

O-350-15

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3049550 BY
DANCE FACTORY LIMITED
TO REGISTER THE TRADE MARK SERIES:**



FOR GOODS IN CLASS 3

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 402672 BY
UV GLOW LIMITED**

BACKGROUND

1) On 1 April 2014 Dance Factory Limited (“the applicant”) applied to register the following series of trade marks



The application was published for opposition purposes on 09 May 2014 for the following goods:

Class 3: *Cosmetics; cosmetics for use on the skin or eyes; colour cosmetics for the skin or eyes; face paint; Body paint (cosmetic).*

2) The application is opposed by UV Glow Limited (“the opponent”), which claims that registration of the marks would be contrary to sections 3(1)(a),(b),(c) and (d) of the Trade Marks Act 1994 (“the Act”) for the following reasons:

- Before the date of application for registration the sign was in commonplace use in relation to body paints which glowed upon exposure to UV light, as well as entertainment services in which such paints were used. It is therefore not capable of distinguishing the goods or services of one undertaking from those of other undertakings. Registration would contravene sections 3(1)(a) and 3(1)(b) of the Trade Marks Act 1994 (“the Act”).
- UV GLOW is clearly descriptive in relation to body paints which glow under UV light, while the device bears an immediate and clear reference to paints and has been commonplace in respect of these goods probably for hundreds of years. Before the date of application for registration the sign served to designate the kind, intended purpose or other characteristics of (body) paints which glowed upon exposure to UV light, and to designate the kind or other characteristics of entertainment services in which such paints were used. Registration would contravene section 3(1)(c) of the Act.
- Before the date of application for registration the sign UV GLOW had become customary in the current language of the trade in (body) paints which glowed upon exposure to UV light, and of the trade in entertainment services in which such paints were used. Moreover, the device had become customary in the bona fide and established practices of the paint trade. Registration would contravene section 3(1)(d) of the Act.

3) In its notice of opposition and statement of grounds the opponent had originally also claimed that registration of the marks would be contrary to section 3(6) of the

Act. On conclusion of the evidence rounds the opponent was informed by the tribunal in a letter of 10 March 2015 that, since its evidence had been directed to the section 3(1) grounds only, the opposition would proceed on the basis of these grounds only. The applicant filed a notice of defence and counterstatement, denying the grounds of opposition, and putting the opponent to proof of its claims. Evidence, which also contained submissions, together with separate written submissions, were filed by the opponent. I take note of these submissions and will refer to them, as necessary, in my decision, but will not summarise them here. Neither side requested a hearing. I therefore give this decision after a careful review of all the papers before me.

THE OPPONENT'S EVIDENCE

4) This consisted of a witness statement of 2 March 2015 of Mr Anthony Gregory Burrows, a registered trade mark attorney representing the opponent in these proceedings. Mr Burrows appends as **Exhibit AGB1** definitions of the words "cosmetics" and "cosmetic" given by the on-line Oxford Dictionary (British & World English), and an extract from EU Regulation (EC) No. 1223/2009 containing a definition of "cosmetic product" for the purposes of that directive; I have not found it necessary to refer to these in my decision. He attaches as **Exhibit AGB2** an excerpt printed out on 24 February 2015 from the website "*uk.answers.yahoo.com*" where, in response to a question on the meaning of "*uv glow gel*" in connection with hair gel, an answer shown as given "7 years ago" states that "*UV glow gels have a special chemical that can "glow" under UV lighting, or black light*".

5) Mr Burrows states that he entered "*UV glow 2010*" into the "Google" search engine, and printed off the first two pages which appeared; he attaches the prints as **Exhibit AGB3**. He also printed out excerpts from four of the individual websites which appeared on this list of search results as examples of use of "UV glow" for body paints and, also, cosmetics other than body paints, prior to the date of filing of the present Application. These constitute **Exhibits AGB4-7**.

