

O-239-04

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NOS 2287359 AND 2287388  
BY RECKITT BENCKISER (UK) LIMITED**

**TO REGISTER THE TRADE MARKS:**

**CRYSTAL AIR FRESHENER**

**AND**

**CRYSTAL**

**IN**

**CLASSES 3, 5 AND 21**

**AND**

**THE CONSOLIDATED OPPOSITIONS THERETO  
UNDER NOS 90530 AND 90538**

**BY**

**ROBERT MCBRIDE LIMITED**

## Trade Marks Act 1994

**In the matter of application nos 2287359 and 2287388  
by Reckitt Benckiser (UK) Limited  
to register respectively the trade marks:  
CRYSTAL AIR FRESHENER  
and  
CRYSTAL  
in classes 3, 5 and 21  
and  
the consolidated oppositions thereto  
under nos 90530 and 90538  
by Robert McBride Limited**

### BACKGROUND

1) On 5 December 2001 Reckitt Benckiser (UK) Limited, which I will refer to as Reckitt, applied to register the trade marks **CRYSTAL AIR FRESHENER** and **CRYSTAL**. The applications were respectively assigned the numbers 2287359 and 2287388. On 30 January 2002 the two applications were published, for opposition purposes, in the “Trade Marks Journal”. The applications were published with the following specifications:

*perfuming preparations for the atmosphere, pot pourri, perfumery preparations, fumigation preparations, deodorants, room fresheners;*

*air freshening preparations; fumigation preparations, deodorants, room air fresheners;*

*dispensers and dispensing apparatus; deodorising apparatus; containers in the nature of pomanders for scenting the atmosphere, or for dispensing perfumes, air freshening or air purifying preparations into the ambient atmosphere.*

The above goods are in classes 3, 5 and 21 respectively of the “International Classification of Goods and Services”.

On 4 June 2003 a request was received to amend the specifications to read as follows:

*perfuming preparations for the atmosphere, pot pourri, fumigation preparations, deodorants, room fresheners; but not including any such goods in the form of crystals, or in crystalline form;*

*air freshening preparations; fumigation preparations, deodorants, room air fresheners; but not including any such goods in the form of crystals, or in crystalline form;*

*dispensers and dispensing apparatus; deodorising apparatus; containers in the nature of pomanders for scenting the atmosphere, or for dispensing air freshening or air purifying preparations into the ambient atmosphere; but not including any such goods made from crystal glass.*

Reckitt was advised that the amended specifications were acceptable and that they would be

published for opposition purposes in “Trade Marks Journal” 6487 on 4 July 2003. Owing to an error only application no 2287388 was published. A further error has meant that although this application was published with the correct specification, the Register shows an incorrect specification; the term *perfumery preparations* being retained. It will be necessary for the Registry to publish the amendment to application no 2287359 and to correct the error on the Register in relation to 2287388 (but see paragraph 73). I also return to this matter in paragraph 29 et seq.

2) On 29 April 2002 Robert McBride Limited, which I will refer to as McBride, filed notices of opposition to the two applications.

3) McBride claims that the trade marks are devoid of any distinctive character as they consist of ordinary terms commonly used throughout the industry. Registration of the trade marks would be contrary to section 3(1)(b) of the Trade Marks Act 1994 (the Act).

4) McBride claims that the trade marks consist exclusively of signs which may serve in trade to designate the characteristics of the goods. McBride states that, for example, the signs could designate air fresheners being liquid crystals or crystals sold in liquid crystal or crystal form or air freshener dispensers containing the goods in a liquid crystal or crystal form or sold in crystal shaped dispensers. Registration of the trade marks would be contrary to section 3(1)(c) of the Act.

5) McBride claims that the public would be deceived as to the nature and the quality of the goods unless the goods are in crystal or liquid crystal form.

6) McBride requests that the applications are refused and seeks an award of costs.

7) Reckitt filed counterstatements in which it denies the ground of oppositions. Reckitt requests that the applications proceed to registration and seeks an award of costs.

8) McBride was advised of the amendment to the specifications of the applications but maintained its oppositions.

9) Only McBride furnished evidence.

10) The cases were heard on 22 June 2004. Reckitt was represented by Mr Michael Edenborough of counsel, instructed by Alexander Ramage Associates. McBride was represented by Mr James Mellor of counsel, instructed by Marks & Clerk.

## **EVIDENCE**

11) The evidence of McBride consists of a witness statement by Keith Leonard Hodkinson. Mr Hodkinson is a trade mark agent.

12) Mr Hodkinson states that room freshening and room deodorising products are a relatively recent extension to the home cleaning product market place and are sold mainly by companies with household cleaning product ranges such as Reckitt and McBride. He states that early products were in the form of spray cans dispensing aerosols but more recently candles and volatile gel or liquid dispensing devices, including electrically powered “plug in” devices have become popular.

13) Mr Hodkinson states that these products are commonly sold in the market place in association with advertising campaigns which stress that the air will seem fresh and clean. He states that the analogy to be drawn is with crystal clear water. Mr Hodkinson states that the term crystal is commonplace for household products in general, including products of the type specified in the specifications of the goods of the applications. He states that candle holders, liquid and gel containers and dispensing devices, including those for perfumes and scents, are commonly made of crystal glass. He states that this is reflected in the many trade mark registrations and applications which incorporate the word into a larger mark.

14) In his statement Mr Hodkinson identifies the core products at issue as room freshening and room deodorising products (and products for dispensing them).

15) A good deal of the evidence of Mr Hodkinson was not of assistance. The numerous pages of exhibit KLH1 consist of state of the register evidence. It sets out to show that crystal is commonly used in relation to classes 3, 5 and 21. Not surprisingly in class 21 there are many references to crystal in relation to crystal glassware. There is an absence of evidence in relation to the specific goods of class 21 of this application, other than used by Reckitt companies (eg Reckitt, Reckitt & Colman (Overseas) Ltd and Reckitt Benckiser Healthcare (UK) Ltd). The same goes for classes 3 and 5 where only two non –Reckitt trade marks make any mention of the goods in question:

CRYSTAL THERAPY, the specification for which includes aromatherapy preparations;  
CRYSTAL TIPPS AND ALISTAIR, the specification for which includes pot pourri.

As has been said so many times before, it is what is happening in the market that is relevant, not what is on trade mark registers. The best that state of the register can do is to be indicative that a certain element might lack distinctiveness. However, owing to the broad specifications of trade mark applications and registrations even this is doubtful in many cases. The state of the register evidence in this case certainly does not tell me anything about the situation in relation to the goods being considered.

