

O-288-05

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2354457A
TO REGISTER A TRADE MARK IN
CLASS 3
BY JOHNSON & JOHNSON**

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BACKGROUND

1. On 27 January 2004, Johnson & Johnson, of One Johnson & Johnson Plaza, New Brunswick, New Jersey, 08933-7001, USA applied to register the following sign as a trade mark in Classes 3 and 5:



2. The application was made in respect of the following goods:

Class 3:

Toiletries, soaps, shampoos and cosmetics for the care and cleaning of skin and hair.

Class 5:

Medicated topical preparations for treating conditions of the skin and hair.

3. Objection was originally taken against the mark under Section 3(1)(b) of the Act because the mark consisted of a sign which served a merely decorative purpose in relation to the goods (toiletries and soaps) which would be devoid of any distinctive character. Following further consideration, the agent was notified in a letter of 1 July 2004 that an objection under Section 3(1)(c) was also appropriate as the mark consisted of a representation of flowers which would act as an indication of a characteristic of the goods ie, floral fragranced soaps.

4. A hearing was held on 12 April 2005 at which the applicant was represented by Ms P Nicholls of D Young & Co, Trade Mark Attorneys. A request to divide the Class 5 specification from the application was received dated 9 September 2005, and consequently actioned resulting in application no. 2354457A for the mark covering the goods detailed above in Class 3 alone. The objection was maintained against the

goods in Class 3 and the application was subsequently refused in accordance with Section 37(4) of the Act.

5. No evidence of use has been put before me, I have, therefore, only the prima facie case to consider.

THE LAW

6. Section 3(1)(b) and (c) of the Act reads as follows:

“3.-(1) The following shall not be registered –

- (a)
- (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.

The Case for Registration

7. In correspondence prior to the hearing dated 1 June 2004, the agent submitted arguments against the Section 3(1)(b) objection which may be summarised as follows:

The goods applied for were not “flower symbols” but “toiletries, soaps, shampoos and cosmetics for the care and cleaning of the skin and hair

That the mark applied for was not merely a decorative sign and that the Registrar had not substantiated use in the trade as a product decoration.

The Registrar had accepted and registered several marks previously containing representations of flowers for similar goods to those covered by the applicant’s mark which should similarly allow acceptance in the present case.

Informal research had been undertaken within Boots stores local to the agent’s offices which did not locate any examples of soaps on which flower designs were embossed which reinforced their view that the mark would not be perceived as mere decoration.

8. Further submissions were made at the Hearing by Ms Nicholls also addressing the objection under Section 3(1)(c) stating that the mark in question comprised various abstract floral designs which would function as a distinctive trade mark as it would not immediately evoke a particular fragrance or message to the average consumer. Ms Nicholls questioned whether the mark was sufficiently distinctive for “baby powder”.

9. In subsequent correspondence dated 24 May 2005, I maintained the Section 3(1)(b) and (c) objection against all goods claimed and also confirmed that the objection would extend to “baby powder” as I considered that the mark would send the message to consumers that the goods on which the mark was used possessed a floral fragrance or, where the particular flowers were identified as vanilla and jasmine, that they incorporated a vanilla and jasmine fragrance.

10. In correspondence dated 15 June 2005, the agent considered it doubtful that the average consumer would recognise the floral devices in the mark as having any reference to particular flowers and then go on to conclude that the applicant’s goods would be fragranced with vanilla or jasmine.

11. Further submissions were made in correspondence of 27 June 2005 that the applicant’s identical mark had been granted prima facie acceptance in other jurisdictions which should likewise mean acceptance in the UK.

12. Finally, I was provided with an unsworn informal survey conducted amongst members of the agent’s London office where each individual was shown a representation of the mark and asked to name the flowers shown. To summarise, of 13 respondents (some of which gave several answers), replies were as follows:

Daffodil – 9
Forget-me-nots – 2
Pansy – 2
Daisy – 3
Spring flowers – 1
Peony -1
Buttercup - 1
Unable to recognise – 4

13. Following refusal of the application, I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Marks Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

DECISION

Section 3(1)(c)

14. In a judgement issued by the European Court of Justice on 23 October 2003, *Wm. Wrigley Jr. Company v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case 191/01P, (the DOUBLEMINT case), the Court gave guidance on the scope and purpose of Article 7(1)(c) of the Community Trade Mark Regulation (equivalent to Section 3(1)(c) of the Trade Marks Act). Paragraphs 28-32 of the judgement are reproduced below:

“28. Under Article 4 of Regulation No. 40/94, a Community trade mark may consist of distinguishing the goods or services of one undertaking from those of other undertakings.

