

O-395-10

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION No. 2337786B
STANDING IN THE NAME OF
BREAKTHROUGH BREAST CANCER, BREAST CANCER CARE, BREAST
CANCER CAMPAIGN**

AND

**IN THE MATTER OF THE CONSOLIDATED REQUEST FOR A DECLARATION
OF INVALIDITY THERETO UNDER No. 83362
AND A REQUEST FOR REVOCATION UNDER No. 83336
BY BRANDCONCERN BV and PINK RIBBON INC**

AND

**IN THE MATTER OF REGISTRATION No. 2212576
STANDING IN THE NAME OF
BREAKTHROUGH BREAST CANCER, BREAST CANCER CARE, BREAST
CANCER CAMPAIGN**

AND

**IN THE MATTER OF A REQUEST FOR REVOCATION UNDER No. 83363
BY BRANDCONCERN BV and PINK RIBBON INC**

BACKGROUND

1) On 14 July 2003, Breakthrough Breast Cancer, Breast Cancer Care and Breast Cancer Campaign (the registered proprietors) applied to register the trade mark PINK RIBBON in respect of the following goods and services:

Class 14: Precious metals and their alloys and goods in precious metals or coated therewith; jewellery; precious stones; horological and chronometric instruments; clocks and watches; costume jewellery.

Class 31: Agricultural, horticultural and forestry products and grains not included in other classes; live animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals, malt.

Class 35: Advertising; business management; business administration; the bringing together, for the benefit of others, of a range of goods comprising printed matter, printed publications, stationery, writing instruments, jewellery and goods of precious metals, articles of clothing, agricultural, horticultural or forestry products, natural plants and flowers, perfumes and toiletries through a mail-order catalogue, or by means of a website, or by means of telecommunications, or in a retail charity store, enabling customers to conveniently view and purchase these goods.

Class 36: Insurance; financial affairs; monetary affairs; real estate affairs; charitable fund-raising services; credit card services.

Class 41: Education; providing of training; entertainment; sporting and cultural activities; educational services in relation to the alleviation of cancer; organisation of conferences and seminars in relation to the alleviation of cancer; publication of books; texts and magazines.

Class 42: Scientific and technological services and research and design relating thereto; information and advisory services on scientific information relating to alleviation and prevention of cancer.

Class 44: Medical services; information and advisory services on medical information relating to alleviation and prevention of cancer.

2) The application was examined and accepted. The trade mark was published for opposition purposes. No opposition was filed, and the registration procedure was completed on 1 July 2005.

3) On 11 September 2008, subsequently amended, Brandconcern BV LLC and Pink Ribbon Inc (the applicants) applied for revocation under section 46 of the Trade Marks Act 1994 (the Act). The grounds are, in summary:

- a) Under Section 46(1)(c) that as a consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered; and
- b) Under Section 46(1)(d) that in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable

to mislead the public, particularly as to the nature, quality or geographical origin of those goods and services.

4) The applicants state that the first breast cancer organisation that used the pink ribbon was the Susan G. Komen Breast Foundation. In 1981 the Komen Foundation handed out pink ribbons to participants in its New York City Race for the Cure for Breast Cancer survivors. They contend that in 1992 the editor in chief of “Self” magazine, Alexandra Penney was working on the second annual Breast Cancer Awareness Month issue of the magazine and came up with the idea to use the pink ribbon symbol. The guest editor was Evelyn Lauder who, it is said, decided to use her cosmetics company to spread the ribbons across the USA. The applicants state that in October 1993 Evelyn Lauder founded the Breast Cancer Research Foundation and used the pink ribbon as an international symbol for breast cancer awareness and funding. The applicants state that the word combination and the symbol of the pink ribbon became the international symbol for the fight against breast cancer. The applicants state that in January 2003 the idea arose with the applicant to create an overall charity for all breast cancer initiatives worldwide under the name “Pink Ribbon Inc. (Pink Ribbon International). The objectives were said to be to create worldwide awareness for breast cancer, to generate funds for research, to support and facilitate organisations in their fight against breast cancer and to inform specialists, patients and those affected by breast cancer of breast cancer initiatives worldwide. They state that they have a number of domain names registered worldwide including in the UK where they have www.pinkribbon.me.uk registered.

5) The applicants state that the USPTO has refused to allow the mark “Pink Ribbon” to become a trade mark and recently the German Patent and Trade Mark Bureau also rejected a registration request. The applicants contend that the registered proprietors have allowed other charities and organisations to use the term “Pink Ribbon” in the UK and as such the term has become generic and no longer can distinguish the activities of the registered proprietors from the activities of others. They state that the words “Pink Ribbon” have become, in English speaking countries, a generic term for breast cancer awareness. The applicants state that there is a great deal of use of the term “Pink Ribbon” in relation to breast cancer but little if any is licensed by the registered proprietors.

6) Further, on 16 October 2008 the applicants filed an invalidity application, subsequently amended, claiming that the mark in suit offended against Sections 3(1)(b), 3(1)(c), 3(1)(d), 3(3)(b), 3(6) and 5(4)(a) of the Act. The applicants rely upon much of what has been said in the earlier revocation action but in addition they state that the registered proprietors were aware of the applicants’ earlier use of the pink ribbon mark in relation to informing the UK public on breast cancer issues. They say that for the registered proprietors to come up with the identical symbol twelve years after the applicants began using the mark in the USA supports their bad faith claim.

7) On 25 March and 16 September 2009 the registered proprietors filed counterstatements denying all the grounds of revocation and invalidity respectively. They point out that any actions which occurred prior to registration cannot assist the applicants under Section 46(1)(c) and (d) as these actions were outside their control. They also point out that much of the “history” referred to by the applicants relates to events outside the UK and are therefore irrelevant. They accept that the term “pink ribbons” has been used in a descriptive sense but deny that this is use of the mark in suit. They state:

“The trade mark PINK RIBBON was registered jointly in the names of the three proprietors as representing members of the Breast Cancer Forum, which is an unincorporated body and, as such, was not able to hold the trade mark registrations in its own name. Permission is

given for other members of the Breast Cancer Forum (most major breast cancer charities in the United Kingdom) to use the trade mark PINK RIBBON and representations of a pink ribbon and consent may be given to commercial users provided that the Proprietors are happy that a legitimate fund-raising operation specifically for breast cancer-related causes is intended.”

8) They also point out that the applicants’ arguments regarding the inability of the mark in suit to act as a badge of origin is undermined by the applicants seeking to register the mark PINK RIBBON and derivatives thereof for their own benefit. They state that the third party use by Gerald Dugdill has been opposed by them. Their opposition to his registering the marks PINK RIBBON MAGAZINE and PINK RIBBON AWARDS were only partly successful and they deny having consented or tolerated the activities of Mr Dugdill. They point out that globally a number of nations have allowed PINK RIBBON registrations.

9) The cases were consolidated late in the day and the evidence in each case is different and my evidence summary will clearly show their origins.

