

O-367-07

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO. 2237302 IN THE NAME OF
MILES-BRAMWELL EXECUTIVE SERVICES LTD**

AND

**AN APPLICATION FOR REVOCATION UNDER NO. 82616 AND AN
APPLICATION FOR A DECLARATION OF INVALIDITY UNDER NO.
82617 THERETO BY A DIFFERENT LTD**

TRADE MARKS ACT 1994

**IN THE MATTER of registration
No. 2237302 in the name of
Miles-Bramwell Executive Services Ltd**

and

**an application for revocation under
No. 82616 and an application for a
Declaration of invalidity under No.
82617 thereto by A Different Ltd**

Background

1. Registration No. 2237302 has a registration date of 27 June 2000, is for the trade mark SIN and stands in the name of Miles-Bramwell Executive Services Ltd (which I will refer to as MBES). The trade mark is registered in respect of the following goods and services:

Class 16: Printed matter; photographs, stationery, books, directories, recipes, pamphlets, charts, greetings cards, magazines, periodical publications.

Class 29: Meat, fish, poultry and game; meat extracts; products containing meat, sausages, puddings, cooked meat, cooked meat products; preserved, dried and cooked fruits and vegetables; jellies; jams; eggs, milk and milk products; edible oils and fats; preserves; prepared meals and snacks, prepared and packaged foods.

Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, flour and preparations made from cereals, bread, snack foods, prepared and packaged meals and foods, pastry products, confectionery, ices, ice creams, honey, treacle, yeast, baking powder, salt, mustard, vinegar, sauces, salad dressing, spices.

Class 32: Beers, mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.

Class 41: Education; providing of training; arranging and conducting of educational seminars.

Class 42: Advisory and counselling services relating to slimming, diet, exercise and health.

2. On 6 September 2006, an application to revoke the registration was filed on behalf of A Different Limited (AD). The application is based on the following grounds:

- Under Section 46(1)(c): that in consequence of acts and/or inactivity of MBES the mark has become the common name in the trade for some or all of the products or services for which it is registered;

- Under section 46(1)(d): that in consequence of the use made of it by MBES or with its consent, it is liable to mislead the public, particularly as to the nature and/or quality of the goods or services for which it is registered.

3. Also on 6 September 2006, AD filed an application seeking to invalidate the above registration based on the following grounds:

- Under Section 47(1) in that the mark was registered in breach of section 3(1), 3(1)(a), 3(1)(b), 3(1)(c), 3(1)(d), 3(3)(a) and 3(3)(b) of the Act in terms that largely follow the wording of the Act.

4. MBES filed counter-statements essentially denying the grounds of both the application for revocation and the application for invalidation. Both parties filed evidence and the matters came to be heard before me on 21 November 2007. MBES was represented by Dr. Peter Colley of Counsel instructed by Swindell & Pearson. AD was represented by Ms Alice Mastrovito of Mastrovito & Associates.

5. On the same day, I also heard associated opposition proceedings filed by MBES against AD's own application for registration. Although the revocation and invalidation proceedings have not been formally consolidated, (either with each other or the opposition proceedings), the evidence is in substance common to the three sets of proceedings. The revocation and invalidation actions were dealt with in composite submissions by the parties' representatives. On this basis, I am issuing a single decision in respect of the revocation and invalidation proceedings with a separate decision being issued in respect of the opposition proceedings. Clearly in the event of appeals the cases should travel together.

AD's evidence

6. This takes the form of witness statements of Nicholas Wallis Mason and is dated 13 December 2006. Mr Mason is the Managing Director of AD and has been in charge of the company since its inception in 2004. By way of background to the revocation and invalidity actions Mr Mason explains that AD has applied to register its own trade mark under No. 2389949. The application is in respect of the following trade mark:

Sin & Slim 

and registration is sought for the following goods and services:

Class 16: *Printed instructional material containing personal slimming plans*

Class 29: *Prepared meals and snacks whose main ingredients are proper to this class*

Class 30: *Prepared meals and snacks whose main ingredients are proper to this class*

Class 41: *Documents (electronic) viewed on a screen, being personal slimming plans*

7. His evidence mainly goes to establishing the signification of the word SIN and usage in relation to food/dieting etc. As the content of the evidence is in substance identical to that filed in the associated opposition proceedings I reproduce below my summary of that evidence as taken from the decision issued in the opposition proceedings.

“Mr Mason explains that he has carried out research into the origins, meaning and usage of the word SIN and exhibits the results of that research. Some of the material is undated or dated after the relevant date in these proceedings. Some of it clearly originates from outside the UK. I do not intend to fully summarise this material, however the exhibits can be broadly categorised into four areas. I set these out below.

DICTIONARY REFERENCES

At OPPNWM 1 and 2 Mr Mason exhibits copies of extracts from a number of dictionaries to show the meaning of the word SIN. Naturally enough, the various extracts coincide greatly. The Ninth Edition of the Chambers Dictionary published in 2003, defines SIN as:

“moral offence or shortcoming, esp from the point of view of religion; the condition of offending in this way; an offence generally;.....”

SIN TAXES

At OPPNWM3-OPPNWM8 and OPPNWM17 Mr Mason exhibits copies of extracts from a variety of sources showing use of the term SIN TAX. At OPPNWM5, is an extract from the US Internal Revenue Services website (undated but downloaded on 22 September 2006) which defines SIN TAX as:

“ a significant tax on a product or service that is unhealthy. The tax is used to discourage the purchase and use of products that pose a risk to health, such as tobacco and alcohol.”