29. Article 7(1)(c) of Regulation No. 40/94 provides that marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographic origin, time of production of the goods or rendering of the service, or other characteristics of the goods or service are not to be registered.

30. Accordingly, signs and indications which may serve in trade to designate the characteristics of the goods or service in respect of which registration are sought are, by virtue of Regulation No. 40/94, deemed incapable, by their very nature, of fulfilling the indication-of-origin function of the trade mark, without prejudice to the possibility of their acquiring distinctive character through use under Article 7(3) of Regulation No. 40/94.

31. By prohibiting the registration of Community trade marks of such signs and indications, Article 7(1)(c) of Regulation No. 40/94 pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all. That provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (see, inter alia, in relation to the identical provisions of Articles 3(1)(c) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of Member States relating to trade mark (OJ 1989 L 40, P.1), *Windsurfing Chiemsee*, paragraph 25, and Joined Cases (C-53/01 to C-55/01) *Linde and Others*[2003] ECT 1-0000, paragraph 73).

32. In order for OHIM to refuse to register a trade mark under Article 7(1)(c) of Regulation No. 40/94, it is not necessary that the signs and indications composing the mark that are referred to in that article 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 such signs and indications could be used for such purposes. A sign 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.”

15. Section 3(1)(c) of the Act excludes signs which may serve, in trade, to designate the kind of goods and services or other characteristics of the goods and services. It follows that in order to decide this issue it must first be determined whether the mark designates a characteristic of the goods and services in question.

16. The mark consists exclusively of a device of flowers and leaves which appear to be vanilla flowers and jasmine, a view supported by the description of the mark given in part 2 (additional information) of application form TM3 where the mark is referred to as “vanilla and jasmine plant designs logo”. In my view, the mark conveys an obvious message in relation to the kind of goods, namely that they incorporate a vanilla and jasmine or floral scent/fragrance. The first impression of the mark on the part of the average consumer would be that it consisted of a combination of flowers which would therefore not give a trade mark message to the average consumer for

these goods as they simply express the significance that the goods, essentially toiletries and cosmetics, consist of, or evoke, a vanilla and jasmine or floral fragrance.

17. Furthermore, there is no graphic or semantic improvement or modification to the picture in question which enhances them with any further characteristic in order to render the sign as a whole capable of distinguishing the applicants' products from those of other traders.

18. I am of the view that a picture of flowers would not be an unusual way of designating a characteristic of the applicant's goods, namely their fragrance, and the public would therefore not be able to distinguish them from those provided under the same or similar signs by other undertakings. Although it may not be immediately apparent exactly what genus of flowers comprise the mark, I do not feel that this detracts from the impression that would be given that the goods incorporated a floral fragrance.

19. The goods in question are essentially everyday products which are often purchased on impulse. They are relatively low cost items and purchasers do not usually take a great deal of care and attention in their purchase. However, it must also be borne in mind that the fragrance of toiletries and cosmetics is an extremely important consideration prior to purchase which may influence a potential consumer to purchase the goods or otherwise, and what may be an attractive fragrance to one person may not be so to another. The fact that two basic designs of flowers are presented in combination would prompt the average consumer to make an assumption that the goods consisted of the particular fragrance of the flowers being depicted or a floral fragrance instead of, for example, a citrus fragrance where a lemon and orange were depicted or a pine fragrance where pine needles and pine cones were presented to them.

20. I therefore reach the conclusion that the mark designates a characteristic of the goods and is debarred from registration under Section 3(1)(c).

Section 3(1)(b)

21. Having found that the mark fails to qualify under Section 3(1)(c) of the Act, I now go on to consider whether it is eligible for registration under Section 3(1)(b). The purpose of Section 3(1)(b) of the Act is to prohibit registration of signs which, although not caught by the parameters set out by Sections 3(1)(c) and (d) of the Act are, nevertheless, incapable of distinguishing the goods and services of one undertaking from those of other undertakings. Each of the grounds for refusal is to be examined independently, although they may overlap on occasions.

