

**TRADE MARKS ACT 1994**

**IN THE MATTER OF  
APPLICATION NO. 2186014  
BY AINSWORTHS (LONDON) LIMITED  
TO REGISTER A TRADE MARK  
IN CLASSES 3, 5 AND 16**

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**DECISION AND GROUNDS OF DECISION**

**Background**

10 On 11<sup>th</sup> January 1999, Ainsworths (London) Limited of 36 New Cavendish Street, London W1M 7LH, applied for registration of the trade mark RECOVERY in respect of the following goods:

15 Class 3:

Non-medicated preparations for care of the body; herbal preparations; essential oils, cosmetics; toiletries; medicated soap; mouthwashes.

20 Class 5:

Herbal health preparations; herbal extracts; pharmaceuticals; preparations including foods for medicinal use.

25 Class 16:

Books, booklets, brochures, handbooks, posters, periodicals.

30 Objection was taken to the application under paragraph (b) and (c) of Section 3(1) of the Act on the grounds that the mark consists exclusively of the word RECOVERY, being a sign other traders may legitimately wish to use to designate the kind and/or subject matter of the goods, ie, those which assist in, or relate to, a person's recovery following illness.

35 Objection was also taken under Section 5(2) of the Act as the mark was considered to conflict with the following earlier mark:

<b>Number</b>	<b>Mark</b>	<b>Class</b>	<b>Specification</b>
40 1441473	RECOVER	16	Paper, paper articles, cardboard, cardboard articles, paper stationery; all included in Class 16.

45 Following the raising of these objections, the applicant's trade mark agent, Mr F Preedy of Trade Mark Owners Association Limited, submitted examples of the packaging use in relation to the product sold under the trade mark. A copy of these examples is shown in the annex attached.

## Hearing and Decision

At the hearing, attended by Mr Preedy, the objection under Section 3(1)(b) and (c) of the Act was maintained. However, the objection under Section 5(2) of the Act was waived and therefore no further reference is made to this objection in the following decision.

Following the issue of the notice of refusal of the application under Section 37(4) of the Act, I am now asked under Section 76 of the Act and Rule 56(2) of the Trade Mark Rules 1994 to state in writing the grounds of the decision and the materials used in arriving at it.

At the hearing and in correspondence, Mr Preedy put forward various arguments in support of acceptance of the mark, which are summarised as follows:

S RECOVERY is a word which only alludes to the goods and cannot be described as one which other traders may legitimately wish to use in relation to the goods as filed. It has no direct reference to any of the items in the specifications;

S a blanket refusal under Section 3 is inappropriate for the wide range of goods in respect of which the application is filed;

S if the mark is registered, for example, for “soaps”, it would be perceived to be a reference to a particular brand of soap and its registration would not prevent any third party from referring to their brand of soap, as for example, “aiding recovery after a hard day at work”;

S the registrar had accepted marks in the past such as RESCUE and EMERGENCY ESSENCE both of which are of equal distinctiveness to the applicant’s mark.

These arguments did not persuade me to waive the remaining objection.

The relevant part of the Act under which the objection was taken is as follows:

Section 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.*

5 No evidence of use has been put before me, therefore the proviso to this Section of the Act does not apply and I have only the prima facie case to consider.

10 The mark consists of the word of the ordinary word RECOVERY. In Collins English Dictionary (4<sup>th</sup> edition 1998), various definitions are attributed to the word “recovery” and the following are most relevant:

1 *the act or process of recovering, especially from sickness, a shock or a setback; recuperation.*

15 2 *restoration to a former or better condition.*

In The New Oxford Dictionary of English (1998) the prime definition is:

*a return to a normal state of health, mind or strength.*

20 In my opinion the mark clearly conveys to the public that the goods specified under Class 3 and Class 5 are intended to be used as an aid to recovery from a eg a skin problem or other disorder of the body which requires care or treatment. For example, there are skin creams which restore moisture to dry skin or herbal health preparations which may assist in the treatment of acne and allow the recovery of a clear complexion. Essential oils may be used in aromatherapy treatment in order to help in the recovery from sickness. Moreover, the wording used on the packaging of one of the products used under the mark (see annex) demonstrates that there is no indirect reference to the kind (or intended purpose) of the goods. For instance, on the product marked “Recovery Cream” and “Ainsworths Original Dr Bach Formulation” appears the statement:

30 *Recovery Cream™ To Soothe And Restore*

I take the view that the public would understand, without hesitation, that this product is to allow users of the cream to make a recovery to a normal state of health.

