

TRADE MARKS ACT 1994

AND

**THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996
IN THE MATTER OF INTERNATIONAL REGISTRATION No 900028
AND THE REQUEST BY BEIERSDORF HOLDING FRANCE SARL
TO PROTECT A TRADE MARK IN CLASS 3**

DECISION AND GROUNDS OF DECISION

Background

1. On 22 September 2006 Beiersdorf Holding France Sarl of 1, rue des Sources, F-77176 Savigny Le Temple, France, on the basis of International Registration 900028, requested protection in the United Kingdom under the provisions of the Madrid Protocol of the following trade mark:

SUMMER LOOK

2. Protection is sought for the following goods:

Class 3

Cosmetics.

3. It was considered that the request failed to satisfy the requirements for registration in accordance with Article 3 of the Trade Marks (International Registration) Order 1996 and notice of refusal under Article 9(3) was given because the mark is excluded from registration by Sections 3(1)(b) and (c) of the Trade Marks Act 1994. This is because the mark consists exclusively of the words SUMMER LOOK, being a sign which may serve, in trade, to designate the intended purpose of the goods e.g. cosmetics that give a summer look appearance.

4. Following a hearing, which was held on 11 June 2007, at which the applicant was represented by Mr Chinnery of Dashbrook Secretarial Services, their trade mark attorneys, the objection was maintained.

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

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

The Law

7. Section 3(1)(b) and (c) of the Act reads 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

8. Both at the hearing, and in subsequent correspondence, Mr Chinnery referred me to the acceptance of an identical mark for a range of goods in Class 3. I note that this specification of goods includes the term “cosmetics”. Following opposition this application was withdrawn. For the sake of convenience details of this application may be found at Annex A.

Decision

9. 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 C-191/01 P, (the DOUBLEMINT case), the Court gives 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 any signs capable of being represented graphically, provided that they are capable 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 trade 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 is 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 as 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 Article 3(1)(c) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of Member States relating to trade marks (OJ 1989 L 40, p. 1), *Windsurfing Chiemsee*, paragraph 25, and Joined Cases C-53/01 to C-55/01 *Linde and Others* [2003] ECR I-3161, 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.”

10. I also take account of the decision of the European Court of Justice in *Postkantoor* (Case C-363/99) which again considered the registrability of combinations of descriptive words. Paragraphs 96 – 100 of the judgement are reproduced below:

- “96. If a mark, such as that at issue in the main proceedings, which consists of a word produced by a combination of elements, is to be regarded as descriptive for the purpose of Article 3(1)(c) of the Directive, it is not sufficient that each of its components may be found to be descriptive. The word itself must be found to be so.
97. It is not necessary that the signs and indications composing the mark that are referred to in Article 3(1)(c) of the Directive 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 those signs and indications could be used for such purposes. A word 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 (see to that effect, in relation to the identical provisions of Article 7(1)(c) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), Case C-191/01 P *OHIM v Wrigley* [2003] ECR I-0000, paragraph 32).

98. As a general rule, a mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics for the purposes of Article 3(1)(c) of the Directive. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned.
99. However, such a combination may not be descriptive within the meaning of Article 3(1)(c) of the Directive, provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements. In the case of a word mark, which is intended to be heard as much as to be read, that condition must be satisfied as regards both the aural and the visual impression produced by the mark.
100. Thus, a mark consisting of a word composed of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, is itself descriptive of those characteristics for the purposes of Article 3(1)(c) of the Directive, unless there is a perceptible difference between the word and the mere sum of its parts: that assumes either that, because of the unusual nature of the combination in relation to the goods or services, the word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts, or that the word has become part of everyday language and has acquired its own meaning, with the result that it is now independent of its components. In the second case, it is necessary to ascertain whether a word which has acquired its own meaning is not itself descriptive for the purpose of the same provision.”

11. Section 3(1)(c) of the Act has common roots to Art. 7(1)(c) of the CTMR, and is substantially identical to that provision. Accordingly, the ECJ’s guidance with regard to that provision may be taken to apply equally to Section 3(1)(c) of the Act. The provision excludes signs which may serve, in trade, to designate the kind of goods or other characteristics of goods. It follows that in order to decide this issue it must first be determined whether the mark designates a characteristic of the services in question.

12. The specification of goods is limited to “Cosmetics” and, although this is a term which covers a range of separate products, the objection is equally valid in respect of all of these products, as the trade mark applied for is equally descriptive for each of them.

13. I am aware that cosmetics are widely available in stores throughout the United Kingdom and I am also aware that sales of such goods are extremely high. They are sold under many brand names and are available from a large range of traders. They are available from mail order services and from Internet web sites. As a consequence

of these very high sales, competition is rife, and advertising of each traders goods is strong and continuous. New products are being continually introduced, although I am aware that some products have remained on sale for many years.

