

TRADE MARKS ACT 1994

**IN THE MATTER OF
APPLICATION NO. 2266156**

**TO REGISTER A SERIES OF
TRADE MARKS IN CLASS 10**

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IN CLASS 10
BY
THE DEZAC GROUP LIMITED**

DECISION AND GROUNDS OF DECISION

Background summary

1. On 3rd April 2001, The Dezac Group Limited of Cheltenham, Gloucestershire applied to register the following series of two trade marks in Class 10:

LIGHTMASK

LightMask

2. The goods for which registration is sought are as follows:

Therapeutic devices, in particular for the treatment of migraines and hormonal associated conditions such as pre-menstrual syndrome, by the use of sensory stimulation.

3. Objection was raised initially under Section 3(1)(b) of the Act because the marks consist exclusively of the word “Light” and the word “Mask” conjoined, the whole being devoid of any distinctive character, for example, masks which emit light or are used in light therapy. A further objection was taken later under Section 3(1)(c) of the Act on the grounds that the marks may serve in trade to designate the kind and intended purpose of the goods.

4. In order to substantiate the objections, the examiner sent to the applicant’s representatives various extracts from web sites on the internet. These are shown in the attached annex.

5. The objections were maintained and the matter came to be heard on 3rd May 2002, when the applicant was represented by Mr Brian Dunlop of Wynne-Jones, Lainé & James, trade mark agents.

6. At the hearing, I maintained the objections under Section 3(1)(b) and (c) of the Act and the application was subsequently refused on 20th May 2001 in accordance with Section 37(4).

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

8. No evidence that the mark has acquired a distinctive character as a result of use has been put before me and therefore I have only to consider whether the mark is inherently distinctive.

The law

9. The relevant part of Section 3 of the Act is 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,”

The case for registration

10. In support of the application, submissions were made by the applicant’s representatives in correspondence and at the hearing which may be summarised as follows:

- S any mark that is a play on words, or which has a double meaning should be allowed;
- S if the devices were used as a mask, on seeing the mark LIGHTMASK, members of the public are highly unlikely to interpret this as a mask that transmits light. Usually a mask is seen as blocking out light (see the dictionary definition in Penguin 2000) and the public would not envisage a mask that transmits light, which is the opposite of what one would expect;
- S the word “light” has a number of meanings, for example the opposite of dark or heavy;
- S the marks have a distinctive meaning and are to be used in a specialist area of goods;
- S the extract from the internet web site headed “Tools for Wellness” post-dates the application.

Reasons for refusal

11. Dealing with the last submission first, whilst it is acknowledged that this extract appears to be dated April 26, 2001, which is after the date of the application, it is by no means clear when the contents of the article were written. However, if all the extracts supplied are examined, further references to “light mask” will be found which clearly pre-date the filing of the application. For example, in the document headed “S.A.D. And P.M.S.”, which is from the “Scarlet Pixel Archives” dated August 1999, on page 2 there is a reference to:

“The treatment consists of wearing a flickering light mask for 10-20 minutes in the evening.”

This article explains research into treatment of PMS using light treatment.

12. In the remaining extract, which bears the date 4 August 1999, there is an article titled "Brighten up your outlook" by Sheila Lavery. In this article Ms Lavery refers to the daily use of a flickering light mask helping conditions such as PMS and migraine.

13. Although I have no materials which might show how the applicant is using or intends to use the marks, it is clear that the "masks" described in the extracts from internet web sites are included within the specification of goods set out on the application form.

14. On 20 September 2001, the European Court of Justice issued a judgement in *Proctor & Gamble Company v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case-383/99P for the mark *Baby-Dry*. This judgement gives useful guidance on the test for descriptiveness under Section 3(1)(c) of the Act.