At OPPNWM8 is exhibited an article dated 6 March 2004 downloaded from the BBC News website. The article refers to a survey having been carried out in the UK to determine to which products or services respondents would like to see SIN TAXES applied. Fast food was listed at number 3 on the list.

DEADLY SINS

At OPPNWM9 and OPPNWM10 Mr Mason exhibits various website pages which relate to the seven deadly sins in general and gluttony in particular.

SIN(S) IN CONJUNCTION WITH FOOD AND/OR DIETING

At OPPNWM11-28 Mr Mason exhibits extracts from various website pages to show the use of the word SIN in relation to food or dieting. I shall set these out in greater detail.

OPPNWM11:

Source: christianitymagazine.co.uk

Date: May 2004.

Article entitled Food, Glorious Food

Extract: "But Sin gets everywhere. That's what it does best so you're as likely to find evidence of it in the food chain as in the heart of a toddler."

OPPNWM12:

Source: Guardian.co.uk

Date: October 25, 2005

Article entitled The Onslaught

Extract: "It's reverse, sleight-of-hand advertising: you get all the credit for exalting virtue, when really you're still selling sin."

OPPNWM13:

Source: prnewswire.co.uk

Date: 1 January 2002

News release

Extract: "Don't feel bad if you sin occasionally. It doesn't mean you can't and won't lose weight."

OPPNWM14:

Source: Spiked-online.com

Date: 19 August 2003

Article entitled Fad panics

Extract: "Today's well-fed Western world increasingly views food as a sin or a toxin: something we should berate ourselves for eating because it is good, or hate ourselves for eating because it is bad."

OPPNWM15:

Source: oup.co.uk

Date: downloaded on 15 December 2005 but refers to a book with a publication date of 6 November 2003

Book entitled: Gluttony: The seven Deadly Sins

Extract: "Part of a series of highly entertaining books on the history of sinning. Eating too much is one of the Western world's greatest problems, but relatively few people would consider it a crime against God."

OPPNWM16:

Source: Superdrug.com press release

Date: Undated

Article entitled: Shape up to a new you

Extract: “Sweetener tablets & Sweetener granules. If the thought of tea and coffee without sugar gives you the shivers reach for these sin-free sweeteners.”

OPPNWM17:

Source: Weber Shandwick Report

Date: February 2004

Article entitled: Obesity: Challenges and Implications for Europe

Extract: “In response to the obesity crisis, many governments around the world are taking their own actions, exploring options, including “sin” taxes, advertisement bans, educational campaigns, physical activity programmes and more.” And “53% of respondents were against such a ban-or additional “sin” taxes on certain foods...”

OPPNWM18:

Source: UK Parliament Select Committee on Health Minutes of Evidence

Date: 27 November 2003

Extract: “For example VAT has been levied on so-called “sin-food” for over 20 years”

OPPNWM19:

Source: The National Centre for Eating Disorders

Date: 1999

Article entitled: The psychology of Dieting

Extract: “After the milk shake, instead of doing penance for the calorific sin, the dieter persists in sinful indulgence, say the psychologists.”

OPPNWM20:

Source: Telegraph

Date: 4 January 2004

Article entitled: UK Food agonises over Atkins

Extract: “Potatoes are an Atkins cardinal sin”

OPPNWM21:

Source: The People

Date: 14 May 2006

Front Page Headline: Sin & Thin: Be Bad..But lose a stone in a month

Article entitled: Sin Yourself Slim

OPPNWM22:

Source: The diet detectives

Date: Undated but bears copyright date of 2006-2008

Extract: “Most of us tend to underreport what we eat, and it’s mostly those “sin” foods that are forgotten, such as cakes, candy, salty snacks, and other high-calorie and high-fat items.”

OPPNWM23:

Source: Veggiehealth magazine

Date: undated

Extract: “Eating fat is not the original sin; in fact, our bodies can’t function properly without it.”

OPPNWM24:

Source: Women’s health magazine

Date: March 2006

Extract: Sub-headings entitled: “The sin: the breakfast binge” “The sin: the all day graze” “The sin: the fast-food lunch”, “The sin-girls’ night out gluttony” and “The sin-Happy hour blues”

OPPNWM25:

Source: sirc.org

Date: Undated

Article entitled: Food and Eating: An anthropological Perspective

Extract: “The real modern descent into sin and wickedness is a dieter who goes on a junk food binge”

OPPNWM26:

Source: iccoventry.co.uk

Date: Undated but downloaded 12 September 2006

Article entitled: Chocs away

Extract: “Her aim, she says, is to stop people thinking of chocolate as a guilty sin”

OPPNWM27:

Source: ivillage.co.uk

Date: undated but downloaded 15 December 2005

Article entitled: Child Fare

Extract: “Ditch the “naughty but nice” attitude. Thanks to those old cream cake adverts a whole generation has grown up attaching guilt and sin to certain foods.”

OPPNWM28:

Source: Wikipedia

Date: Undated but downloaded 27 October 2006

Article entitled: Weight Watchers

Extract: “in the UK, Weight Watchers advertises under the slogan “where no food is a sin”: this is a reference to its chief competitor Slimming World’s system of giving some food “sin” values.”

