

**TRADE MARKS ACT 1994**

**IN THE MATTER OF:**

**OPPOSITION No. 71259**

**IN THE NAME OF MARY QUANT COSMETICS JAPAN LTD**

**TO THE REQUEST FOR PROTECTION OF INTERNATIONAL  
REGISTRATION No. 849617**

**IN THE NAME OF ABLE C&C Co LTD**

**AND IN THE MATTER OF:**

**OPPOSITION No. 94159**

**IN THE NAME OF MARY QUANT COSMETICS JAPAN LTD**

**TO TRADE MARK APPLICATION No. 2400494**

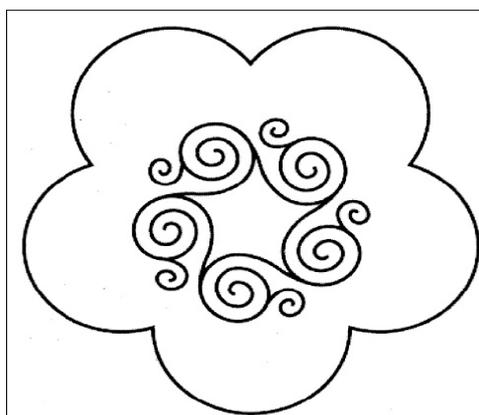
**IN THE NAME OF ABLE C&C Co LTD.**

---

**D E C I S I O N**

---

1. On 12 November 2004 Able C&C Co. Ltd (**‘the Applicant’**) requested protection of the following trade mark:

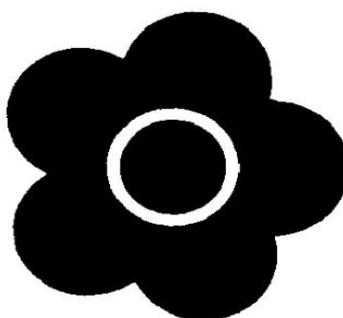


for use in relation to the following goods in Class 3:

Nourishing creams, eyebrow pencils, lipsticks, mascara, nail polish, liquid foundations, blushers, sunscreen creams, common lotions, skin fresheners, skin cleansing cream, eye shadow, eau de Cologne, cold creams, solid powder for compacts, creamy foundations, skin whitening creams, perfumes, hair lotions, detergents prepared from petroleum for household cleaning use, liquid soaps, cleansers for detergent purposes, bath soaps, cosmetic soaps, shampoos, hair rinses.

The request for protection was made under the provisions of the Madrid Protocol in relation to International Registration No. 849617, which was in its own turn based on a corresponding national registration in the Republic of Korea.

2. The request for protection was opposed by Mary Quant Cosmetics Japan Ltd (**‘the Opponent’**) on various grounds, of which only one is now pursued. That is an objection raised on the basis of the Opponent’s right to protection under Section 5(2)(b) of the Trade Marks Act 1994 for the following device mark:



registered under number 996393 with effect from 4 August 1972 for use in relation to the following goods:

Non-medicated toilet preparations; cosmetic preparations, soaps, perfumes, preparations for cleaning the teeth, and toilet articles included in Class 3.

3. The Opponent maintained that there were similarities (in terms of marks and goods) which would have combined to give rise to the existence of a likelihood of confusion if in November 2004 the Applicant's trade mark and the Opponent's earlier device mark had been used concurrently in the United Kingdom for goods of the kind for which they were respectively registered and proposed to be registered.

4. On 31 August 2005 the Applicant applied under number 2400494 to register the following trade mark:



for use in relation to the same goods in Class 3 as it had specified in its request for protection of International Registration No. 849617. The Opponent's objections to registration included an objection under Section 5(2)(b) of the Act which raised in relation to application number 2400494 an objection based on its earlier device mark to the same effect as that raised in relation to the request for protection of the International Registration. I do not need to refer to the Opponent's other objections as they are no longer pursued.

