

O-072-04

**TRADE MARKS ACT 1994**

**IN THE MATTER OF  
APPLICATION NO. 2316409  
TO REGISTER A TRADE MARK  
IN CLASS 3**

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BY CONSTANCE CARROLL COSMETICS plc**

**DECISION AND GROUNDS OF DECISION**

**Background**

1. On 20<sup>th</sup> November 2002, Constance Carroll Cosmetics plc of 32 Gorsey Place, East Gillibrands, Skelmersdale, Lancashire WN8 9UP applied to register the trade mark EYE SPARKLES in Class 3 in respect of the following goods:

Non-medicated toilet preparations; cosmetic and make-up products; nail polish, nail polish remover; eye shadow, eye toner, eye liner, eye pencils, mascara, lipstick, lip gloss, lip liner, make-up cream, face powder, compacts, powder blushers, make-up kits, liquid make-up; perfumes, toilet water, fragrances, toiletries; talcum powder; anti-perspirants, deodorants, body sprays; soap for personal use; bath gel, shower gel; shaving soap, shaving cream and shaving gel; aftershaves; skin care preparations.

2. Objection was taken against the application under Sections 3(1)(b) and (c) of the Act because the mark consists exclusively of the term EYE SPARKLES which is considered devoid of any distinctive character and may serve in trade to designate a characteristic of the goods, e.g. cosmetics to make the eye sparkle.

3 In order to substantiate the objection, extracts from web sites on the internet showing use of terms “eye sparkles” or “eye sparkle” were sent to the applicant’s representatives. Examples of these are shown in Annex A attached to this document.

**Decision**

4. A hearing was held on 7<sup>th</sup> August 2003 at which the applicant was represented by Mr Bruce Marsh of Wilson Gunn M’Caw, Trade Mark Attorneys. The objection under Section 3 (1)(b) and (c) of the Act was maintained and the application was subsequently refused on 18<sup>th</sup> November 2003 in accordance with Section 37(4) of the Act.

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. The relevant part of Section 3 of the Act is as follows:

“Section 3(1):

The following shall not be registered-

- (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,”

## **The case for registration**

8. In support of the application, submissions were made in correspondence and at the hearing by Mr Marsh, whose principle arguments may be summarised as follows:

- Cosmetics would not be directly applied to the eye but to the surrounding area and therefore the words EYE SPARKLES do not immediately denote a product that makes the eye brighter or sparkling;
- EYE SPARKLES is merely a fanciful phrase used to describe a particular type of cosmetic product;
- There is no category of goods described as “eye sparkles”. The references shown in the extracts supplied from the internet which relate to “eye sparkles” may refer to the applicant’s own goods. Furthermore, the dates of publication of the internet extracts are indeterminate;
- In use, EYE SPARKLES would be perceived as a trade mark.

9. In order to show how the mark is being used, Mr Marsh supplied a photocopy depicting what appears to be a cylindrical shaped container bearing the words EYE SPARKLES. This is shown at Annex B.

## Decision

10. The mark consists of the words EYE SPARKLES which is not a phrase that may be found in dictionaries. It is, nonetheless, a combination of two words which may serve in trade to designate characteristics of the goods and services covered by the application and is therefore debarred from registration under Section 3(1)(c) of the Act. Although the original objection focussed on the intended purpose of the goods, i.e., products which make the eye sparkle, for reasons which I state below, I am of the view that the mark is equally open to objection because "eye sparkles" may serve in trade to designate the kind of goods, i.e. cosmetics. In relation to goods and services where the mark does not designate their characteristics, e.g. perfumes, shaving cream etc, I take the view that it is also debarred from registration under Section 3(1)(b) of the Act.

### Section 3(1)(c)

11. On 20 September 2001, the European Court of Justice issued a judgement in *Proctor & Gamble Company v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case-383/99P for the mark *Baby-Dry*. This judgement gives useful guidance on the test for descriptiveness under Section 3(1)(c) of the Act.

12. I give below paragraphs 37, 39 and 40 of the judgement in full:

"37. It is clear from those two provisions taken together that the purpose of the prohibition of registration of purely descriptive signs or indications as trade marks is, as both Procter & Gamble and the OHIM acknowledge, to prevent registration as trade marks signs or indications which, because they are no different from the usual way of designating the relevant goods or services or their characteristics, could not fulfil the function of identifying the undertaking that markets them and are thus devoid of the distinctive character needed for that function."

"39. The signs and indications referred to in Article 7(1)(c) of Regulation 40/94 are thus only those which may serve in normal usage from a consumer's point of view to designate, either directly or by reference to one of their essential characteristics, goods or services such as those in respect of which registration is sought. Furthermore, a mark composed of signs or indications satisfying that definition should not be refused registration unless it comprises no other signs or indications and, in addition, the purely descriptive signs or indications of which it is composed are not presented or configured in a manner that distinguishes the resultant whole from the usual way of designating the goods or services concerned or their essential characteristics."

