

O-085-13

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION  
No. 2584638  
BY LAKELAND LIMITED  
TO REGISTER THE TRADE MARK**



**IN CLASS 3**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER No. 102608 BY  
RECKITT BENCKISER (UK) LIMITED**

## **BACKGROUND**

1) On 15 June 2011 Lakeland Limited (hereinafter the applicant), applied to register the following trade mark:



2) In respect of the following goods in Class 3: “Cleaning, polishing, scouring, bleaching and abrasive preparation; cleaning preparations having anti-bacterial properties.”

3) The application was examined and accepted, and subsequently published for opposition purposes on 5 August 2011 in Trade Marks Journal No.6899.

4) On 7 November 2011, Reckitt Benckiser (UK) Limited, (hereinafter the opponent) filed a notice of opposition. The grounds of opposition are in summary:

- a) The mark in suit is devoid of any distinctive character as the term is non-distinctive in relation to the goods applied for i.e. products which are sprayed to take away dirt, grease or grime. The mark offends against Section 3(1)(b).
- b) The mark in suit consists of a sign which designates kind, quality, intended purpose or other characteristics of goods covered by the mark and so offends against Section 3(1)(c).
- c) The term “spray away” is in common use for household and personal care products. Third parties unrelated to either party in the instant case use the term both descriptively and in a trade mark manner in relation to such goods. The mark offends against section 3(1)(d).

5) On 9 January 2012, the applicant filed a counterstatement which denied the opponent’s claims.

6) Only the opponent filed evidence. Both parties seek an award of costs in their favour. The matter came to be heard on 21 November 2012. At the hearing, the applicant was represented by Mrs McGrath of Messrs W P Thompson & Co.; the opponent was represented by Ms Baxter of Reckitt Benckiser Corporate Services Limited.

## **OPPONENT’S EVIDENCE**

7) The opponent filed a witness statement, dated 1 March 2012, by Rosina Margaret Baxter a trade mark attorney representing the opponent. She states that the dominant element of the mark is the words “spray away”. She states that the stylisation is minimal and the graphic element simply depicts spray particles or droplets. She contends that the term is merely a simple juxtaposition of two common English words. She contends that the term “spray away” is descriptive of cleaning preparations and the like which are dispersed in fine particles away from the container, or sprayed to remove or destroy bacteria. She states that her company has for many years manufactured and marketed a wide range of household and personal care cleaning products including those having anti-bacterial

properties. Further, that the term “spray away” may serve in trade to designate the kind, quality, intended purpose or other characteristic of these goods. For example cleaning products in an aerosol could be described as being for use to spray away dirt and grease. She also provides the following exhibits:

- RMB1 dictionary definitions:

Spray: a noun meaning water or other liquid dispersed by impact, etc, in fine mist-like particles; a jet of medicated vapour or the like, used especially as a disinfectant or in a deodorizer; an instrument used for applying such a jet; a verb meaning to diffuse or send in the form of a spray; to scatter in minute drops; to sprinkle with or as with spray, to wet with fine particles of water or other liquid.

Away: Removal from this (or that) place straightaway, without hesitation or delay; gone from existence; destroyed.

- RMB3: An internet search which is not dated. The single page shows two “hits” for the term “Sprayway” instead of “Sprayaway”. Two other hits refer to car repairs and painting. One is the applicant, one is for a product to spray water at animals in a garden and the other is to eradicate head lice.
- RMB4: Pages from websites of third parties which show use of the term “spray away” on products as a trade mark. None of the pages are dated. They all appear to be UK websites and refer to companies trading from UK premises. Four relate to general cleaning products (pages 1, 2, 3 & 6). One is for cleaning horses (pages 4 & 5), one for cleaning air brushes (page 7), one is an item of equipment for boats and recreational vehicles (page 8), a garden pest controller (page 9) and the last (page 10) is to eradicate head lice.
- RMB5: Pages from websites of third parties which show use of the term “spray away” used in a descriptive manner. None of these are dated. Only one (page 7) is clearly from a UK websites and refers to an antiseptic spray which can spray away infection. Page 5 refers to a cleaning product said to spray away dirt and grime which is clearly from the USA. Another (page 6) refers to cleaning vinyl siding on a house. It is not clear if this is from the UK. Page 1 refers to “Never attempt to spray away dirt with heavy duty cleaners” and is not clearly from the UK. Page 3 informs how to use baking soda and vinegar to “spray away odours” in order to “deodorize” a house. Pages 2 and 4 refer to using a pressure washer to “spray away” dirt or soap residue.
- RMB6: Pages from the internet of UK companies who offer cleaning services under names which incorporate “spray away” or “sprayaway”. Of the six companies, two offer commercial cleaning (pages 1 & 3), one (page 2) provides carpet and upholstery cleaning, another (page 4) provides stonework cleaning, another (page 5) is a weed control specialist, and the last one (page 6) has no services listed.