5. The opposition to the request for protection of the International Registration was rejected for the reasons given by Mr. George Salthouse in a written decision issued on behalf of the Registrar of Trade Marks under reference O-305-07 on 16 October 2007. He considered that the evidence before him was insufficient to establish that the distinctive character of the Opponent's device mark had been enhanced through use. He regarded the device shown in paragraph 2 above as a *'very simplistic and almost childlike representation of a daisy'*. His assessment of the Applicant's trade mark shown in paragraph 1 above was that it would not be viewed as a flower device without an appreciable degree of thought and would be perceived by anyone who actually went through that thought process as a significantly different flower device from that of the earlier trade mark registration. Even though the goods in issue were identical, there was insufficient similarity between the marks in issue to give rise to the existence of a likelihood of confusion. All grounds of opposition were rejected and the Opponent was ordered to pay the Applicant £1,000. as a contribution towards its costs of the proceedings in the Registry.

6. The opposition to trade mark application number 2400494 was rejected by Mr. Salthouse for the reasons he gave in a written decision issued on behalf of the Registrar of Trade Marks under reference O-303-07 on 16 October 2007. His assessment of the Applicant's trade mark shown in paragraph 4 above was that it combined the word **MISSHA** which would be seen as an invented term with a device which represented a flower with a long stalk. On comparing the Applicant's trade mark with the Opponent's device mark shown in paragraph 2 above, he found that they displayed *'only a small element of similarity in that they both have a flower device'* with the devices being

different because *'one has a very long stalk whereas the other is a birds eye view of the head of a flower only'*. Even though the goods in issue were identical, there was insufficient similarity between the marks in issue to give rise to the existence of a likelihood of confusion. All grounds of opposition were rejected and the Opponent was ordered to pay the Applicant £500. as a contribution towards its costs of the proceedings in the Registry.

7. Both decisions were appealed to an Appointed Person under Section 76 of the 1994 Act. In the grounds of appeal relating to the Hearing Officer's decision allowing protection of the International Registration it was contended:

3. Although he correctly summarised the law in paragraphs 21 to 22 of his decision he failed to take into account in paragraphs 28 and 29 of his decision that there was no limitation as to colour in either the Opponent's registration or the Applicant's mark as sought to be registered. By failing to consider the possibility of each mark being used in a variety of different colour combinations, the Hearing Officer was led into error in his comparison of the marks.

4. For example the Applicant's mark could be used in a form in which the body of the flower was coloured, leaving the scroll device in a lighter colour. At least when used with dark petals, the Applicant's mark will clearly be seen to resemble a daisy contrary to paragraph 28 of the decision.

5. Likewise, the Opponent's mark could be used in a form in which the flower was a lighter colour, and the central ring a darker colour. Indeed, the evidence established that there was actual use by the Opponent of its trade mark in this form: see for example exhibit MQCJL8, attachments 3, 11 and 12.

6. In such cases the Applicant's mark would closely resemble the Opponent's mark and give rise to a likelihood of confusion. The 5 petal outline of both marks is very similar, and the scroll like central ring of the Applicant's

mark will be seen by consumers simply to be a variant of the central ring of the Opponent's mark.

In the grounds of appeal relating to the Hearing Officer's decision allowing trade mark application number 2400494 to proceed it was contended:

2. His comparison of the marks in paragraphs 24 to 28 of his decision fell into error as a matter of law because he did not consider the fact that the Applicant's mark consisted of two distinct elements, namely the word "missha" and the daisy device. Each of these elements plays an independent role in the perception of the mark. The "device" part of the mark consists of a daisy device which closely resembles the Opponent's daisy device registration.

3. In paragraphs 26 and 27 of his decision, the Hearing Officer concentrated on the fact that the mark applied for consisted of two elements, and appeared to consider that the presence of both elements meant that there was no likelihood of confusion.

4. He should have taken into account the facts that the word "missha" is largely meaningless, and that the presence of the daisy device as a distinct graphical element, would lead the public to believe that the Applicant's goods and services to which its mark is applied, derive, at the very least, from companies which are linked economically. In such circumstances, the opposition under Section 5(2)(b) should have been held to have succeeded.

These contentions were developed in argument at the hearing before me. The Opponent expressly confirmed that it was not relying upon the effect of any reputation in the device mark shown in paragraph 2 above.

