

**BEFORE:
MR SIMON THORLEY QC**

IN THE MATTER OF THE TRADE MARKS ACT 1994

AND

**IN THE MATTER OF TRADE MARK APPLICATION NO 2040748
IN THE NAME OF LABORATORIES S.I.P.A**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
OPPOSITION NO 45587 IN THE NAME OF
WELLA AKTIENGESELLSCHAFT**

**Appeal of Applicants from the decision of Mr M Foley, acting on behalf
of the Registrar, dated 8th October 1999**

**MR T MOODY-STUART (instructed by Baron & Warren)
appeared on behalf of the Appellants**

**MR D DEVON (of Marks & Clerk)
appeared on behalf of the Respondents**

D E C I S I O N

MR THORLEY: This is an appeal from a decision of Mr Foley, the officer acting for the Registrar, in opposition proceedings to the registration of trade mark No 2040748 by Laboratories S.I.P.A.

5 The trade mark is for the word TONALITE HENNE in Class 3 in respect of hair colourants, hair dyes, hair waving preparations, hair cosmetics, hair lotions and shampoos, all containing henna. It is common ground that the words TONALITE HENNE are in the French language.

10 Registration was opposed by Wella AG under Section 3(1)(b) because the mark applied for was said to be devoid of any distinctive characteristic and under Section 3(1)(c) on the ground that the mark applied for consisted exclusively of a sign or indication which may serve in the trade to designate the kind, quality or other characteristics of the goods.

15 It is common ground before me that if the objection under Section (3)(1)(c) cannot succeed then neither can the objection under Section 3(1)(b). I propose, therefore, to ignore Section 3(1)(b).

20 Mr Foley upheld the opposition under Section 3(1)(c) and the primary reasoning in his decision comes in the passage beginning on page 8 at line 39. It is there he recites that the parties accept that the words are in the French language and he recites the conflict of evidence as to how those words would be translated into English.

25 At page 9, line 5 he states: "It seems to me that there are two matters that need to be determined and upon which the outcome of this case rests. Accepting that TONALITE is a French word, does it correctly translate into English as TONALITY or HUE, and depending on the answer to this question, does the mark as a whole when translated consist exclusively or an indication which may serve, in trade, to designate a characteristic of the goods?"

30 He went on to answer "HUE" to the first question and answered the second in the affirmative. At line 42 on page 9, he concluded: "In this case having considered the relevant material, I come to the view that it would be likely that traders would wish to use the description

TONALITE HENNE, or in other words, HENNA HUE, to describe a characteristic of goods which are for use in colouring the hair various shades of henna, or for use with hair so coloured.” He, accordingly, declined to allow the mark to remain on the register.

5 Mr Moody-Stuart, who has appeared before me on behalf of the appellants, has submitted that these conclusions were wrong.

I have had the advantage not only of his oral submissions but also a full, reasoned statement of grounds of appeal and a skeleton argument. In paragraph 3(ii) of the grounds of appeal Mr Foley is criticised for placing too much weight on the evidence of the English translators. It is
10 said that he should have had regard to the dictionary definitions where TONALITE is translated as the English word TONALITY but only as being appropriate to describe musical tones and colour tones, but in pictures.

In paragraph 3(i) Mr Foley is criticised for placing too little weight upon the fact that the
15 equivalent French mark was accepted. In paragraph 3(iv) reference is made to a German application and a suggestion that little or no weight should be placed on that.

These submissions were all repeated in the skeleton but, in addition, in paragraph 3(c) of the skeleton, a new argument is raised. It is stated: “In particular(c) even on the assumption
20 that the mark TONALITE HENNE bear a meaning HENNA HUE in English, the Hearing Officer assumed without any evidence that purchasers of hair products would understand the mark to have that English meaning”. It was that argument, which was amplified in paragraphs 6 and 10 of Mr Moody-Stuart’s skeleton, that was the main subject of the submissions before me, and I shall shortly turn to deal with them.