8) That concludes my summary of the evidence filed, insofar as I consider it necessary.

## DECISION

9) The opposition is based upon Sections 3(1)(b), (c) and (d) which read:

“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 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.”

10) I shall first consider the ground of opposition under section 3(1)(d). I take into account *Telefon & Buch Verlagsgesellschaft mbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-322/03, where the General Court (GC) stated:

“49 Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the *bona fide* and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma (BSS)* [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public’s perception of the mark (*BSS*, paragraph 37).

50 With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (*BSS*, paragraph 38).

51 Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for

which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and *BSS*, paragraph 39).”

11) At the hearing it was contended that exhibit RMB4 provided actual examples of use by UK companies on cleaning products.

“I have already under section 3(1)(b) argued that the spray away word mark is the dominant part of the word mark, the word element, with the graphic element having very little distinctiveness and it is illustrating the way in which the product is used, and the term “spray away” is certainly a descriptive term which either is, I believe, in use in the current trade or may be wished to be used by traders as a descriptive term,”

12) In relation to exhibit RMB4 it was contended:

“But the fact that four or five of those just serve to illustrate that spray away is a sign which is being used in the relevant trade in a trade mark manner as the name of goods, either with or without a distinctive element.

Basically the applicant has not disclaimed any right to the exclusive use of the term “spray away”. Reckitt is a company engaged in the manufacture of cleaning preparations, including cleaning preparations having antibacterial properties, and it is concerned that, if registration of the mark applied for was granted, Lakeland could then seek to prevent the use of spray away by Reckitt or other traders upon or in relation to cleaning preparations, particularly cleaning preparations having antibacterial properties.

Also, Lakeland could use its mark to seek to challenge future applications by Reckitt or others for marks incorporating the descriptive term “spray away” in conjunction with another element.”

### **Expectations of the average consumer**

13) It was accepted at the hearing that the average consumer of the opposed goods would be a member of the general public who would be reasonably well informed, observant and circumspect. However, the opponent contended that cleaning preparations are likely to be purchased from supermarkets as part of the weekly shop and that the purchaser is unlikely to spend time selecting the item and closely reading the label before putting it in the trolley or basket. The reasoning behind this contention was that the customer “may be distracted; they may have young children with them; they may even order online where the products are not clearly visible by the image of the product.”

14) The opponent also claimed that the average consumer was “not going to pick up each bottle on the shelf and closely examine it unless you have a lot of time to do your weekly shop. It is not the sort of item like a car or a large purchase where you are going to take a lot of time and consideration over it.” I do not accept these comments as, to my mind, the average consumer will need to ensure that the cleaning preparation they are purchasing will do the task for which it is being purchased. These days there are a huge range of specialised products which are suitable for particular applications. If one has an induction hob then you have to be very careful as to the cleaning product used or it will cease to

function. Similarly there are numerous other types of surface that can be quickly ruined by inappropriate cleaners. The average consumer is quite likely therefore to pick up the product and read the label to ensure it will not damage whatever it is they require to clean.

15) In order for the opponent's objection based upon 3(1)(d) of the Act to succeed, it must establish that at the relevant date in these proceedings (i.e. the date of the application for registration), the average consumer would have considered the mark in suit to consist exclusively of signs or indications which had become customary in the current language or in the bona fide and established practices of the trade. In *Stash Limited v Samurai Sportswear Ltd* (BL O/281/04) Professor Annand, sitting as the appointed person, stated:

“33. In the event, I do not believe this issue of the interpretation of section 3(1)(d) is central to the outcome of the appeal. “Customary” is defined in the Oxford English Reference Dictionary, 1995 as: “usual; in accordance with custom”. In my judgment, the Opponent has failed on the evidence to prove that at the relevant date STASH contravened section 3(1)(d) as consisting exclusively of signs or indications which have become customary either in the current language or in trade practices for the goods concerned.”

