

IN THE MATTER OF APPLICATION NO. 2354457A IN THE NAME OF
JOHNSON & JOHNSON

DECISION

Introduction

1. On 27 January 2004 Johnson & Johnson to register the sign shown below as a trade mark in Classes 3 and 5.



2. In the box for “additional information” on the Form TM3 the sign was described as “a vanilla and jasmine plant designs logo”.
3. The application was made in respect of the following goods:

Class 3: Toiletries, soaps, shampoos and cosmetics for the care and cleaning of skin and hair.

Class 5: Medicated topical preparations for treating conditions of the skin and hair.

4. The examiner objected to the application in Class 9 under section 3(1)(b) and (c) of the Trade Marks Act 1994.
5. Following a hearing, the application was divided into separate Class 3 and Class 5 applications. Mr Gareth Hicks acting for the Registrar refused the application in Class 3 for reasons given in a written decision dated 25 October 2005 (O/288/05). The Class 5 application has proceeded to registration. The applicant now appeals against the refusal of the Class 3 application.

Relevant provisions of the Trade Marks Act 1994

6. Section 3 of the 1994 Act provides *inter alia* as follows:
 - (1) The following shall not be registered-
 - (b) trade marks which are devoid of any distinctive character,
 - (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services.

These provisions correspond to Article 3(1)(b) and (c) of Council Directive 89/104/EC of 21 December 1988 to approximate the laws of the Member States relating to trade marks.

The hearing officer's decision

Section 3(1)(c)

7. Having noted that the applicant did not rely upon acquired distinctiveness and having directed himself in accordance with Case C-191/01P *Wm. Wrigley Jr. Company v Office for Harmonisation in the Internal Market (Trade Marks and*

Designs) (*DOUBLEMINT*) [2003] ECR I-12447 at [28]-[32], the hearing officer concluded that the application was precluded from registration by section 3(1)(c) for the following reasons:

16. The mark consists exclusively of a device of flowers and leaves which appear to be vanilla flowers and jasmine, a view supported by the description of the mark given in part 2 (additional information) of application form TM3 where the mark is referred to as ‘vanilla and jasmine plant designs logo’. In my view, the mark conveys an obvious message in relation to the kind of goods, namely that they incorporate a vanilla and jasmine or floral scent/fragrance. The first impression of the mark on the part of the average consumer would be that it consisted of a combination of flowers which would therefore not give a trade mark message to the average consumer for these goods as they simply express the significance that the goods, essentially toiletries and cosmetics, consist of, or evoke, a vanilla and jasmine or floral fragrance.
17. Furthermore, there is no graphic or semantic improvement or modification to the picture in question which enhances them with any further characteristic in order to render the sign as a whole capable of distinguishing the applicants’ products from those of other traders.
18. I am of the view that a picture of flowers would not be an unusual way of designating a characteristic of the applicant’s goods, namely their fragrance, and the public would therefore not be able to distinguish them from those provided under the same or similar signs by other undertakings. Although it may not be immediately apparent exactly what genus of flowers comprise the mark, I do not feel that this detracts from the impression that would be given that the goods incorporated a floral fragrance.
19. The goods in question are essentially everyday products which are often purchased on impulse. They are relatively low cost items and purchasers do not usually take a great deal of care and attention in their purchase. However, it must also be borne in mind that the fragrance of toiletries and cosmetics is an extremely important consideration prior to purchase which may influence a potential consumer to purchase the goods or otherwise, and what may be an attractive fragrance to one person may not be so to another. The fact that two basic designs of flowers are presented in combination would prompt the average consumer to make an assumption that the goods consisted of the particular fragrance of the flowers being depicted or a floral fragrance instead of, for example, a citrus fragrance where a lemon and orange were depicted or a pine fragrance where pine needles and pine cones were presented to them.

20. I therefore reach the conclusion that the mark designates a characteristic of the goods and is debarred from registration under Section 3(1)(c).

Section 3(1)(b)

8. Having directed himself in accordance with Joined Cases C-53/01 to C-55/01 *Linde AHG, Windward Industries Inc and Rado Uhren AG* [2003] ECR I-3161 at [37], [39]-[41] and [47], the hearing officer concluded that the application was precluded from registration by section 3(1)(b) for the following reasons:

23. I must assess the mark's distinctiveness in relation to the goods for which the applicant seeks registration, and must also have regard to the perception of average consumers of the goods. Even though the mark does not consist exclusively of the plain words 'FLORAL FRAGRANCE' or 'FLORAL SCENT' which would present the consumer with a clear statement of what to expect of the goods, the depiction of a basic drawing of flowers would not, in my view, hide or conceal the identical message. It seems unlikely to me that the relevant consumer of the goods claimed would perceive this mark as denoting trade origin as it would simply be seen as a picture of flowers presented to demonstrate the fragrance of the item being sold.
24. I am therefore not persuaded that the mark applied for would serve in trade to distinguish the applicant's goods from those of other traders. In my view, the mark will not be identified as a trade mark without first educating the public that it is one, and I therefore conclude that the mark applied for is devoid of any distinctive character and subsequently excluded from prima facie acceptance under Section 3(1)(b) of the Act.

Acceptance by other tribunals

9. Having reached these conclusions, the hearing officer considered the applicant's argument that the application should be accepted because it had been accepted for registration in a number of other countries but rejected it in reliance upon Case C-218/01 *Henkel KGaA v Deutsches Patent and Markenamt* [2004] ECR I-1725 at [61]-[65].