10) In addition, Pink Ribbon Inc. and Brandconcern BV by an application dated 22 June 2009, applied for the revocation of registration 2212576 PINK RIBBON under the provision of Sections 46(1)(a) & (b) claiming there has been no use of the trade mark in suit since its registration or in the five year period 16 October 2003 – 15 October 2008. They are seeking revocation from either 17 June 2005 or 16 October 2008. This revocation action is launched against all of the goods for which this mark is registered:

Class 3: Perfumes; non-medicated toilet preparations, cosmetic preparations; depilatory preparations; toilet articles; soaps; shampoos; preparations for the hair, essential oils; fragrances.

11) The registered proprietor filed a counterstatement on 9 September 2009 stating that the mark had been used on “cosmetic preparations”, or was brought back into use prior to the revocation action being launched.

12) Only the applicants filed evidence in the revocation and invalidity actions (83336 & 83362) against registration 2337786B. In the revocation action (83363) against registration No. 2212576 both sides filed evidence. Both ask for an award of costs. The matter came to be heard on 12 August 2010 when the registered proprietors were represented by Ms Harland of Messrs Reddie & Grose and the applicants by Mr Wood of Messrs Wood Trade Marks and Designs Limited.

APPLICANTS’ EVIDENCE - revocation 83336

13) The applicants filed a witness statement, dated 14 September 2009, by Aaron Ronald Wood the applicants’ Trade Mark Attorney. Mr Wood describes how he carried out a series of internet searches restricted to UK sites. His first search was of the words “breast cancer charity”. The first twenty results are provided at exhibit ARW1. Mr Wood states that in the sponsored links on the upper right hand side of the results page he noted that the top sponsored link uses the words PINK RIBBON STORE as its title. He also notes that Google suggested as a related search the search term BREAST CANCER CHARITY PINK RIBBON. He then visited some of the websites highlighted by the search. He provides print-outs of those visited at exhibit ARW2. These show the following sites:

- Walk the Walk uniting against breast cancer: This does not appear to have any references to pink ribbon or any device of a ribbon. This group was clearly active in 2008.
- Breast cancer Haven: this states that it has branches in London Leeds and Hereford. The letter “A” in “haven” has been replaced by a device of a pink ribbon. It is not clear when this group began operating, and they appear to offer only information and complementary therapies.
- The Pink Ribbon Foundation: Only the front page with the title is provided. It does not show where this body is active.
- Seeking a vaccine against breast cancer: the second letter “A” in the word “against” has been replaced with a ribbon device. This is slightly different to that used by breast cancer haven above but still obviously a ribbon device which is coloured pink. Whilst a UK group there is no indication of when they were set up. It offers links to shopping sites and provides a small percentage of the money spent via its website to customers which it suggests they could use to donate to charity.
- The breast cancer site: This is clearly an American site with the goods on offer priced in dollars.

14) Mr Wood states that he then searched for sites which include the words “Breast Cancer Charity Pink Ribbon” although in his search he did not put these words into quotation marks. The results are therefore all sites which includes these words at some point, but not in any order or even next to each other. Therefore, the fact that there were 30,000 sites listed is not particularly significant. Although the listing is said to be restricted to UK pages it includes a UK domain site for the applicant which is only operational in the USA. Other sites are for electronic manufacturers and insurance companies who have supported breast cancer charities. Mr Woods then reviewed certain selected sites from the 30,000 listed. He provides print outs of those reviewed at exhibit ARW4. The first site, Stockpins.com is an American website which offers lapel pins which feature a pink ribbon device. The next is Zazzle.co.uk, however, it is an American company which will accept orders via the internet from most countries including the UK. The next is Insure Pink, a UK company offering car insurance, which has the device of a pink ribbon replacing the letter “p” in “Pink”. The website shows that they won an award in 2008 and so were active prior to the relevant date. The next page reports on a Pink Ribbon Gala Dinner sponsored by Samsung which raised US\$3million for breast cancer charities in 17 European countries. I assume that this is in 2008 as the gala was held in November, the search carried out in September 2009 and yet the article speaks of funds raised “this year”. The next page shows a silver charm which has a purse with a ribbon motif, the only date shown on this is the search date of 9 September 2009. The next item shows a figurine described as “dressed in glorious pink with symbolic pink ribbon motifs”. The advertisement states that a proportion of the purchase price will go to breast cancer charities, the only date shown on this is the search date of 9 September 2009. An article from the Telegraph, dated 4 October 2005, features on the next page. This describes how each October is now filled with pink products and pink ribbons to promote breast cancer awareness. This mentions its beginnings in New York with Estee Lauder and mentions the registered proprietors. The article is critical of the commercialisation of the campaign.

15) Mr Wood describes how he then searched under the term FUNDRAISING PINK RIBBON and at exhibit ARW5 he provides the first thirty results from this search. He then visited a number of these sites and provides the results at exhibit ARW6. The first is from the Cancer Research UK

website and shows methods of raising money for charity, dress in pink day, cake sale, no-caffeine week, sweets in a jar etc. Included is a group who dressed in pink and posed in the shape of a ribbon, the only date on this exhibit is the search date of September 2009. The next exhibit simply appears to be attacking the commercialisation of breast cancer and appears to have an issue with the way society deals with women. It attacks the sale of everyday objects which are simply coloured pink for October, it is dated 31 January 2007. I do not see the relevance of this article to the instant case. The next article describes the Royston Pink Ribbon Run/Walk which raises money for Cancer Research UK and Marie Curie Cancer Care, and has been in existence for at least three years.

16) Mr Wood then searched under the term “PINK RIBBON” using the speech marks. He attaches the first 30 results at exhibit ARW7. He then visited selected sites and the print outs are provided at exhibit ARW8. The only two sites shown in detail are Dance for Life, a registered charity in the UK raising money for breast cancer and targeting mostly the Israeli community in the UK. This refers to the dance for Life 2009 event held on 26-28 February 2009. Their website has the device of a large pink ribbon on it. It is clear from the information that the group have been in operation since 2001, although it is not clear when they began use of the pink ribbon device. Also featured is Women Aid International which also has pink ribbon devices, and refers to “The Pink Ribbon Project”. This charity is based in London and is raising money for overseas projects connected to breast cancer. It is not clear if the group have only begun using the image of pink ribbons and the word “The Pink Ribbon Project” in relation to this one appeal, or when this appeal began. At exhibit ARW9 a printout from the Pink Ribbon Support website is provided which shows a calendar of events worldwide, for September 2009, including the Great Wall of China Trek and The Great North Run which is a UK event. The website states there are organisations in the UK who can help in the struggle with breast cancer and they mention one such group Breast Cancer Care.

17) At exhibits ARW 10, 11 & 12 Mr Wood provides print-outs from the registered proprietors own websites to show how they use the words PINK RIBBON, images of pink ribbons and the concept of the pink ribbon. Finally, at exhibit ARW13 he provides an advertisement in support of the Caron Keating Foundation which has the word “PINKTOBER” where the letter “O” is replaced by the device of a pink ribbon. This was published on 11 September 2009.