25 Before doing so, I should deal with two matter of further evidence which it was sought to adduce on the hearing of this appeal. First, there was a further declaration of Mr Stacey, the agent acting for the appellants, given evidence as to the further progress of the German application. Both parties were agreed, on consideration, that the progress of the German
30 application was irrelevant to my decision. Accordingly, I refuse to allow that declaration to be

introduced.

The second declaration was a declaration of a Madame Vittoz who is a French trade mark attorney and who acted in the course of the prosecution of the French trade mark. In substance, she confirms the evidence previously given by Mr Stacey that the French trade mark proceeded to registration in France after examination on absolute grounds equivalent to Section 3(1)(c) and without any observations being filed by third parties. There is no evidence, either from Mr Stacey or from Madame Vittoz, as to whether or not the registration was granted on the basis of evidence of use.

Mr Devons, who appeared for the respondents, adopted the pragmatic view that, since Madame Vittoz' declaration added nothing to Mr Stacey's, time should not be spent on an argument as to whether it should be admitted and I therefore did so. I should, however, before passing from this make the observation that I made during the course of the argument. The declaration of Madame Vittoz was signed on 4th April 2000 and yet was not supplied to Mr Devons until 5th December. This is unacceptable. It left Mr Devons with very little time in which to take instructions and, while I do not doubt that instructions could have been taken, if necessary, it is wrong that unreasonable pressure should be placed on one party to an appeal by the late filing of evidence.

I return, then, to the issues in this appeal. As I see it, there are three: first, what is the correct translation; second, what is the relevance of that translation in law; and third, what weight is to be attached to the fact of registration in France.

I turn to the first of those. I have before me on this appeal dictionary translations from a number of dictionaries. I also have, in Exhibit JMS 5, a translation by an official French court translator called Monsieur of Madame Motte of an advertisement for a product sold under the trade mark TONALITE HENNE. These words are translated into English as HENNA HUE. That this is an appropriate translation is confirmed by Veronica Lawson in her declaration. She has been a professional translator since 1960.

Translators can function in two ways. First, they can give a variety of meanings, the correct one of which will depend upon the context in which the word is used and secondly, they can translate a word or phrase in a given context. To my mind, the latter evidence is of far greater assistance to this Tribunal than the mere provision of dictionary definitions. A certified translation of the words forming the trade mark, when used in relation to the goods for which registration is sought, is of far greater assistance for this reason. The translator can employ his or her skills so as to convey in the translation the same nuance of language as is, in their opinion, conveyed by the original wording in context. In the case of a trade mark sought to be registered, much greater assistance is provided by contextual translation. Merely providing dictionary definitions leaves this Tribunal to select the correct meaning - and I believe that is a question of fact rather than of law on which a qualified translator is much better placed to assist. As indicated, in the present case we have the advantage of agreement between two translators that, in context, the word HUE rather than the word TONALITY is a preferable translation.

In paragraph 11 of his skeleton, Mr Moody-Stuart contended that the Hearing Officer was wrong to accept the translation of TONALITE HENNE as HENNA HUE when faced with evidence from dictionary definitions as to the natural meaning of TONALITE as being TONALITY.

In my judgment, it is precisely because the translation of TONALITE as TONALITY was thought to be inappropriate in the context of a hair dye that the translators used the word HUE. I therefore answer the first question that, in the context of this trade mark, the correct translation is HENNA HUE.

That brings me to the second question of what is the relevance of that translation in law. First, it is common ground that the English expression HENNA HUE would not, without evidence of use, be registrable. Therefore the question is whether the fact that the words are in a foreign language make any difference.

Reference was made, both by the Hearing Officer and before me, to the Registry practice in

relation to languages where the practice is stated in relation to well-known European languages, such as French, German, Italian and Spanish, that they are likely to be known to a reasonable and increasing number of United Kingdom residents and that objection will therefore be raised if the mark is the name of the goods or is a description of the characteristics of the goods. This is particularly so where a foreign language is often used in this country in relation to certain goods or services; the use of French in relation to restaurants or beauty care services being an example.