Mr Mason concludes his evidence by stating his belief that MBES appears to understand that the word SIN is unable to function as a trade mark and has abandoned its use adopting instead the word SYN. At OPPNWM30 he exhibits material produced by MBES showing use of the word SYN. At OPPNWM31, he exhibits copies of extracts taken from the UK Trade Marks Registry websites showing details of MBES’ applications for the latter mark.”

MBES' evidence

8. This is a witness statement of David Rathbone dated 21 March 2007. Mr Rathbone makes various criticisms of AD's evidence which I do not intend to summarise but take into account in reaching my decisions. Also in his witness statement, Mr Rathbone adopts the evidence filed by him in the associated opposition proceedings. Again, I reproduce my summary of that evidence as taken from the decision issued in those proceedings.

“Mr Rathbone is Financial Director of MBES a position he has held since 1996. Mr Rathbone says he has been associated with MBES and its predecessors in business for over fourteen years, has a good knowledge of the trade and records of MBES, has full and unrestricted access to those records and is authorised to make his statement on its behalf.

Mr Rathbone explains that MBES trades as Slimming World, one of the UK's leading independent weight control and dietary organisations with an approximate 40% share of the UK market. The company and its predecessors have traded continuously in the UK since 1969. MBES trades through a network of 2,500 (approx) trained consultants who between them hold around 5,500 weekly slimming and weight control meetings for Slimming World members. Mr Rathbone says that at least one million members attend the groups each year and over three million are influenced to eat and live more healthily through MBES' products and services. He does not explain how this later figure is reached. Mr Rathbone states that since 1996 MBES has had approximately 600,000 new members per year subscribe to its products and services.

Mr Rathbone states that MBES' core business has always been the development and provision of weight control/eating plans, consultation and guidance to assist members of the public in controlling their weight and to assist in weight loss whilst maintaining a healthy diet. This has involved the developments of plans, concepts and supporting material. He explains that each new member is given a pack of printed material which includes a diet book. He estimates that at least 5.6 million diet books and similar publications have been printed and distributed to members joining the meetings. He confirms that the mark SIN is used in a “generally consistent manner” throughout all the material produced by MBES. In 2004 MBES “re-worked” use of its mark to SYN which, he says is used in exactly the same way as SIN.

Mr Rathbone confirms that MBES' annual turnover has been in excess of £15m for each of the last eight years. Products and services are promoted through local and national newspapers and advertising and through its own national magazine.

Mr Rathbone explains that much of the publicity for MBES is generated through articles in national and local newspapers. He exhibits a selection of such articles at DR6. Of the twelve pages exhibited, ten make reference to Slimming World. As far as I can tell, the other two merely refer to weight loss in general terms. None of the articles make any reference to SIN.

Although he provides no examples, Mr Rathbone states that advertisements for MBES services have regularly appeared in the following newspapers and magazines:

Daily Mail	The Sun	Sunday People	Mail on Sunday
Daily Mirror	Daily Record	Real	Pregnancy Magazine
Marie Claire	Shape	Women's Health	Zest
Inside Soap	Home & Life	Total Style	Woman's Weekly
Top Sante	New Baby	Health & Fitness	Woman's Own
You & Your Baby			

Mr Rathbone provides the following details for MBES' annual promotional and publicity spend in the UK:

Year	Advertising and promotional spend £ (approximate annual)
Pre TV advertising	
1995	400,000
1996	400,000
1997	400,000
1998	400,000
1999	400,000
2000	400,000
2001	400,000
2002	400,000
2003	400,000
Including TV Advertising	
2004	1,000,000
2005	1,000,000

No explanation is given on how much of the 2005 relates to the period before the relevant date in these proceedings.

Mr Rathbone goes on to state that in addition to MBES' nationwide advertising, its consultants also advertise in their own areas, generally by way of local newspaper advertising and flyers. Whilst he states that "guidelines for consultants' advertising provides for an annual advertising spend by consultants to be in the order of £2.8million. This is in addition to the Company's spend..." he does not say specifically what the actual spend might have been nor are any examples of such advertising provided.

Mr Rathbone says that SIN has been used continuously for over thirty years. MBES is the proprietor of both of the trade marks it relies on in this opposition and, at DR1, Mr Rathbone exhibits copies of the registration certificates for both.

Mr Rathbone explains that SIN is a unique way of enabling customers to "identify the relative "healthiness" of foods in a simple and effective manner.

The less healthy a foodstuff is considered to be, in accordance with the Company's eating plans, the greater the SIN value attributed to that foodstuff'.

Mr Rathbone states that SIN has been used in written materials produced by MBES "and otherwise" and is used verbally within the slimming and weight control meetings. He attaches a number of exhibits to illustrate this material:

- DR2. Two booklets. He states that the first booklet dates back to 1986 and is a complete and accurate copy of a membership booklet issued by MBES. The booklet sets out the principles behind the "SIN-A DAY diet, and explains that certain foods:

"will prevent a good weight loss if eaten to excess, so these must be counted. They will be found on the **Food Value Chart** and the amount of carbohydrate each item contains is written alongside in points."

It goes on to say that the dieter should "choose your sins (points) each day from the **Food Value Chart**".

The second booklet forming the exhibit bears no date but Mr Rathbone believes it to date back some fourteen years. It again refers to the SIN-A-DAY diet and gives various foodstuffs a SINS value.