APPLICANTS’ EVIDENCE - invalidity 83362

18) The applicants filed a witness statement, dated 28 January 2010, by Walter Julius Albert Scheffrahn the founder of Brandconcern BV and also the founder of Pink Ribbon Inc. He states that his evidence comes from his own knowledge and the books and papers of his two companies. He also confirms that he is conversant with the English language. He states that at the filing date of the registration there were “a lot of charities using the concept of the pink ribbon, and a large number of third parties using the concept”. He states that this led to consumers being advised to be cautious and that charities were trying to make their ribbons unique. He states that as a result of the use, at the filing date of the registration the term PINK RIBBON and pink ribbons had become common in the area of fundraising for breast cancer, and that they had also been extensively used for fundraising merchandise. He also provides, at exhibit WJAS1, the following website extracts from the Internet archive. The numbers relate to the numbers provided by the fax machine to the whole witness statement and exhibit.

- Page 8/15 is dated 28 January 2003 from the website of Against Breast Cancer which has alongside its name an image of a ribbon. As the copy is in black and white the colour cannot be determined.
- Page 9/15 is dated 11 October 2002 from the Daily Mirror. The article refers to the Pink Ribbon Ball and continues:

“The success of the sell-out ball is a tribute to genuine pink ribbon campaigns, which have become a huge money-generating fixture each October.

But a Sorted investigation can reveal that the fund-raising drive is tarnished by the rogue Pink Ribbon Magazine which is piggy-backing on the good name of the Pink Ribbon breast cancer cause.”
- Page 10/15 from “thinkbeforeyoupink.org”. This refers to the fact that it was launched in 2002 in “response to the growing concern about the overwhelming number of pink ribbon products and promotions on the market”.
- Page 11/15 from www.carolsutton.net. The only discernable date is 28 January 2010. This page is very badly photocopied and most of it is unreadable. What can be seen is “The first pink ribbon on the internet. The history of virtual pink ribbons as an addition to the history of the pink ribbon, the symbol for breast cancer awareness”.
- Page 12/15 refers to an International kite festival on 1 September 2002 at Bristol. It refers to a kite which had a 50ft long tail “in the shape of a pink ribbon- the worldwide symbol of hope”. It states that the kite was flown to promote the work of Cancer Research UK.
- Page 13/15 dated 28 January 2010. It is very badly photocopied and is almost impossible to read.
- Page 14/15 is dated 1 October 2002 from the Action Cancer website. This mentions that they had taken “delivery of the latest consignment of new ‘limited edition’ pink ribbon badges”. This was a pink metal badge which the website says “will help make its ribbons more distinctive and so raise more money for local cancer services”.
- Page 15/15 is dated 12 July 2002 from the Breakthrough Breast Cancer website “urging you to turn October pink by donning the symbolic pink ribbon to show how much you care. Never one to follow the crowd, our ribbon is sparkly, so now you can dazzle for a good cause too.”

APPLICANTS’ WRITTEN SUBMISSIONS - 83336 & 83362

19) On 16 September 2009 the applicants filed submissions. They state:

“The registered proprietors have suggested that the relevant section of the Act only applies where the mark has come to designate the name of goods. This, however, does not reflect the wording of the section which simply requires that as a consequence of acts or inactivity of the proprietor, the mark has become the common name in the trade for a product or service in respect of which it is registered. In that regard, we respectfully suggest that our client’s position is supported by the case of *Julius Samann v Tetrosyl Limited* [2006] EWHC529.

The intention behind the provisions relating to revocation of registrations is to provide the mechanism for a registration to be revoked in circumstances where it would not be appropriate for registration if a fresh application were made as at the date of the application for revocation. Without prejudice to any comments which the applicant for revocation may make in the connected invalidity proceedings, it is our view that at the very least as at the date of revocation the position in the United Kingdom was that the mark would be inappropriate for registration on the basis of the wide-spread use of the marks PINK RIBBON, imagery of pink ribbons or the use of physical pink ribbons in relation to activities and goods connected with breast cancer.

Insofar as the goods for which registration has been achieved are not actual pink ribbons and those goods for which there is no evidence of substantial use to date, it is our view that the so-called “penguin” practice would apply to this situation such that articles in the shape of pink ribbons would be immediately characterised by the words PINK RIBBON. Moreover, as a result of the widespread use of the same, the mark in any event would be objected to on the basis of section 3(1)(b) on the basis that the mark in suit is non-distinctive due to its common use. In effect, the result of the widespread use is that the mark is “generic” beyond those areas where it has been used.”

20) The applicants filed further submissions dated 28 January 2010. These point out that the registered proprietor did not contend that the proviso to Section 3 applied and so they were not relying upon any use of the mark to alter the position which the applicants claim pertained at the date that the mark was registered. The applicants state that in 2002 there was increasing concern over the misuse of the pink ribbon by those not connected to charities and it was against this backdrop that the registered proprietor applied to register the mark. They continue:

“We believe that the reasons for filing the Registration can be inferred from the factual situation at that time, namely that the charities wanted to put a stop to the use of the term by those who did not have charitable motivations, or did not make a sufficiently large contribution. These are aims which should properly have been dealt with by local enforcement agencies (such as Trading Standards or the Charities Commission) rather than by the registration of a trade mark in circumstances where they knew that no one charity could lay claim to the term to the exclusion of all others.”

REGISTERED PROPRIETORS’ EVIDENCE - 83363

21) The registered proprietor filed two witness statements. The first, dated 27 November 2009, is by Linda Jane Harland the registered proprietor’s Trade Mark Attorney. She states:

“3) I am advised by the charities that, in fact, the trade mark has been put to genuine use in the United Kingdom during October of each year for Breast Cancer Awareness Month in respect of cosmetics sold by The Estee Lauder Companies Inc and related and subsidiary companies (Estee Lauder) thereof (collectively, ‘Estee Lauder’) to raise money for breast cancer awareness. That use is use made with the consent of the Charities.”

22) Ms Harland then states that she carried out searches of the internet to identify materials showing this use. She provides copies of her findings at exhibit LJH1 which shows use of the trade mark PINK RIBBON by Estee Lauder in respect of cosmetic preparations during October 2007

and October 2008. The first item is an article from Hello magazine, dated October 2008, which states that Liz Hurley will “sign purchases from the Estee Lauder Pink Ribbon Collection, each of which will include a donation to Breast Cancer Research”. The next exhibit, dated October 2008, is an article from the Telegraph newspaper which refers in an article to the Estee Lauder Pink Ribbon Collection in relation to lipstick. The next page in the exhibit is from the Mail Online dated October 2008 and it shows a photograph of the “Elizabeth Hurley Pink Ribbon Lipgloss Collection”.