22. The approach to be adopted when considering the issue of distinctiveness under Section 3(1)(b) of the Act was summarised by the European Court of Justice in paragraphs 37, 39 to 41 and 47 of its Judgement in Joined Cases C-53/01 to C-55/01 *Linde AHG, Windward Industries Inc and Rado Uhren AG* (8th April 2003) in the following terms:

“37. It must be noted at the outset that Article 2 of the Directive provides that any sign may constitute a trade mark provided that it is, first capable of

being represented graphically and, second, capable of distinguishing the goods and services of one undertaking from those of other undertakings.

.....

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

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

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

.....

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

23. I must assess the mark's distinctiveness in relation to the goods for which the applicant seeks registration, and must also have regard to the perception of average consumers of the goods. Even though the mark does not consist exclusively of the plain words "FLORAL FRAGRANCE" or "FLORAL SCENT" which would present the consumer with a clear statement of what to expect of the goods, the depiction of a basic drawing of flowers would not, in my view, hide or conceal the identical message. It seems unlikely to me that the relevant consumer of the goods claimed would perceive this mark as denoting trade origin as it would simply be seen as a picture of flowers presented to demonstrate the fragrance of the item being sold.

24. I am therefore not persuaded that the mark applied for would serve in trade to distinguish the applicant's goods from those of other traders. In my view, the mark will not be identified as a trade mark without first educating the public that it is one, and I therefore conclude that the mark applied for is devoid of any distinctive character and subsequently excluded from prima facie acceptance under Section 3(1)(b) of the Act.

Acceptance by other tribunals

25. I finally turn now to the submission in Ms Nicholls' letter of 27 June 2005 that several overseas jurisdictions including several EU Member States, Australia, Barbados, Canada, Hong Kong, Kenya, New Zealand, Singapore, Trinidad & Tobago and the USA had accepted the applicant's identical mark on a prima facie basis, all of which "*were "common-law" countries operating examination on distinctiveness grounds which employ the same criteria as those in the United Kingdom*" which should likewise warrant similar acceptance in the UK.

26. However, I am not aware of the circumstances surrounding the acceptance of these marks by such jurisdictions and it is arguable whether each of these national tribunals operate identical criteria for acceptance on absolute grounds as the United Kingdom, and I was nevertheless not persuaded by this argument. In this regard, I have taken into account the decision by the European Court of Justice in *Henkel KGaA v Deutsches Patent and Markenamt* (C-218/01) paragraphs 61 to 65 where it was stated:

"61 The competent authority of a Member State may take account of the registration in another Member State of an identical trade mark for products or services identical to those for which registration is sought.

62 However, it does not thereby follow that the competent authority of a Member State is bound by the decisions of the competent authorities of the other Member States, since the registration of a trade mark depends, in each specific case, on specific criteria, applicable in precise circumstances, the purpose of which is to demonstrate that the trade mark is not caught by any of the grounds for refusal of registration set out in Article 3(1) of the Directive.

63 In that connection, whilst registration of an identical trade mark for identical goods or services effected in one Member State constitutes a circumstance which may be taken into consideration by the competent authority of another Member State among all the facts and circumstances which it is appropriate to take into account, it cannot, however, be decisive as regards the latter authority's decision to grant or refuse registration of a given trade mark..

64 As to whether it is necessary, when distinctive character is assessed under Article 3(1)(b) of the Directive, to undertake administrative investigations to determine whether and to what extent similar trade marks have been registered in other Member States, it need merely be borne in mind that 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 mark for goods or services similar to those in respect of which the first trade mark was registered. (Judgement delivered today in case C-363/99 KPN [2004] ECR I-000, paragraph 44).

65 The answer to the third question must therefore be that the distinctive character of a trade mark within the meaning of Article 3(1)(b) of the Directive may be assessed solely on the basis of a national trade usage, without any need for other administrative investigations to be undertaken in order to determine whether and to what extent identical trade marks have been registered or have been refused registration in other Member States of the European Union.

The fact that an identical trade mark has been registered in one Member State as a mark 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”.

CONCLUSION

27. In this decision, I have considered all the documents filed by the applicants and all the arguments submitted to me in relation to this application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because the mark fails to qualify under Sections 3(1)(b) and (c) of the Act.

Dated this 26th day of October 2005

GARETH HICKS
For the Registrar
the Comptroller-General