"40. As regards trade marks composed of words, such as the mark at issue here, descriptiveness must be determined not only in relation to each word taken separately but also in relation to the whole which they form. Any perceptible difference between the combination of words submitted for registration and the terms used in the common parlance of the relevant class of consumers to designate the goods or services of their

essential characteristics is apt to confer distinctive character on the word combination enabling it to be registered as a trade mark."

13. These paragraphs indicate that only marks which are no different from the usual way of designating the relevant goods or services or their characteristics are now debarred from registration by Section 3(1)(c). I am of the view that EYE SPARKLES comprises a phrase which is not an unusual way of describing the applicant's goods and therefore the public could not distinguish them from those provided by other undertakings. Without any evidence to persuade me to the contrary, I believe that the mark "may serve in normal usage from a consumer's point of view to designate" one of the essential characteristics of the goods and services.

14. It is clear from the extracts identified on web sites on the internet (under Annex A) that the terms "eye sparkle" or "eye sparkles" are of the type which may be used in trade to describe cosmetics. For example, in the paper headed "Beauty and Makeup Tips and Tricks" there is advice on how to achieve "eye sparkle". In an article by the firm Superdrug, reference is made to "STARDUST – a long-lasting ultra fine illuminescence powder for eyes mixed with micro particles of shimmer for striking eye sparkle – choose from 14 shades". From the Accessorize web site, a multi-wand set is promoted which consists of lip-gloss and eye sparkle wands. The Lycos article extracted from the Saftershopping web site refers to "Eye Sparkles. Glitter highlighters. Use on the face or body." Finally, in an article titled "Colour Cosmetics 2000" reference is made to "sparkles and glitters find application in all types of cosmetic product, from shampoos and bathroom toiletries to lipsticks, eye shadows and nail enamels".

15. Concerning the question of the dates of internet extracts supplied to Mr Marsh, it should be noted that the extract from the Safershopping web site (copyright Lycos) is dated 2001 and the reference in the "Colour Cosmetics 2000" article, I take to mean the year 2000. Although the other references do not appear to bear any dates of publication and may constitute use after the date of the application, I am of the view that they are of relevance in that they confirm the descriptive potential of EYE SPARKLES when the application was filed.

16. These references underline the importance that EYE SPARKLES is a term which should be kept free for use by others. Recent decisions and opinions of the European Court of Justice make it clear that there remains a public interest in keeping free certain words or combinations of words which others wish to use. For example, in the Opinion of Advocate General Jacobs in the trade mark *DOUBLEMINT*, he said (on 10 April 2003):

*"Availability for general use*

91. That last consideration leads me to the question of the extent to which Article 7(1)(c) of the Trade Mark Regulation must be interpreted in the light of the aim referred to in the *Windsurfing Chiemsee* judgment, namely that descriptive signs and indications should be freely available to be used by all traders in relation to the relevant goods.

92. In my Opinion in *Baby-Dry*, (39) I took the approach that in the scheme of the Community Trade Mark Regulation a trade mark could include signs or indications designating product characteristics but could not consist exclusively of them. By virtue of Article 12(b), the trade mark cannot prevent other traders from using such signs for

descriptive purposes. The aim of Article 7(1)(c) is to avoid the registration of descriptive brand names for which no protection could be available rather than to prevent any monopolising of ordinary descriptive terms. A very similar view was taken by the Court at paragraph 37 of its judgment.

93. In the present case, both the Office and the United Kingdom Government have expressed reservations about that approach, which has also been criticised in the literature. (40) It appears, they have pointed out, to represent a departure from the Courts statement in *Windsurfing Chiemsee* that Article 7(1)(c) of the Trade Marks Directive 'pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the categories of goods or services in respect of which registration is applied for may be freely used by all and that Article 6(1)(b) (which corresponds to Article 12(b) of the Regulation) does not have a decisive bearing on that interpretation.'

94. It may be feared that the approach in question is liable to shift the balance of power in favour of a trade mark owner with monopolistic ambitions who may assert, or threaten to assert, his rights against an alleged 'infringer who merely seeks to use descriptive terms descriptively and honestly'. In the real world, a defence under Article 12(b) might be worth rather less than its ostensible value in law.

95. That danger cannot be ignored. A trade mark owner wishing to monopolise not only his trade mark but the area around it may threaten unmeritorious proceedings against a competitor, who may capitulate rather than incur the costs of litigation as well as risk an adverse outcome.

96. However, for the reasons already given, I do not think that the *Baby-Dry* case, properly understood, does shift the balance in the way that has been suggested. And the danger mentioned will be obviated if the criterion of 'perceptible difference' in paragraph 40 of the *Baby-Dry* judgment is applied as I have suggested above, so that a mark is accepted for registration only when it is apparent to both traders and consumers that as a whole it is not suitable, in the ordinary language of trade, as a designation of characteristics of the product in question.

