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TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION m 2123770  
BY JUMPER LTD  
TO REGISTER A TRADE MARK  
**COSMETICS**  
IN CLASS 5

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AND IN THE MATTER OF OPPOSITION THERETO UNDER  
OPPOSITION NO.47435 NEXT RETAIL LIMITED.

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TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No 2123770  
by JUMPER LIMITED  
5 TO REGISTER A TRADE MARK IN CLASS 5

AND IN THE MATTER OF OPPOSITION THERETO  
by NEXT RETAIL LIMITED

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## DECISION

On 14 February 1997, Jumper Limited of Bridge Mill, Cowan Bridge, Carnforth, Lancashire, LA6  
2HS applied under the Trade Marks Act 1994 for registration of the Trade Mark COSMETICS  
15 in respect of the following goods in Class 25:

“Clothing; footwear, headgear”

On the 2 September 1997 Next Retail Limited of Desford Road, Enderby, Leicester, LE9 5AT  
20 filed notice of opposition to the application. The grounds of opposition are in summary:

i) The mark applied for, particularly in relation to hosiery and similar goods, offends  
against Section 3(1)(a), 3(1)(b) & 3(1)(c).

25 ii) The mark applied for offends against Section 3(3)(b) in that it is of such a nature as  
to deceive the public.

iii) The mark applied for offends against Section 3(4) in that its use is prohibited in the UK  
by any enactment or rule of law or by any provision of Community law.

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The opponents further requested that the Registrar refuse application number 2123770 in the  
exercise of his discretion. However, under the Trade Marks Act 1994 the Registrar does not have  
a discretion to refuse an application as he did under the old law. An application can only be  
refused if it fails to comply with the requirements of the Act and Rules in one or more respects.  
35 The applicants filed a counterstatement denying all the grounds of opposition. Both sides asked  
for costs. Neither party wished to be heard in this matter. My decision will therefore be based on  
the pleadings and the evidence filed.

## 40 OPPONENTS' EVIDENCE

This takes the form of three statutory declarations. The first, dated 4 August 1998, is by Carolyn  
Springett the buying manager for womenswear of Next Plc, a position she has held for two years,  
having been involved in the womenswear clothing retail industry for more than ten years.

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Ms Springett states that the opponents have no objection to the applicants mark being registered  
for clothing if tights and similar goods were excluded from the specification. She states that the

opponents have more than 300 retail outlets throughout the UK and sell men's, women's and children's clothing, accessories and footwear. Some stores also sell bedding, wallpaper and light fittings. Tights are sold in the majority of their stores, with nineteen different styles of hosiery being available. In her opinion the words COSMETIC or COSMETICS when used on tights are descriptive.

A definition of the word cosmetic from the Oxford English dictionary is provided:

“Intended to adorn or beautify the body; intended to improve only appearances; superficially improving or beneficial”.

Ms Springett states that tights “can have many purposes’ one of which is to beautify the appearance of legs”. To back up her contention that the word cosmetic is used by the hosiery trade in a descriptive sense Ms Springett provides a copy of an article from The Drapers Record, a weekly trades magazine for the clothing retail industry. The article is titled “Cosmetic Comfort” and states:

“Aside from physical improvement promises hosiery now sells, there is the growing perception of hosiery as make-up for legs. There are the new cosmetic shades in the ultra sheer hosiery and the use of patterns for decorative appeal”.

Ms Springett explains that sales of tights traditionally reduced dramatically during the period March - September each year. This was due to the weather getting warmer and more recently due to the trend towards a “healthy, attractive appearance and a suntan, particularly on the legs, enhances this”. Clothing retailers and the hosiery industry have, according to Ms Springett, consciously set out to try to increase sales of hosiery during the summer months. A range of sheer tights that fulfils the need to colour the leg and enhance its appearance has been developed. She states that this has resulted in tights becoming a year round purchase. The opponents have for sale tights in natural shades in a seven-denier weight. She explains that the denier of a pair of tights refers to the weight of the yarn and therefore the appearance of the tight on the leg. A lower denier gives a sheer appearance, whereas a higher denier gives a more opaque product. She also states that whilst ten denier tights are currently the most popular in the opponents’ range, making up 36% of sales, the customer is now demanding even sheerer tights ( seven and five-denier). Ms Springett is of the opinion that the reason for this shift in demand towards tights of a lower denier is: -

“to beautify the colour of the legs and give the appearance of smoothing out imperfections. They are, by their nature beautifying and therefore the use of the word cosmetic is wholly descriptive in this context. In the past tights made of lower deniers would also snag or ladder easily and were therefore impractical. Technology has recently made it possible, due to the increase strength of the fibres from which the tights are made, to mass produce tights of a denier as low as five and still be strong enough to wear on a regular basis.

The colours of tights also show their cosmetic role in that the most common colours sold in the summer month’s range between tan and nude shades. The colour tan describes the colour of the tights when worn on the legs, that is those tights which when worn will give the appearance as though the legs have been tanned by the sun. Some women obtain the same appearance of having tanned legs by using liquids on their legs to give the

appearance of a fake tan. The tights use material to obtain the same effect. Again in this context the sole purpose of the tights is to beautify the appearance of the legs. Certainly in the summertime it would be arguably cooler not to wear tights than to wear them, however some women wear tights in the summer to improve the appearance of their legs and the clothing retail industry has set out to encourage them to do so to increase the sale of tights during the summer months, taking advantage of the new technology and fibres available”.