14. Although traders may well offer a full range of products at any time of the year, their advertising at any one time will concentrate on certain types of products. In the same way that the style and colour of clothes and accessories changes with the seasons then so do other complementary goods such as cosmetics. This is why advertising will concentrate on certain products at certain times and why advertisements will concentrate on different shades in the summer as opposed to more autumnal shades in the autumn season.

15. Advertisements which concentrate on products which are intended to provide a summer look are likely to stress that they will complement summer style clothing and they are likely to focus on certain factors. In some cases they may be designed to provide a sun-tanned complexion, whereas others may be designed to create a more natural appearance. Products designed to provide a summer look are likely to be marketed as being light, fresh and sun-kissed. Some products are marketed as providing glowing skin or a shimmering look. These are cosmetics that are designed to provide the users with a summer look as opposed to e.g. an autumnal look.

16. Cosmetics themselves are available in a range of prices and are generally purchased by members of the general public who I consider to be the relevant consumer of such goods. Although they are purchased by both male and female consumers I assume that there are more purchases by female consumers than there are by males. I say this because from my own personal experience of such goods I consider this to be a true fact. Because of the range of products on offer, and the range of prices for which they are sold, the level of attention to these goods may well vary. However, judging the mark applied for in its entirety, I am of the view that this mark will be perceived by the relevant consumer as a reference to the season for which these particular goods are most suitable. Because of this perception by the relevant consumer, the words fail to designate goods from a single undertaking.

17. Mr Darlington has referred me to the earlier acceptance of an identical trade mark and has suggested that this should influence the outcome of this application. I do not accept this.

18. I am unaware of the circumstances surrounding the acceptance of this mark and it is of little if any assistance in determining the outcome of this application. I draw support for this from the judgement of Jacob J in *British Sugar* [1996] R.P.C. 281 at 305 where he stated:

“Both sides invited me to have regard to the state of the register. Some traders have registered marks consisting of or incorporating the word “Treat”. I do not think this assists the factual enquiry one way or the other, save perhaps to confirm that this is the sort of word in which traders would like a monopoly. 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 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 *e.g. MADAME Trade Mark* and the same must be true under the 1994 Act. I disregard the state of the register evidence.”

19. I am aware that the trade mark applied for is a combination of the two dictionary words SUMMER and LOOK. In the context of the goods applied for the meaning of each word will be clearly understood by the relevant consumer and their combination SUMMER LOOK, will be perceived as a combination of words indicating that which will be perceived by the relevant consumer as a reference to the season for which these particular goods are most suitable.

20. Consequently, I have concluded that the mark applied for consists exclusively of signs which may serve, in trade, to designate the kind of services and is, therefore, excluded from registration by Section 3(1)(c) of the Act.

21. Having found that this mark is to be excluded from registration by Section 3(1)(c) of the Act, that effectively ends the matter, but in case I am found to be wrong in this decision, I will go on to determine the matter under section 3(1)(b) of the Act.

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

“37. It is to 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 1 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 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 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 judgment 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 determine whether the trade mark applied for is capable of enabling the relevant consumer of the goods in question to identify the origin of the goods and thereby to distinguish them from other undertakings. In *OHIM v SAT.1* (Case C-329/02) the European Court of Justice provided the following guidance at paragraph 41:

“41 Registration of a sign as a trade mark is not subject to a finding of a specific level of linguistic or artistic creativity or imaginativeness on the part of the proprietor of the trade mark. It suffices that the trade mark should enable the relevant public to identify the origin of the goods or services protected thereby and to distinguish them from those of other undertakings.”

24. I have already found that the objection taken under Section 3(1)(c) of the Act is valid for all of the goods for which registration is sought. For the same reasons that I found this trade mark is to be excluded by the provisions of Section 3(1)(c) of the Act I have concluded that the relevant consumer of the goods in question would not consider this mark to denote trade origin. The average consumer of these goods will, upon encountering the words *SUMMER LOOK*, perceive them as no more than an indication as to the season for which these particular goods are most suitable. That is why it will not be seen as a badge of origin. I am not persuaded that the trade mark applied for is sufficient, in terms of bestowing distinctive character on the sign as a whole, to conclude that it would serve, in trade, to distinguish the goods of the applicant from those of other traders.

25. I have concluded that the mark applied for will not be identified as a trade mark without first educating the public that it is a trade mark. I therefore conclude that the mark applied for is devoid of any distinctive character and is thus excluded from *prima facie* acceptance under Section 3(1)(b) of the Act.

Conclusion

26. 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 Sections 3(1)(b) and 3(1)(c) of the Act.

Dated this 7th day of December 2007

**A J PIKE
For the Registrar
The Comptroller-General**

ANNEX A