23) The second witness statement, dated 30 November 2009, is by Jenny Burley a solicitor employed by the charity Breakthrough Breast Cancer, she is also their company secretary. She states that her company is a member of an unincorporated association called the Breast Cancer Forum. Ms Burley states that in 2001 this forum entered into correspondence with The Estee Lauder Companies Inc. regarding the trade mark PINK RIBBON. At this stage the UK trade mark No. 2212576 was held by a company Milton-Lloyd Ltd which was unconnected to either Estee Lauder or the Breast Cancer Forum. She states that in return for the charities consenting to the use of the mark by Estee Lauder in the UK, Estee Lauder would assist in removing trade mark 2212576 from the UK register. She states that in the event the mark was not removed but assigned to the current proprietors. The proprietors’ copy of this agreement was lost in a major warehouse fire in July 2006 and so attached to the witness statement is the letter, signed only by Breast Cancer Campaign, to Estee Lauder Companies Inc. setting out the terms of the agreement. The agreement, broadly speaking, provides that Estee Lauder can continue to use the pink ribbon trade mark on products to raise awareness of breast cancer provided that it makes a financial contribution to one of the forum members.

APPLICANTS’ EVIDENCE - 83363

24) The applicants filed a witness statement, dated 3 February 2010, by Walter Albert Scheffrahn the founder of Brandconcern BV and also the founder of Pink Ribbon Inc. He states that on 10 July 2008 Estee Lauder Cosmetics Limited filed CTM No. 7057441 for the mark PINK RIBBON. This was opposed by, inter alia, Breast Cancer Care and Breakthrough Breast Cancer. He states the filing of this CTM by Estee Lauder and the opposition by two of the proprietors of UK 2337786B shows that Estee Lauder did not consider themselves to be licensees of the registered proprietors or as requiring the consent of the registered proprietors to use the mark PINK RIBBON, and that “the use and registration of the mark PINK RIBBON was something which had not been dealt with between the registered proprietors and Estee Lauder”.

REGISTERED PROPRIETOR’S ADDITIONAL EVIDENCE - 83363

25) The registered proprietor filed a second witness statement by Jenny Burley, dated 1 April 2010. She provides as an exhibit a copy of the letter sent by the Breast Cancer Forum to Estee Lauder which she obtained from Lovells LLP the solicitors who acted for Estee Lauder Companies Inc in 2001. This is a copy signed by all the members of the Forum, but does not show the signature of anyone from Estee Lauder.

APPLICANTS’ WRITTEN SUBMISSIONS - 83363

26) The applicants did not file any evidence but instead filed submissions. These included comments on whether the registered proprietors’ evidence was admissible. However, at the hearing the applicants accepted that the registered proprietors’ evidence should be regarded as

being properly filed. The applicants point out that Estee Lauder had been using the mark in the UK for a number of years and did not require the consent of the registered proprietors to use the mark. They also point out that if Estee Lauder were licensed by the registered proprietors then why would Estee Lauder apply for the CTM. They also point out that the letter of agreement supplied is not signed by Estee Lauder.

27) That concludes my review of the evidence filed in these proceedings insofar as I consider it necessary.

DECISION

Revocation 83363

28) I will first deal with the revocation action based upon Sections 46(1)(a) and (b) which read as follows:

“46.-(1) The registration of a trade mark may be revoked on any of the following grounds -

- (a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;
- (b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;
- (c)
- (d)

(2) For the purposes of subsection (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made.

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.”

29) The applicants allege that the mark has not been used in the five years following registration and also in the five year period 16 October 2003 – 15 October 2008. The mark in suit was registered on 16 June 2000. The periods in question are, therefore, for Section 46(1)(a) 17 June 2000 – 16 June 2005 and for Section 46(1)(b) 16 October 2003 – 15 October 2008. Thus, giving revocation dates of 17 June 2005 or 16 October 2008.

30) Where the registered proprietors claim that there has been use of the trade mark, the provisions of Section 100 of the Act make it clear that the onus of showing use rests with them. It reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

31) The guiding principles to be applied in determining whether there has been genuine use of a mark are *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 and *Laboratoire de la Mer Trade Mark* [2006] F.S.R. 5. From these cases I derive the following main points:

- genuine use entails use that is not merely token. It must also be consistent with the essential function of a trade mark, that is to say to guarantee the identity of the origin of goods or services to consumers or end users (*Ansul*, paragraph 36);
- the use must be ‘on the market’ and not just internal to the undertaking concerned (*Ansul*, paragraph 37);
- it must be with a view to creating or preserving an outlet for the goods or services (*Ansul*, paragraph 37);
- the use must relate to goods or services already marketed or about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37);
- all the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account (*Ansul*, paragraph 38);
- the assessment must have regard to the nature of the goods or services, the characteristics of the market concerned and the scale and frequency of use (*Ansul*, paragraph 39);
- but the use need not be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39);
- an act of importation could constitute putting goods on the market (*Laboratoire de la Mer*, paragraph 25 referring to the earlier reasoned order of the ECJ);
- there is no requirement that the mark must have come to the attention of the end user or consumer (*Laboratoire de la Mer*, paragraphs 32 and 48);
- what matters are the objective circumstances of each case and not just what the proprietor planned to do (*Laboratoire de la Mer*, paragraph 34);
- the need to show that the use is sufficient to create or preserve a market share should not be construed as imposing a requirement that a significant market share has to be achieved (*Laboratoire de la Mer*, paragraph 44).

32) I also take note of the CFI case T-334/01, *MFE Marienfelde GmbH v OHIM* (HIPOVITON) where at paragraph 37 they stated:

“37. However, the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the party opposing new registration to produce additional evidence to dispel possible doubts as to its genuineness.”

33) The registered proprietors stated in their evidence that the mark is not used on the goods by themselves but is used by Estee Lauder Cosmetics Inc. with their consent. There is clear evidence of use of the mark PINK RIBBON in relation to cosmetics in the exhibits provided. The applicants’ main contention seemed to be focussed upon whether the use shown could be construed as use with the consent of the registered proprietor. The applicants pointed out that the versions of the agreement filed did not include a version signed by Estee Lauder. The registered proprietor’s evidence covered the issue of the warehouse fire which destroyed the original but did not say why a copy was not obtained from Estee Lauder. However, the evidence of Ms Harland and Ms Burley is not challenged and nor were they called to be cross examined. The applicants questioned why Estee Lauder would give up its rights to the mark in suit as it is clear from the evidence that it used the mark prior to the registration being applied for by the registered proprietors. To my mind this is very obvious from the various press articles that have been filed. It seems clear that Estee Lauder is upholding the finest traditions of corporate America in utilising its reputation to raise both awareness and cash for reputable charities. That it should choose to relinquish a commercial position in the interests of a worthy cause may seem odd to the applicants but it rings true to any who are aware of the reputation of the company. Similarly, the issue of the filing of a CTM by Estee Lauder to prevent the applicants in the instant case obtaining a registration of the mark follows the same pattern. Tactically, Estee Lauder would have been better placed to file such a registration and also to pay the fees, whilst at the same time informing the registered proprietors of its actions and allowing and even encouraging them to oppose. As a method to achieve the goal of preventing others registering the mark it is a sensible method. I do not find any of this incredible and although the evidence of use and documentation provided was not as robust as I would have preferred I have to judge the matter on the balance of probabilities. In doing so I find that the evidence provided is sufficient to show that the mark has been used on cosmetic preparations by Estee Lauder operating with the consent of the registered proprietor. The application for revocation therefore fails in respect of cosmetic preparations, although it succeeds with regard to the balance of the specification which was not defended by the registered proprietors, having acknowledged in their counterstatement that the mark had not been used other than on cosmetic preparations.

