

TRADE MARKS ACT 1994

**IN THE MATTER OF
APPLICATION No 2323133
BY TRACIE MARTYN, INC
TO REGISTER A TRADE MARK
IN CLASS 03**

DECISION AND GROUNDS OF DECISION

Background

1. On 7 February 2003 Tracie Martyn, Inc of 59 Fifth Avenue, New York, N.Y. 10011, United States of America applied to register the following trade mark in Class 3:

ABSOLUTE PURITY VISIBLE RESULTS

2. The application was made in respect of the following goods:

“Cosmetic and skin care products; facial cleansers; facial creams, facial emulsions, facial masks, facial scrubs, body lotions, facial makeup, astringents for cosmetic purposes, cocoa butter for cosmetic purposes, cosmetic pads, cotton sticks for cosmetic purposes, cotton swabs for cosmetic purposes, cosmetic pencils, swabs for cosmetic purposes, eye makeup remover, eye makeup, foundation makeup, skin cleaning lotion, skin conditioners, skin cleansing cream, skin cream, skin and face lotions, skin moisturiser, skin clarifiers, skin cleansers, skin emollients, skin lighteners, skin masks, skin moisturiser masks, skin soaps, skin toners, skin whitening cream, wrinkle removing skin care preparations”.

3. Objection was taken under Section 3(1)(b) of the Act because the mark consists of the words “ABSOLUTE PURITY VISIBLE RESULTS”, the whole being a laudatory slogan and devoid of distinctive character for, eg, goods without additives that achieve visible results.

4. At a hearing, at which the applicants were represented by Ms Alison J. Cole of Urquhart-Dykes & Lord, their trade mark attorneys, the objection was maintained.

5. Following refusal of the application I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Mark Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

6. No evidence of use has been put before me. I have, therefore, only the prima facie case to consider.

The Law

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

“3.-(1) The following shall not be registered-

(b) trade marks which are devoid of any distinctive character,”

The Case for Registration

8. At the hearing Ms Cole handed me a sample of the packaging for the goods showing how the mark is used, a photocopy of which is attached at Annex 1. She argued that it is used in a trade mark sense, as a tag line, not as an ingredient or property of the goods. She argued that “purity” has no meaning in relation to cosmetics which are made from a mixture of chemicals, that the total combination of four words in the mark does not describe anything, and that the overall impression created by the mark is of a trade mark which would be applied to the goods to distinguish them from those of other manufacturers.

The Decision

9. The test to be applied in respect of this application is not whether the mark, in its totality, is a combination which is used in common parlance to describe the goods applied for but whether the mark, again in its totality, is devoid of any distinctive character. The whole purpose of Section 3(1)(b) of the Act is to prohibit registration of signs which, although not caught by the clear parameters set out by Sections 3(1)(c) and (d) of the Act are, nevertheless, incapable of distinguishing the goods and services of one undertaking from those of other undertakings.

10. The approach to be adopted when considering the issue of distinctiveness under Section 3(1)(b) of the Act was summarised by the European Court of Justice in paragraphs 37, 39 to 41 and 47 of its Judgment in Joined Cases C-53/01 to C-55/01 *Linde AG, Windward Industries Inc and Rado Uhren AG* (8th April 2003) in the following terms:

“37. It must first of all be observed 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.

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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* [2002] ECR I-5475, 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).

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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".

11. I must assess the mark's distinctiveness in relation to the goods for which the applicant seeks registration, which is the range of cosmetic and skin care products listed above. I must also have regard to the perception of the relevant consumers of the goods, who, in my view, are the general public.

12. As used on the packaging which Ms Cole handed to me at the hearing, I do not believe the average consumer would view the mark as an indication of trade origin, even though it is accompanied by the letters TM.

13. I must of course assume notional and fair use of the mark in relation to the goods applied for, which includes use on the packaging of the goods as well as use in advertising, wherein it is customary for advertisements to use abbreviated language, a notion endorsed by Mr Simon Thorley QC sitting as the Appointed Person in "*Where all your favourites come together*" (BL 0/573/01).

14. Whether the applicant's mark is used on the packaging of the goods or in advertising, it seems to me that the phrase "absolute purity" gives a message that the contents are pure and benign and therefore effective, and the phrase "visible results" describes a desirable outcome of using the product. The combination of these two phrases which describe characteristics of the goods would not give a trade mark message to the average consumer of these goods, because they simply convey the message that the effectiveness of the ingredients leads to the visible results.