- DR3A copy extracts of the third edition (1999) and fourth edition (2000)
- DR3B sample of sixth edition (2002)
- DR3C copy of eighth edition (2004)

of MBES' Food Directory which has been produced annually since 1997 in similar form and with consistency of use of the word SIN. The directory is a reference book which gives various foodstuffs a SIN value. The foodstuffs are categorised by brand. Mr Rathbone states that most of MBES members purchase and use such a book although they are also available to the general public. He estimates that some 200,000 books have been sold each year.

- DR3D copies of two further booklets Free Branded Food 4 and 5. These are also annually produced directories and refer to foods which MBES has categorised as being healthy enough to be SIN FREE.
- DR3E Book entitled One Hundred Original Sin Free Recipes. Mr Rathbone says the book was first published in 1992 and is still for sale. In excess of 750,000 are said to have been distributed in UK since 1994.
- DR3F Green SIN-A-DAY Eating Plan and Original SIN-A-DAY eating plan. The latter dates to about 1994 the former is believed to date from an earlier period. Mr Rathbone believes that some 600,000 have been produced.
- DR3G Green and Original SIN-A-DAY Eating Plan booklet dating from approx 1999/2000.
- DR3H Copies of registration certificates

- DR3I A random selection of publications dating from 1997-2001
- DR3J 2001 Celebrity Cookbook
- DR3K 2000 Guide to Health and beauty produced with Avon Cosmetics
- DR3L 2001 Cookbook

Since January/February 1998 MBES has produced a magazine entitled Slimming World. Distribution has increased from around 195,000 to 260,000 copies. Mr Rathbone states that it has been the best selling diet magazine title in the UK over the last five years. It is published every two months. A selection of the magazines, one from each year between 1998 to 2004, are exhibited at DR4.

Mr Rathbone states that MBES has undertaken work with the major supermarkets to produce directories which include a rating of the supermarkets' products using SIN values. Copies are provided at DR5. He says that the above books and many others have been and continue to be sold throughout the UK both to members and the general public, through book clubs and via the Internet and other distribution channels.

Mr Rathbone explains that in 2004 MBES reworked SIN to SYN and uses the latter in exactly the same way it used the former. He states that MBES established a website in 1997 and that SIN/SYN has been used continuously on the site since it went live. At DR7 he exhibits pages downloaded from the website on 20 July 2006. A second website was developed (date unknown) which is intended for use by those in the Health Care profession and copies of pages from that site, also downloaded on 20 July 2006, are exhibited at DR8.

Mr Rathbone has also filed a further witness statement. In it, he describes a witness identification programme that was undertaken to identify individuals able to give evidence relating to the issues in these proceedings. His witness statement, dated 25 October 2006, sets out what was done. The starting point was the distribution of questionnaire forms for district managers at a gathering at the company's headquarters. The district managers manage self-employed consultants either directly or through other Team Managers or Team Developers. The district managers were not themselves asked to complete the questionnaires but were responsible for getting the consultants and members to do so. The blank questionnaires are exhibited at DR9.

Mr Rathbone estimates that something in the order of 250 replies to the questionnaires were received. Those who were prepared to give a witness statement or attend to give evidence were identified. Of these, 5 were consultants and 33 were members. In view of the volume, the 5 consultants and 12 of the 33 members were approached to give evidence. The 12 were derived from an objective division of the 33 members according to their geographic origin and then for those regions where more than one member's form was present, one of that number was randomly selected. Mr Rathbone says that he believes the replies received provide a representative sample as the forms were distributed to 30 out of

2,200 consultants and 600 out of a total membership of approximately 250,000. Mr Rathbone refers to evidence from 17 people, however, only 14 witness statements are in the material before me. Dr Colley confirmed the reference to 17 people to be a typographical error.

The basic questionnaires were lengthy documents (19 questions to members and 21 in the case of consultants). I have not been shown the completed questionnaires. The resulting witness statements must, therefore, represent a condensed version of the views expressed. Annex A to this decision contains material extracted from the 14 witness statements recording the answers to certain key questions.”

AD’s evidence in reply

9. This takes the form of a second witness statement by Mr Mason, dated 21 May 2007. Mr Mason comments adversely on the evidence filed by Mr Rathbone in so far as it consists of submission and exhibits at REV2NM1 a copy of Tribunal Practice Notice (TPN 5/2004) entitled “Evidence in inter partes proceedings before the Registrar of Trade Marks: submission and argument”.

10. Mr Mason provides details of a search which he says was carried out on those UK newspapers available online prior to 2000 showing use of the word SIN in relation to food, dieting and related services. These are:

Source: Times

Date: 5 December 1988

Article entitled: Bejam Tempus

Extract: “The stock market has been waiting a long time for the bid for *Bejam*, which has become synonymous with frozen food. Bejam committed the sin of...”

Source: Independent

Date: 21 January 1989

Article entitled: Cooking your goose liver

Extract: “ There is the lovely stuff, truffle-studded, which comes in little rectangular tins and which you eat on little bits of toast while thinking sinful thoughts...” and “I do not like associating food with sin...”