16) Mr Hodkinson states that the fashion for aromatherapy has led to advertising campaigns and branding strategies which suggest that room freshening and deodorising products and devices and products and devices for dispensing them may be used with aromatherapeutic effect. He does not exhibit any examples of any such campaigns and strategies but states that this is reflected in some of the trade marks used in relation to such products, for example, by Reckitt. At KLH1 he exhibits printouts for seven trade marks. One, for AROMACOLOGY, is abandoned, one for AROMAZONE/AROMASPHERE is pending, in neither of the specifications is there any reference to aromatherapy. The remainder of the trade marks are in the name of Reckitt companies:

UK 2167727 and UK 2167733 HAZE MOODS AROMATHERAPY, there are two registrations owing to a geographical limitation to the specification of the first registration.

UK 2176002 and UK 2176007 MOODS AROMATHERAPY WITH ESSENTIAL OILS and device, there are two registrations owing to a geographical limitation to the specification of the first registration.

UK 2180374 MOODS AROMATHERAPY

UK B1517067 AROMAPLUG (now lapsed)

UK B1529494 AROMA JAR (now lapsed)

All of the specifications encompass air freshening preparations or the like. Clearly only the three MOODS registrations make any reference to aromatherapy, none of the specifications mention aromatherapy. I cannot see the equivalence of aroma with aromatherapy. For most people aroma is the equivalent of smell; so the presence of aroma in a trade mark tells me very little, other than that the goods may well have or impart an aroma.

17) Mr Mellor did not rely on exhibit KLH1; I believe wisely.

18) Mr Hodkinson filed various printouts from the Internet. He stated that his searches were confined to United Kingdom websites. In fact only one was. He also put in terms without boolean operators, so hits were shown simply because somewhere on pages interrogated by the search engine the two words turned up. Applying the googlewack principle, it would be most unlikely when putting two common words in a Google search if he did not get a good number of hits. The majority of the hits are of no or of dubious relevance. There were many hits showing crystal and aromatherapy but only indicating that the sorts of persons and undertakings who believe that crystals can cure their dogs' fleas also partake in aromatherapy. The hit and miss nature of this search strategy can be illustrated from exhibit KLH3, an abbreviated printout for a Google search conducted on 24 September 2002 using the term crystal bottle for pages in the United Kingdom, one of the hits advises that Crystal Palace Football Club is looking for a cellar assistant. No attempt was made to highlight particular hits that might be of relevance. Exhibits KLH8, 9 and 10 deal with rock crystal soaps and bath crystals. I fail to see their relevance in the context of these cases.

19) Mr Hodkinson states that exhibit KLH2 comprises an abbreviated printout of the first few pages of results of an Internet search undertaken on 24 September 2002 seeking United Kingdom websites by reference to the term crystal fragrance. In fact the search strategy shows that it was not limited to pages from the United Kingdom. The search brings up hits where the words crystal and fragrance occur in the interrogated web pages; so some of the results do not show both words, as only the summary of hits is exhibited. A good number refer to brands such as Crystal – in the case of this brand referring to its fragrance free products - and Crystal Mountain; various refer to crystal glassware for fragrances. The only hit that could have any potential bearing upon this case refers to “fragrances to impregnate the crystal”.

20) Mr Hodkinson states that exhibit KLH15 comprises an abbreviated printout of the first few pages of results of an Internet search undertaken on 24 September 2002 seeking United Kingdom websites by reference to the term aromatherapy atmosphere. In fact the search strategy shows that it was not limited to pages from the United Kingdom. Again most of the hits tell me little. Hits that might have a bearing upon this case refer to aromatherapy candles, aromatherapy incense, aromatherapy diffusers.

21) Exhibited at KLH16 are copies of pages downloaded from the web pages [crystalcastle.net/aromatherapy.html](http://crystalcastle.net/aromatherapy.html) on 24 September 2002. There is no indication as to the location of the website. The first page refers to blends of crystals and essential oils for aromatherapy purposes. It is stated that the blends can be used in a vaporiser or as a massage oil. The other pages refer to essential oils being used in combination with various crystals.

22) Mr Hodkinson states that exhibit KLH14 comprises an abbreviated printout of the first few pages of results of an Internet search undertaken on 24 September 2002 seeking United Kingdom websites by reference to the term aromatherapy crystal. In fact the search strategy shows that it was not limited to pages from the United Kingdom. Very few of the hits show use of the two words together without an intervening comma. There are references to an aromatherapy crystal pendant, aromatherapy crystal cleaning salts, aromatherapy crystal pendant, aromatherapy crystals, aromatherapy bath crystals. Most of the hits simply indicate that the sort of undertakings that sell crystals for healing purposes also sell aromatherapy products. It would appear that the sort of person who thinks that a crystal has prophylactic properties also believes the same for aromatherapy.

23) Exhibited at KLH13 is a copy of a page downloaded from crystalherbs.com on 24 September 2002. The page relates to individual flower, gem and crystal essences for healing purposes.

24) Exhibited at KLH11 is a copy of an Erevna catalogue dated January 2001. In the catalogue there is a section headed "Crystal Fresh Natural Deodorant". The accompanying information advises that the goods use pure Twas crystal from the Philippines and also states:

"Simply apply the Crystal to wet skin after a shower or bath, alternatively pass the stone under a cold tap and apply to underarms for all day protection."

Included in the list of goods is a refillable spray and a multi powder.

25) Exhibited at KLH12 is a copy of pages downloaded from thegemtree.co.uk web site. It deals with the uses and effects of crystals, such as healing and their aura. Mr Hodkinson specifically identifies the parts of the pages which deal with the curing of fleas in pets and the calming of puppies and the placing of crystals in baths in order to energise the water.

26) Exhibit KLH6 is a photograph of what Mr Hodkinson describes as crystal shaped fragrance dispensing candles purchased in the open market in the United Kingdom in September 2002.

27) Mr Hodkinson describes KLH5 as an extract from the website www.daisydirect.co.uk, he states that it was "available" on 24 September 2002. Unfortunately, the print has been severely clipped and so none of the surrounding details such as address and date can be seen. The product shown is described in these terms:

"Watchman Air Freshener Refills, Available in Autumn, Crystal, Evening, Floral and Fresh fragrances. 6 x 310ml per box. Suitable for all offices. Manufactured by Kimberly Clark."