REVOCAION 83336

34) I now turn to the grounds under Section 46(1)(c) and 46(1)(d) which read:

“46.-(1) The registration of a trade mark may be revoked on any of the following grounds:

(a)....

(b)....

(c) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered;

(d) that in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality, or geographical origin of those goods or services.”

35) I have to determine the relevant date for the revocation. In *Scandecor Development AB v Scandecor Marketing AB* [2002] FSR 7 Lord Nicholls stated:

“49 The claim in these proceedings is that, in consequence of the use made of the marks by Scandecor Marketing and Scandecor Ltd with the consent of Scandecor International, the marks are "liable to mislead the public". That is essentially a question of fact. That question of fact must be answered having regard to matters as they now are, not as they were at some time in the past. In deciding this issue of fact the court must have due regard, as I have been at pains to emphasise, to the message which a trade mark conveys. But since the question is whether the marks are currently liable to mislead, the message which is relevant is the message which use of the marks conveys today, not the message it would have conveyed to the public in the past.”

36) Clearly he was taking the date of the trial as the date at which the question had to be considered. This was a case dealing with section 46(1)(d) of the Act, revoking a trade mark registration on the basis that in consequence of the use made of it, it is liable to mislead the public. It is therefore on all fours with the current case.

37) The applicants contend that there has been use of the mark in suit by a number of parties and that has not been exclusively with the consent of the registered proprietors. They state that as a result of this use the public does not see the mark in suit, PINK RIBBON, as indicating the origin of the goods and services for which the mark is registered. They state that the mark in suit “has become the common name in the trade for a product or service for which it is registered”. They refer in particular to the exhibits ARW1-13. They point out that the registered proprietor did not file any evidence in defence. The applicants referred me to two cases. The first is case O-388-99 VOICE PERSONALS. However, in this case the Hearing Officer determined the matter under the grounds for invalidity under Sections 3(1)(b) and 3(1)(d) and therefore declined to make a finding under Section 46(1)(c). The second case relied upon by the applicants is *Julius Samann Ltd v Tetrosyl Ltd* [2006] ETMR 75 in which Kitchen J. said:

“Art.12(2)(a)

111. Article 12 of the Directive (Art.51 of the Regulation is in like terms) reads, so far as relevant:

“2 A trade mark shall also be liable to revocation if, after the date on which it was registered,
(a) in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service in respect of which it is registered”.

112. Tetrosyl recognised that this was not its strongest ground of attack on the Tree marks. Nevertheless it contends that as a result of the acts or inactivity of the claimants the Tree marks have become the common name in the trade for air fresheners. The argument runs as follows:

- (i) First, the fact that the language refers to “the” common name in the trade does not mean that it must be the only name, taking a purposive construction: [Hormel Foods Corp v Antilles Landscape Investments NV \[2005\] R.P.C. 28](#) ;
- (ii) Secondly, the words “in the trade” do not confine the inquiry to professional traders. The perception of the public plays a decisive role: Case C371/02 [Bjornekulla Fruktindustrier AB v Procordia Food AB \[2004\] R.P.C. 45](#) ;

- (iii) The language of Art.12(2)(a) cannot have been intended to cover word marks only, notwithstanding reference to the “common name in the trade”;
- (iv) A tree shape in the form sold by the claimants and variations thereof (i.e. the concept of a tree shape about two or three inches in height, that hangs from a rear view mirror) is generic. Such items are not seen as having trade mark significance but are seen in the same way as other ornaments that commonly hang from a rear view mirror, such as boxing gloves, furry dice, religious symbols and so on;
- (v) They are generic for the goods in issue, namely car deodorants and car air fresheners;
- (vi) The reason for this is in large part due to the inactivity of the claimants. While they have occasionally taken action against some third parties, they have allowed many others to remain unchecked over many years.

113. Although I accept the first two propositions, the argument must be rejected. First, there must be considerable doubt as to whether this provision could ever apply to device marks such as the Tree marks. They are not word marks and do not contain words. Nor are they marks which have come to be referred to by words which are common in the trade. On the contrary, the evidence showed that the products of the claimants are referred to, if anything, by the name Magic Tree and there is no suggestion that this has become common in the trade.

114. Secondly, and assuming the objection is available against device marks, the evidence fails to establish that carded air fresheners in the shape of fir trees or fir tree devices have become common in the trade. The only tree shaped product on the market for any length of time is the Mighty Oak. I have already concluded that this is visually distinct from the Tree marks but in any event it does not establish that tree shapes are generic. As to carded air freshener products having fir tree shapes, the claimants have taken vigorous steps over the years to prevent such use and have been successful in doing so. Further, and for the reasons I have given, far from being generic the Tree marks are distinctive of the claimants.

115. This attack on the Tree marks also fails.”

38) The applicant relies upon its evidence provided in exhibits ARW1-13 inclusive. However, I note that much of this evidence cannot be taken into account. Some of the exhibits are unclear as to where the group who own the website operate or when they began their activity. Other exhibits refer to activity outside the UK which also cannot be taken into account, or refer to companies such as electronics manufacturers or insurance companies that have referred to their support for such charities. Some of the exhibits also referred to the activity of the registered proprietors. These considerations restrict the evidence that I have to consider to:

- The use of a device of a pink ribbon, by a group offering information and complementary therapies.
- The use of a pink ribbon device offering links to shopping sites and providing a small percentage of the money spent via its website to customers which it suggests they could use to donate to charity.
- The use by an insurance company, Insure Pink, which has the device of a pink ribbon replacing the letter “p” in “Pink”.

- The use of the term “Pink Ribbon Gala Dinner” by electronics company Samsung.
- An article from the Telegraph, dated 4 October 2005, describing how each October is now filled with pink products and pink ribbons to promote breast cancer awareness. This mentions its beginnings in New York with Estee Lauder and mentions the registered proprietors. The article is critical of the commercialisation of the campaign.
- Use of a ribbon motif on a silver charm in the shape of a purse.
- A figurine described as “dressed in glorious pink with symbolic pink ribbon motifs”. The advertisement states that a proportion of the purchase price will go to breast cancer charities.
- The use of the term the “Royston Pink Ribbon Run/Walk” for fund raising for charities.
- A dance party, organised to raise funds for charity which has on its website the device of a large pink ribbon on it.
- A charity for overseas projects which uses pink ribbon devices, and refers to “The Pink Ribbon Project”, under its own name.
- Use on a website of the name Pink Ribbon Support which states there are organisations in the UK who can help in the struggle with breast cancer.
- An advertisement for a concert in support of the Caron Keating Foundation which has the word “PINKTOBER” where the letter “O” is replaced by the device of a pink ribbon.
- A newspaper article reporting on the Pink Ribbon Ball and warning of parasites piggy-backing on the respectable charity, it names Pink Ribbon magazine in this context.
- A website article referring to “the overwhelming number of pink ribbon products and promotions on the market”.
- A kite which had a 50ft long tail in the shape of a pink ribbon flown to promote the work of Cancer Research UK.
- Pink ribbon badges offered for sale.

