

**O-578-16**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 500975  
BY LA MER TECHNOLOGY INC.  
FOR REVOCATION OF TRADE MARK No. 1402537  
STANDING IN THE NAME OF  
LABORATOIRE DE LA MER**

## BACKGROUND

1) The following trade mark is registered in the name of Laboratoire De La Mer (hereinafter LDL).

Mark	Number	Date registered	Class	Specification
LABORATOIRE DE LA MER	1402537	07.02.92	3	Cosmetics containing marine products; all included in Class 03.

2) By an application dated 1 September 2015 La Mer Technology Inc. (hereinafter LMT) applied for the revocation of the registration shown above under the provisions of Section 46(1)(b) claiming there has been no use of the trade mark on the goods for which it is registered in the five year period 1 September 2010 – 31 August 2015. Revocation is sought from 1 September 2015.

3) On 3 November 2015 LDL filed its counterstatement. LDL contends that its mark and/or a mark differing in elements which do not alter the distinctive character of the registered mark has been used during the specified period.

4) Both sides filed evidence. The matter came to be heard on 23 November 2016 when Mr Barlett of Messrs Beck Greener represented LMT. LDL chose not to attend but relied upon submissions previously filed which I shall refer to as and when required in my decision.

## DECISION

5) The revocation action is based upon Section 46(1)(b) of the Trade Marks Act 1994, the relevant parts of which read as follows:

“Section 46(1) of the Act states that:

“The registration of a trade mark may be revoked on any of the following grounds-

(a) ...

(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 purpose 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.

(4) An application for revocation may be made by any person, and may be made to the registrar or to the court, except that –

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from –

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date.”

6) Section 100 is also relevant, which reads:

“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.”

7) Revocation is sought under Section 46(1)(b) in respect of the time period 1 September 2010 – 31 August 2015. Revocation is therefore sought from 1 September 2015. The revocation action was filed on 1 September 2015.

8) LDL have provided evidence of use of the mark in suit in respect of two ranges of products in the UK. The product ranges were sold under the names RESPIMER and AUDICLEAN with the mark in suit included upon packaging and instruction leaflets. This aspect is not in dispute. The dispute between the companies revolves around precisely what goods the marks were used upon. LDL insists that the use was upon “cosmetics” for which the mark was registered whilst LMT contend that the goods do not fall within the normal definition of “cosmetics” and that the products are in fact medicinal.

9) In its initial evidence and evidence in reply LDL describes the products as follows:

a) RESPIMER: “is a nasal wash used to cleanse the nose and sinuses.”

b) AUDICLEAN: “is a range of products used to prevent build-up of excess earwax.”  
The range consisted of two products an ear cleansing wash and an ear wax remover.

10) LDL provide, at exhibit NS1, a copy of the European Union Regulation on cosmetic products (EC 1223/2009) (the Regulation). LDL point out Article 2(1)(a) of the Regulation defines a “cosmetic product” as:

“means any substance or mixture intended to be placed in contact with the external parts of the human body (epidermis, hair system, nails, lips and external genital organs) or with the teeth and the mucous membranes of the oral cavity with a view exclusively or mainly to cleaning them, perfuming them, changing their appearance, protecting them, keeping them in good condition or correcting body odours.”

6. Audiclean is a substance which is intended to be placed in contact with the epidermis of the ears with a view to cleaning and protecting the ears and keeping them in good condition.

7. Respimer is a substance which is intended to be placed in contact with the mucous membranes of the nasal cavity with a view to cleaning and protecting them and keeping them in good condition. Although the nasal cavity is not referred to expressly in the definition of “cosmetic product” under the Regulation, we submit that the reference to oral cavity should be interpreted as extending to the nasal cavity.”

8. Accordingly, Audiclean and Respimer are both cosmetic products under the Regulation and should both be treated as cosmetic products for the purposes of this application.”

11) LDL state:

“6. Audiclean is a substance which is intended to be placed in contact with the epidermis of the ears with a view to cleaning and protecting the ears and keeping them in good condition.

7. Respimer is a substance which is intended to be placed in contact with the mucous membranes of the nasal cavity with a view to cleaning and protecting them and keeping them in good condition. Although the nasal cavity is not referred to expressly

in the definition of “cosmetic product” under the Regulation, we submit that the reference to oral cavity should be interpreted as extending to the nasal cavity.