The Registry practice is a sensible and valuable guide to practitioners, but it does not have the force of law. Each case must be decided on its own facts. In the present case, Mr Moody Stuart submitted that both the Registry practice and a decision of this Tribunal had been overruled by a decision of the European Court of Justice in the **Windsurfer Chiemsee Produktions v Boots** case [1999] ETMR 585. This is a submission that has to be examined with some care.

The **Windsurfer Chiemsee** case was a case relating to a geographical location, the Chiemsee lake in Southern Germany. The question was as to whether, on the basis of acquired distinctiveness, the word Chiemsee could be registered for clothing. The present case relates to an unused mark. While, undoubtedly, guidance can be gained from the **Windsurfer Chiemsee** case as to the correct approach - an approach which has been subsequently followed in the **Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV** [1999] FSR 627 case - of taking an overall global view, I think Mr Devons is right when he suggests that care must be taken in applying the actual reasoning of that case to the present case. Here there is the difference not only that the mark is not used but also one is considering a specific problem; that of the registrability of words in a foreign language which would not be registrable if in the English language.

The decision that Mr Moody-Stuart had particularly in mind when drawing my attention to **Windsurfer Chiemsee** was a decision of Mr Geoffrey Hobbs QC, sitting as an Appointed Person, given under the 1938 Act in **El Canal de Las Estrellas Trade Mark** [2000] RPC 291. In that case the trade mark consisted of Spanish words, one meaning of which was “The

channel of the stars” and, an alternative meaning, “The pathway of stellar bodies”.

Mr Hobbs’ decision is, if I may respectfully say so, a thoroughly detailed and reasoned decision containing research into the authorities not only of the last century but of the century before last carried out with characteristic erudition showing not only his full comprehension of the law but also of the jingles of Radio Luxembourg. I do not think it is necessary, for present purposes, to do any more than to recite the head note:

“Held, dismissing the appeal: (1) There was not rule that foreign words had to be examined for registrability by reference to their meaning in translation. The purpose of translation was to ensure that foreign words were not registered without knowing their meaning.

“(2) For registration, foreign words needed only to be capable of functioning satisfactorily as trade marks in relation to the goods or services supplied in or from the United Kingdom, whether or not they would also qualify for protection elsewhere.

“(3) The less obscure a foreign word was, the greater the weight which had to be given to its meaning in translation.

“(4) Traders engaged in intra-community trade were not, unjustifiably, to be prevented from using words in the language of other member states of the European Union.

“(5) Spanish was a modern language widely understood and spoken in the United Kingdom. Spain was a trading partner of the United Kingdom and a fellow member of the European Union. The services specified in the application were supplied nationally and internationally.

“(6) EL CANAL DE LAS ESTRELLAS was easily recognisable as Spanish which when used in respect of the services specified would be understood as laudatory and not a reference to stellar bodies.

“(7) The disclaimers offered did not cure the defects of the mark.”

I am unable to accept that the reasoning of Mr Hobbs is in any way less applicable to an application made under the 1994 Act than to one made under the 1997 Act. In my judgment, it oozes common sense. The question is plainly a matter of degree and each case must be
5 decided on its own facts. It follows from that that I believe the Registry practice remains correct practice - again with the caveat that it is a guide; it does not have the force of law.

Turning, then, to the facts of this case, there is no doubt that HENNE, used in relation to beauty products, would be seen as being the French for HENNA; that HENNE by itself would
10 be descriptive and unregistrable. The question, therefore is what is the effect on an English speaker of the addition of the word TONALITY? Would it serve to distinguish the origin of the product or would it serve merely to emphasise the descriptive nature of the word HENNE?

Mr Moody-Stuart contends that the mere fact that the words would be translated as HENNA
15 HUE by a profession translator does not carry Mr Devons home. He contends, in paragraph 6 of his skeleton which he amplified before me, that it falls to the appellants to show not only that the mark applied for bears a descriptive meaning in English when translated from the French, but also that, as a result of the degree of familiarity among the relevant class of
20 persons - purchasers of hair products - with the French words, they would understand the mark to have that meaning and that the mark is therefore liable to be used in future as an indication of the nature of goods by third parties.