8. I take as my starting point the proposition that the registered representation of a trade mark is definitive as to the identity of the protected mark<sup>1</sup>, with that being taken to

---

<sup>1</sup> Case C-273/00 Sieckmann v. Deutsches Patent-und Markenamt [2002] ECR I-11737 at paragraphs 45 to 55.

consist only of the particular features which have actually been recorded in the register.<sup>2</sup>

The registration may show:

- (1) that the protected mark has been registered subject to a limitation or disclaimer making the use of particular colouring indispensable, in which case the absence of such colouring will prevent a finding of identity or similarity;<sup>3</sup>
- (2) that the protected mark has been registered in colour without any limitation or disclaimer confining it to the particular colouring recorded in the register, in which case the use of other colouring or no colouring will be sufficient to prevent a finding of identity but may not be sufficient to prevent a finding of similarity;<sup>4</sup> or
- (3) that the protected trade mark has simply been registered in black-and-white, in which case colouring is optional hence inessential<sup>5</sup> and therefore not a factor which permits or prevents a finding of identity or similarity relative to the mark as registered.

In effect, colouring is in the same degree (ir)relevant to a finding of identity or similarity as it is (im)material to the distinctiveness of the trade mark as registered.

---

<sup>2</sup> L'Oréal SA v. Bellure NV [2007] EWCA Civ. 968 at paragraph 110 per Jacob LJ.

<sup>3</sup> Nestlé SA's Trade Mark Application [2004] EWCA Civ. 1008 (Lord Phillips of Worth Matravers MR, Mummery and Chadwick L. JJ) at paragraphs 32 et seq Phones 4U Ltd v. Phone 4U.co.uk Internet Ltd [2006] EWCA Civ. 244 at paragraphs 49 et seq per Jacob LJ; L'Oréal SA v. Bellure NV [2007] EWCA Civ. 968 at paragraphs 118 to 120 per Jacob LJ.

<sup>4</sup> At first instance and on appeal in O2 Holdings Ltd v. Hutchison 3G Ltd [2006] EWHC 534 (Ch); [2006] EWCA Civ. 1656; black-and-white bubble imagery was found to be similar to bubble imagery registered (in some cases) in colour.

<sup>5</sup> With the result that colouring can only become an essential feature of a trade mark graphically represented in black-and-white by means of an alteration which substantially affects the identity of the trade mark: Nestlé SA's Trade Mark Application [2004] EWCA Civ. 1008 (Lord Phillips of Worth Matravers MR, Mummery and Chadwick L.JJ).

9. The ECJ has recently confirmed<sup>6</sup> that the protection of a trade mark proprietor's rights is more narrowly focused in infringement proceedings than it is in opposition and invalidity proceedings:

65. It is true that the notion of likelihood of confusion is the same in Articles 4(1)(b) and 5(1)(b) of Directive 89/104 (see, to that effect, Case C-425/98 *Marca Mode* [2000] ECR I-4861, paragraphs 25 to 28).
66. Article 4(1)(b) of Directive 89/104, however, concerns the application for registration of a mark. Once a mark has been registered its proprietor has the right to use it as he sees fit so that, for the purposes of assessing whether the application for registration falls within the ground for refusal laid down in that provision, it is necessary to ascertain whether there is a likelihood of confusion with the opponent's earlier mark in all the circumstances in which the mark applied for might be used if it were to be registered.
67. By contrast, in the case provide for in Article 5(1)(b) of Directive 89/104, the third-party user of a sign identical with, or similar to, a registered mark does not assert any trade mark rights over that sign but is using it on an ad hoc basis. In those circumstances, in order to assess whether the proprietor of the registered mark is entitled to oppose that specific use, the assessment must be limited to the circumstances characterising that use, without there being any need to investigate whether another use of the same sign in different circumstances would also be likely to give rise to a likelihood of confusion.

So the question whether the proprietor of a trade mark registered for protection in colour can prevent registration of a later trade mark recorded in black-and-white must be answered with due regard for '*all the circumstances in which the mark applied for might be used*' and therefore with due regard for the fact that the person applying for

---

<sup>6</sup> Case C-533/06 *O2 Holdings Ltd v. Hutchison 3G Ltd* [2008] ECR I-00000.

registration will (unless otherwise specified) have *'the right to use it as he sees fit'* in colour.<sup>7</sup> This recognises that normal and fair (that is to say, straight) use of the recorded mark in colour is just as much use of it as use in black-and-white. No change to the template or pattern of the recorded mark is envisaged.