- **Exhibit AGB4** is an item from the website *www.amazon.co.uk* headed "*UV clear nail polish ULTRA VIOLET glow 15ml by La Femme*" and stating that it was first available at *Amazon.co.uk* as of the 13 February 2009; customer reviews are dated 4 May 2010, 17 November 2012 and 2 May 2013.
- **Exhibit AGB5** is an item from the website *www.amazon.co.uk*. For some reason the first couple of letters of each line of text seem to have been lost, but it can be seen that the item is headed, as stated by Mr Burrows, "*[NE]W SNAZAROO UV GLOW IN THE DARK MAKE [UP] FACE PAINT KIT*". "Date first available" is given as 29 October 2010.
- **Exhibit AGB6** is an item from the website *www.rusu.co.uk* headed "*Fusion Presents a UV Glow in the Dark Party*". This appears to relate to an event organised by Reading University Students Union on the 12th November 2010, and announces that a "*2000 capacity 3sixty night club will be transformed into a UV Paradise with UV Cannons, Glow Sticks and Pens, Glow Body Painting and more ...*".

- **Exhibit AGB7** is an item from the website *www.skiddle.com* headed “*uv glow party hosted by lipstick*” announcing a party held at *Funky Buddha* in Mayfair, London on the 13 August 2010 and inviting the reader to “*Join us this Friday at Funkybuddha for the ultimate Glow Party hosted by Lipstick! Think UV lights, neon colours and eccentric face art which will take you right back to the eighties*”.

6) Mr Burrows states that he repeated his “Google” search, this time for *UV GLOW 2011*, and again printed off the first two pages, attaching them as **Exhibit AGB8**. He also printed out excerpts from two of the individual websites as examples of UV GLOW being used descriptively, attaching them as **Exhibits AGB9-10**.

- **Exhibit AGB9** is from the website *www.residentadvisor.net*. It is headed “*I Love Uv Glow Party McCluskys at McClusky’s Kingston...*” and announces an event to be held on the 22nd June 2011 at Kingston-upon-Thames, where “*We will be bringing you uv painters...*”.
- **Exhibit AGB10** is an item uploaded to the website *www.youtube.com* on 3 April 2011. It is headed “*UV GLOW PARTY/DISCO, YNYSDDU RFC*”, and was apparently a “*UV GLOW PARTY*” held in Ynysddu Rugby Club in Wales. The video cannot be viewed in the paper exhibit, but Mr Burrows describes it as showing patrons glowing under UV light.

7) Mr Burrows refers to the images which appear on the “Google” search engine when the search “*paint splodges 2010*” is entered, and says that there are a large number of “splodges” with radiating parts, some of them multi-coloured, some bearing text roughly centrally, some of inviting the viewer to share text with terms such as “*YOUR TEXT HERE*”. He does not attach a print-out of these search results to his witness statement; but he does state that clicking on the images leads to various websites, and attaches as **Exhibits AGB11-14** excerpts from four of these.

- **Exhibit AGB11** is an item from the website *www.jwbeyond.deviantart.com*, consisting of an image of a green, white and black human face, with a reference to “*UV face paint*”, and dated 2010.
- **Exhibit AGB12** is an item from the website *www.webdesignhot.com*, showing examples of multi-coloured paint blots, dated between 2010 and 2013. One, for example, appears under the heading “*Colorful Paint Splats Vector Background*”, is dated May 2012, and bears the text “*SAMPLE TEXT*” superimposed on the blot. It is shown in Annex A, together with other examples from this exhibit.
- **Exhibit AGB13** is an item from the website *www.canstockphoto.com*, bearing images of “colorful splodges”, “Stock Illustration Pricing” in “USD” and “Stock Illustration Information” including keywords such as “*paint... ink... splatter... splash... stain... splat... splotch*”. The main illustration appears to have been added on 29 November 2010. It is shown in Annex B. The materials in this and the previous exhibit use American spelling, suggesting that the websites are not targeted at the UK.

- **Exhibit AGB14** is an item from a blog created by students of art, art history and visual studies at Duke University and describes, with illustrations, the process of splattering paint onto surfaces to create multi-coloured designs. It is shown in Annex C.

8) **Exhibit AGB15** is a print of an article dated 17 April 2013 from <http://paintertainment.blogspot.co.uk>. Although American spelling is used, the article appears on a UK website, and is thus targeted at a UK audience. It is headed “*Paintertainment*” and the name is accompanied on either side by stylised simple impact paint blots of one colour, as shown below.