Source: Independent

Date: 7 July 1990

Article entitled: The structural sin of factory farming

Extract: “The answer, I suspect, can be found by talking about structural sin, and other insights borrowed from Marxism” and “For the sinful structures in which Mr Gummer finds himself...” and “To contemplate the details of it fills us with a sense of sin: whose hallmark is that the exercise of the vice involved (greed) suddenly reveals or suggests a moral imbalance...” and “the fruits of sin turn to fast food in our mouths, as they should. Even more biblically, the sin is a corporate one.”

Source: Times

Date: 6 December 1990

Article entitled: Life with relish

Extract: “Sadly, I don’t think the English have changed all that much in their approach to food. The microwave is a sin and an abomination.”

Source: Independent

Date: 11 May 1991

Article entitled: Private cranks team up with public gaffes

Extract: “Food or life itself on this sinful planet are an equal problem”

Source: Times

Date: 25 August 1991

Article entitled: Heartily sick of the experts

Extract: “Researchers have Anne Smith wondering why chips with everything is a sin” and “the most significant factors in our dietary sinning”

Source: Independent

Date: 1 March 1992

Article entitled: The taste of things to come

Extract: “Even in food the sins of the eighties are being punished”

Source: Independent

Date: 25 July 1992

Article entitled: Racing round Athens in a day

Extract: “the service is as miserable as sin, but the food and prices are good”

Source: Independent

Date: 17 July 1993

Article entitled: Of steak and sin

Extract: “What was so sinful about a good porterhouse steak...” and “And, too, I will assert that such foods are in fact “sinful” as Mrs Tindermarsh would have it...”

Source: Independent

Date: 7 December 1993

Article entitled: Deadly diets

Extract: “Most smokers compound their sins with poor diets...”

Source: Times

Date: 19 December 1993

Article entitled: Taking turkey, with passion in chocolate sauce

Extract: “...sisters were sinning vicariously through their cooking, food is often a metaphor”

Source: Independent

Date: 13 January 1994

Article entitled: Fouquet’s fowl falls foul of the food flics

Extract: “for a menu of gastronomic sins including serving frozen food billed as fresh...”

Source: Times

Date: 3 April 1994

Article entitled: Rise and shine

Extract: “It is very old (founded 1828) amazingly diet-free, very manly, very British and the worst sin of all it specialises in....” and “there is a choice of two set menus. “The Great British breakfast”.....the second set menu, “The Ten Deadly Sins” which consists of...”

Source: Times

Date: 26 November 1995

Article entitled: Duty that’s hard to swallow

Extract: “the foulest of British sins, waste food”

Source: Independent

Date: 25 February 1996

Article entitled: The mystery is: why do we go on watching

Extract: “conflating food with sin”

Source: Independent

Date: 4 March 1996

Article entitled: How much intolerance can we tolerate

Extract: “it was not a sin for the hungry to steal food”

Source: Independent

Date: 22 September 1996

Article entitled: Don’t mention the “d” word

Extract: “I want a diet where no food is a sin”

Source: Times

Date: 3 January 1997

Article entitled: No miracle diets; slimmers are told

Extract: “The magazine found that Slimming World....the idea of “sin foods” some of which were....”

Source: Independent

Date: 29 September 1997

Article entitled: They’ll be two rich ladies

Extract: Ms Dickson Wright and Ms Patterson represent the sinning side of the American dietary paradox”

Source: Times

Date: 26 October 1997

Article entitled: The Taste Sensation

Extract: “ he even dictates that the stags he buys are carried, not dragged, off the hill-may redeem the food sins of the fathers”

Source: Times

Date: 10 December 1997

Article entitled: A little of what you fancy does you good

Extract: “A bunch of dried-up puritans announce that your food is wicked and sinful and will lead us into bad ways.”

Source: Independent

Date: 14 December 1997

Article entitled: Free and easy US resorts are less of a paradise for poseurs

Extract: "Alcohol for the under 21s equals Big Sin in the US. While food is much cheaper..."

Source: Independent

Date: 18 December 1997

Article entitled: None given

Extract: "not much new in this for aficionados of Kennedy sins to chew over-juiciest food for thought....."

Source: Independent

Date: 6 September 1998

Article entitled: Stars who never say diet

Extract: "indulgence in food is sinful"

Source: Independent

Date: 16 January 1999

Article entitled: Our annual chance to play the weighting game

Extract: "A man who on a bamboozling diet involving a set number of "sins"..."

Source: Times

Date: 10 January 1999

Article entitled: Dock horror

Extract: "This sort of bastardised ethnic food isn't a sin, it's simply pointless"

Source: Independent

Date: 24 January 1999

Article entitled: Fat and happy at last

Extract: "...had not commented on her choice of "sinful" food..."

Source: Times

Date: 28 February 1999

Article entitled: We who are about to diet salute you

Extract: "if you are going to sin on a diet you want it to be a good sin"

11. That completes my summary of the evidence.

DECISION

The revocation issues

12. Section 46(1)(c) and (d) of the Act reads as follows:

"**46.**-(1) The registration of a trade mark may be revoked on any of the following grounds-

(a)....

(b)....

(c) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product of service for which it is registered;

(d) that in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.”

13. The UK provision mirrors Article 12(2) of First Council Directive 89/104. Following discussion at the hearing, Ms Mastrovito conceded that the provisions of section 46(1)(c) could not apply because SIN is not a common name in the trade for any of the products or services contained in registration No. 2237302. This case is, to that extent, clearly distinguishable from *Hormel Foods Corp v Antilles Landscape Investments NV* [2005] R.P.C. 28 where it was held that SPAMBUSTER had become a common name in the trade for computer programming services to prevent or combat SPAM (junk electronic mail).