10. The present oppositions under Section 5(2)(b) are based on the rights conferred by registration of a device mark recorded in the register in black-and-white. It follows that colouring is immaterial to the distinctiveness of the Opponent's device mark as registered and therefore irrelevant for the purposes of the assessment of similarity in both oppositions. The Opponent's contentions to the contrary proceed upon the incorrect premise that registration in black-and-white is in all respects equivalent to registration in any and every possible colour and combination of colours. The true position is that registration in black-and-white provides protection unrelated to colour. Protection related to colour is the corollary of registration in colour. It is not open to the Opponent to claim protection related to colour on the basis of the registration cited in support of its objections under Section 5(2)(b) (and no claim to protection in colour has been raised on the basis of any rights acquired by virtue of the law of passing off or the provisions of the 1994 Act relating to the protection of well-known trade marks). There is accordingly no foundation for the appeal relating to the decision issued under reference O-305-07.

11. The appeal in relation to the decision issued under reference O-303-07 is directed to the question whether and, if so, how far it can be maintained that the flower device in

---

<sup>7</sup> Hence the finding of conflict under Section 5(2)(b) in esure Insurance Ltd v. Direct Line Insurance Plc [2008] RPC 5, p.99 at paragraphs 115 to 117 and 140 to 143 (Mr. Allan James) and [2008] EWCA Civ. 842 (Arden, Jacob and Maurice Kay L.JJ) at paragraphs 9, 53 to 59, 68 to 70 and 79.

the trade mark shown in paragraph 4 above performs an independent distinctive role<sup>8</sup> in the context of the trade mark as a whole. The mark must be assessed without dismemberment or excision. It appears to me that the contribution of the verbal element **MISSHA** outweighs the contribution of the flower device to the overall distinctiveness of the mark. It is true to say that there is nothing, in point of law, to prevent a finding that there are two marks (one verbal, the other non-verbal) in the same field of view where that accords with the reality of the case.<sup>9</sup> However, the reality with regard to the mark shown in paragraph 4 above is that it is likely to be seen and remembered as the word mark **MISSHA** integrated with an element of visual embroidery linked to the concept of fragrancy. The evidence on file is not sufficient to substantiate the proposition that the flower device would perform an independent distinctive role as contended in the grounds of appeal. The Hearing Officer found that the differences between the marks in issue outweighed the similarities with sufficient individualising effect to avoid the existence of a likelihood of confusion. It was well within the margin of appreciation available to him to come to that conclusion. His determination is not liable to be set aside on appeal.

12. Both appeals will be dismissed for the reasons I have given above. The Opponent is in each case directed to pay the Applicant £350. as a contribution towards its costs of the unsuccessful appeal. Those sums are to be paid within 21 days of the date of this decision. They are payable in addition to the sums awarded by the Hearing Officer in relation to the proceedings below.

---

<sup>8</sup> Case C-120/04 Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH [2005] ECR I-8551, paragraphs 30 to 36.

<sup>9</sup> Case C-488/06P L&D SA v. OHIM [2008] ECR I-00000, paras. 31, 55 and 84; Case I ZR 37/04 Golden Rabbit Trade Mark [2007] ETMR 30, p.465 (BGH); Julius Sämann Ltd v. Tetrosyl Ltd [2006] EWHC 529 (Ch) (Kitchen J.); BP Amoco Plc v. John Kelly Ltd [2002] FSR 5, p.87 (CA. NI); Reckitt & Colman Products Ltd v. Borden Inc. [1990] RPC 341 (HL); Levi Strauss & Co. v. Shah [1985] RPC 371 (Whitford J.).

Geoffrey Hobbs Q.C.

22 August 2008

Michael Hicks instructed by Frank B. Dehn & Co appeared as Counsel for the Opponent.

Damian Latif of Jensen & Son appeared on behalf of the Applicant.

The Registrar was not represented.