

O-156-11

TRADE MARKS ACT 1994

**IN THE MATTER OF
REGISTRATION NOS 2419255 AND 2520635**

**IN THE NAME OF
GORDON R LUCAS
OF THE TRADE MARKS:**



AND



IN CLASSES 3, 5 AND 16

AND

THE CONSOLIDATED APPLICATIONS FOR DECLARATIONS

OF INVALIDITY THERETO

UNDER NOS 83653 AND 83652

BY

UNILEVER PLC

Trade Marks Act 1994

**In the matter of registration nos 2419255 and 2520635
in the name of Gordon R Lucas
of the trade marks:**



and



**in classes 3, 5 and 16
and the consolidated applications for declarations of invalidity
thereto under nos 83653 and 83652
by Unilever PLC**

1) The above trade marks were registered on 2 February 2007 and 23 October 2009 respectively. The applications for declarations of invalidation relate only to part of the class 3 specifications, namely:

cleaning, polishing, scouring and abrasive preparations; soaps; perfumes, body and hair lotions, deodorants for personal use.

2) On 4 January 2010 Unilever PLC (Unilever) filed applications for declarations of invalidation in respect of the above goods. The grounds of the applications were made under sections 3(1)(b), (c) and (d) of the Act. Applications for invalidation under these grounds are governed by section 47(1) of the Act:

“47. - (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.”

Subsections 5 and 6 of section 47 of the Act state:

“(5) Where the grounds of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that this shall not affect transactions past and closed.”

3) Sections 3(1)(b), (c) and (d) of the Act state:

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

(a)

(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,

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade:

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.”

4) The basis of the claims is that strata, the plural of stratum, indicates several layers, particularly when such layers are layers of tissue or cells, such as cells of the skin. Unilever claims that the device elements of the trade marks are de minimis. It does not comment on the stylisation of the lettering of the first trade mark.

5) Mr Lucas filed counterstatements. Mr Lucas claims that strata is not a commonplace word. He states that the average consumer is likely to have heard of strata, although he or she may or may not know its meaning or whether it is the plural of stratum or somehow related to stratum. Mr Lucas claims that if the average consumer knows the meaning of strata, that consumer will know that it means layers, in particular layers of rock. Mr Lucas refers to the definition of stratum in the tenth edition of the *Collins English Dictionary*.

- “1. (*usually plural*) any of the distinct layers into which sedimentary rocks are divided,
2. *biology* a single layer of tissue or cells,
3. a layer of any material, esp one of several parallel layers,
4. a layer of ocean or atmosphere either naturally or arbitrarily demarcated,
5. a level of a social hierarchy that is distinguished according to such criteria as educational achievement or caste status.”

Mr Lucas states that the Wikipedia entry for strata, as of 6 April 2010, reads “Strata is the plural of stratum (the geological formation); for other uses in which it can be used in the singular or plural, see Stratum (disambiguation).”

6) Mr Lucas claims that the meaning relating to tissues or cells is in a biological context. He states that none of the goods the subject of the applications relate in any manner to biology but are concerned with cleaning and personal care. Mr Lucas claims that the average consumer is unlikely to attribute the biological meaning to strata, if any meaning is attributed. He claims that, therefore, strata is apt to operate as a trade mark in relation to the goods and is highly distinctive in relation to them.

7) Mr Lucas states that the devices and the fonts in which strata is written enhance the distinctiveness of the trade marks.

8) All of the grounds of invalidation are denied.

9) Both parties filed witness statements.

10) A hearing took place on 21 April 2011. Mr Lucas was represented by Mr Alan Bryson of counsel, instructed by J A Kemp & Co. Unilever was represented by Ms Denise McFarland of counsel, instructed by Murgitroyd & Company.

11) The evidence of Unilever is in the form of a witness statement made by Katrina Burchell. Ms Burchell is “Global Head of Trade Marks and also Global and European Regional Category Counsel, skin of Unilever Plc”. Ms Burchell states that she has considerable experience of Unilever’s skin care business, having provided advice to the relevant divisions on numerous occasions.

12) Ms Burchell states that degradation of the skin can manifest itself in a number of forms. She states that one such manifestation is dry skin. Ms Burchell states that key to the maintenance of hydrated and healthy skin is the condition of its outer layer, the stratum corneum.

13) Ms Burchell states that references to the stratum corneum are widespread in literature published by academics. Exhibited at KB-1 is a copy of an adjudication from the Advertising Standards Authority dated 25 July 2007. Included in the adjudication is the following:

“The product slightly increased turnover of the surface layers of the skin (stratum corneum) but there was no evidence that the complete skin renewal cycle was affected. However, because the testing was carried out on the inner arm, the data could not readily be transferred to facial skin. We also understood that the tests on turnover were all carried out on groups that were at the lower end of stratum corneum turnover before the treatment started and, therefore, might not be representative of all consumers.”