First, there is a question of onus and I must therefore decide where the onus lies. Mr
25 Moody-Stuart is correct that the primary onus is on the respondents. They have sought to discharge this by reference to dictionary definitions and translations to show that TONALITE does, in a generic sense, have a colour connotation and that, in context, it means hue. Is this enough to transfer the onus to the appellants to show that, notwithstanding this, the words are not sufficiently well known or likely to be sufficiently well known to the relevant class of
30 persons to cause that connotation?

I do not find this an easy matter. The submission that the onus should lie on an opponent to adduce evidence as to what the average consumer understands of a foreign language is a difficult one. I am not sure even how own goes about doing it. In terms of the French language, I am prepared to propose myself as being an average consumer although not a frequent buyer of hair dye. Were it in the German, Spanish, Italian or Japanese language, I could not do so.

I believe that the evidence put forward on behalf of Mr Devons' clients is proper evidence. It is evidence that the words have a given meaning from which this Tribunal can assess the likelihood that the average purchaser would make the connection. I have, therefore, come to the conclusion that the evidence put forward on behalf of the respondents is sufficient to transfer the onus to the appellants to demonstrate, if they can, that the actual meaning in translation would be lost on the average consumer. This could be done by indicating ignorance of the actual foreign language in general, ignorance of the translated word - the translated word, for example, not being in common use in the English language, or, possibly, by showing the translation is so dissimilar to the original word that one would not evoke an image of the other.

In the present case that has not been done, but it is perfectly open to Mr Moody-Stuart to argue, as he did, that the likely translation of TONALITE by the average consumer would be TONALITY and that this would not, to him or her, be indicative of colour.

I am unable to accept that. Even if the ordinary purchaser did not translate TONALITE as HUE, I think he or she would, when dealing with beauty care goods and appreciating that the language was French, believe that the word TONALITE was a further description of the henna colouring. Accordingly, I believe that the Registry should proceed with caution in registering a mark descriptive in English merely because the word is in French. Here, in the opposition proceedings, on the facts of this case, I believe the caution is justified on the evidence for the reasons given.

This leads me to the third question: Does the registration in France lead to a conclusion that

none the less the trade mark should be registered here? Mr Foley relied upon another decision of Mr Hobbs sitting as the Appointed Person in **Automotive Network Exchange Trade Mark** [1998] RPC 885. I do not propose, in this judgment, to repeat the whole of the quotation cited by Mr Foley. The essential part is that Mr Hobbs drew attention to the fact that it could transpire that, as a result of linguistic, cultural or social differences, the sign in question is too descriptive to be registered here and yet sufficiently distinctive to be registrable elsewhere. The bare fact, he said, of registration in other countries is not sufficient to establish that a sign is eligible for registration here. I agree.

Here the facts are that the mark was registered in France in 1995. It was registered without opposition or observation and we are unaware whether or not there was evidence of use. In circumstances where a party is going to seek to invite the Tribunal to place weight on a foreign registration, I believe it is necessary that full details of the way in which the mark came to be registered should be given; the mere fact of registration is not sufficient.

While harmonisation is desirable, due effect must be given to linguistic, cultural and social differences and caution must be taken when approaching registration in other countries to ensure that the facts are the same. I am not satisfied in the present case that the facts of registration in France are sufficiently similar to the facts in this country that I should place any great weight on the fact that the French mark was registered. I have reached the clear conclusion that this trade mark should not be registered, that there are good reasons for proceedings with caution in registering the French equivalent of a mark which would be unregistrable in English, and that it would therefore be wrong for me to place any significant weight on the French registration.

For all these reasons, I dismiss this appeal.

MR DEVONS: Sir, I hope you will confirm the order of costs and particularly costs in this appeal, bearing in mind the extra evidence filed at the last moment.

MR THORLEY: Mr Moody-Stuart, do you have anything to say?

MR MOODY-STUART: Sir, I have no submissions to make on costs. They should follow the normal course.

MR THORLEY: I will make a further award of the same sum, **£835** as a contribution to the costs of this appeal.

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Are there any other matters? (No response) Thank you both very much.