It is not possible to ascertain whether Autumn, Crystal, Evening, Floral and Fresh are being used simply as descriptors or as trade marks. Consequently, I cannot see that this exhibit is of any assistance to McBride.

28) Exhibit KLH4 consists of two photographs which Mr Hodkinson states shows examples of volatile liquid mixtures for fragrancing a room in crystal like containers. He states that these were obtained on the open market in September 2002. The quality of the photographs is rather poor and it is difficult to decipher exactly the nature of the products shown.

## DECISION

### Preliminary issue

29) After the hearing Reckitt wrote to state that it wished to withdraw the amendment to the specification of application no 2287359. It stated:

“In the event of an objection that this might constitute a widening specification, we note that the Registrar in her letter of 10<sup>th</sup> June 2003 said “the above application *will be subject to an amendment after publication* in Journal 6487 published on 04 July 2003. (our emphasis). However, the request to amend the specification has never been published and, consequently, the application cannot have been the subject of the amendment referred to in the Registrar’s letter.

Further, the Rules clearly anticipate that a request to amend can be withdrawn. An amendment to the specification of a published application is subject to a one month opposition period. Rule 13A(1) of the Trade Mark Rules 2004 indicate that if it is opposed and if the applicant does not file a counterstatement, the request for amendment “*shall be deemed to be withdrawn*”. Clearly this specific statement anticipates that a request to amend can be withdrawn by the applicant.”

30) I invited McBride to make submissions in relation to this request. Mr Mellor responded for McBride as follows:

“15. The Applicant seeks to amend the specification for one application and not the other. Whether the Applicant is playing games with the Registry or not does not really matter because it is clear that the amendments the Applicant now seeks to make are not permitted under s 39 of the Act.

16. So far as amendments to specifications of goods or services are concerned under s.39 of the Act:

16.1 the applicant may at any time restrict the goods or services covered by the application (s 39(1));

16.2 in other respects, an application may be amended only by correcting errors of wording or obvious mistakes and then only where the correction does not extend the goods or services covered by the application (s 39 (2)).

17. Here, the starting point is that the previous amendments were permitted under section 39, leaving the specification as shown on the website. The current specification now represents “the goods or services covered by the application”. The previous amendments were deliberate and cannot be described as errors of wording or obvious mistakes. In any event, the amendments now proposed by the Applicant would clearly extend the goods and services covered by the application. There is no basis on which the proposed amendments can be made.”

31) The amendment was requested by Reckitt. That amendment was then accepted by the Registrar. That is the fact. It has given up part of the goods of the specification. I can see nothing in the Act or the Rules that allows for the withdrawal of such an amendment. In this case the amendment has also been placed on the data base, which is the Register. Reckitt made a choice to limit its specification, any request to remove the limitation must be an expansion of the specification and as such, as submitted by Mr Mellor, cannot be accepted. I do not see that the failure to publish the amendment has any bearing upon the issue. The publication always follows the event of the amendment. It advises interested parties of the amendment. Once the request was made, subject to the amendment being acceptable under sections 39(1) and (2), it has effect. The deed is done, the specification is limited and cannot be delimited ie expanded. In this case the amendment had not only been filed, it had been officially accepted and recorded upon the Register. Subsequent applications will have been considered in relation to this revised specification.

32) I do not see how Reckitt equates an ability to oppose under rules 18(2) and (3) of the Trade Marks Rules 2004 with a power to withdraw an amendment. Rules 18(2) reads as follows:

“(2) Any person claiming to be affected by the amendment may, within one month of the date on which the amendment or a statement of the effect of the amendment was published under paragraph (1), give notice to the registrar of objection to the amendment on Form TM7 which shall include a statement of the grounds of objection which shall, in particular, indicate why the amendment would not fall within section 39(2).”

An opposition to an amendment to a specification relates in particular to section 39(2) of the Act. So the basis for a successful opposition is that the specification has been expanded; the very thing that Reckitt is now trying to do by withdrawing the amendment. A successful opposition will not negatively affect trade mark applications made after the amendment of the Register as it will, by invoking section 39(2), have to limit the breadth of specification.

33) I also cannot see the equivalency of an amendment to a specification being refused in the event of a counterstatement not being filed and an ability to withdraw that amendment. Taking into account rule 18(2), if the issue relates to the specification, the failure to file a counterstatement is an acceptance that the amendment is contrary to section 39(2). Again we are back to Reckitt trying to invoke a rule to do what is specifically designed not to allow, an expansion of the specification.

34) Reckitt has limited its specification. It cannot expand it. That is what it is trying to do. It is trying to circumvent section 39(2) of the Act.

**35) The application to amend the specification of application no 2287359 is refused.**

**36) As the amended specifications were correctly accepted, if not correctly dealt with afterwards, the case will be decided upon the amended specifications. It will be necessary for the Registry to publish the amendment to application no 2287359 and to correct the error on the Register in relation to 2287388.**

**Distinctiveness – sections 3(1) (b) and (c)**

37) Section 3(1)(b) and (c) of the Act read as follows:

“3.-(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.”

38) Reckitt has furnished no evidence of use and so the proviso cannot come into play.

39) Before tackling the case law and any discrete issues relating to sections 3(1)(b) and (c) I intend to look at whether the word CRYSTAL could be descriptive of some characteristic(s) of the goods of the specifications. I will deal with this firstly in relation to the goods generally, ignoring the exclusions at the ends of the specifications. Taking into account the nature of the goods and the objections I do not see that the words AIR FRESHENER are going to have any determinative effect on the issues.

40) The nature of the evidence is such that it has been necessary to go through a lot of chaff to find the wheat. The first evidence that I intend to consider is the Erevna catalogue, exhibited at KLH11, dated January 2001. This catalogue has the benefits of emanating from before the date of application and being from the United Kingdom. The catalogue shows the use of crystals as deodorants. The crystal is made wet or is applied upon wet skin and then used very much like a roll-on deodorant. Included in the list of goods is a refillable spray and a multi powder. There is no clear explanation of how the spray works. I presume that the powder is made from pulverised crystals.

41) On the third page into exhibit KLH2 the following is seen:

“Aroma Rocks, Natural Crystal Potpourri From Aromas Unlimited  
.....popular fragrances to impregnate the crystal. However we carry over 150 different potpourri fragrances from which to choose. It you wish a special fragrance....  
www.aromasunlimited.com/aromarcks.htm 14k -23 Sep 2002 – Cached”

The hit is after the material date and the location of the website cannot be identified.