The article explains the characteristics of paint which glows under UV or “black” light. Under the heading “*What is the difference between Neon, UV, Day Glow, Fluorescent ...??*” the author explains: “*Most people use these terms simply as a way to say they are “super bright colors”. If you want to make sure a product glows under a black light, the only question you need to ask is if the product itself reacts to UV light (like a black light) by fluorescing phosphors. Or in other words, “does it fluoresce under black light? A paint labelled with any of these terms doesn’t necessarily mean it reacts to UV light. I mean, usually it does in the face and body painting world, but not all products, colors, and industries use these words the same. So if you are doing a gig where your paints must glow under black light, make sure to ask the right questions before making a purchase”.*

THE LAW

9) Section 3(1) of the Act is as follows:

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

(a) signs which do not satisfy the requirements of section 1(1),

(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,

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

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.”

Section 1(1) is as follows:

“1(1) In this Act a “trade mark” means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking other undertakings. A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.”

10) The relevant date at which to decide whether any of the exclusions set out in section 3(1) of the Act apply is the date on which the application to register the trade marks was filed, namely 1 April 2014.

Section 3(1)(a)

11) In *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418(Ch), Arnold J said:

“44. ... As I discussed in *JW Spear & Sons Ltd v Zynga Inc* [2012] EWHC 3345 (Ch) at [10]–[27], the case law of the Court of Justice of the European Union establishes that, in order to comply with art.4 , the subject matter of an application or registration must satisfy three conditions. First, it must be a sign. Secondly, that sign must be capable of being represented graphically. Thirdly, the sign must be capable of distinguishing the goods or services of one undertaking from those of other undertakings.

45. The CJEU explained the third condition in *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (Case C-363/99) [2004] ECR I-1619 as follows:

"80. As a preliminary point, it is appropriate to observe, first, that the purpose of Article 2 of the Directive is to define the types of signs of which a trade mark may consist *Sieckmann* (Case C-273/00) [2002] ECR I-11737 at [43]), irrespective of the goods or services for which protection might be sought (see to that effect *Sieckmann*, paragraphs 43 to 55, *Libertel*, paragraphs 22 to 42, and *Shield Mark* (C-283/01) [2003] ECR I-14313, paragraphs 34 to 41). It provides that a trade mark may consist inter alia of 'words' and 'letters', provided that they are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

81. In view of that provision, there is no reason to find that a word like 'Postkantoor' is not, in respect of certain goods or services, capable of fulfilling the essential function of a trade mark, which is to guarantee the identity of the origin of the marked goods or services to the consumer or end user by enabling him, without any possibility of

confusion, to distinguish the goods or services from others which have another origin (see, in particular, *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc (C-39/97) [1998] E.C.R. I-5507* at [28]; *Merz & Krell*, paragraph 22, and *Libertel* at [62]. Accordingly, an interpretation of Article 2 of the Directive appears not to be useful for the purposes of deciding the present case."

46. The Court went on to say that the question whether POSTKANTOOR (Dutch for POST OFFICE) was precluded from registration in respect of particular goods and services (i.e. those provided by a post office) because it was devoid of distinctive character and/or descriptive in relation to those particular goods and services fell to be assessed under article 3(1)(b) and (c) of the Directive (Article 7(1)(b) and (c) of the Regulation).

47. It follows that "the goods or services" referred to in Article 4 are not the particular goods or services listed in the specification, as counsel for the defendants argued. Rather, the question under Article 4 is whether the sign is capable of distinguishing any goods or services."

12) Article 4 of Regulation 207/2009 of 26 February 2009 – the Community Trade Mark Regulation – corresponds to section 1(1) of the Act, as set out above. The marks in suit are not incapable of distinguishing *any* goods and services. Graphically represented word and device marks of the sort at issue here are capable of functioning as a trade mark, and therefore, according to this authority, such marks do not fall foul of section 3(1)(a). **Accordingly, the objection under section 3(1)(a) fails.**

13) It is worth noting that the objection under 3(1)(a) is in any event academic because, if the mark is clear from objection under the other grounds, then clearly, section 3(1)(a) cannot apply, whereas if the mark is objectionable under any of the grounds then section 3(1)(a) takes matters no further forward. It will be convenient to continue my analysis by examining the objections first under section 3(1)(d), then under 3(1)(c), concluding with section 3(1)(b).