Also included in the exhibit are pages downloaded from mercksource.com on 29 December 2009. The reader is advised that the “epidermis has several strata (layers) that contain all four cell types”; other than this reference, there is no use of stratum or strata on their own. Reference is made to the stratum basale, the stratum spinosum, the stratum granulosum, the stratum lucidum and the stratum corneum; being layers of the epidermis. Copies of pages from *Fundamentals of Anatomy & Physiology*, eighth edition, are part of the exhibit. It bears a copyright date of 2009. The pages give information about the strata referred to in the pages from the Internet. The stratum basale is given an alternative name, stratum germinativum. There is no use of stratum or strata without qualification, the various levels of the skin are referred to as layers.

14) A copy of a further page from *Fundamentals of Anatomy & Physiology* is exhibited at KB-3. This is the page preceding the pages exhibited at KB-1. It is headed:

“5-1 The epidermis is composed of strata (layers) with various functions”.

The following appears in the extract:

“You will notice that the various layers have Latin names. The word *stratum* (plural, *strata*) means “layer”; the rest of the name refers to the function or appearance of the layer. The strata, in order from the basal lamina towards the free surface, are the *stratum germinativum*, the *stratum spinosum*, the *stratum granulosum*, the *stratum lucidum*, and the *stratum corneum*.”

15) Ms Burchell states that “the word strata is habitually used to refer to the existence of various different layers of the skin”.

16) Mr Lucas filed a witness statement. It is a critique of the evidence of Ms Burchell, rather than evidence of fact. Mr Lucas also refers to a decision of Mr Foley, BL O/172/10, and in particular paragraph 19:

“The consumer “may” understand STRATA to be a reference to layers of the skin, and therefore descriptive of products such as those for skin-care. However, to my mind this reference is allusive such that the consumer will

not scratch beneath the surface of the word. If they understand STRATA to mean layers, this will most likely be as Mr Bryson argued, for rocks, but see little, if any connection with skin-care products; it is a distinctive mark.”

This was an opposition brought by Mr Lucas against Unilever under section 5(2)(b) of the Act. As Mr Lucas was the opponent, Unilever’s only avenue in relation to grounds under section 3(1) of the Act was to bring invalidation proceedings. These are those proceedings. There can be no issue as to estoppel¹.

17) Ms McFarland accepted that the proceedings hinged upon section 3(1)(b) of the Act. The basis of the section 3(1)(b) of the Act claims is that strata is descriptive of a characteristic of the goods and that the other elements of the trade marks are not such as to give them any distinctive character.

18) In *Develey Holding GmbH & Co Beteiligungs KG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-238/06 P* the Court of Justice of the European Union (CJEU) stated:

“79. According to consistent case-law, the distinctive character of a trade mark within the meaning of Article 7(1)(b) of Regulation No 40/94 means that the mark in question makes it possible 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 those of other undertakings (Joined Cases C-473/01 P and C-474/01 P *Procter & Gamble v OHIM* [2004] ECR I-5173, paragraph 32, and Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 42). That distinctive character must be assessed, first, by reference to the products or services in respect of which registration has been applied for and, second, by reference to the perception of the relevant public (*Procter & Gamble v OHIM*, paragraph 33, and Case C-24/05 P *Storck v OHIM* [2006] ECR I-5677, paragraph 23).”

The General Court (GC) in *Rewe Zentral AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-79/00* described the issue in a clear and pragmatic manner:

“26. The signs referred to in Article 7(1)(b) of Regulation No 40/94 are signs which are regarded as incapable of performing the essential function of a trade mark, namely that of identifying the origin of the goods or services, thus enabling the consumer who acquired them to repeat the experience, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent acquisition.”

In *BioID AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-37/03 P* the CJEU stated:

“73 As pointed out by the Advocate General in point 105 of his Opinion, when the overall impression conveyed by the trade mark applied for to the relevant public is examined, the abbreviation BioID, which is devoid of any distinctive character, is the dominant element of that mark.

74 Moreover, as OHIM observed in paragraph 21 of the contested decision, the figurative and graphic elements are so minimal in nature that they do not endow the trade mark applied for as a whole with any distinctive character. Those elements do not possess any feature, in particular in terms of fancifulness or as regards the way in which they are combined, allowing that mark to fulfil its essential function in relation to the goods and services covered by the trade mark application.”

19) It was Ms McFarland’s argument that the average consumer for the goods would know of the use of strata in relation to the skin and that the goods under attack related to the skin. It is not possible to see how polishing and scouring preparations and hair lotions have a connection to the skin. Perfumes are applied to the skin but are not skin products. Consequently, the grounds of invalidation are dismissed in relation to these goods.