42) The hits exhibited at KLH15 refer to aromatherapy candles, aromatherapy incense,

aromatherapy diffusers. The copies of pages downloaded from the web pages [crystalcastle.net/aromatherapy.html](http://crystalcastle.net/aromatherapy.html) exhibited at KLH16 refer to blends of crystals and essential oils for aromatherapy purposes. It is stated that the blends can be used in a vaporiser or as a massage oil. There is no indication as to the location of the website. There is a photograph of what Mr Hodkinson describes as crystal shapes fragrance dispensing candles exhibited at KLH6, the candles were purchased in the open market in the United Kingdom in September 2002. Finally, exhibited at KLH4 there are two photographs of what Mr Hodkinson states shows examples of volatile liquid mixtures for fragrancing a room in crystal like containers. He states that these were obtained on the open market in September 2002.

43) There is enough evidence in relation to crystal glass and no one is contending that for glass CRYSTAL is not descriptive.

44) The evidence of McBride that is relevant to the issues is fairly sparse. However, it shows, in my view, that crystals are used to both fragrance the air, as part of aromatherapy, and as deodorants. It also shows, not surprisingly, that the goods could be in crystalline shape or be packaged in a crystalline shape. Any shape is likely to potentially lend itself to such usage. Much of the demonstration of use is after the date of application and is not tied down to the United Kingdom. If there were an objection under section 3(1)(d) this would have greater significance. In relation to section 3(1)(c) there is only a necessity to show a potentiality for descriptive use. In addition to the evidence of McBride and the normal meaning of the word CRYSTAL, there are the exclusions that Reckitt has added. These exclusions could have neither rhyme nor reason if the goods could not be in the form of crystals or in crystalline form. Mr Mellor submitted that there is also a laudatory nature to the word CRYSTAL as in crystal clear air; indicating that the products get rid of smells and make the air seem crystal clear.

45) I have come to the conclusion that in relation to the goods the word CRYSTAL could indicate that they contain crystals, that they are crystals, that they are crystalline shape, that they are packaged in a crystalline shape or that they are of crystal glass. There is a part of the market that specifically identifies crystals with having therapeutic properties and uses them to diffuse a scent into the atmosphere in order to benefit from these alleged properties. This finding relates to considering CRYSTAL for the goods in question without reference to the exclusions that are included in the specification.

46) The issues that must be considered in relation to section 3(1)(c) of the Act have been dealt with exhaustively by the European Court of Justice (ECJ) in *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* Case C-363/99 [2004] ETMR 57:

“55. That public interest requires that all signs or indications which may serve to designate characteristics of the goods or services in respect of which registration is sought remain freely available to all undertakings in order that they may use them when describing the same characteristics of their own goods. Therefore, marks consisting exclusively of such signs or indications are not eligible for registration unless Article 3(3) of the Directive applies.

56. In those circumstances, the competent authority must, under Article 3(1)(c) of the Directive, determine whether a trade mark for which registration is sought currently represents, in the mind of the relevant class of persons, a description of the characteristics of the goods or services concerned or whether it is reasonable to assume

that that might be the case in the future (see to that effect *Windsurfing Chiemsee*, paragraph 31). If, at the end of that assessment, the competent authority reaches the conclusion that that is the case, it must refuse, on the basis of that provision, to register the mark.

57. It is irrelevant whether there are other, more usual, signs or indications for designating the same characteristics of the goods or services referred to in the application for registration than those of which the mark concerned consists. Although Article 3(1)(c) of the Directive provides that, if the ground for refusal set out there is to apply, the mark must consist exclusively of signs or indications which may serve to designate characteristics of the goods or services concerned, it does not require that those signs or indications should be the only way of designating such characteristics.

58. Similarly, whether the number of competitors who may have an interest in using the signs or indications of which the mark consists is large or small is not decisive. Any operator at present offering, as well as any operator who might in the future offer, goods or services which compete with those in respect of which registration is sought must be able freely to use the signs or indications which may serve to describe characteristics of its goods or services. ....

61. The answer to the fourth question must therefore be that Article 3(1)(c) of the Directive precludes registration of a trademark which consists exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services in respect of which registration is sought, and that is the case even when there are more usual signs or indications for designating the same characteristics and regardless of the number of competitors who may have an interest in using the signs or indications of which the mark consists.....

95. It follows from paragraphs 54 and 55 of the present judgment that Article 3(1)(c) of the Directive pursues an aim which is in the public interest, namely that descriptive signs or indications descriptive of the characteristics of the goods or services in respect of which registration is applied for may be freely used by all. Article 3(1)(c) therefore prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trademarks.....

97. It is not necessary that the signs and indications composing the mark that are referred to in Article 3(1)(c) of the Directive actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that those signs and indications could be used for such purposes. A word must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned (see to that effect, in relation to the identical provisions of Article 7(1)(c) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trademark (OJ 1994 L 11, p. 1), Case C-191/01 P *OHIM v Wrigley* [2003] ECR I-0000, paragraph 32). ....

102. It is also irrelevant whether the characteristics of the goods or services which may be the subject of the description are commercially essential or merely ancillary. The wording of Article 3(1)(c) of the Directive does not draw any distinction by reference

to the characteristics which may be designated by the signs or indications of which the mark consists. In fact, in the light of the public interest underlying the provision, any undertaking must be able freely to use such signs and indications to describe any characteristic whatsoever of its own goods, irrespective of how significant the characteristic may be commercially.....

104 .....For the purposes of determining whether Article 3(1)(c) of the Directive applies to such a mark, it is irrelevant whether or not there are synonyms capable of designating the same characteristics of the goods or services mentioned in the application for registration or that the characteristics of the goods or services which may be the subject of the description are commercially essential or merely ancillary.”

47) Here we have the signs CRYSTAL and CRYSTAL AIR FRESHENER that clearly describe characteristics of the goods that are in the specifications. There are also exclusions; it would appear to overcome the basis of the oppositions. However, the exclusions in classes 3 and 5 do not exclude goods that contain crystals and the evidence shows that all of these goods might contain crystals owing to their use in aromatherapy and deodorants. The class 21 specification fails to exclude goods that dispense aromas using crystals or dispensing goods that are in the shape of crystals. On this level the exclusions do not set out what they intend to do. In *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* the ECJ has again stated that there is a need to leave free. Registration of the applications would not give rise to a theoretical problem but to a real one; as the evidence shows that there are undertakings whose businesses are at least partly based on the supply of crystals which can be used to impart aromas into the atmosphere. As the ECJ has stated whether the number of competitors is large or small is not decisive. The public interest requires that descriptive terms should be free to use. I am not convinced by Mr Mellor’s arguments as to the laudatory nature of the term CRYSTAL in respect of the goods. It is, in my view, an argument that requires the addition of other words, such as clear or fresh.