Section 3(1)(d) of the Act

14) In *Telefon & Buch Verlagsgesellschaft mbH v OHIM (Case T-322/03)* the General Court ("GC") summarised the case-law of the Court of Justice of the European Union ("CJEU") under the equivalent of section 3(1)(d) of the Act as follows:

"49. Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma(BSS)* [2003] ECR II-411, paragraph 37). Accordingly, whether a mark

is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public's perception of the mark (*BSS*, paragraph 37).

50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (*BSS*, paragraph 38).

51. Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and *BSS*, paragraph 39).

52. Finally, signs or indications constituting a trade mark which have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not therefore fulfil the essential function of a trade mark (see, by analogy, *Merz & Krell*, paragraph 37, and *BSS*, paragraph 40)."

15) In its evidence the opponent addresses separately the issue of whether the phrase UV GLOW was being used commonly before the relevant date to identify a property of paints, particularly body paints and cosmetics, and the issue of whether "splodges" had "for many decades" been used to indicate paints and cosmetic substances. I would observe at the outset that a sign may consist of more than the sum of its parts, that it is the sign as a whole that must have become customary to sustain an objection under section 3(1)(d), and that there is nothing in the evidence to support this. However, even if I am wrong about this, I address separately below the questions of whether the phrase *UV Glow* and whether the "splodge" device of the contested mark had become customary.

16) The goods in respect of which registration is sought are: *cosmetics; cosmetics for use on the skin or eyes; colour cosmetics for the skin or eyes; face paint; Body paint (cosmetic)*. The totality of the evidence shows that, before the contested marks were applied for, parties and entertainment events were being organised in the UK at which participants wore or carried items and/or body-paint and other cosmetics which glowed when exposed to a certain kind of ultra violet light in a darkened venue. The phrase *UV Glow* occurs in all the exhibited example items announcing and describing these events, as part either of the wider term "*UV glow party*" (**Exhibits AGB7, AGB9, AGB10**) or of "*UV Glow in the Dark Party*" (**Exhibit AGB6**). These items also make reference to "*UV*" in connection with "*Glow Body Painting*" (**Exhibit AGB6**) and "*eccentric face art*" (**Exhibit AGB7**), and to the provision of "*uv painters*" (**Exhibit AGB9**). The list of "hits" in **Exhibit AGB3** also includes two further search summaries containing references to UK events: a "*UV GLOW PARTY*"

and a “*UV Glow Rave*”, though extracts from the websites in question are not provided in the opponent’s evidence. It is clear that such events create a demand among their participants for cosmetics and face and body paints which will react to UV light so as to glow in a darkened venue, as confirmed in the “*Paintertainment*” article in **Exhibit AGB15**. There is evidence that these products are bought both by the general public and third parties who provide face and/or body-painting services. The question and answer in **Exhibit AGB2**, for example, with its reference to “*uv glow gel*” glowing “*wen u go to a disco or bar*” indicates purchase by the end-user. Reference to the provision of “*uv painters*” in **Exhibit AGB9** points to service providers who will have bought the relevant products themselves for professional use. It would seem that both types of consumer form the target public for the products.

17) The above evidence establishes an important reason why consumers of cosmetics or face and body paints would be interested in establishing whether these products possess the property of glowing in the kind of light used at the events described. However, it only shows use of the words *UV glow* – as part of a wider phrase – in respect of such events in four concrete cases (six if one includes the two additional search summaries in **Exhibit AGB3**). It falls short even of showing that the phrase *UV Glow* had become customary in the current language of the trade in respect of such events – let alone that it had become so in respect of the cosmetics or face and body paints worn by participants.