35 In relation to the items listed under Class 16, the mark would likely be perceived by the public as indication to the subject matter of a publication, eg a book or periodical which contains information about how to regain one’s health or perhaps a poster which sets out a “recovery” regime to be followed after a surgical operation. I therefore reject the view that a blanket refusal is inappropriate.

40 Mr Preedy argued that registration of the mark would not prevent any third party from using the word RECOVERY in a descriptive sense. Mr Hugh Laddie said in the PROFITMAKER trade mark (1994) RPC 17:

45 *“The fact that honest traders have a number of alternative ways of describing a product.... is no answer to the criticism of the mark. If it were, then all those*

*alternative ways could, on the same argument, also be the subject of registered trade marks. The honest trader should not need to consult the register to ensure that common descriptive or laudatory words, or not unusual combinations of them, have been monopolised by others”.*

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Moreover, in the AD2000 trade mark (1997) RPC 168, Geoffrey Hobbs QC said:

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*“Although section 11 of the Act contains various provisions designed to protect the legitimate interests of honest traders, the first line of protection is to refuse registration of signs which are excluded from registration by the provisions of section 3. In this regard, I consider that the approach to be adopted with regard to registrability under the 1994 Act is the same as the approach adopted under the old Act. This was summarised by Robin Jacob Esq QC in his decision on behalf of the Secretary of State in Colorcoat Trade Mark [1990] RPC 511 at 517 in the following terms:*

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*“That possible defences (and in particular that the use is merely a bona fide description) should not be taken into account when considering registration is very well settled, see eg Yorkshire Copper Work Ltd’s Trade Mark Application (1954) RPC 150 at 154 lines 20-25 per Viscount Simonds LC. Essentially the reason is that the privilege of a monopoly should not be conferred where it might require “honest men to look for a defence”.”*

25

Mr Preedy drew my attention to several previous registrations (by various other proprietors) and argued that the applicant’s mark was as equally distinctive and urged me to accept the application for this reason. I am not aware of the circumstances surrounding the acceptance of the marks that Mr Preedy referred to and, in any event, each case must be dealt with on its own merits. Mr Justice Jacob in the British Sugar PLC and James Robertson and Sons Ltd (TREAT) decision (1996) RPC 281 said:

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*“In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the Registrar to put the marks concerned on the Register. It has long been held that under the old act that comparison with other marks on the Register is in principle irrelevant when considering a particular mark tendered for registration, see MADAME trade mark (1966 RPC 541) and the same must be true of the 1994 Act. I disregard the state of the register evidence.”*

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Having decided that the mark fails to qualify under Section 3(1)(c) of the Act in respect of all the items listed under Classes 3, 5 and 16, it follows that the mark is devoid of any distinctive character and also fails to qualify under Section 3(1)(b) of the Act. The test for distinctiveness was clearly set out by Mr Justice Jacob in the TREAT decision (1996) RPC 281:

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*“Next, is “Treat” within Section 3(1)(b). What does devoid of any distinctive character mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark? A*

5                    *meaningless word or a word inappropriate for the goods concerned (“North Pole” for bananas) can clearly do. But a common laudatory word such as “Treat” is, absent use and recognition as a trade mark, in itself (I hesitate to borrow the word inherently from the old Act but the idea is much the same) devoid of any distinctive character.”*

10 I take the view that the public would require educating that RECOVERY is a badge of origin and although not unregistrable, even substantial use of the mark in the manner shown in the attached annex is unlikely to prove, in itself, that the mark has acquired a distinctive character. As Justice Jacob remarked in the TREAT decision (1996) RPC 281:

15                    *“I think the Registrar was wrong to accept this evidence as demonstrating that the mark was “capable of distinguishing” for the purpose of the Act. Mere evidence of use of a highly descriptive or laudatory word will not suffice, without more, to prove that it is distinctive of one particular trader - is taken by the public as a badge of trade origin. This is all the more so when the use has been accompanied by what is undoubtedly a distinctive and well recognised trade mark.”*

20                    **Conclusion**

In conclusion, in the absence of evidence that the mark has acquired a distinctive character by reason of the use made of it, it is debarred from registration under Section 3(1)(b) and (c) of the Act.

25 In this decision I have considered all the documents filed by the applicant 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 it fails to qualify under Section 3(1)(b) and (c) of the Act.

30 Dated this 20th day of September 2000.

35  
40 Charles Hamilton  
For the Registrar  
the Comptroller General

**ANNEXE ONLY AVAILABLE AS A PAPER COPY**