**48) I find that the applications should be refused under section 3(1)(c) of the Act as the signs CRYSTAL and CRYSTAL AIR FRESHENER for the specifications of goods describe goods that contain crystals or in the case of class 21 could be used to dispense aromas from crystals or for dispensers which are in the form of crystals.**

49) In *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* the ECJ stated:

“86. In particular, a word mark which is descriptive of characteristics of goods or services for the purposes of Article 3(1)(c) of the Directive is, on that account, necessarily devoid of any distinctive character with regard to the same goods or services within the meaning of Article 3(1)(b) of the Directive. A mark may none the less be devoid of any distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive.”

50) The finding under section 3(1)(c) means that upon the same basis registration of the applications would be contrary to section 3(1)(b) of the Act. However, in the circumstances of this case I consider that it is advisable to consider the section 3(1)(b) objection on its own merits also.

51) There is an important difference in the nature of objections under sections 3(1)(c) and 3(1)(b) of the Act, even if they can arise from the same circumstances. Section 3(1)(b) is very

much rooted in the perception of the average consumer for the goods or services in question as the ECJ stated in *Koninklijke KPN Nederland NV v Benelux-Merkenbureau*:

“75. 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.

76. It follows that if, on completion of the examination of a trademark application, the competent authority finds, in the light of all the relevant facts and circumstances, that the average consumer of certain goods or services, reasonably well informed and reasonably attentive, perceives a mark as devoid of any distinctive character with regard to those goods or services, it must refuse to register the mark for those goods or services pursuant to Article 3(1)(b) of the Directive.”

52) How would the average consumer for the goods in question perceive the signs in question? Would he or she see them as indicating origin? In *Norma Lebensmittelfilialbetrieb GmbH & Co KG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) (Mehr für Ihr Geld)* Case T-281/02 the Court of First Instance (CFI) dealt with the issues surrounding the meaning of being devoid of any distinctive character:

“24 The signs devoid of any distinctive character 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 (Case T-79/00 *Rewe-Zentral v OHIM(LITE)* [2002] ECR II-705, paragraph 26). Such is the case for inter alia signs which are commonly used in connection with the marketing of the goods or services concerned (Case T-122/01 *Best Buy Concepts v OHIM (BEST BUY)* [2003] ECR II-0000, paragraph 20).

25 However, registration of a trade mark which consists of signs or indications that are also used as advertising slogans, indications of quality or incitements to purchase the goods or services covered by that mark is not excluded as such by virtue of such use (see, by analogy, *Merz & Krell*, cited above, paragraph 40). A sign which fulfils functions other than that of a trade mark in the traditional sense of the term is only distinctive for the purposes of Article 7(1)(b) of Regulation No 40/94 however if it may be perceived immediately as an indication of the commercial origin of the goods or services in question, so as to enable the relevant public to distinguish, without any possibility of confusion, the goods or services of the owner of the mark from those of a different commercial origin (*BEST BUY*, cited above, paragraph 21).”

This case dealt with a slogan, *Mehr für Ihr Geld*, however, the judgment goes over familiar ground in relation to the purpose of a trade mark. Importantly, in my view, it refers to the immediate need for recognition of a sign as an indication of commercial origin. If there is no other sign in use on a product, the consumer may by default return to the product by reference to this sign. He or she may make the decision by the absence of other signs rather than the presence of a distinctive sign. It is that immediate clear linkage to commercial origin that is

important. It is that linkage that use might establish in the perception of the consumer.

53) Seeing goods, which despite the exclusions, could contain crystals or be in aroma dispensers in the shape of crystals, I do not see that the exclusions to the specifications of the goods will have any great effect upon the consumer. How relevant are the exclusions when the goods could be in a crystal shaped dispenser? Certain of the goods could be in liquid form and so would have to be in a dispenser. The dispenser and the goods could become conflated (see the judgment of the ECJ in *Henkel KGaA v Deutsches Patent – und Markenamt* C-218/01 re conflation of goods and their containers in relation to section 3(1)(c) of the Act where the Court stated:

“In view of the foregoing considerations, the answer to paragraph (b) of the first question must be that, for three-dimensional trade marks consisting of the packaging of goods which are packaged in trade for reasons linked to the very nature of the goods, the packaging thereof may serve to designate characteristics of the packaged goods, including their quality, within the meaning of Article 3(1)(c) of the Directive.”)

Of the goods in classes 3 and 5 only pot pourri would not be likely to require packaging for the purposes of commercialisation. The class 21 specification allows for dispensers in the form of crystals which could include the class 3 and 5 goods, so in the reality of the marketplace the exclusions would amount to naught.

54) CRYSTAL encompasses all types of crystal, it is the Platonic ideal from which all forms of crystal are derived. There is no type of crystal that does not fall within the gamut of the word. Its use, therefore, has a far more sweeping effect than one mere representation of a crystal. Consequently, the word must be worse than any particular representation of the concept of the word. So Reckitt’s position is, in my view, far worse than Christian Belce and Axion SA in their joined cases before the CFI against OHIM in Cases T-324/01 and T-110/02. In those cases the applications were for specific representations of a cigar and a gold ingot and the CFI found them wanting of any distinctive character.

55) It is also born in mind that the need to leave free relates to section 3(1)(b) as much as the other parts of section 3(1). As the CFI stated in *Deutsche SiSi-Werke GmbH & Co. Betriebs KG v Office for Harmonization in the Internal Market (Trade Marks and Designs)* Joined Cases T-146/02 to T-153/02:

“The Court finds that the applicant's conclusion on the legal basis of the need for availability is incorrect. First, Article 7(1)(b) of Regulation No 40/94 is the only legal basis mentioned in the contested decisions. Second, no direct and exclusive link can be established between the risk that a monopoly may be created and a specific absolute ground for refusal. On the contrary, there is settled case-law to the effect that the absolute grounds for refusal set out in Article 7(1)(b) to (e) of Regulation No 40/94 address the concern of the Community legislature to prevent the grant to one operator of exclusive rights which could hinder competition on the market for the goods or services concerned (see, as regards the ground for refusal relating to a trade mark's distinctive character, Case C-104/01 *Libertel* [2003] ECR I-3793, paragraph 60).”