Finally, Ms Springett states that she is aware of two other companies (Sainsbury’s and Aristoc) who use the word COSMETIC on the packaging of tights in a descriptive manner. An example of the packaging of Aristoc is provided at exhibit CS2. This shows the name Aristoc and “Flawless Finish” on the front of the packet. Under the same title on the rear of the packet are the words “Cosmetic finish 15 Denier sheer tights.....”.

The second statutory declaration is by Nicola Bannon, dated 19 August 1998, who is the product manager for hosiery in the Beauty Business Centre of the Boots Company Plc, a position she has held for ten months. She states that Boots currently uses the word COSMETIC as the name of the colour of one of the pairs of tights in their hosiery range. A sample of the packaging is provided at exhibit NB1 and shows the Boots logo, with the words “Tights, Shine and Sheer” in large print, with the word COSMETIC appearing at the top right corner with the size alongside. To prove that this use is to describe the colour, another packet of tights is provided at exhibit NB2 which shows the same layout except that the word COSMETIC has been replaced by the word BLACK.

Ms Bannon concludes by stating that Boots consider the word COSMETIC to be a descriptive one when applied to tights. Boots have been using the word COSMETIC in “a descriptive manner on the packaging of our pairs of tights for at least the last two years if not longer”.

The last statutory declaration is by Mr Keith Bashford, dated 18 August 1998, who is the Head of Trading Law at J Sainsbury Plc, a position he has held since 1991. He states that Sainsbury’s use the word COSMETIC on hosiery as part of a description of the product and states his belief that the word is descriptive and a generic term. He provides a copy of packaging from a Sainsbury product which shows their use of the word COSMETIC. This shows the words “Sainsbury’s BARELY THERE tights” in large print with the words “Light cosmetic finish for natural legs” underneath.

As the applicants did not file any evidence that concludes my review of the evidence. I now turn to the decision.

#### **SECTION 1(1) & SECTION 3(1)(a) OF THE ACT**

Section 1(1) of the Act is in the following terms:

*“1 (1) In this Act a “trade mark” means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings”.*

*“A trade mark may, in particular, consist of words (including personal names), designs,*



There is no separate definition of the word cosmetics, and I therefore accept that there is little to distinguish the two. Whilst I take note of the dictionary definition, it alone cannot be decisive. Section 3(1)(c) excludes from registration “signs or indications which may serve, **in trade**, to designate” characteristics of the goods or services (emphasis added). If the word COSMETICS is a sign which is likely to be used honestly, in trade, to describe characteristics of the goods or services at issue, the sign is excluded from registration by Section 3(1)(c), whether or not such use is correct from an academic viewpoint. Words excluded from registration by Section 3(1)(c) will also be excluded by Section 3(1)(b).

The opponents have put forward evidence to show that the mark applied for is used by others in the trade as a description for hosiery products. The applicants have denied this in their counterstatement but have offered no argument or evidence to substantiate their claim. In my view the word COSMETICS is an apt name for hosiery products. I do not consider that the public would perceive such a word as a distinctive trade mark when used on hosiery.

Moreover, I have to take into account the effect that registration of the mark would have on other businesses. Mr Laddie QC (as he was then) said in PROFITMAKER Trade Mark (1994 RPC 613)

“The fact that honest traders have a number of alternative ways of describing a product is no answer to the criticism of the mark. If it were, then all these other ways could, on the same argument, also be the subject of registered trade marks. The honest trader should not need to consult the register to ensure that common descriptive or laudatory words, or not unusual combinations of them, have been monopolised by others.” Although these comments related to a trade mark being registered under the 1938 Trade Marks Act, the comments are relevant to the 1994 Act.

The opposition under Section 3(1)(b) &(c) of the Act succeeds in relation to hosiery goods.

I next consider the ground of opposition under Section 3(3)(b) which states:

- (3) *A trade mark shall not be registered if it is -*
- (a) *.....*
  - (b) *of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).*

The opponents have contended that the mark applied for, COSMETICS, is descriptive of the product when applied to hosiery products. Their evidence does not contain any arguments that the public would be deceived as to the nature, quality or geographical origin of the products if the mark were applied to any of the applicants’ goods. The ground of opposition under Section 3(3)(b) therefore fails.

#### **SECTION 3(4)**

- (4) *A trade mark shall not be registered if or to the extent that its use is prohibited in the United Kingdom by any enactment or rule of law or by any provision of Community law.*

Similarly, the opponents have offered no evidence in support of this ground of opposition and therefore it fails.

5 The opposition to the applicants mark in relation to hosiery products has been successful. As grounds for refusal exist only in respect of hosiery products the application will be allowed to proceed to registration if, within one month of the end of the appeal period for this decision, the applicants file a TM21 restricting the specification as follows:

10 Class 25 “Clothing, footwear, headgear; excluding all articles of hosiery.”

If the applicants do not file a TM21 restricting the specification as set out above the application will be refused in its entirety.

15 The opposition having been successful the opponents are entitled to a contribution towards their costs. I order the applicants to pay the opponents the sum of £535

Dated this 7 day of April 1999

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25 George W Salthouse  
For the Registrar  
The Comptroller General