97. In any event, it seems clear that there was no intention, in the *Baby-Dry* judgment, to depart from the view in *Windsurfing Chiemsee* that it is in the public interest that descriptive signs may be freely used by all. Very recently, in *Linde*, (42) the Court has expressly reaffirmed that position."

17. This opinion was confirmed by the European Court of Justice in Case C191-01 (*Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr* 2003 WL 101985) which said:

"31. By prohibiting the registration as Community trade marks of such signs and indications, Article 7(1)(c) of Regulation No 40/94 pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all.

That provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks.”

18. The fact that in many instances the trade refers to “eye sparkle” in the singular in preference to “eye sparkles” does not affect the question of distinctiveness. In the context of assessing the mark when used to promote cosmetics, I take the view the public would likely perceive EYE SPARKLES as a mere pluralized form of “eye sparkle” and therefore either version of the mark is descriptive of cosmetic products.

19. As I stated earlier in this decision, the original objection placed emphasis on the mark being open to objection because it is descriptive of goods, e.g., which make the eye sparkle. Obviously cosmetic eye drops could perform this role but the term “eye sparkles” could equally refer to the type of product which is applied around the eye area or to eyelids. The possibility that EYE SPARKLES may be interpreted ambiguously and therefore have more than one meaning is not a relevant consideration in assessing whether the mark is descriptive. In the *DOUBLEMINT* decision of the European Court of Justice C191-01 (see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr* 2003 WL 101985) the ECJ confirmed the validity of the OHIM’s approach that a word such as DOUBLEMINT does not cease to be descriptive simply because it can have several meanings and is therefore ambiguous. In the mind of the average consumer, DOUBLEMINT is spontaneously associated with certain potential characteristics of the goods in question, namely their mint-based composition and their mint flavour, so that the word is necessarily descriptive and cannot therefore be registered as a Community trade mark. The Court agreed and, further, stated:

“32. In order for OHIM to refuse to register a trade mark under Article 7(1)(c) of Regulation No 40/94, it is not necessary that the signs and indications composing the mark that are referred to in that article actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that such signs and indications could be used for such purposes. A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned.”

### **Section 3(1)(b)**

20. The *Cycling IS...* case [2002] R.P.C. 37 advanced the notion that section 3(1)(b) has separate and independent scope from section 3(1)(c), an approach since reinforced both in the European Court of Justice, in its judgement on *Companyline* [2003] E.T.M.R. 20 and by the English High Court in *Have A Break* [2002] EWHC 2533 (Ch). Therefore, having found that the mark is debarred from registration under Section 3(1)(c) of the Act, I now have to consider whether the mark is devoid of any distinctive character under Section 3(1)(b).

21. The approach to be adopted when considering the issue of distinctiveness under Section 3(1)(b) of the Act has recently been 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.

.....

39. Next, pursuant to the rule 1 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).

.....

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”.

22. I must assess the mark’s distinctiveness in relation to the goods for which the applicant seeks registration, which are cosmetics, perfumes, toiletries and the like goods. I must also have regard to the perception of the relevant consumers of these goods, which in my view are the general public.

23. Assuming notional and fair use of the mark, which includes use on the packaging of the goods as well as in advertising, it seems to me that the relevant consumer would not consider this mark to denote trade origin because “eye sparkles” would likely be regarded as a type of cosmetic product. As a matter of practice, in respect of goods for which a mark is not descriptive, the Registrar has long been reluctant to register the name of one product as a trade



mark for another product in a closely related sector of the market: see *Portogram Radio Electrical Company Limited's Application* 69 RPC [1952] 241 at 245. It is self-evident why the word “duvet”, for example, would not be able to function as a trade mark for bed sheets, or why the word “shirt” would not function as a trade mark for ties. In the present case, EYE SPARKLES is unable to denote trade origin for closely connected items of commerce such as soaps, shaving products, perfumes etc. In use in relation to such goods these signs would be, at best, ambiguous as to their meaning, and would probably just result in confusion. A similar point arose in a recent decision dated 2 May 2002 of Mr G Hobbs QC as Appointed Person in *Fourneaux de France Limited v The Range Cooker Co. plc*, BL 0-240-02.

24. I am not persuaded that the mark EYE SPARKLES in totality is distinctive in that it would serve in trade to distinguish the applicant's 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**

25. In this decision I have considered all documents filed by the agent, and for the reasons given the application is refused under the terms of Section 37(4) of the Act because the mark fails to qualify under Sections 3(1)(b) and (c) of the Act.

Dated this 22nd day of March 2004.

Charles Hamilton  
For the Registrar  
the Comptroller-General