission in his reaction to Mr Jäcker's statement and finally Mr Jäcker submitted pure submission. If both sides had stuck to evidence of fact the situation would not have arisen. All the later evidence is in stark contrast to the evidence of Ms Moss-McGrath who managed to present evidence of fact, and evidence of fact which went to the issues in this case. In my view, Ms Moss-McGrath's first witness statement represents an exemplum of both the nature of evidence that should be submitted and the way that it should be presented.

61) In its grounds of opposition Henkel requested that it should be taken into account in the award of costs that it had advised Mr Peterson of its objections to the application but the application had not been withdrawn. Mr Peterson was entitled to defend his application and I cannot see that it would be appropriate to penalise him for mounting a defence. There may be exceptional circumstances where this is a matter that should be taken into account. I do not consider that this case falls into the exceptional category. I do not consider that it would be appropriate to make any additional award in respect of this.

**62) I order Eric Peterson to pay Henkel Kommanditgesellschaft auf Aktien the sum of £2075. 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 27th day of May 2004**

**David Landau  
For the Registrar  
the Comptroller-General**