18) The opponent’s evidence showing the words *UV GLOW* applied directly to cosmetics or face or body paints before the relevant date in the UK is very sparse; the phrase is shown being applied to hair gel (though the references in **Exhibit AGB2** feature on a community-driven question-and-answer site, rather than providing examples of use in trade), and to a “*UV GLOW IN THE DARK MAKE [UP] FACE PAINT KIT*” (though this example in **Exhibit AGB5** shows use of the words as part of a wider descriptive phrase); and another product is described as “*UV clear nail polish ULTRA VIOLET glow 15m by La Femme*” (here again, in this example in **Exhibit AGB4** the words are used as part of a wider phrase). A further example of potentially descriptive use can be found on page six of the “*Paintertainment*” article in **Exhibit AGB15**, where a jar can be seen labelled “*KRYOLAN’S UV-DAYGLOW AQUACOLOR*”. In this example, however, the term clearly differs from that used in the contested mark. Though published on a UK website, the article is written in American spelling, so the illustration may well be a product available in America. Moreover, the article explains that “*The face and body painting industry uses all sorts of terms for products that really have a lot of artists confused*”. This confusion is apparently shared by the potential consumer enquiring about the meaning of the phrase *UV GLOW* in relation to hair gel in **Exhibit AGB2**. The evidence falls far short of establishing that the term *UV GLOW* could be described as customary in the current language of the trade in respect of cosmetics or face and body paints at the date of application for the contested marks.

19) In his witness statement Mr Burrows states that “*it is within the common knowledge of ordinary purchasers of paints and cosmetic substances that splodges have for many decades been used to indicate them*”. The opponent submits that “*to an end purchaser before the Application date of body paints which glowed under UV light (the attached Evidence shows that such purchasers were relatively*

commonplace by that time), the Mark in black and white would have meant paint (the splodge) which glowed under UV light (“UV GLOW”), whilst the other Mark with the multicolour splodge would have meant paint (the splodge) which was available in various colours (the multicolour character of the splodge) and glowed under UV light (“UV GLOW”).

20) **Exhibits AGB12-14** demonstrate that (1) use of the search term “*paint splodges 2010*” produces a large number of images of paint blots and splashes on a large number of websites; (2) libraries of such splash images, and vectors and processes for producing them, are available on the internet (one assumes these would be of interest to graphic designers, designers of websites, etc.). This tends to suggest that such splash images are not uncommonly used. The opponent’s evidence, however, contains only one example of a splash image being used in the general context of face or body paints, namely the heading of the “*Paintertainment*” article in **Exhibit AGB15**. This article explains the terminology used in connection with face and body paints which glow under UV light, and the *Paintertainment* heading is accompanied on either side by stylised, simple impact paint splash images, each of one colour. The article is taken from a *Paintertainment* blogspot. The exact nature of *Paintertainment* or its business is not clear from the article. The evidence includes no further examples of splash images used in trade in respect of cosmetics or face/body paints. The evidence falls short of establishing that images comparable with the device in the contested marks had become customary in the *bona fide* and established practices of the trade at the date of application for the contested marks. Thus, even if I had found that the phrase *UV GLOW* had become generic by the relevant date, the requirement of section 3(1)(d) that the marks should consist *exclusively* of signs or indications which have become customary in the current language or *bona fide* and established practices of the trade would not have been met. **Accordingly, the objection under section 3(1)(d) fails.**

Section 3(1)(c) of the Act

21) In *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) (“*Starbucks*”) Arnold J summarised the case law under art.7(1)(c) of the CTM Regulation, which is applicable to section 3(1)(c) of the Act, in the following way:

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the Court of Justice of the European Union (“CJEU”) in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of

Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94 . Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia , *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44 , paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley* , paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94 , it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie* , paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it

may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94, the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56)."

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97]."

22) In *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04, the CJEU held that:

“24. In fact, to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say in trade and or amongst average consumers of the said goods or services, reasonably well-informed and reasonably observant and circumspect, in the territory in respect of which registration is applied for (see Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 29; Case C-363/99 *Koninklijke KPNNederland* [2004] ECR I-1619, paragraph 77; and Case C-218/01 *Henkel* [2004] ECR I-1725, paragraph 50).”

23) In paragraphs 15-20 I have already explained the reasons why I do not consider it has been shown that either the term *UV Glow* or the splash device of the contested mark were customary in the current language or in the *bona fide* and established practices of the trade at the relevant date. It is important to note, however, that in order to fall foul of section 3(1)(c) it is not necessary that the sign in question should actually be in use at the time of the application for registration. It is sufficient that the sign *could* be used for such purposes. I must be satisfied that the sign could be used to describe a characteristic, recognisable as such by the relevant class of persons, of the goods or services in respect of which registration is sought.