39) In my opinion the applicant has failed to show in its evidence that the words “pink ribbon” or even a device consisting of an image of a pink ribbon had become a common name in the trade for the goods and services for which the mark in suit is registered. The evidence shows scant use by a number of disparate groups offering goods and services and media articles questioning the use of the colour pink on all manner of everyday goods in an attempt to piggyback upon the work done by specific charities in raising awareness of the issue of breast cancer during the month of October. I accept that during October any use of the colour pink will remind the average consumer of breast cancer. However, this does not mean that the mark in suit has become common in the trade. Clearly, the evidence does not support such a finding. Nor do I believe that the public will be misled in any way as to the nature, quality, or geographical origin of those goods or services. I also note that the grounds under Section 46(1)(c) and (d) can only succeed owing to the actions

and inactions of the proprietor. To my mind this has not been established. The grounds of revocation based upon Sections 48(1)(c) and (d) therefore fail.

INVALIDITY

40) At the hearing the grounds of invalidity under Sections 5(4)(a) and 3(3)(b) were withdrawn. I shall first consider Section 3(6) which reads:

“3. (6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

41) Section 3(6) has its origins in Article 3(2)(d) of the Directive, the Act which implements Council Directive No. 89/104/EEC of 21 December 1988 which states:

“Any Member State may provide that a trade mark shall not be registered or, if registered, shall be liable to be declared invalid where and to the extent that....

(c) the application for registration of the trade mark was made in bad faith by the applicant.”

42) The Directive gives no more clue as to the meaning of “bad faith” than the Act. Subsequent case law has avoided explicit definition but has not shirked from indicating its characteristics. In *AJIT WEEKLY Trade Mark* [2006] RPC 25, Professor Ruth Annand sitting as the Appointed Person held as follows:

“[35] ... Bad faith is to be judged according to the combined test of dishonesty for accessory liability to breach of trust set out by the majority of the House of Lords in *Twinsectra Ltd v Yardley* [2002] 2 AC 164, with *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 providing the appropriate standard, namely acceptable commercial behaviour observed by reasonable and experienced persons in the particular commercial area being examined.....

[41] ... the upshot of the Privy Council decision in *Barlow Clowes* is: (a) to confirm the House of Lords’ test for dishonesty applied in *Twinsectra*, i.e. the combined test [footnote omitted]; and (b) to resolve any ambiguity in the majority of their Lordships’ statement of that test by making it clear that an enquiry into a defendant’s views as regards normal standard of honesty is not part of the test. The subjective element of the test means that the tribunal must ascertain what the defendant knew about the transaction or other matters in question. It must then be decided whether in the light of that knowledge, the defendant’s conduct is dishonest judged by ordinary standard of honest people, the defendant’s own standards of honesty being irrelevant to the objective element....

[44] In view of the above and in particular the further clarification of the combined test given by the Privy Council in *Barlow Clowes*, I reject Mr Malynicz’s contention that the Hearing Officer erred in failing to consider the registered proprietor’s opinions on whether its conduct in applying for the mark fell below ordinary standard of acceptable commercial behaviour.”

43) In asserting that the marks were registered in bad faith, the onus rests with the applicant for invalidity to make a prima facie case. A claim that a mark was registered in bad faith implies some

deliberate action by the registered proprietor which a reasonable person would consider to unacceptable behaviour or, as put by Lindsay in the *Gromax* trade mark case [1999] RPC 10:

“includes some dealings which fall short of the standards of acceptable commercial behaviour”.

44) The issue must be determined on the balance of probabilities. On the basis of these authorities it is clear that a finding of bad faith may be made in circumstances which do not involve actual dishonesty. Furthermore, it is not necessary for me to reach a view on the registered proprietor’s state of mind regarding the application for registration if I am satisfied that their actions in applying for the mark in the light of all the surrounding circumstances would have been considered contrary to normally accepted standards of honest conduct.

45) I also take into account the comments of Mr Arnold Q.C (as he was) when acting as the Appointed Person in *Extreme O/161/07* where he commented on the issue of unchallenged evidence and cross examination:

“Unchallenged evidence

33. *Phipson on Evidence* (16th ed) states at paragraph 12-12:

In general a party is required to challenge in cross-examination the evidence of any witness of the opposing party if he wishes to submit to the court that the evidence should not be accepted on that point. The rule applies in civil cases as it does in criminal. In general the CPR does not alter that position.

This rule [sic] serves the important function of giving the witness the opportunity of explaining any contradiction or alleged problem with his evidence. If a party has decided not to cross-examine on a particular important point, he will be in difficulty in submitting that the evidence should be rejected.

However the rule is not an inflexible one...

34. The authority cited in support of this statement of the law is the decision of the House of Lords in *Browne v Dunn* (1894) 6 R 67. The relevant passages from the speeches are set out in the judgment of Hunt J in *Allied Pastoral Holdings v Federal Commissioner of Taxation* (1983) 44 ALR 607, the material parts of which are quoted in the judgment of the Court of Appeal in *Markem Corp v Zipher Ltd* [205] EWCA Civ 267, [2005] RPC 31 at [59]-[60].

35. In my judgment the learned editors of *Phipson* are correct to say that the rule is not an inflexible one. There are at least two well-established exceptions to it. The first is that, as the speech of Lord Herschell LC in *Browne v Dunn* makes clear, it may not be necessary to cross-examine on a point if the witness has been given full notice of it before making his statement. As I pointed out in *BRUTT Trade Marks* [2007] RPC 19 at [23], this may be significant in registry proceedings where evidence is given sequentially. The second is that a court is not obliged to accept a witness’s evidence in the absence of cross-examination if it is obviously incredible: see *National Westminster Bank plc v Daniel* [1993] 1 WLR 1453.

36. Where, however, evidence is given in a witness statement filed on behalf of a party to registry proceedings which is not obviously incredible and the opposing party has neither

given the witness advance notice that his evidence is to be challenged nor challenged his evidence in cross-examination nor adduced evidence to contradict the witness's evidence despite having had the opportunity to do so, then I consider that the rule in *Brown v Dunn* applies and it is not open to the opposing party to invite the tribunal to disbelieve the witness's evidence.

37. Despite this, it is not an uncommon experience to find parties in registry hearings making submissions about such unchallenged evidence which amount to cross-examination of the witness in his absence and an invitation to the hearing officer to disbelieve or discount his evidence. There have been a number of cases in which appeals have been allowed against the decisions of hearing officers who have accepted such submissions. Two recent examples where this appears to have happened which were cited by counsel for the proprietor are *Score Draw Ltd v Finch* [2007] EWHC 462 (Ch), [2007] BusLR 864 and *EINSTEIN Trade Mark* (O/068/07). Another recent example is *Scholl Ltd's Application* (O/199/06). I consider that hearing officers should guard themselves against being beguiled by such submissions (which is not, of course, to say that they should assess evidence uncritically)."