**56) Exclusions or not, the nature of the goods will, in my view, lead to the signs not being perceived by the average consumer of the products as indicating commercial origin and so their registration would be contrary to section 3(1)(b) of the Act.**

## Deception – section 3(3)(b) of the Act

57) Section 3(3)(b) of the Act states:

“A trade mark shall not be registered if it is——

(b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).”

The above rehearses the language of article 1(g) of First Council Directive 89/104 of December 21, 1988 (the Directive).

58) Mr Edenborough referred me to the *SMIRNOFF* cases, BL 0/523/01 in relation to this matter. In this case the hearing officer stated:

“43. In relation to Section 3(3)(b) the applicant for the declaration of invalidation accepts that this statutory provision focuses on the intrinsic characteristics of the trade mark itself when viewed in the light of the specification at the time the application for registration was made. Section 46(1)(d) comes into play when consideration is given to the way in which the trade mark has actually been used by the registered proprietor following registration. In respect of those two provisions Mr Edenborough suggested that I should approach matters as under Section 11 of the Trade Marks Act 1938. In that connection he drew my attention to the views of the Court of Appeal in *Swiss Miss Trade Mark* [1998] RPC 889 at 893 and in *Bali* [1969] RPC 472 and 495. In addition, my attention was drawn to my decision in *Madgecourt Limited's Application* [2000] ETMR 825. In Mr Edenborough's view the test under Section 3(3)(b) was a low one. It was simply whether "a number of persons are caused to wonder" that, in this case, vodka, sold under the registered proprietors trade marks, emanated from Russia. In the *Madgecourt* case I said:

"It seems to me having regard to the evidence and submissions, that because of the inclusion in the trade mark of a term "PARFUMS DE PARIS" there would be an expectation that the perfume and any of the perfumed products included in the specification would be manufactured in Paris and that if the specification of goods did not reflect that then the trade mark would be deceptive. Also having noted that France and Paris in particular has a reputation for perfumes, it seems to me that the public would be deceived not only as to the geographical origin of the goods but may also be deceived as to their nature and quality."

This view is in line with the Registrar's practice as set out in the extract from the Registry Work Manual quoted above. It is also in line with the judgment of Vinelot J in the *Swiss Miss* case [1997] RPC 219 page 222 line 43 where, having found that Switzerland had a reputation for chocolate of high quality, he said:

"The question is whether the mark would cause a number of persons, to entertain as a serious and not merely a fanciful possibility, whether the goods had a Swiss origin."

44. In relation to Sections 3(3)(b) and 46(1)(d) Mr Mellor submitted that the relevant tests were identical to concepts under other Community law. Though slightly different

wording was used, “liable to mislead the public” and “misleading”, all were expressions used in Community instruments dealing with all sorts of consumer protection. He drew on a number of authorities in order to reinforce his point that the test under Section 3(3)(b) and 46(1)(d) was much more severe than the ‘cause to wonder test’ which was established under Section 11 of the Trade Marks Act 1938.

45. In *Gorgonzola/Cambozola* ECJ 4.0399 the European Court of Justice dealt with a dispute centred on use of the term *Cambozola* and the designation *Gorgonzola*. At paragraphs 41 and 42 of the judgement the Court states:

“41. As to that the circumstances contemplated in Article 3(1)(c) of the first Directive 89/104 do not apply to the present case. Circumstances envisaged in the other two relevant provisions of that Directive - refusal of registration, invalidity of the trade mark, or revocation of the proprietors rights, which preclude its use being continued in Article 14(2) of Regulation No 2081/92 - presupposes the existence of actual deceit or a sufficiently serious risk that the consumer will be deceived.

42. Once again it is for the National Court to apply those tests to the facts of the case before it. Although the term *Cambozola*, which evokes the designation *Gorgonzola*, can not on that ground alone be deemed liable to deceive the public as to the nature, quality or origin of the goods designated .....

46. He also referred me to *PALL* [1990] ECR 1-4827, *CLINIQUE* [1994] ECR 1-317 and *MARS* [1996] ECR 1-1923 which I have read. As a result it seems to me that the authorities consider the consumer to be reasonably observant and circumspect and thus sufficiently alert and sensible such as not to need protection from claims that might only deceive a relatively small number of customers. Overall, what is alleged to be misleading must be sufficiently serious and likely to affect the economic behaviour of the public.

47. In this case, therefore, I ask myself whether there is anything inherent within the various trade marks that would cause a number of persons to entertain as a serious possibility that the vodka supplied under the trade marks in suit had a Russian origin. But in determining that question I must have regard to the way in which these particular goods are sold in the market place. By that I mean what does the trade do in terms of promoting and selling vodka in the market place which might influence the way in which the public might perceive the trade marks in relation to such goods.

48. From the evidence of Mr Paul Walsh who exhibited photographs of bottles of vodka purchased in England there appears to be a common theme amongst producers of vodka which is to indicate in some way or other that the vodka has a Russian connection. Some trade marks use Russian sounding words like 'Kirov', 'Kalinska', others use devices of double-headed eagles, Cyrillic script, representations of buildings with onion shaped domes reminiscent of Russian architecture, red star devices and so on. It therefore seems that the trade itself has lead the public to expect that vodka, wherever it is produced (because the evidence also indicates that the vodka upon which these trade marks are used is not produced in Russia but either in the United Kingdom or elsewhere in the European Union) will have a get-up, at least, which has connotations of Russia. Therefore, simply having a Russian sounding name,

or labels which include items which suggest a Russian ancestry or connection, would not be sufficient in my view to produce a positive finding under Section 3(3)(b). This is because the public would not, given the nature of branding and promotion of vodka be given any cause to wonder about the geographical origin of goods sold with this sort of decoration or with a Russian sounding name. The trade has educated the public to expect vodka sold in the United Kingdom to have, in one way or another, Russian connotations.

49. Thus, taking all those points and authorities into account, I reach the view that in relation to Section 3(3)(b) there must be something inherent within the trade mark sufficient to mislead the public to a material extent before a positive finding can be made. In this case, the various trade marks including the indicia used in support of the dominant or predominant elements, the imperial regalia, the heraldry, the medals, the statements that the goods were previously supplied to the Imperial Court of Russia and the date of establishment of the business do not suggest to me that deception by the public is likely. Even if Mr Edenborough's test was correct (which I do not believe it is) they would not be given any cause to wonder. The public would not believe that either individually or collectively the elements which make up the various trade marks in suit are in any way inherent as an indication of the nature, quality or geographical origin of the goods because within the trade it is common to decorate labels with crowns, medals etc to promote a Russian connection with the product.