14. I also understand that the objection under Section 46(1)(d) is not pressed. It was suggested that “the registered trade mark misleads the public in the sense that, because it is a registered trade mark, they are under an illusion that it is a validly registered trade mark” (from the transcript of the hearing). The registration enjoys the prima facie presumption of validity accorded by Section 72. The validity of the mark has been put in question in invalidity action No. 82617. The applicant’s case in this respect is considered below. I do not consider that the applicant’s statement of grounds and subsequent evidence disclose any basis for an attack under Section 46(1)(d). The revocation action as a whole stands dismissed.

The invalidation issues

15. In her skeleton argument, Ms Mastrovito indicated that all objections other than those based on sections 3(1)(b) (c) and (d) of the Act were not being pursued. On that basis, the relevant parts of the statutory provisions read as follows:

Section 47(1):

“**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.”

Section 3(1):

“**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 consists 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.”

Characteristic of the goods/services? (Section 3(1)(c))

16. I propose to start with the objection that the mark at issue, SIN, consists of a word that serves in trade to designate a characteristic of the goods and services.

17. There are now a number of judgments from the ECJ which deal with the scope of Article 3(1)(c) of First Council Directive 89/104 and Article 7(1)(c) of Council Regulation 40/94 (the Community Trade Mark Regulation), whose provisions correspond to Section 3(1)(c) of the UK Act. I derive the following main guiding principles from the cases noted below:

- subject to any claim in relation to acquired distinctive character, signs and indications which may serve in trade to designate the characteristics of goods or services are deemed incapable of fulfilling the indication of origin function of a trade mark – *Wm Wrigley Jr & Company v OHIM* – Case 191/01P (*Doublemint*) paragraph 30;
- thus Articles 7(1)(c) (Section 3(1)(c) pursues an aim which is in the public interest that descriptive signs or indications may be freely used by all – *Wm Wrigley Jr v OHIM*, paragraph 31;
- it is not necessary that such a sign be in use at the time of application in a way that is descriptive of the goods or services in question. It is sufficient that it could be used for such purposes – *Wm Wrigley Jr v OHIM*, paragraph 32;
- it is irrelevant whether there are other, more usual signs or indications designating the same characteristics of the goods or services. The word ‘exclusively’ in paragraph (c) is not to be interpreted as meaning that the sign or indication should be the only way of designating the

characteristic(s) in question – *Koninklijke KPN Nederland NV and Benelux Merkenbureau*, Case C-363/99 (*Postkantoor*), paragraph 57;

18. It is also well established that the matter must be considered in the context of the goods and services at issue and from the perspective of the average consumer (*Rewe Zentral AG v OHIM (LITE)* [2002] E.T.M.R. 91). In reality this dispute concerns two organisations which for practical purposes operate, or intend to operate, in the same area of trade (slimming). The relevant consumer group must include a broad swathe of the population who are or may at some point be concerned with slimming, dietary, exercise and health issues though, given current concerns about childhood obesity, there is no reason to restrict the audience to the adult population. There is also no restriction in MBES's specification (other than Class 42) limiting their use in this way. However, even taking a broader view of the scope of the specification does not seem to me to make a material difference to the process of identifying the relevant consumer group other than in respect of certain items such as beers which clearly are not aimed at children.

19. Before considering what conclusions can be drawn from the evidence I need to say a little more about the scope of an objection under Section 3(1)(c). The paragraph is concerned with trade marks that consist exclusively of signs or indications that may serve in trade to designate characteristics. A number of characteristics that would serve to found an objection are listed in the paragraph itself but this is clearly not intended to be an exhaustive list. There is the catch-all "or other characteristics of goods or services".

20. There is guidance in a number of cases that have been before the Appointed Persons on appeal that give a helpful indication as to the interpretation of what is or is not to be regarded as a characteristic.

21. In *Mezzanine Trade Mark*, 0-044-04, Geoffrey Hobbs QC said:

".... it appears to be necessary to interpret the word "*characteristics*" in the expression "*or any other characteristics*" as applicable not only to what a trader may be willing to supply, but also to when, where, why and how it may be supplied. Such matters – and suitable ways of designating them – are liable to vary according to the context or manner in which goods or services of the kind specified for registration may actually be provided by traders in the relevant line of business. I think it follows that a mark can be objectionable under Section 3(1)(c) without being descriptive in every context or manner in which it could be used with reference to goods or services of the kind specified in an application for registration."

22. In *Linkin Park*, 0-035-05, Richard Arnold QC had issues before him as to whether the name of the American rock group constituted a characteristic in relation to certain Class 16 goods on the basis that it indicated subject matter. He said:

"The applicant's second main contention is that the Mark does not designate a characteristic of the Goods because subject matter is not a "characteristic" of them, and therefore the present situation was distinguishable from cases such as *DOUBLEMINT*. The applicant's attorney argued that to be a

“characteristic” something had to be, as he put it, a measurable property of the Goods rather than the information content of the Goods. I cannot accept this argument, since it is not difficult to think of goods where the information content is a critical characteristic of the goods, notably computer programs.