16) Section 3(1)(d) of the Act states that the mark in suit must 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. The opponent has provided four examples which show other UK companies using the words “SPRAY AWAY” in relation to cleaning products. However the mark in suit also has a device element and so there is no use by others of the mark in the form that it seeks to be registered. But even if I ignored the device element and simply concentrated upon the word aspect the evidence at exhibit RMB4 is not dated prior to the relevant date. The opponent has therefore failed to show that at the relevant date the trade mark in the form in which it appears earlier in this decision had become customary in the current language or in the bona fide and established practices of the trade. **In the absence of appropriate evidence, the opponent's objection based upon section 3(1)(d) of the Act fails.**

17) I next turn to consider the grounds of opposition under sections 3(1)(b) & (c) of the Act. I take into account *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* in which the CJEU said in relation to article 3 of the regulation, the equivalent of section 3(1)(c) of the Act:

“54 As the Court has already held ( *Windsurfing Chiemsee* , para.[25], *Linde*, para.[73], and *Libertel* , para.[52]), Art.3(1)(c) of the Directive pursues an aim which is in the public interest, namely that such signs or indications may be freely used by all. Article 3(1)(c) therefore prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks.

55 That public interest requires that all signs or indications which may serve to designate characteristics of the goods or services in respect of which registration is sought remain freely available to all undertakings in order that they may use them when describing the same characteristics of their own goods. Therefore, marks consisting exclusively of such signs or indications are not eligible for registration unless Art.3(3) of the Directive applies.

56 In those circumstances, the competent authority must, under Art.3(1)(c) of the Directive, determine whether a trade mark for which registration is sought currently represents, in the mind of the relevant class of persons, a description of the characteristics of the goods or services concerned or whether it is reasonable to assume that that might be the case in the future (see to that effect *Windsurfing Chiemsee*, para.[31]). If, at the end of that assessment, the competent authority reaches the conclusion that that is the case, it must refuse, on the basis of that provision, to register the mark.

57 It is irrelevant whether there are other, more usual, signs or indications for designating the same characteristics of the goods or services referred to in the application for registration than those of which the mark concerned consists. Although Art.3(1)(c) of the Directive provides that, if the ground for refusal set out there is to apply, the mark must consist exclusively of signs or indications which may serve to designate characteristics of the goods or services concerned, it does not require that those signs or indications should be the only way of designating such characteristics.

58 Similarly, whether the number of competitors who may have an interest in using the signs or indications of which the mark consists is large or small is not decisive. Any operator at present offering, as well as any operator who might in the future offer, goods or services which compete with those in respect of which registration is sought must be able freely to use the signs or indications which may serve to describe characteristics of its goods or services.”

18) I also note Case C-37/03 P *BioID AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* where the CJEU stated that for a term to be viewed as being descriptive of a characteristic of goods and services:

“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).”

19) In *Combi Steam Trade Mark* (BL O/363/09) the Appointed Person commented on section 3(1)(b) of the Act in the following terms:

“7. It has been said that lack of distinctive character is the essence of any objection under section 3(1)(b), (c) or (d) of the Act and that, despite its position in the list, section 3(1)(b) performs “a residual or sweeping-up function”, backing up the other two provisions, which contain specific and characteristic examples of types of marks that lack distinctive character: *Procter & Gamble Ltd’s Trade Mark Application* [1999] RPC 673 (CA) per Robert Walker LJ at 679. If a trade mark is entirely descriptive of characteristics of goods or services (and thereby prohibited from registration under section 3(1)(c)), it will also be devoid of any distinctive character under section 3(1)(b): Case C-363/99 *Koninklijke KPN Nederland BV v Benelux-Merkenbureau (POSTKANTOOR)* [2004] ETMR 57 (ECJ) at [86]. However, the converse is not true: a mark which is not descriptive may nevertheless be devoid of distinctive character for other reasons (*ibid.*).

8. When a trade marks examiner assesses the distinctiveness of a trade mark within the meaning of section 3(1)(b), s/he must do so firstly by reference to the goods or services listed in the specification, and secondly by reference to the perception of the mark in relation to such goods or services by the relevant public, which consists of average consumers of the goods or services in question, who are deemed to be reasonably well informed, observant and circumspect: *Joined Cases C-53/01 to C-55/01 Linde AG, Winward Industries Inc and Radio Uhren AG* [2003] ETMR 78 at [41].