50. As Mr Mellor put it "Imperial regalia, medals, coats of arms, crowns etc. are evidently seen by the average consumer as decoration or imagery and not in any sense a trade description or conveying any indication of origin, nature or quality of the goods. The average consumer would not believe that the appearance of Imperial regalia on a label means that this exact product was supplied to the Imperial Court of Russia". On the basis of the evidence. I agree. Insofar as the requests for revocation and declarations of invalidation based on Section 3(3)(b) these therefore can be dismissed. Further, the registered proprietor has not done anything since the trade marks were registered that I can see to cause the provisions of Section 46(1)(d) to apply. Therefore those grounds of revocation can be dismissed."

59) In the end, in my view, the question is whether in relation to the goods or services in question the average consumer is likely to be deceived in the purchasing process. This is a broader test than a deception based on some element of a trade mark that might add value to the goods. Is it likely that the average, circumspect consumer would end up purchasing something that did not satisfy his or her reasonable expectations in the nature of the goods? In considering the issue it must be taken into account all likely sale outlets. In this case this is not just a matter of sale in retail premises but also by mail-order and the Internet, as the evidence indicates. This question, however, has to be considered within the parameters of the grounds of opposition which raised an objection upon the basis that "the public will be deceived as to the nature and quality of the goods unless those goods are in crystal or liquid crystal form".

60) The first issue I have to consider is the average consumer. In this case the evidence suggests that there are potentially two types of consumer. There is the consumer who knows of the various uses of crystals in what might be described as the alternative side of consumerism. Certainly, before dealing with this case I had no inkling of the uses of crystals. I would not have taken someone seriously who advised me that I could rub a crystal under my

arm for deodorant purposes. There is that other part of the public which will not be aware of the use of crystals. A situation could arise where the knowledgeable could be deceived whilst the “crystal ignorant” would not be deceived. In drawing a conclusion as to what the position should be I have looked to *Ghazilian’s Trade Mark Application* [2002] RPC 33. In this case Mr Thorley, sitting as the appointed person, had to adjudicate on section 3(3)(a) of the Act – where registration of a trade mark would be contrary to public policy or accepted principles of morality. In that case Mr Thorley was seized with the extent of the public who might be outraged by the trade mark; he held:

“The outrage or censure must be amongst an identifiable section of the public and a higher degree of outrage or censure amongst a small section of the community will no doubt suffice just as lesser outrage or censure amongst a more widespread section of the public will also suffice.”

I consider that the criterion that Mr Thorley applies can be used in the question before me; deception can be found where there is likely to be a high degree of deception amongst a particular public. I think that this must be right, if there is something strongly deceptive in a trade mark to a certain segment of the population this cannot be countered by the ignorance of the many. 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 commented in relation to likelihood of confusion:

“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.”

I consider that the same must apply to the issue of deception; a case cannot be built upon the basis of the deception of the careless or stupid. The majority of the public in the United Kingdom will quite possibly not be aware that crystals can be used as deodorants. However, for those “in the know” the use of CRYSTAL for deodorants would bring a definite and tangible expectation as to the nature of the goods; and an equally definite and tangible deception is the product was not a crystal. Taking into account the nature of the goods, this part of the population would reasonably expect the goods to contain or be for use with crystals. With the products in front of them for consideration prior to purchase it is likely that they would not be deceived. However, if purchasing the products by means of the Internet for instance, this check would not exist and deception would be likely. Taking these factors into account I do not consider that it would only be the careless or the stupid who would be deceived.

61) In relation to the class 21 goods which could be of crystal glass, the general public is likely to suffer a deception. However, I cannot see that the nature of the opposition under this head can be considered to encompass crystal glass. Yes, the class 21 specification is deceptive but not on the basis of the grounds of opposition – goods being in crystal or liquid crystal form. I do not consider that this can be read as referring to crystal glass. Consequently, the objection does not succeed against the class 21 goods.

62) In considering these issues I have considered the full gamut of the specifications. Reckitt

has not put in any evidence as to the nature of its goods. It may be that the use they make will not deceive owing to the nature of that use. That is not something, even if there had been evidence to this point, that I can take into account. 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.”

I consider that the same must apply for the deceptiveness.

63) In trying to avoid the section 3(1)(b) and (c) objections by exclusion, Reckitt has compounded the deceptiveness arising from the combination of the signs and the goods. It has stated that the goods will not be of crystalline form or of crystal glass, thus thwarting the reasonable expectations of consumers. Even if in the former case this might be a limited group who will be seriously deceived.

**64) I find that registration of the applications would be contrary to section 3(3)(b) of the Act in relation to the goods in classes 3 and 5 of the specification.**

### **The exclusions**

65) At the hearing I advised Mr Edenborough that in the light of the judgment of the ECJ in *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* that I was concerned about the specifications. In relation to exclusions in specifications the ECJ stated:

“113 Likewise, when registration of a mark is sought in respect of an entire class within the Nice Agreement, the competent authority may, pursuant to Art.13 of the Directive, register the mark only in respect of some of the goods or services belonging to that class, if, for example, the mark is devoid of any distinctive character in relation to other goods or services mentioned in the application.

114 By contrast, where registration is applied for in respect of particular goods or services, it cannot be permitted that the competent authority registers the mark only in so far as the goods or services concerned do not possess a particular characteristic.

115 Such a practice would lead to legal uncertainty as to the extent of the protection afforded by the mark. Third parties--particularly competitors--would not, as a general rule, be aware that for given goods or services the protection conferred by the mark did not extend to those products or services having a particular characteristic, and they

might thus be led to refrain from using the signs or indications of which the mark consists and which are descriptive of that characteristic for the purpose of describing their own goods.

116 Since the Directive precludes such a practice, there is no need to examine the request for an interpretation of the Paris Convention.

117 In those circumstances, the answer to the eighth question must be that the Directive prevents a trade mark registration authority from registering a mark for certain goods or services on condition that they do not possess a particular characteristic.”

At the request of Mr Edenborough, I allowed counsel time to submit written submissions in relation to whether this part of the judgment had a bearing upon the two applications. Counsel for both sides filed written submissions in relation to this. Mr Mellor submits that the specifications of the applications squarely fall foul of the judgment of the ECJ and furnish a further reason as to why the applications should be refused. He argues that there are two possible interpretations of the judgment of the ECJ:

i) A specification is acceptable so long as the description of the goods or services is sufficiently precise for there to be legal certainty as to the scope of protection conferred upon the registration. This must be the case even if there is a limitation, be it negative or positive, contained within the specification.

ii) The ECJ is prohibiting negative limitations (or maybe even all limitations) as a matter of principle, even if the resulting specification is legally certain, then it is submitted that the ECJ has erred in its consideration of the matter.