An alternative argument might [be] to say that subject matter is neither “kind” nor “quality” nor “intended purpose” nor “value” nor “geographical origin” nor “time of production” and that “other characteristics” must be construed *ejusdem generis* with these expressions. I cannot accept this argument either, however. In my view these expressions do not constitute any recognisable genus. On the contrary, they show that a considerable diversity of characteristics is embraced by section 3(1)(c). In my judgment the purpose of the words “other characteristics” is to make it clear that section 3(1)(c) extends beyond the specific types of characteristics mentioned. I see no reason why subject matter should not qualify.”

23. However, whilst the scope of the term ‘characteristics’ must not be construed too narrowly, there must still be a clear relationship with the goods or services as noted by the CFI in *Tegometall International AG v OHIM*, Case T-458/05 in following the earlier cases that are referenced in the following passage:

“80. It follows that, for a sign to be caught by the prohibition set out in that provision, there must be a sufficiently direct and specific relationship between the sign and the goods or services in question to enable the public concerned immediately to perceive, without further thought, a description of the goods or services in question from one of their characteristics (see, to that effect, Case T-311/02 *Lissotschenko and Hentze v OHIM (LIMO)* [2004] ECR II-2957, paragraph 30, and *PAPERLAB*, paragraph 25).”

24. More recently, in *O2 Holdings Limited Trade Mark Applications*, O-127-07, Professor Annand, had to consider whether a number of marks consisting of icons for use on computer and mobile telephone screens were open to objection under Section 3(1)(c). The first was an envelope device, the second a device of a mobile phone handset with an arrow pointing at it, and so on. The Registry’s hearing officer had held that the marks were open to objection under both Section 3(1)(b) and (c). In the case of the envelope device the hearing officer considered that it would signify that the services can communicate with or be accessed via e-mail. In the case of the mobile telephone device he considered that it would indicate that download goods and services are available. Thus, the hearing officer considered such icons to be indicators of functionality and hence characteristics of the goods and services.

25. Professor Annand on appeal, whilst upholding certain objections under Section 3(1)(b) was not persuaded that the icons were open to objection under 3(1)(c). Thus, in relation to the envelope device she held, *inter alia*, that:

“.... I do not accept that just because goods and services can communicate with or be accessed by e-mail, the device of an envelope designates a characteristic of such products.”

26. Likewise, in relation to the mobile telephone device she considered that the fact that certain goods and services can communicate with or be accessed via a mobile phone to be

“...at too general a level to qualify as even “lower order” (POSTKANTOOR, paragraph 102) characteristics of goods or services for the purpose of Section 3(1)(c)”.

The reference to *Postkantoor*, Case C-363/99, is to a paragraph where the ECJ had held that it was “irrelevant whether the characteristics of the goods or services which may be the subject of the description are commercially essential or merely ancillary”.

27. Finally, in relation to the above case I note that Professor Annand acknowledged, by reference to other European cases (considered in paragraphs 35 and 36 of her decision) that “the authorities indicate that there may be difficulty in pinpointing the exact boundaries of “characteristics” for the purpose of section 3(1)(c).”

28. With those observations on the nature and scope of the term ‘characteristics’ of goods and services in mind I turn to the facts of this case bearing in mind that the position must be considered first of all as at 27 June 2000, the filing date of the registration under attack.

29. For convenience the above evidence summary breaks the applicant’s evidence down into four main areas. The dictionary meaning of sin in terms of breaking a religious or moral law is well accepted and needs no further comment. Likewise the fact that gluttony is treated as one of the seven deadly sins. I also accept that there have been journalistic reference to sin taxes usually directed at gambling, tobacco and alcohol. None of these references comes remotely close to establishing that SIN is a word used to describe a characteristic of any of the goods or services contained in registration No. 2237302.

30. Of greater potential relevance is the material, principally exhibits 11 to 28 of the applicant’s evidence in chief which is said to place use of the word SIN in the context of food and dieting. Much of this material is from after the relevant date (and in most cases well after). The evidence summary gives a flavour (no pun intended) of the context and content of the references. Most of the references fall into the category of being convenient journalistic shorthand to allude to the ‘guilty pleasure’ to be derived from certain foodstuffs. They are in general well removed from establishing any sort of case to support the proposition that SIN is a characteristic of the goods or services in issue. Even where there is a more direct link between use of the word and a foodstuff (e.g. Exhibits 20 and 22 for instance) the context very clearly points away from the word being used to indicate a characteristic of particular goods or services.

31. It is true that Mr Mason’s reply evidence addresses Mr Rathbone’s criticism that much of the evidence in chief is outside the relevant date but it does not take the matter any further forward in terms of establishing that SIN(S) is a characteristic of the goods and services. It is in essence evidence in the same vein drawn from an earlier timeframe.

32. I think Dr Colley was right to say that SIN in the context of the applicant's evidence relates to the disapprobation attached to over-indulgence or the 'guilty pleasure' to be associated with a particular pattern of behaviour (eating sweet foods say) rather than the foodstuffs themselves. In other words foods are not in any sense sinful in themselves but eating too much of certain foods or eating too much in general may be a reflection on the behaviour of the consumer (though even then the behaviour would not be considered by many to be sinful in the conventional religious or moral sense). It seems to me, therefore, that the applicant's own evidence is a long way from establishing that SIN is a characteristic of any or all of the goods and services. Furthermore, what is singularly lacking is any evidence that other traders in the field have sought to use SIN to describe a characteristic of their goods or services.