15. I give below paragraphs 37, 39 and 40 of the judgement in full:

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

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

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

16. These paragraphs indicate that only marks which are no different from the usual way of designating the relevant goods or services or their characteristics are now debarred from registration by Section 3(1)(c). Without any evidence to persuade me to the contrary, I believe that the marks " may serve in normal usage" from a consumer's point of view to

designate one of the essential characteristics of the goods, namely a mask incorporating lights used in therapy.

17. I reject the argument that because marks may possess a double meaning it therefore follows that they ought to be registrable. If only one of the significations conveyed by the marks “may serve in normal usage” to designate the goods’ essential characteristics, then the marks must still be refused. Thus, I am not persuaded in the present case that because the term “light” could convey other meanings, the marks therefore possess inherent distinctiveness. Trade marks are normally seen in the context of the marketing of goods or services, for example in advertising, and perceptions are formed in this setting and not in a vacuum. It is my view that in this context consumers would not attribute any alternative meanings which the marks might have. The only likely perception is that the marks will be interpreted as a wholly apt description of the product.

18. The fact that the mark is to be used only in respect of a specialist area of goods does not, in this case, affect the question of distinctiveness.

19. Having found that the mark is debarred from registration under Section 3(1)(c) of the Act, I now have to consider whether the mark is devoid of any distinctive character under Section 3(1)(b).

20. In *Cycling IS... Trade Marks* [2002] RPC 37, Geoffrey Hobbs QC as Appointed Person made the following comments:

“66. That brings me to the question of whether the signs possess a distinctive character enabling them to fulfil the essential function of a trade mark in relation to goods and services of the kind specified in the application for registration. (*The goods and services comprise “clothing, footwear and headgear” in Class 25 and “advertising, all relating to the cycling industry” in Class 35*).

67. The case for allowing registration rests upon the proposition that the signs are cryptic to a degree which makes it more likely than not that they would carry connotations of trade origin (whatever other connotations they might also carry) in the minds of the relevant class of persons or at least a significant proportion thereof.

68. The case for refusing registration rests upon the proposition that the signs are visually and linguistically meaningful in a way which is more likely than not to relate the goods and services to the activity of cycling without also serving to identify trade origin in the minds of the relevant class of persons.

69. The difference between these two positions resides in the question whether the perceptions and recollections the signs would trigger in the mind of the average consumer of the specified goods and services would be origin specific or origin neutral.

70. The relevant perspective is that of the average consumer who does not know there is a question, but who is otherwise reasonably well-informed and reasonably observant and circumspect.

71. I do not suppose that such a person would pause to construe the signs when encountering them in any of the different settings (including advertising and promotional settings) in which they might be used. Even so, the degree of attention required to take note of the signs in the first place would be sufficient, in my view, to leave a well-informed and reasonably observant and circumspect person with the clear impression that the signs were being used with reference to goods and services related to cycling.”

21. Mr Hobbs went on to observe:

“73. Doing the best I can on the materials before me, I think that the signs in question would be perceived by the relevant class of persons as pronouncements in identifying cycling as the *raison d’être* for the marketing of the goods and services to which they are related. That is a message that the members of a consortium of bicycle retailers might naturally be interested in putting across to customers and potential customers. I do not think that the nature of the pronouncement or its presentation can in either case be regarded as sufficiently striking to function as an indication of trade origin in relation to goods or services of the kind specified in the application for registration that is now before me.

74. It seems to me that the perceptions and recollections the signs would trigger in the mind of the average consumer of the specified goods and services would be origin neutral (relating to the general commercial context of the relevant trading activities) rather than origin specific.”

22. In relation to the marks applied for, I take the view that it would likely be perceived by the average consumer as being origin neutral rather than origin specific. The mark cannot function in the *prima facie* as an indication of trade origin and therefore under Section 3(1)(b) of the Act I conclude that it is devoid of any distinctive character.

Conclusion

23. In this decision I have considered all documents filed by the agent, and for the reasons given the application 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 7th day of August 2002.

Charles Hamilton
For the Registrar
the Comptroller General

Annex in paper copy only