

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No: 2114552
by Patrick L'Estrange Gillon
for the registration of a trade mark in Classes 32 & 33**

**AND IN THE MATTER OF Opposition thereto
under No: 48004 by Mystic Brands Inc**

Background and Pleadings

1 On 1 November 1996, Patrick L'Estrange Gillon of Flat 2, Calonne Road, London, SW19
5HH applied for registration of the trade mark shown below in Classes 32 & 33:

RAINFOREST

6 Following examination, the application was subsequently accepted and published for the
following goods:

Class 32:

11 "Fruit juices and low alcohol fruit juices"

Class 33:

16 "Alcoholic fruit juices"

The application is opposed by Mystic Brands, Inc of 709 Westchester Avenue, White Plains,
New York, USA. In their notice of opposition, the opponents say that they have advertised
and used the trade mark RAIN FOREST and/or marks including the words RAIN FOREST
21 upon and in relation to non-alcoholic drinks. As a result of this use, the opponents claim that
they have a reputation and goodwill in the words RAIN FOREST. The opponents further
contend that the mark applied for is identical with, or is confusingly similar to, its earlier trade
marks. With this general background established, the specific grounds of opposition are as
follows:

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- 1) under Section 3(1)(a) of the Act, the opponents say that the mark is not
capable of distinguishing the goods of one undertaking from those of other
undertakings, given the use of the mark RAIN FOREST by the opponents.
 - 31 2) Under Section 3(1)(b) of the Act, in that the mark is devoid of any
distinctive character, given the use of the mark RAIN FOREST by the
opponents.

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3) Under Section 3(4) of the Act, because use of the mark in the UK is prohibited, given the opponents reputation in the words RAIN FOREST.

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4) Under Section 3(6) of the Act, because the application was made in bad faith.

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5) The opponents say that use of the mark applied for in the UK is liable to be prevented by the law of passing off. Although not particularised, this objection goes to Section 5(4)(a) of the Act.

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6) Under Section 6(1)(c) of the Act, because at the date of application of the mark applied for, the opponents RAIN FOREST mark was entitled, as a result of the use that had been made of it, to protection under the Paris Convention as a well-known mark.

7) Under Section 32(3) of the Act, on the grounds that the applicant had no intention to use the mark on all the goods covered by the application as filed.

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The opponents say that the voluntary withdrawal of the application has been requested, but has been declined. The opponents asks for the Registrar to exercise her discretion and to award costs in their favour. In so far as the former is concerned, the Registrar has no discretion. A mark is either acceptable or it is not.

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The applicant filed a counterstatement in which the following points are made:

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1) Market surveys undertaken by the applicant suggest that the opponents have not advertised or used the RAIN FOREST trade marks in relation to drinks or any other consumer goods in the UK.

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2) The applicant says there is no evidence of any goods having been marketed or sold by the opponents in the UK, nor is there any suggestion that the opponents had or has any plans to market their products under the RAIN FOREST marks in the UK.

3) It follows from the comments at (1) and (2) above, that the suggestion of passing-off by the applicant is unlikely in the context of the UK market.

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Only the opponents filed evidence in these proceedings. Neither side has asked for a hearing. Acting on behalf of the Registrar and after a careful study of the papers, I give this decision.

Opponents Evidence-in-Chief

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This consists of two Statutory Declarations both by Linda Ann Bray. Ms Bray explains that she is a registered trade mark agent and a partner in the firm of Wildbore & Gibbons. The contents of her first declaration dated 5 May 1998, have been obtained from documents available to her and information and documents sent to her by Margaret Civetta, who is an

1 attorney acting for the opponents in the USA.

The following facts emerge from Ms Bray's first declaration:

6 (i) The opponents produce a range of fruit juices or fruit flavoured drinks under the name MISTIC RAIN FOREST NECTARS. The goods were first sold in the USA in May 1996. Exhibit LAB1 consists of examples of point of sale material, in which the mark is shown.

11 (ii) By the end of July 1997, the opponents had spent \$520,000 promoting the mark, with 1,116,700 cases sold.

16 (iii) On 15 May 1996, the opponents filed an application for registration of the mark MISTIC RAIN FOREST NECTARS in the USA. The application was filed in Class 32 in respect of "fruit drinks containing all natural fruit juices and fruit purees". The United States Patent & Trademark Office (USPTO) raised an objection to the application on the basis that the term RAIN FOREST describes "a current genre of foods (especially food and beverages) which are attractive to ecology conscious consumers". They supported this objection with a range of references, copies of which are provided at exhibit LAB3. The opponents mark was subsequently registered with the following disclaimer: "No claim is made to the exclusive right to use RAIN FOREST NECTARS" apart from the mark as shown". Exhibit LAB2 is a copy of the US registration certificate.