46) I am also aware of the comments of Mr Arnold Q.C. (as he was then) acting as the Appointed Person in *BRUTT Trade Marks* [2007] RPC 19 where he said:

"Cross-examination

23. It is the function of cross-examination to assist the tribunal to resolve conflicts of evidence. I agree with the hearing officer in thinking that cross-examination would have assisted him in the present case. It does not follow, however, that cross-examination is essential in a case where bad faith is alleged or that the tribunal cannot assess evidence or make findings of fact in its absence. Fairness requires that adverse findings should not ordinarily be made against a witness, such as a finding that he has acted in bad faith, without the witness having the charge put to him and being given an opportunity to answer it: see *Allied Pastoral Holdings v Federal Commissioner of Taxation* (1983) 44 ALR 607 at 623. It should be borne in mind, however, that in proceedings such as these evidence is served sequentially and that giving a witness a proper opportunity to deal with a point will not necessarily require cross-examination.

More importantly, perhaps, if the opportunity for cross-examination is passed up, the consequence is that the tribunal must assess the evidence on that basis rather than refraining from considering the evidence and reaching a conclusion. It is instructive to remember that OHIM and the courts in most civil law jurisdictions consider themselves perfectly well-equipped to make findings that parties have acted in bad faith without the benefit of cross examination."

47) The applicant did not challenge the evidence of Ms Burley for the registered proprietor nor did they seek to cross examine her as to perceptions at the time of the application. It is contended by the applicant that at the time of the application the registered proprietor would have been aware of the use of the term PINK RIBBON by others. I was referred to the ECJ decision in *Chocoladefabriken Lindt & Sprungli AG v Franz Hauswirth GmbH* where they ruled that all the relevant factors must be taken into account such as:

“The fact that the applicant knows or must know that a third party is using, in at least one Member State, an identical or similar sign for an identical or similar product capable of being confused with the sign for which registration is sought;

the applicant’s intention to prevent that third party from continuing to use such a sign; and

the degree of legal protection enjoyed by the third party’s sign and by the sign for which registration is sought.”

48) The registered proprietor was clearly aware of the use made in the USA of the mark PINK RIBBON by Estee Lauder. However, as they had signed an agreement with this company allowing them use of the mark this usage cannot be taken into consideration. The use of the mark by a variety of bodies in the USA is of no relevance to the instant case. Use shown in the UK prior to the relevant date is limited and appears to be use of the word “pink” or pink items. Other use is of a device element of a pink ribbon but with various additions which are potentially more dominant elements. Other use shown appears to be by members of the group which signed an agreement with Estee Lauder and so are licensed users. The applicant also refers to the “open” nature of the mark. This seems to suggest that charities should not be able to register marks where they relate to issues where there will be considerable interest. I take the view that having a group of charities, such as in the instant case, which are willing to come together in using a mark which promotes the overall message of awareness of breast cancer, whilst allowing them to work individually on aspects of their particular interest is perfectly acceptable. By registering the mark it allows them to license or acquiesce to use by those with the same values as themselves whilst preventing its use by chancers, parasites and ne’er-do-wells. Taking all the relevant factors into account I do not believe that the application was made in bad faith. The ground under Section 3(6) fails.

49) I now turn to the grounds under 3(1)(b), 3(1)(c) and 3(1)(d) which read:

“ 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,
- (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.”

50) The relevant date is the date of the application, 14 July 2003. Although the registered proprietor can benefit from use after the date of registration to show acquired distinctiveness.

51) At the hearing the ground under Section 3(1)(c) was reduced so that it relates solely to the services under Class 36.

52) It is clear from the views expressed by the European Court of Justice in *Companyline* [2003] E.T.M.R. 20 and the High Court in *Have a Break* [2002] EWHC 2533 (Ch) that Section 3(1)(b) has separate and independent scope from Sections 3(1)(c) & (d). Therefore, I have to consider each section separately.

53) I turn first to consider the position under Section 3(1)(c). There are a number of European Court of Justice judgments which deal with the scope of Article 3(1)(c) of First Council Directive 89/104 and Article 7(1)(c) of Council Regulation 40/94 (the Community Trade Mark Regulation), whose provisions correspond to Section 3(1)(c) of the UK Act. I derive the following main guiding principles from the cases noted below:

- subject to any claim in relation to acquired distinctive character, signs and indications which may serve in trade to designate the characteristics of goods or services are deemed incapable of fulfilling the indication of origin function of a trade mark – (*Wm Wrigley Jr & Company v OHIM* – Case 191/01P (Doublemint) paragraph 30;
- thus Article 7(1)(c) (Section 3(1)(c)) pursues an aim which is in the public interest that descriptive signs or indications may be freely used by all – *Wm Wrigley Jr v OHIM*, paragraph 31;
- it is not necessary that such a sign be in use at the time of application in a way that is descriptive of the goods or services in question. It is sufficient that it could be used for such purposes – *Wm Wrigley Jr v OHIM*, paragraph 32;
- it is irrelevant whether there are other, more usual signs or indications designating the same characteristics of the goods or services. The word ‘exclusively’ in paragraph (c) is not to be interpreted as meaning that the sign or indication should be the only way of designating the characteristic(s) in question – *Koninklijke KPN Nederland NV v Benelux Merkenbureau*, Case C-363/99 (Postkantoor), paragraph 57;
- if a mark which consists of a word produced by a combination of elements is to be regarded as descriptive for the purposes of Article 3(1)(c) it is not sufficient that each of its components may be found to be descriptive, the word itself must be found to be so – *Koninklijke KPN Nederland NV v Benelux Merkenbureau*, paragraph 96;
- merely bringing together descriptive elements without any unusual variations as to, for instance, syntax or meaning, cannot result in a mark consisting exclusively of such elements escaping objection – *Koninklijke Nederland v Benelux Merkenbureau*, paragraph 98;
- an otherwise descriptive 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 trade 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 – *Koninklijke Nederland NV v Benelux Markenbureau*, (*Postkantoor*), paragraph 99.

54) I note the comments made in *Matratzen Concord AG v Hukla Germany SA* Case C-421/04) where the ECJ stated:

“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, who are 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 KPN Nederland* [2004] ECR I-1619, paragraph 77; and Case C-218/01 *Henkel* [2004] ECR I-1725, paragraph 50)”.

55) I am also mindful of the decision of the General Court (formerly CFI) in *Ford Motor Co v OHIM*, Case T-67/07 where it was stated:

“there must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the category of goods and services in question or one of their characteristics.”