20) The average consumer for *cleaning and abrasive preparations; soaps; body lotions, deodorants for personal use* is the public at large. Ms McFarland referred to *Longevity Health Products v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T – 363/09*, where the GC identified the relevant consumers as being end consumers and health professionals. This case was dealing with class 5 goods. As per *Altecnic Ltd's Trade Mark Application* [2002] RPC 34, the class in which goods are placed can affect the nature of the goods. In this case the only goods that are in class 3 and could be medicated or for medical purposes are *soaps* (which will also be included in *cleaning preparations*), consequently, *Longevity Health Products* cannot be prayed in aid in relation to the other goods in so far as one set of average consumers are health professionals.

21) Ms McFarland submitted that the average consumers for the goods would include persons from the medical professions and beauticians. There is no evidence that beauticians would be aware of the strata of the skin. Ms McFarland submitted that as members of the medical profession were members of the public at large, they could be considered the average consumers. Members of the medical profession are members of the public at large but to extrapolate from that they can be treated as being average consumers, is an extreme syllogism. Ms McFarland made an analogy with German speakers. She proposed that if the a trade mark was in German then the average consumer could be seen as being a German speaker as a number of the average consumers will be German speakers. These arguments as well as being syllogistic also replace the average consumer with a consumer with a particular knowledge, which by its definition is not the average consumer when the average

consumer is the public at large. Ms McFarland considered it of note that *Fundamentals of Anatomy & Physiology* had been purchased in the Croydon branch of Waterstones, indicating that it was available to the public at large. Bookshops have specialist areas, areas which will be of interest to specialists and not the public at large. There is nothing to suggest that the public at large will be interested in the topics in *Fundamentals of Anatomy & Physiology*. Ms Burchell refers to literature published by academics, such literature is not aimed at the public at large. In both *Fundamentals of Anatomy & Physiology* and the printout from mercksource.com, strata is followed in brackets by 'layers'; indicating that publications aimed at a specialist public do not assume that the word will be understood in relation to the skin.

22) In respect of all of the goods, with the exception of *soaps* and *cleaning preparations* (in so far as the latter includes soaps), there is only one average consumer group, the public at large. There is nothing to suggest that to the public at large, strata will suggest any characteristic of the goods under attack. The trade marks will, to the public at large, act as indicators of origin, even if the stylisation and device elements are ignored. They do have distinctive character.

23) *Soaps* and *cleaning preparations* (in so far as the latter includes soaps) if medicated or for medical purposes will be included in the class and so covered by the specification. (Such goods as *body lotions* if medicated or if for medical purposes will be included in class 5 and so are not encompassed by the specification. An objection can only be run against the goods which are actually included in the specification.) As Mr Bryson submitted Unilever seems to be arguing that strata is a synonym for skin, which it is not. The argument of Unilever is that the skin has strata, certain of the goods may be used on the skin, therefore, strata represents a characteristic of the goods; again Unilever is indulging in syllogistic argument. For a term to be viewed as being descriptive of a characteristic of goods:

“there must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the goods and services in question or one of their characteristics (see Case T-19/04 *Metso Paper Automation v OHIM(PAPERLAB)* [2005] ECR II-2383, paragraph 25 and the case-law cited).”

(*JanSport Apparel Corp v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-80/07 at paragraph 22). Even for members of the medical profession, who may know that the skin has strata, there is no direct and specific relationship between the goods and the word strata which will be perceived immediately. The premise of Unilever's actions is built upon either the public at large or medical professionals undertaking an analysis of the trade marks of Mr Lucas as if they were trying to fathom out a clue in a cryptic crossword.

24) The arguments of Unilever have been built upon the claim that strata is somehow a characteristic of the goods and as such will not allow the trade marks to act as indicators of origin, the other elements not being sufficient to create wholes that are capable of distinguishing. As the argument re strata identifying a characteristic of the goods is rejected, the applications for invalidation must be rejected and it is not necessary to consider the overall impression of the trade marks (as per *BioID AG v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case C-37/03 P).

25) Mr Lucas having been successful is entitled to a contribution towards his costs. The witness statement of Mr Lucas, not being evidence of fact and having no bearing upon the case, no award is made in respect of it. Costs are awarded on the following basis:

Preparing statements and considering the statements of Unilever:	£500
Considering the evidence of Unilever:	£250
Preparing for and attending the hearing:	£500
Total:	£1,250

Unilever PLC is ordered to pay Gordon R Lucas the sum of £1,250. This sum is 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.

Dated this 10 day of May 2011

**David Landau
For the Registrar
the Comptroller-General**

ⁱ See *Special Effects Ltd v L'Oréal SA and L'Oréal UK Ltd* [2007] RPC 15.