26 (iv) Exhibits LAB4 and LAB5 are the results of an Internet search conducted by Wildbore & Gibbons for the phrase "rain forest products". The opponents say that these searches revealed a large number of items showing that the words RAIN FOREST are used to refer to a range of goods and in particular that many RAIN FOREST products are used in the manufacture of beverages, in particular quinine (which is used in tonic water), passion fruit, guava, camu-camu, cashu fruit and cupuacu (which are used in fruit-juice based beverages).

36 Ms Bray's second declaration is dated 17 June 1998. In her declaration, Ms Bray explains that she instructed a firm of investigators, Kingsley & Talboys to find out more about the current and past use of the term RAINFOREST in the UK. Where possible, the information that has been obtained is prior to the date of filing of the application for registration. The declaration and the eight exhibits attached to it (LAB6 to LAB13), have been provided in an effort to establish that the word RAINFOREST is in common generic usage by a range of organisations. I do not propose to itemise the declaration or exhibits in detail, but will refer to them later where appropriate.

41 That concludes my review of the evidence.

Decision

46 It will be apparent from the above summary that the opponents have raised a large number of objections, a number of which have not been explained or pursued in evidence.

1 In my view there has been no evidence filed which supports the opponents grounds of objection under Sections 3(1)(a), 3(4), 3(6), 5(4)(a), 6(1)(c) or Section 32(3) of the Act.

6 If I am right in this conclusion, this leaves the opponents with only one ground of opposition, namely Section 3(1)(b) of the Act. In their notice of opposition this ground is framed in the following terms:

11 “By virtue of the use made of the mark RAIN FOREST and/or marks including the words RAIN FOREST by the opponent, the mark applied for offends against the provisions of Section 3(1)(b) in that it is devoid of any distinctive character for the applicants goods”.

16 The wording of this ground suggests a relative as opposed to an absolute ground of objection. However, I note that the principal evidence filed by the opponents relates to the non-distinctive nature of the word RAINFOREST in relation to the goods for which registration is sought. That being the case, I have proceeded on the basis that the objection under Section 3(1)(b) (as originally filed) was poorly worded, and that it is the opponents intention to pursue 3(1)(b) as an absolute ground of objection.

21 To support their contention that the mark lacks distinctive character, the opponents point to the following evidence:

26 (i) The outcome of the opponents application for the mark MISTIC RAIN FOREST NECTARS in the USA. The opponents rely upon the results of an investigation conducted by the USPTO, which in the view of the USPTO established that the term RAINFOREST is in common usage in relation to a variety of goods. The opponents accepted this view in the US, and agreed to enter a disclaimer of the words “RAIN FOREST NECTARS”.

31 (ii) The results of an Internet search conducted by their UK trade mark Attorneys, which establishes in the opponents view that the term RAINFOREST is in common usage.

36 (iii) Finally, the opponents rely upon the results of an investigation by Kingsley & Talboys, which the opponents say shows that the word RAINFOREST is in common usage by a variety of traders in relation to a range of goods.

41 Before reaching a conclusion, one needs to see from where and from when, this evidence originates. The evidence provided by the USPTO to support their objection to the opponents application in the USA in 1996, appears (in the main) to refer to American publications. An example is an extract from the Los Angeles Times dated 10 September 1991. This article makes the following point:

46 “From the depths of Brazil’s Amazon forest to the shelves of the American supermarket is a distance not easily bridged, but a growing variety of “rain forest chic” consumer products is making the connection”.

1 The article goes on to say:

“Cultural Survival’s list of wholesale American customers has increased from 17 to 40 items in the last year, and the number of consumer products containing the tropical commodities has risen from 19 to about 100. New ones being developed include fruit drinks, dried fruits, nut mixes, lip balm and bath beads”.

In addition, there are a number of references to British publications. Examples of which, are an article which appeared in The Economist on 9 September 1989 and an extract from Food Manufacture dated November 1990. The first article is entitled “Rain-forest products, Growing Profits”, while the second article includes the following extracts:

“Recent consumer research in the UK by the Fast Foodfax Service of Cambridge Market Research, on behalf of the Food Business, has helped to answer questions like: how does the consumer view food products containing ingredients from the rainforest?”

The consumers motive for buying rainforest products has been identified as the wish to help care for the rainforest and people are willing to pay a premium”.

Clearly the Internet search performed by the opponents UK trade mark Attorneys would have been conducted after the filing date of the application for registration. Whilst I note that a number of the articles do refer to rain forest products (fruits, nuts and flowers are mentioned), it would appear that the majority of the articles provided originated in the USA and are (where appropriate) for the sale of goods to the US Market. I do note however (at exhibit LAB5), the references to JUNGLE ADE and JATOBA TEA, which are described respectively as, “a blend of exotic tropical fruits that grow in the pristine Amazon Rainforest”, and “a unique treasure of the Brazilian and Peruvian Rainforests”.