8. Accordingly, both Audiclean and Respimer are both cosmetic products under the Regulation and should both be treated as cosmetic products for the purposes of this application.”

12) I note that Article 2(2) of the Regulation states:

“2(2): For the purposes of point (a) of paragraph 1, a substance or mixture intended to be ingested, inhaled, injected or implanted into the human body shall not be considered to be a cosmetic product.”

13) Having considered LDL’s initial evidence LMT comment that the two products, Audiclean and Respimer, upon which the mark has been used on in the UK are not cosmetics. It points out that the New Shorter Oxford English Dictionary (1993) provides the following definition of the word “cosmetic”: “A preparation for use in beautifying the face, skin or hair”. In a highly detailed analysis of LDL’s various websites and also the packaging for both of the products, Audiclean and Respimer, LMT point out that LDL itself describes the products, the users, how to use them, when to use them and why you should use them utilising, *inter alia*, the following words:

RESPIMER:

- a) “Class 1 medical device”;
- b) This medical device is a regulated healthcare product;
- c) Mild irrigation in case of moderate symptoms;
- d) Intense irrigation in case of severe symptoms;
- e) Pharmaceutical grade complex;
- f) correct dosage; nasal irrigation helps to reduce symptoms in the nose and sinuses such as headaches, facial pressure, nasal congestion and rhinorrhea;
- g) Respimer Netiflow is an effective nasal irrigation device that is useful and suitable for the treatment of rhinosinusitis. By administering 240 ml of solution with suitable pressure and flow, nasal irrigation means that the nose and the passages leading to the sinuses are thoroughly cleaned;

- h) Nasal lining is therefore cleansed and the healing process facilitated;
- i) Patients;

## AUDICLEAN

- a) Audiclean is approved as a medical device CE 0459 in accordance with the European Community requirements of directive 93/42 and the Australian Therapeutical Goods Administration (ARTG no. 096547). Audiclean is a medical device in compliance with regulatory requirements of the U.S. FDA;
- b) How do you know if you have excessive wax build-up? There are several symptoms that indicate that you may have a build-up of earwax, including:
  - Difficulty hearing;
  - Pain in the ear or ears;
  - Ringing noise in the ear;
  - A feeling of blockage in the ears;
  - Temporary deafness after swimming or taking a shower or bath.
- c) Audiclean Ear Wax Remover combines 3 actions:
  - Cerumenolytic action: Infiltrates and disintegrates the earwax plug;
  - Lubricating action: Lubricates the ear canal to evacuate earwax;
  - Purifying properties: Helps prevent the risk of infection with the recognised d)
- d) Dosage;
- e) Specially adapted tip for the anatomy of the ear; an otoscope-shaped ear nozzle designed by ENT;

14) LMT also point out that one stockist of Audiclean, Boots, does not list the product under “toiletries” or “beauty” but under “Pharmacy and Health”. Another UK distributor, Passion For Life Healthcare, only deals in products promoting good health and treating medical conditions, not for enhancing beauty.

15) In its evidence in reply LDL did not question any of the above comments, other than to maintain that the products are cosmetics.

16) At the hearing LMT commented upon the EU regulation relied upon by LDL. LMT contends:

“17. The second point to note is that the Regulation expressly does not apply to medical products or medical devices. Thus recital (6) of the Regulation states “*This Regulation relates only to cosmetic products and not to medicinal products, medical devices or biocidal products.*”

18. Further, in view of the following, it is plain that neither Respimer nor Audiclean could fall within the definition of “cosmetics” in the Regulation, in any event:

- 18.1 First, the term epidermis in the definition in the Regulation is expressly limited to the “*external parts of the human body*”. The auditory canal and aural cavities are not, by definition, “external” parts of the human body. Audiclean could not therefore fall within the first limb of the definition in the Regulation as submitted by the Proprietor (and nor indeed could Respimer.)
- 18.2 Second, the second limb of definition in the Regulation refers to the oral cavity but not to the nasal (or aural) cavity. It is not credible, given that the definition arises from legislation, that if the nasal (or aural) cavity were intended to be included in that definition, as proposed by the Proprietor, it would have been omitted. Again, therefore neither Respimer (nor Audiclean) can reasonably be said to fall within the second limb of the definition.
- 18.3 Third, both limbs of the definition are further limited by the words “*mainly to cleaning them, perfuming them, changing their appearance, protecting them, keeping them in good condition or correcting body odours;*”. This would further exclude both Respimer and Audiclean. The stated purpose of both products is medical – in the case of Respimer to treat and reduce nasal congestion and pain, discomfort and other complications arising from nasal congestion; in the case of Audiclean to remove ear wax and to alleviate pain, discomfort and other complications arising from the build-up of ear wax.
- 18.4 Fourth, as noted earlier, both Respimer and Audiclean are kits, consisting of an applicator and fluid for use with the applicator. There is no evidence that the fluid is sold separately from the kits. The products are not therefore a “substance” or a “mixture” as required by the definition in the Regulation.

19. In summary, neither Respimer nor Audiclean are cosmetic products. They are medical kits, respectively, for relieving nasal congestion and aural congestion for the purposes of preventing pain, discomfort and other complications. The use of the mark in the registration in relation to these products is not use of the mark for the Goods and so could not support the Registration. No other use of the mark is advanced and there are no reasons given for the non-use of the mark. The registration should for these reasons be revoked.”

17) At the Hearing LMT referred me to a number of cases where the law as to how words in specifications of goods and services should be construed has been reviewed. They cited *Omega Engineering Incorporated v Omega SA [2012] EWHC 3440 (Ch)* between [21] and [33] where Arnold J concluded that the authorities were consistent and that words in specifications should be given their natural and usual meaning. Arnold J reiterated that view in *Aveda Corporation v Dabur India Limited [2013] EWHC 589 (Ch)*. At [56] of *Aveda*, he said:

“I reviewed the correct approach to the construction of the specification of goods and/or services of a registered trade mark in *Omega Engineering Inc v Omega SA [2012] EWHC 3440 (Ch)* at [21]-[33]. In short, the words used in the specification should be given their natural and usual meaning.”

18) In *Thomson Holidays Limited v Norwegian Cruise Lines Limited [2002] EWCA Civ 1828*, cited by Arnold J in *Omega*, Aldous LJ said at [31] as follows at:

“If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

19) I also take into account the comments of Neuberger J in *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another [2000] FSR 267* where he stated:

“I should add that I see no reason to give the word "cosmetics" and "toilet preparations" or any other word found in Schedule 4 to the Trade Mark Regulations 1994 anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context. In particular, I see no reason to give the words an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor.”

20) Firstly, I am not at all certain that the European Regulation relied upon by LDL is applicable to their particular products. At paragraph 16 above I have set out the contentions of LMT as to why the two products relied upon by LDL do not fall within the remit of the regulation. I also noted at paragraph 12 above that the Regulation states that any product which is to be “ingested, inhaled, injected or implanted into the human body shall not be considered to be a cosmetic product.” To my mind, squirting a fluid up one’s nose or into one’s ears falls foul of this part of the regulation. I also take note that in the packaging and advertising of the product LDL describes them in terms of alleviating symptoms, which most consumers would view as a medicinal product, not a cosmetic. In any event, it is clear from the authorities from the Courts that I should rely upon the natural meaning of a word in a specification as it would appear to the average consumer and the trade rather than an obscure European Regulation, which I am not bound by. A cosmetic would be readily understood by the average consumer to mean “a preparation for use in beautifying the face, skin or hair.” This is not a description which would be used by anyone with regard to the products relied upon by LDL.

21) As the mark in suit has not been used on “cosmetics” the application for revocation succeeds.

**CONCLUSION**

**22) The mark will be revoked with effect from 1 September 2015**

**COSTS**

23) LMT has been successful and is therefore entitled to a contribution towards its costs.

Expenses	£200
Preparing a statement and considering the other side’s statement	£300
Filing evidence and considering the other side’s evidence	£1500
Attendance at the hearing	£800
<b>TOTAL</b>	<b>£2,800</b>

24) I order Laboratoire De La Mer to pay La Mer Technology, Inc. the sum of £2,800. This sum to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 7<sup>th</sup> day of December 2016**

A handwritten signature in black ink, appearing to read 'G W Salthouse', with a large, sweeping flourish extending to the right.

**George W Salthouse  
For the Registrar,  
the Comptroller-General**