56) It is clear from the above that I must determine whether, assuming notional and fair use, the mark in suit, will be viewed by the average consumer to directly designate the essential characteristics, “kind” and “intended purpose”, of the Class 36 services for which invalidity is sought. Only if the mark is no different from the usual way of designating the relevant services or their characteristics can it be debarred from registration. The services concerned are as follows: “Insurance; financial affairs; monetary affairs; real estate affairs; charitable fundraising services; credit card services.”

57) The applicant’s evidence has been summarised earlier at paragraph 38, and I see no reason to repeat it here.

58) It is claimed that the words “pink ribbon” and images of pink ribbons are not only entirely descriptive and non-distinctive, but serve in the trade to indicate the kind of service being offered. However, the evidence shows only one instance of use in relation to insurance services and none in relation to financial affairs; monetary affairs; real estate affairs or credit card services. Further, I do not believe that the mark is inherently non-distinctive or descriptive such that it “may” serve in trade to indicate the kind of service being offered etc. The invalidity action against these services must therefore fail.

59) With regard to the “charitable fundraising” services for which the mark is registered there is a limited amount of use shown by others, and some use shown by the registered proprietors and by members of the Forum. In my opinion, the use shown is unlikely to mislead the public or serve in trade with regard to the kind, quality, quantity, intended purpose, value, geographical origin, the time of rendering of services, or other characteristics of the services. As to the media articles it refers to unauthorised use of the image of pink ribbons and also use of the colour pink along with spurious claims regarding donations to charity. The fact that a mark is being used by unscrupulous charlatans is no reason for determining that the mark in suit fails the test under Section 3(1)(c). Therefore, the invalidity action under Section 3(1)(c) in relation to all of the services in Class 36 must fail.

60) I now turn to consider the issue under Section 3(1) (d) of the Act. The applicant alleges that the mark in suit had become “generic in the trade”. However, as I have outlined already in this decision the evidence filed by the applicant does not support such a claim as there is very little evidence of use by others in the UK in trade. The invalidity action under Section 3(1)(d) therefore fails.

61) I now turn to consider the ground of invalidity under Section 3(1)(b). In doing so I adopt the approach summarised by the ECJ in its judgment in *Linde AG, Windward Industries Inc and Rado Uhren AG* Joined Cases C-53/01 to C- 55/01:

“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 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 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.”

62) I must determine whether the trade mark applied for is capable of enabling the relevant consumer of the goods and services in question to identify the origin of the goods and services and thereby to distinguish them from other undertakings. In *SAT.1 Satelliten Fernsehen GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-329/02 the ECJ provided the following guidance:

“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.”

63) In *Cycling Is... Trade Mark*, [2002] R.P.C. 37, Mr Hobbs QC stated:

“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.”

64) It is clear from the above that I must assess the mark’s distinctiveness in relation to the goods and services for which mark is registered. I must also take into account the perception of the relevant consumer of the goods and services which, to my mind, means the general public.

65) In their submissions, the applicant for invalidity stated:

“It is our submission that as a result of the widespread use of the words pink ribbon, images of pink ribbons and physical pink ribbons in connection with fundraising, awareness and merchandise in connection with breast cancer the words PINK RIBBON no longer serve as a trade mark in relation to the goods and services for which they are registered under the registration at issue.”

And:

“Insofar as the goods which registration has been achieved are not actual pink ribbons and those goods for which there is no evidence of substantial use to date, it is our view that the so-called “penguin” practice would apply to this situation such that articles in the shape of pink ribbons would be immediately characterised by the words PINK RIBBON. Moreover, as a result of the widespread use of the same, the mark in any event would be objected to on the basis of section 3(1)(b) on the basis that the mark is non-distinctive due to its common use. In effect, the result of the widespread use is that the mark is “generic” beyond those areas where it has been used.”

And also:

“In 2002 there was concern about the misuse of the term PINK RIBBON or the sale of pink ribbon-inspired merchandise by companies not connected to breast cancer, or by those who did not donate enough to charity. This had come to the attention of the national press. Individuals were concerned. Websites and organisations were set up with the purpose of dispelling the misconceptions of the public. Charities were creating particular pink ribbons to try to mark themselves out from the crowd. Many companies were using the term.

It is against this backdrop that the Registered Proprietors applied to register the mark PINK RIBBON. It was at a time that the words PINK RIBBON and physical pink ribbons had come to be used on a significant scale to identify activities to raise funds in support of the treatment, cure and publicising of breast cancer. It was a term that was being used and misused widely. The internal motivations of the charities to register these marks at that time is not known, but they were professionally represented and must have known the effect of registering trade marks. They must have known that no one company could legitimately make a claim to the mark PINK RIBBON to the exclusion of all others in the UK given the factual background.

On that basis we suggest that the words PINK RIBBON were not available for registration as at the filing date of the Registration, and that it is a registration which should be declared invalid on the basis of the arguments presented at the time of filing of this application. The term was exclusively descriptive (s.3(1)(c)), had become “generic” in the trade (s.3(1)(d)) and was origin-neutral no longer serving to distinguish the goods and services (s.3(1)(b)).

We believe that the reasons for filing the Registration can be inferred from the factual situation at the time, namely that the charities wanted to put a stop to the use of the term by those who did not have charitable motivations, or did not make a sufficiently large contribution. These are aims which should properly have been dealt with by local enforcement agencies (such as Trading Standards or the Charities Commission) rather than be the registration of a trade mark in circumstances where they knew that no one charity could lay claim to the term to the exclusion of all others.”

66) I must therefore consider the issue from the perspective of someone who encounters the mark “PINK RIBBON” used in relation the goods and services for which the mark is registered and determine how that person would react. It is clear that the words have a well known literal meaning as referring to narrow strips of fine material, such as silk, which are pink in colour.

67) At the hearing the opponent did not make a case against each of the goods and services but relied upon an overall view that the mark in suit was descriptive and/or non-distinctive. Although it was claimed that there was extensive use of the mark in suit prior to registration, even allowing for the evidence of use in the years since registration it is clear that the use by third parties has been limited. The media are, correctly, concerned that the public are not duped by criminals who, from the reports filed, seem to be mostly using pink coloured items and assertions that the purchase price includes an amount that will go to good causes. The amount of use by others in relation to retailing or fundraising is scant and these groups tend to use marks which whilst they contain an image of a pink ribbon have considerable other distinctive and dominant characteristics. Reviewing the goods and services registered the mark in suit is clearly distinctive for them all. The average consumer would find that it functioned as an indication of origin. The invalidity action under section 3(1)(b) therefore fails with regard to all the goods and services.

COSTS

68) As the registered proprietors have been successful they are entitled to a contribution towards costs. There are three sets of proceedings even though there was only one hearing, the costs reflect the fact that they were not consolidated until part way through the process. I order the applicant to pay the registered proprietor the sum of £3,500. This sum is calculated as shown below and is to be

paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Preparing a statement and considering the other side's statement	£1200
Preparing evidence and considering and commenting on the other side's evidence	£1400
Prepare for and attend a hearing	£900
TOTAL	£3,500

Dated this 15 day of November 2010

**G W Salthouse
For the Registrar
the Comptroller-General**