In so far as the results of the investigation carried out by Kingsley & Talboys is concerned, there is at exhibit LAB6 a number of extracts from a range of publications which clearly establish that the rain forests are the source of a wide range of products which have multi-various applications. Exhibit LAB7 consists of a label from a chocolate bar consisting of an organic dark chocolate, produced by a Partnership called Green & Blacks. Amongst other text and devices, the label also contains the following text: “The authentic maya taste of rainforest spices and oranges”. Although the product was purchased after the filing date of the application in suit, I note that the facsimile sent to the investigators from Ms Fairley (who is a partner in Green & Blacks), mentions that the word RAINFOREST has been used by them since 1991 in a purely descriptive context. Similar usage is provided in exhibit LAB8, which consists of a bottle bearing the trade mark GUSTO. Also purchased after the date of application, I note that the bottle contains the following text: “The Amozon river basin is a treasure house of herbs-guarana seeds grow on vines in the rain forest”. In exhibit LAB9 the owners of the GUSTO brand confirm that they have used the word RAINFOREST in a descriptive sense on their labels since 1991. Exhibits LAB10, 12 and 13 are examples of similar types of descriptive usage in relation to brazil nuts, fromage-frais and honey.

1 In the light of this evidence, I turn now to consider the objection under Section 3(1)(b) of the Act.

Section 3(1) of the Act reads as follows:

- 6 3. (1) The following shall not be registered-
- (a).....
 - (b) trade marks which are devoid of any distinctive character,
 - 11 (c).....
 - (d).....

16 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.

21 In this case the applicant for registration did not file any evidence in either the ex-parte or inter-partes proceedings. As such, the proviso to Section 3(1) of the Act is not relevant and I must consider the application as an unused mark.

26 In reaching a conclusion as to the acceptability of the word RAINFOREST (absent use), I am guided by the comments of Jacob J in the British Sugar Plc and James Robertson and Sons Ltd case (the TREAT case) [1996] RPC 281: Jacob J said:

31 “Next is “Treat” within Section 3(1)(b)? What does devoid of any distinctive character mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark? A meaningless word or a word inappropriate for the goods concerned (“North Pole” for bananas) can clearly do. But a common laudatory word such as “Treat” is, absent use and recognition as a trade mark, in itself (I hesitate to borrow the word from the old Act inherently but the idea is much the same) devoid of distinctive character. I also think

36 “Treat” falls within Section 3(1)(c) because it is a trade mark which consists exclusively of a sign or indication which may serve in trade to perform a number of the purposes there specified, particularly to designate the kind, quality and intended purpose of the product”.

41 In addition, the comments made by the Court of Appeal in Procter & Gamble Ltd’s Trade Mark Application, [1999] RPC 673 at pages 678 and 9, that “despite its position in Section 3(1) of the 1994 Act, paragraph (b) performs a residual or sweeping-up function, backing up paragraphs (c) and (d)” is also of assistance, given that the opponents chose not to include Section 3(1)(c) in their grounds of opposition.

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1 The evidence filed by the opponents suffers from a number of defects, namely that some of the
use is from overseas, or post-dates the application for registration. That said, there is in my
view a significant body of evidence which points to the fact that the word RAINFOREST was
already in use in relation to a range of products which emanated from the various rain forests
of the world, prior to the filing date of the application. In addition, I note that the applicant has
6 not responded to the opponents evidence.

Taking the best view I can of all the evidence filed, combined with the applicants reluctance to
refute that evidence, I have come to the conclusion that the word RAINFOREST is one that
describes goods sourced from a rainforest, which may then be used in the making of
11 beverages. As such, it is devoid of any distinctive character as a trade mark for the goods at
issue. Consequently, the opposition succeeds under Section 3(1)(b) of the Act.

In light of the decision I have been able to reach under Section 3(1)(b), I see no need to
consider the other grounds put forward by the opponents save to say that, if on appeal I was
16 found to be wrong in relation to Section 3(1)(b), I do not think the opponents would be in a
better position on the basis of the other grounds pleaded.

In so far as costs are concerned, I note that although successful under Section 3(1)(b) of the
Act (a ground which in itself was ambiguously pleaded), the opponents have been
21 unsuccessful on six other grounds. Indeed, as I mentioned above, no evidence appears to have
been filed to substantiate these grounds. Had the applicant been clear as to the actual nature of
the opponents objections, a speedy resolution to this dispute may have been possible.

In the circumstances, I feel it is appropriate to make a suitable reduction in the award of costs.
26 Consequently, I order the applicant to pay to the opponents the sum of £200. This sum 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.

31 **Dated this 14 Day of June 2000.**

36 **C J BOWEN**
For The Registrar
The Comptroller General