24) As **Exhibit AGB15** explains: A “black light” may be used in a darkened room to make objects glow. “Black light” produces UVB light – a certain kind of ultraviolet (commonly abbreviated as “UV”) light. When exposed to this kind of UV light, phosphors will glow. Where black light is used in a darkened room, therefore, objects which contain phosphors, or which have been treated or coated with substances which contain phosphors, will glow.

25) A simple description of this phenomenon might be “glows in ultraviolet light”. *UV glow* is admittedly a truncated or contracted form, but I consider it to be a natural and straightforward one which could be used in trade as a simple and conveniently compact description of this characteristic. Admittedly, it could also be used, in a phrase like *UV Glow Party* as a compendious way of describing an event at which the appropriate UV light will be deployed to exploit this property. These uses are very closely bound up with one another, however, and do not, in my view, preclude the conclusion that *UV glow* could be applied to cosmetics and face or body paints as a conveniently succinct way of saying “glows in ultraviolet light”. I have already pointed out that the evidence showing the words *UV GLOW* applied directly to cosmetics or face or body paints in the UK is very sparse, that the article in **Exhibit AGB15** explains that “*The face and body painting industry uses all sorts of terms for products that really have a lot of artists confused*”, and that this confusion is apparently shared by the potential consumer enquiring about the meaning of the phrase *UV GLOW* in relation to hair gel in **Exhibit AGB2**. Although the enquirer in the latter case is not sure whether the exact meaning is “glow in the dark” or “glow when under certain light”, however, he recognises that the phrase describes a specific characteristic. On balance, I have come to the conclusion that the phrase

UV GLOW, when used in connection with face or body paints or cosmetics, can be used to designate a characteristic of those products recognisable by the relevant class of persons. I consider that this conclusion is consistent with the totality of the evidence.

26) However, for the objection under section 3(1)(c) to be made good, it must be shown that the mark consists *exclusively* of signs or indications which may serve, in trade, to designate the kind, intended purpose or other characteristics of the relevant goods. Although the words *UV GLOW* are a dominant element of the contested marks, there are also figurative elements to consider. There is nothing unusual about the chunky typeface in which the phrase is written. The words might be said to be mildly stylised, to the extent that they are written in purple and edged in black, thus contrasting against the background of the rest of the marks (including the monochrome mark); but such minimal stylisation would be insufficient to overcome objection under section 3(1)(c)¹. However, the marks also include a device element consisting of a multicoloured disc or circle over which a number of multicoloured splash images have been superimposed to produce an irregular pattern of explosively radiating lines. The words *UV GLOW* are superimposed over this device.

27) I have already referred in paragraph 18 to Mr Burrow's assertion that "*it is within the common knowledge of ordinary purchasers of paints and cosmetic substances that splodges have for many decades been used to indicate them*", and to the opponent's submissions as to what meaning purchasers would put upon the splash image device in the contested mark. I found that, beyond the use of simple, stylised impact paint splash images on the *Paintertainment* article heading, the evidence includes no further examples of splash images actually used in trade in respect of cosmetics or face/body paints (or of paints or inks generally).

28) I bear in mind that section 3(1)(c) may also apply to figurative marks² and marks consisting of both word and device elements, and that current use is not required. The device in the contested marks is certainly allusive of coloured paints or inks (I think this arguably applies even to the monochrome mark), but I do not consider that it is descriptive of them. Although I have found that the verbal element of the marks is a dominating element, and that the message it conveys is descriptive, I consider that the device does more than simply reinforce that descriptive message, or supplement it with further description. The device amounts to more than a mere stylistic embellishment or the "figurative fig-leaf" as referred to by Arnold J in *Starbucks*. Stepping back, and considering the marks as a whole, they cannot be said to consist *exclusively* of elements that designate characteristics of the goods. **Accordingly, the objection under section 3(1)(c) of the Act fails.** I must therefore now proceed to examine whether the marks are devoid of distinctive character within the meaning of section 3(1)(b).

¹ See *BioID v OHIM* C-37/03 at paragraphs 67-75; *Hormel Foods Corp v Antilles Landscape Investments NV* [2005] EWHC 13 (Ch) at paragraphs 149-150; *Combi-Steam O/363/09* at paragraphs 33-37.

² See *Johnson & Johnson's Application O/105/06* at paragraph 12 and *Nadine Trautwein Rolf Trautwein GbR, Research and Development v OHIM* T-386/08 (device of a horse).