Standard of review

10. This appeal is a review of the hearing officer's decision. The decision under challenge is essentially an assessment of the distinctiveness of the mark sought to be registered. As explained by May LJ in *DU PONT Trade Mark* [2003] EWCA Civ 1368, [2004] FSR 15 at [94], the appropriate degree of respect to be accorded to a decision of a lower tribunal on such a review depends on the nature of the tribunal, the evidence and the issue. In my judgment, the degree of respect to be applied in the present case is that articulated by Robert Walker LJ in *REEF Trade Mark* [2002] EWCA Civ 763, [2003] RPC 5 at [28] as follows:

In such circumstances an appellate court should in my view show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle.

Grounds of appeal

11. The applicant contends that the hearing officer erred in principle in a number of respects. In relation to section 3(1)(c), the applicant argues that (i) the hearing officer erred in his assessment of the manner in which the mark would be perceived by the average consumer, (ii) he was wrong to take into account the statement on the form TM3 quoted above, (iii) he failed to have any or any sufficient regard to an informal survey carried out by the applicant's attorneys, (iv) he failed to have any or any sufficient regard to the existence of a considerable number of registrations of floral devices in Class 3 and (v) he was wrong not to place weight on the acceptance of the mark by foreign registries which included some in other EC Member States. In relation to section 3(1)(b), the applicant argues that the hearing officer's reasoning indicates that he found the mark to be lacking in distinctive character because it was descriptive and therefore all the same points apply.

Section 3(1)(c)

12. The applicant's attorney accepted that the hearing officer was right to say at [16] that "the first impression of the mark on the part of the average consumer would be that it consisted of a combination of flowers". She submitted, however, that the hearing officer was wrong to jump from this to the conclusion that the message that the mark would convey to the average consumer was that the goods in question incorporated a floral fragrance. She accepted that a botanically accurate representation of flowers would be less registrable than an abstract representation, since it would be more likely to be taken as denoting a characteristic of the goods, but argued that the device in question was a line drawing that had an abstract quality rather than a faithful representation of particular flowers. In my view the mark is a realistic representation of flowers rather than an abstract device. In any event, however, I consider that the hearing officer was entitled to come to the conclusion that the message that the mark would convey to the average consumer of the goods in question was that they incorporated a floral fragrance.

13. So far as the statement on the Form TM3 is concerned, the applicant's attorney pointed out that this statement need not have been included in the application and did not form part of the mark. Although it would be seen by anyone who troubled to inspect the file, it did not even appear on the Registry's electronic database. She therefore argued that the hearing officer was wrong to take the statement into account when assessing the average consumer's perception of the sign. I would agree with this argument if the hearing officer had based his assessment purely on the statement on the Form TM3. However, in my judgment it is clear from his decision that the hearing officer merely treated the statement as supporting his own assessment. Moreover, his assessment was that the message conveyed by the sign was that the goods incorporated a "vanilla and jasmine *or* floral scent/fragrance [emphasis added]". I interpret the hearing officer as having proceeded on the basis that some consumers would recognise the flowers depicted in the sign and some would not. Thus the hearing officer's analysis at [16]-[19] does not depend on the average

consumer recognising the flowers as vanilla and jasmine. Indeed, he does not mention vanilla or jasmine at all at [18]-[19].

14. Turning to the survey relied upon by the applicant, the hearing officer recorded in his decision at [12] that he had been provided with the results of an informal survey conducted amongst staff at the London office of D. Young & Co in which respondents were shown the mark and asked to name the flowers shown. Of 13 respondents, none named either of the two flowers correctly. Although the hearing officer did not refer to this survey later in his decision, I do not consider that it can be concluded that he did not take it into account. In any event, as I have already said, I interpret the hearing officer as having accepted that some consumers would not recognise the flowers depicted in the mark.
15. As to the existing registrations, the applicant's attorney argued that these were relevant in two ways. First, because they showed that the average consumer was accustomed to seeing floral devices used as trade marks. Secondly, because they showed that there was no pressing need to keep such signs free for all to use. In my judgment the hearing officer was correct not to have regard to the state of the register. As Jacob J pointed out in *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281 at 305, the state of the register does not tell one what is actually happening out in the market and one has no idea what the circumstances were which led to the marks concerned being put on the register. A further difficulty in the present case is that some of the registrations pre-date the 1994 Act, let alone the judgment of the ECJ in *DOUBLEMINT*. Thus one cannot be sure that the registrations are valid. Even if one does have regard to the registrations, what strikes me is that many of them consist of much more stylised representations of flowers than the present mark. In other cases the marks are recognisable as particular flowers but have a different connotation, such as the red roses registered by the University of Central Lancashire and the Rugby Football Union.
16. As to the foreign registrations, it was common ground that these were merely of persuasive value. The Registrar's representative accepted that they might

tip the balance in a borderline case, but submitted that this was not a borderline case. In my judgment the hearing officer was right to place little weight upon them in the absence of reasoned decisions explaining the basis upon which the mark was accepted for registration.

17. I therefore conclude that the applicant has not shown that the hearing officer made any error which would justify me in overturning his decision.

Section 3(1)(b)

18. In the light of my conclusion in relation to section 3(1)(c), the attack on the hearing officer's decision under section 3(1)(b) must also fail. I would add that, although the hearing officer's reasoning at [23] was based on the sign being descriptive, his conclusion at [24] that the sign would not be identified as a trade mark without first educating the public that it was one might have been supportable even if the sign was not descriptive. It is not necessary for me to reach any conclusion on this point, however.

Conclusion

19. The appeal is dismissed.

Costs

20. In accordance with normal practice in this type of case I shall make no order as to the costs of the appeal.

12 April 2006

RICHARD ARNOLD QC

Penelope Nicholls of D. Young & Co appeared for the applicant.

D. Morgan appeared for the registrar.