Mr Edenborough submits that if the second interpretation is taken then the matter should be referred to the ECJ under Article 234 of the Treaty Establishing the European Community. Mr Edenborough submits that negative exclusions have been used for many years and are also used by the Office for the Harmonization in the Internal Market.

66) The issue of the ECJ being wrong 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:

“128. Mr Hobbs' response to the Gerri/Kelly case was to attack it. He said it was inconsistent with paragraphs 51-55, 63-64 of the BMW case, paragraph 28 of the Chiemsee case [1999] ECR I-2799, paragraphs 51-56 of the Arsenal case [2003] RPC 9 at p.144, the 12<sup>th</sup> Recital to the Directive, Art.10 bis of the Paris Convention, and Arts. 2(1) and 39 of the TRIPS agreement. That is to suggest that the Court has completely blundered. Not only do I not agree, but it is not for me or any national court to question the latest guidance from the Court. The fact is that trade mark law is and the concepts involved are much subtler and more complex than an outsider would, at first blush, expect. The Court is naturally evolving its views on the problems involved and the often conflicting policy questions.”

I think that answers Mr Edenborough's argument that the ECJ might have got it wrong. This is also not a matter of obiter dictum; the ECJ was directly answering the question put to it.

That exclusions might have been practised for many years does not affect the issue. The question of negative exclusions has to now be considered in the light of the judgment of the ECJ.

67) The ECJ does not state that negative exclusions per se are not acceptable. It refers to the goods or services not possessing a particular characteristic, not goods or services per se. It is definition by negative characteristic that leads to uncertainty. It seems to me a clear point of logic that this must be the case. A specification can end up without clearly defining what it in fact covers. As Mr Mellor points out in his submissions this will give rise to difficulties in relations to sections 10(1), (2) and (3) of the Act. Equally, it will give rise to problems under sections 5(1), (2) and (3) of the Act. The ECJ goes on to define the particular mischief that will be created:

“Third parties--particularly competitors--would not, as a general rule, be aware that for given goods or services the protection conferred by the mark did not extend to those products or services having a particular characteristic, and they might thus be led to refrain from using the signs or indications of which the mark consists and which are descriptive of that characteristic for the purpose of describing their own goods.”

The issue of characteristic exclusions must, in my view, be considered through the prism of this part of the judgment.

68) From the submissions of Mr Edenborough one could gain the impression that specifications which define the goods by reference to characteristics that they do not possess are essential to the trade mark system. It is open for applicants to define their goods by what they actually are and not what characteristic they do not possess. The former seems a far more sensible and logical way of drafting a specification. Of course, it might lead to much more limited and precise specifications; specifications that relate to the clear and definite use and intention to use of an applicant.

69) In this case one can see how the applicant has tried to use the specifications as if they were a moveable feast to obtain registration. At one stage it excludes characteristics of the goods, it then tries after the hearing to remove that exclusion. It has tried to use an exclusion of a characteristic in order to obtain registration for trade marks which need to be left free.

70) Mr Edenborough has commented on the existence of specifications which fall foul of the judgment of the ECJ. As the jurisprudence develops and defines the nature of EU, and EEA, trade mark law existing registrations may well find that gaping holes open up beneath them. That is the nature of the beast. This requirement for legal certainty will potentially have an effect upon all those colour trade marks which were registered without reference to an internationally recognised colour code (see *Libertel Groep BV v Benelux-Merkenbureau* Case C-104/01 [2004] FSR 4). Of course, if right holders are concerned by the effects of the *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* judgment they can apply to amend their specifications so that they are positive rather than negative, making sure that they do not offend against section 39(2) of the Act.

71) I have dealt with this in some detail as Mr Edenborough's submissions were quite extensive. However, when asking the question I was not looking to the general implications of the judgment of the ECJ and how it should be interpreted. I was only looking to see if counsel considered that in the context of the grounds of opposition in this case if it had any

impact. Perhaps I should have phrased my question more precisely. However, as I am only concerned with the issues within the context of the facts and statement of grounds of opposition, I presumed that this was a given.

72) I can only consider the judgment in *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* within the context of the statements of grounds of opposition. There has been no request to amend the statements of grounds to take into account the effects of that judgment. There is nothing in the statements of grounds that relate to the nature of the specifications of the applications. Indeed at the time of the filing of the oppositions there were no exclusions in the specifications. McBride, following the applications to amend the specifications applied to amend its statements of grounds. Amendments which were refused. However, the refused amendments do not relate to the issue I am considering here. As McBride has not challenged the applications in relation to the nature of the specifications and as it has not put forward a case as to how the *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* judgment has an impact upon the grounds of oppositions, I cannot find that the judgment has an effect on the cases before me.

## CONCLUSION

73) The amendment of the specification for application no 2287359 not having been published, it might be argued that I should await the publication of that amendment to see if it is opposed and stay this decision pending the outcome of the publication. However, Reckitt has attempted to withdraw the amendment of the specification. I need, therefore, to give a decision on the legitimacy of the withdrawal request before the amendment can be published. So for the publication to take place, or not, I have to give a decision on the legitimacy of the request for the withdrawal of the amendment. It is also the case that if this decision is not overturned on appeal the publication of the amendment would serve no purpose. There would be nothing to oppose. The circumstances of this case are somewhat unusual. I consider that it serves the overriding objectives best to deal with the issues now rather than postpone them. If the amendment to the specification of no 2287359 was successfully opposed it would still leave the application falling foul of sections 3(1)(b) and (c) of the Act and so the end result would be the same.

74) It is possible from the evidence and the current state of the law that the applications could have fallen further foul of the provisions of the Act. However, I can only consider the issues on the basis of the statements of grounds. The result is, nevertheless, the same. **The two applications are refused in their entirety.**

## **COSTS**

**75) Robert McBride Limited having been successful is entitled to a contribution towards its costs. In assessing the costs I have taken into account the effectively identical nature of the statements of grounds and counterstatements. I have also taken into account that a large amount of the evidence was not relevant and/or lacked focus. I order Reckitt Benckiser (UK) Limited to pay Robert McBride Limited the sum of £1900. 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 9<sup>th</sup> day of August 2004**

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