Section 3(1)(b) of the Act

29) The principles to be applied under article 7(1)(b) of the CTM Regulation (which is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act) were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

“29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that 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 those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as *OHIM* points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37).”

30) I have found that the evidence does not support the conclusion that coloured splash images comparable with those of the device in the contested mark are commonly used in trade in respect of cosmetics or face and body paint. I have found the device in the contested marks allusive of coloured paints or inks, but not directly

descriptive of them. Although I have found that the verbal element of the marks is a dominating element, and that the message it conveys is descriptive, I have also found that the device does more than simply reinforce that descriptive message, or supplement it with further description. It makes a graphic impression going beyond mere embellishment. The marks may not be remarkably creative or original. However, stepping back from analysis of their constituent elements, and viewing the marks as a whole, I consider that, despite their descriptive element, they will nevertheless convey an origin message when first encountered by the relevant public³; they will immediately enable the relevant public, without further education, to identify the products in question as originating from a particular undertaking, and thus to distinguish them from those of other undertakings. They are thus not devoid of distinctive character. **Accordingly, the objection under section 3(1)(c) of the Act fails.**

OUTCOME

31) The opposition fails in its entirety.

COSTS.

32) Dance Factory Limited has been successful and is entitled to a contribution towards its costs. The award reflects the fact that Dance Factory Limited did not file evidence or submissions and was unrepresented in the proceedings, thus not incurring the costs of legal representation. I hereby order UV Glow Limited to pay Dance Factory Limited the sum of £200. This sum is calculated as follows:

<i>Preparing a statement and considering the other side's statement</i>	£100
<i>Considering the other side's evidence and submissions</i>	£100

The above sum should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

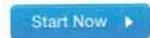
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**Martin Boyle
For the Registrar,
The Comptroller-General**

³ *Mag Instruments C-136/02*, at paragraph 50

Annex A

Web Design Hot!

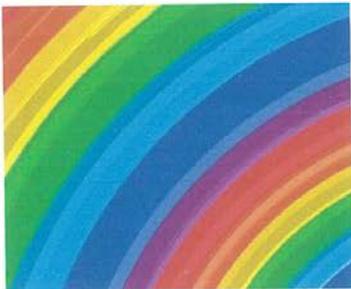
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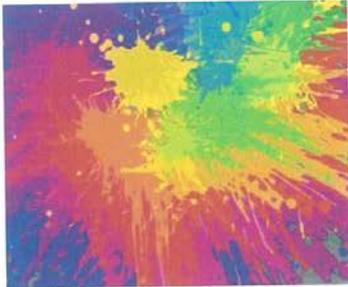
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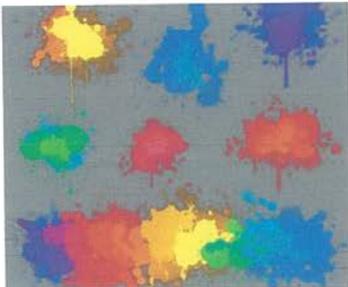
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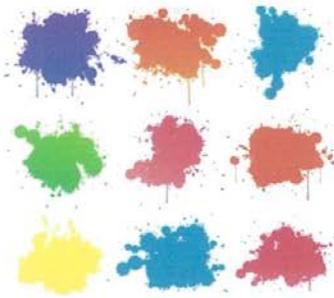
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Annex B

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Annex C

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A blog created by students of art, art history and visual studies at Duke University

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Paint-Filled Eggs

28092010



My machine draws for me when I fill eggs with paint and drop them onto poster board. The machine works as follows. Take an egg and poke a small hole in the smaller end of the shell with a needle. Poke a slightly larger hole in the larger end. Blow on the smaller end so the egg comes out through the bottom of the shell. Fill the egg with the three primary colors of paint through the larger hole. I used red, blue, and yellow tempera. Place a piece of poster board on a hard surface, and drop the egg

http://sites.duke.edu/artsvis54_01_f2010/2010/09/28/paint-filled-eggs/

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onto the poster board. The machine (the egg filled with paint) will smash and splatter paint on the poster board. The pain will swirl and mix to create different colors and designs when it is let out of the egg. The color theory is displayed here by the greens, purples, oranges, and neutral gray/browns created, and the eggshells get painted as well.

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