9. It is not necessary to show that a mark has a particular level of creativity or originality in order to establish distinctive character: *Case C-329/02P SAT.1 Satelliten Fernsehen GmbH v OHIM* [2005] ETMR 20 (ECJ) at [41]. While the Court of First Instance (“CFI”) has repeatedly referred to “a minimum degree of distinctive character” as being sufficient to avoid article 7(1)(b) of the CTMR/article 3(1)(b) of the Directive (for example, *Case T-34/00 Eurocool Logistik GmbH & Co. KG v OHIM (“EUROCOOL”)* [2003] ETMR 4 at [39]; *Case T-128/01 Daimler Chrysler Corp v OHIM* [2003] ETMR 87 at [33]; *Case T-320/03 Citicorp v OHIM (“LIVE RICHLI”)* at [68]), the ECJ has not adopted this wording and has deemed it unnecessary to give any more precise definition to the possible dividing line between lack of distinctiveness and the minimum distinctiveness to which the CFI refers: *Deutsche Krankenversicherung AG v OHIM (“COMPANYLINE”)* [2002] ECR I-7561 at [20].

10. The ECJ approaches the issue of distinctiveness by reference to the underlying purpose of article 3(1)(b) of the Directive/7(1)(b) CTMR, which in the Court’s view is to preclude registration of trade marks that are incapable of performing the essential function of guaranteeing the identity of the origin of the marked product to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin: *SAT.1 v OHIM* at [23]; *Case C-37/03 P BioID AG v OHIM* [2005] ECR I-7975 (ECJ) at [27].”

20) It is clear from the above that for an application to transgress against Section 3(1)(c) there must be “sufficiently direct and specific relationship” between the mark in suit and the goods applied for “to enable the public concerned immediately to perceive, without further thought, a description of the services in question or one of their characteristics”.

21) In *BioID* the CJEU said in relation to article 7(1)(b) of the regulation:

“29 Thirdly, as regards a compound mark, such as that which forms the subject-matter of the present dispute, any distinctive character may be assessed, in part, in respect of each of the terms or elements, taken separately, but that assessment must, in any event, be based on the overall perception of that trade mark by the relevant public and not on the presumption that elements individually devoid of distinctive character cannot, on being combined, present such character (see *SAT.1 v OHIM*, cited above, paragraph 35). The mere fact that each of those elements, considered separately, is devoid of distinctive character does not mean that their combination cannot present such character (see, by way of analogy, *Case C-363/99 Koninklijke KPN Nederland* [2004] ECR I-1619, paragraphs 99 and 100, *Case C-265/00 Campina Melkunie* [2004] ECR I-1699, paragraphs 40 and 41, as well as *SAT.1 v OHIM*, cited above, paragraph 28).”



22) The opponent contended:

“The dominant element of the mark is the words “spray away”. The stylisation of the letters in the mark is minimal. The term “spray away” is a non-distinctive term in relation to the goods applied for. It is a simple juxtaposition of the common English words “spray” and “away”. If we look at the individual words, item 3 comprises copies of dictionary definitions of the words “spray” and “away” and “spray” as a noun means “water or other liquid dispersed by impact, et cetera, in fine mist-like particles” (page 2 of item 3); it can be “a jet of medicated vapour or the like, used especially as a disinfectant or deodorizer; an instrument used for applying such a jet”, and as a verb the word “spray” means “to diffuse or send in the form of spray; to scatter in minute drops; to sprinkle with or as with spray; to wet with fine particles of water or other liquid”.

Similarly there are several meanings of “away”. These are shown on page 4 of the exhibit and these include “from such-and-such a place”, “removal from this (or that) place”; “straightway, without hesitation or delay”; and “gone (from existence); destroyed”. Thus the term “spray away” is descriptive of, for example, cleaning preparations and the like which are dispersed in fine particles away from the container, or sprayed to remove or destroy bacteria.

So that is the word element of the mark. Looking at the accompanying graphic element of the mark, this merely depicts spray particles or droplets and is, therefore, non-distinctive in relation to cleaning products and the like which are dispersed by spraying. I submit that the word element of the mark and the graphic element are each devoid of distinctive character and, in general, where a mark is composed of two signs devoid of distinctive character the trade mark as a whole will also be devoid of distinctive character unless concrete evidence were to indicate that the compound mark was greater than the sum of its parts. I refer you to the decision of the General Court in Case T-28/05. This states at paragraph 45:

“according to case law, if, when the overall impression conveyed by the trade mark is examined, a component which is devoid of any distinctive character is the dominant element of that mark, whereas the other figurative and graphic elements of which it is composed are ancillary and do not possess any feature, in particular in terms of fancifulness or as regards the way in which they are combined, then the trade mark applied for as a whole is devoid of distinctive character ... and must be refused registration”.