15. In paragraphs 21-24 of its Judgement in the "*Companyline*" Decision (Case C-104/00) the ECJ found no error in the reasoning of the Court of First Instance to the effect that "Coupling the words "company" and "line" – both of which are customary in English speaking countries – together, without any graphic or semantic modification, does not imbue them with any additional characteristic such as to render the sign, taken as a whole, capable of distinguishing DKV's services from those of other undertakings." In paragraphs 31-36 of its Judgement the Court specifically rejected the appellant's contention that the mark at issue should not have been refused registration under Section

3(1)(b) (Article 7(1)(b) CTMR) without consideration of the question whether it was free of objection under Section 3(1)(c) (Article 7(1)(c) CTMR).

16. The mark at issue here consists of two phrases rather than two words, but there is no graphic or semantic modification employed in bringing these two phrases together which imbues them with any additional characteristic to render the sign as a whole capable of distinguishing the applicant's products from those of other traders.

17. The fact that the total combination of words in the mark is not a precise description of the goods is not sufficient to avoid an objection under Section 3(1)(b), and this was endorsed by the Court of First Instance in *Best Buy Concepts v OHIM* [2004] ETMR 19:

“20. the marks referred to in Article 7(1)(b) of Regulation No 40/94 [Section 3(1)(b) of the Act] are, in particular, those which do not enable the relevant public to repeat the experience of a purchase, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent acquisition of the goods or services concerned (Case T-79/00 *Rewe-Zentral v OHIM (LITE)* [2002] ECR II-705, paragraph 26). Such is the case for *inter alia* signs which are commonly used in connection with the marketing of the goods or services concerned.

21. However, registration of a trade mark which consists of signs or indications that are also used as advertising slogans, indications of quality or incitements to purchase the goods or services covered by that mark is not excluded as such by virtue of such use (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 40). A sign which fulfils functions other than that of a trade mark in the traditional sense of the term is only distinctive for the purposes of Article 7(1)(b) of Regulation No 40/94 however if it may be perceived immediately as an indication of the commercial origin of the goods or services in question, so as to enable the relevant public to distinguish, without any possibility of confusion, the goods or services of the owner of the mark from those of a different commercial origin.

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30. The argument presented by the applicant at the hearing which acknowledged the indubitable semantic content of the word mark in question but maintained that it tells the consumer nothing about the content or the nature of the services offered is irrelevant. For a finding that there is no distinctive character, it is sufficient to note that the semantic content of the word mark, the principal and dominant element of the mark in question, indicates to the consumer a characteristic of the service relating to its market value which, whilst not specific, comes from information designed to promote or advertise which the relevant public will perceive first and foremost as such rather than as an indication of the commercial origin of the services (see, to this effect, *REAL PEOPLE, REAL SOLUTIONS*, paragraphs 29 and 30). In addition, the mere fact that the semantic content of the

word mark **best buy** does not convey any information about the nature of the services concerned is not sufficient to make that sign distinctive”.

18. It seems to me unlikely that the relevant consumer would consider this mark to denote trade origin, because it will be seen simply as a laudatory slogan designed to promote or advertise the goods by reference to desirable characteristics of the contents of the goods and the results to be gained from using them. The elliptical nature of the mark does not make it any more likely to denote that the goods originate from one particular trader, because the public are used to seeing shorthand used in the promotion of goods.

19. The registrar’s practice on slogans, now incorporated into the Registry Work Manual at Chapter 6 paragraph 32.1.6, says:

“ a mark that is free from objection under Section 3(1)(c) may still be devoid of any distinctive character because it sends a message that could apply to any undertaking and is not therefore capable of individualising the goods or services of one undertaking”.

Whether or not an objection could have been justified under Section 3(1)(c), the objection under Section 3(1)(b) can and must be assessed separately.

20. The test for registering slogans is no different than for any other type of mark but as slogans are often used for advertising purposes they may not be so readily accepted by the general public as an indication of trade source as would more traditional signs such as words, brands, logos and figurative marks (see the Judgement of the Court of First Instance in “*REAL PEOPLE REAL SOLUTIONS*” – Case T- 130/01 5 December 2002).

21. I am not persuaded that the mark ABSOLUTE PURITY VISIBLE RESULTS in totality is distinctive in that it would serve in trade to distinguish the applicants’ goods from those of other traders. In my view the mark applied for will not be identified as a trade mark without first educating the public that it is one. I therefore conclude that the mark applied for is devoid of any distinctive character and is thus excluded from prima facie acceptance under Section 3(1)(b) of the Act.

Conclusion

22. In this decision I have considered all the documents filed by the applicants and all the arguments submitted to me in relation to this application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Sections 3(1)(b) of the Act.

Dated this 17th day of November 2004.

**Anne Pritchard
For the Registrar
The Comptroller-General**