And:

“In the present case the combination of the dominant element, the non-distinctive words “spray away” with a non-distinctive graphic does not make the mark as a whole distinctive, and the Applicant has submitted no concrete evidence to the contrary.”

And:

“The term “spray away” is descriptive, for example, of cleaning preparations presented in aerosol or spray pump containers and used to spray away dirt, grease or bacteria from household surfaces.”

And:

“The argument is that the term “spray away” under section 3(1)(c) does not happen to actually be in use: it is sufficient that it could be a term that other traders wish to use.”

23) I agree that the word “spray” has an obvious meaning particularly when used on a bottle or can with a spray nozzle. However, the word “away” is not, in my view an obvious way of describing the removal of offending grime etc. The combination is also grammatically inelegant. However, the mark in suit does not consist simply of these two words in a normal font. The mark also has a very obvious device element of the spray effect of several jets emanating from behind the wording, surrounding it in a mist of spray and droplets.

24) Having considered the individual elements of the mark in suit I must consider the overall impression the trade mark creates. In *Campina Melkunie BV and Benelux-Merkenbureau (C-265/00)* the CJEU said:

“39. As a general rule, the mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics within the meaning of Article 3(1)(c) of the Directive even if the combination creates a neologism. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned.”

25) In *Flying Scotsman O-313-11* the Appointed Person said:

“19. Since there is no obligation to rule on the possible dividing line between the concept of lack of distinctiveness and that of minimum distinctiveness when assessing the registrability of a sign under Section 3(1)(b), see Case C-104/00 P *Deutsche Krankenversicherung AG v OHIM (COMPANYLINE)* [2002] ECR I-7561 at paragraph [20], it is not necessary to dwell on the question of how far Section 3(1)(b) may go in preventing registration beyond the scope of Section 3(1)(c). It is sufficient to observe that a sign may be:

(1) distinctive for the purposes of Section 3(1)(b), with the result that it cannot be regarded as descriptive for the purposes of Section 3(1)(c) and must be unobjectionable on both bases; or

(2) neither distinctive for the purposes of Section 3(1)(b), nor descriptive for the purposes of Section 3(1)(c), with the result that it must be objectionable on the former but not the latter basis; or

(3) descriptive for the purposes of Section 3(1)(c), with the result that it cannot be regarded as distinctive for the purposes of Section 3(1)(b) and must be objectionable on both bases.

These considerations point to the overall importance of establishing that a sign is free of objection under Section 3(1)(b).”

26) The Appointed Person dealt with section 3(1)(b) of the Act first. Having found the mark under consideration to be free from objection under section 3(1)(b) of the Act, this excluded the possibility of refusal under section 3(1)(c); I shall adopt a similar approach.

27) While it is clear from the comments of the CJEU in *Campina* that as a general rule combining elements each of which are descriptive is unlikely to create a distinctive totality, it is equally clear from the court's comments in *BioID* (by reference to the comments in *SAT1*) that a trade mark's distinctive character must be based upon the average consumer's overall perception of it and not on the presumption that elements individually devoid of distinctive character cannot, on being combined, present such character.

28) To my mind the combination of the words "spray" and "away" do not add anything to each other in the sense of changing its meaning. However, I do not accept the view that these words are completely descriptive and so lack distinctiveness. To my mind, the mark in suit has just enough sufficient distinctiveness to overcome a section 3(1)(b) objection. As the trade mark is distinctive for the purposes of this section of the Act, applying the rationale of the Appointed Person in *Flying Scotsman*, it cannot be considered objectionable under section 3(1)(c) of the Act. However, even if I were to ignore the Appointed Person's view I would hold that the mark in suit does not consist exclusively of signs or indications which may serve in trade to designate the kind, quality etc as it consists of more than just the words "SPRAYAWAY" and further even these words have not been shown to be signs used in trade. **To my mind the grounds of opposition under both Section 3(1)(b) and 3(1)(c) fail.**

## CONCLUSION

29) The opposition has failed under all grounds.

## COSTS

30) The applicant has been successful and it is therefore entitled to a contribution towards its costs.

Preparing a statement and considering the other side's statement	£300
Considering the other sides evidence	£400
Preparing for and attending a hearing	£800
TOTAL	£1500

31) I order Reckitt Benckiser (UK) Limited to pay Lakeland Limited the sum of £1500. 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.

**Dated this 25<sup>th</sup> day of February 2013**

**George W Salthouse  
For the Registrar,  
the Comptroller-General**