33. At this juncture it is also necessary to look at MBES' own use because it is part of the applicant's case that that use has not been as a trade mark. Mr Rathbone's evidence includes copies of documents going back as far as 1986. Exhibit DR2 contains early Slimming World booklets. The introductory paragraphs include reference such as

"You will be put on the 'Sin-a-Day' Diet ..."

"... We can still have a 'sin' a day."

"Choose your 'sin'" and "Choose your sins (points)".

34. The latter bracketed reference indicates how the concept of SIN is used in the Slimming World diet plans. Food value charts contained in the booklets show a range of food items rated by both calories and points.

35. The second booklet in the exhibit does not carry a date but Mr Rathbone considers that it is about fourteen years old. He is writing in 2006 so presumably the booklet is from about 1992. The concept of the 'Sin-A-Day' diet is continued – Page 17 of the booklet is prominently headed SINS and sub-headed 'Choose between 5 and 15 Sins a Day'. The food rating pages show food items set out in columns and the heading SINS at the top of a column showing a rating for the various food and drink items. SINS appears at this point in time, therefore, to have taken over from 'points' but equates to the latter.

36. Later editions of the Slimming World Food Directory contain further refinements on the basic concept. Thus, the directory at Exhibit DR3A now has two columns, one relating to a 'Green Sin value', the other to 'Original Sin value'. The Food Directory is a very comprehensive document. The edition shown at DR3B, for instance, (with a copyright date of April 2002) contains SIN value ratings for more than 40,000 items.

37. There is other material in a similar vein. The recipe book at DR3E offers 'Sin-Free' recipes. The Slimming World 'Green eating plan' booklet at DR3G continues the SINS theme as does the Celebrity Cookbook at DR3J with each of the recipes being given a 'sins per serving' rating.

38. The magazine produced by MBES and called Slimming World is available both to members of the slimming groups and the public at large through ordinary retail sales.

The use of SIN/SINS in the magazines is consistent with the other publications and uses described and exemplified in Mr Rathbone's evidence. Attached to this decision as Annex B is a page from the May/June 2000 magazine (chosen because it is closest to the relevant date) showing how the concept had developed at that point in time to include a SINS Enquiries Hotline. Also included in this Annex is a page from the October 2003 magazine to illustrate how the SIN(S) concept is explained to those who may not be familiar with it.

39. Extracts from the witness statements provided by consultants and members of the Slimming World slimming groups are recorded in Annex A. Asked what their understanding of SIN was they invariably link it to Slimming World and describe it as a term used in the context of diet plans to indicate that the foods in question have to be counted towards the diet plan.

40. In this respect I regard their evidence as being consistent with the manner in which MBES, under the umbrella of its Slimming World brand, has promoted the concept. There is nothing unexpected about this. The consultants and members have been educated to understand the context and manner in which SIN is used.

41. The conclusions I draw from this evidence is that MBES uses SIN and derivative combinations such as SIN-A-DAY and SIN FREE in the context of its own rating system which ascribes a value to a wide range of foodstuffs and drinks. The principal origin-identifier in the material filed is the words Slimming World. The press cutting material at Exhibit DR6 reinforces the fact that Slimming World is the main brand and does not disclose public use in this context of SIN or SINS. I accept Dr Colley's submission that these press references serve as introductory material through which members of the public will encounter SIN (if they choose to join a Slimming World group or read the magazine for instance). But they will thereafter encounter the sort of usages that I have described above. That is to say it takes the average consumer back to the use of SIN as one of the pieces of jargon used by MBES in relation to its services, dietary plans and system of rating foodstuffs.

42. Where does this leave the applicant for invalidity's claim that SIN is a characteristic of the goods and services of the registration? It has not been shown that SIN identifies or relates to any characteristic (essential or ancillary) of the individual goods or services listed. The word may allude at a high level of generality to the concept of an indulgence or over-indulgence but even this, as I have suggested, is more to do with the behaviour of the consumer than the characteristics of the goods. The meaning that members of Slimming World or purchasers of the magazine would, therefore, have been led to understand is SIN relating to food values. But that signification only works in the context of the usage and meaning promulgated by the registered proprietor. It is not the same as saying that SIN serves in trade to indicate a characteristic of the goods or services. The point can be further demonstrated by posing the question as to what a member of the public with no knowledge of Slimming World's usage would make of SIN in relation to the goods and services. In my view the word would not convey any identifiable characteristic. The objection under Section 3(1)(c) must, therefore, fail.

Customary in the current language? (Section 3(1)(d))

43. It is well established that each of the grounds for refusal listed in Article 3(1) of the Directive (Section 3(1) of the Act) is independent of the others and calls for separate examination (Case C-363/99 *Koninklijke KPN Nederland NV v Benelux Merkenbureau (Postkantoor)* at paragraph 67 et seq). My finding that SIN is not a characteristic of the goods and services does not necessarily mean that the mark is not open to objection on other accounts.

44. Section 3(1)(d) provides that a mark shall not be registered (or be declared invalid pursuant to Section 47(1)) if it consists exclusively of signs or indications that have become customary in the language or in the *bona fide* and established practices of the trade.

45. In *Stash Trade Mark*, O-281-04, Professor Annand, sitting as the Appointed Person noted that there are two separate limbs to Section 3(1)(d) covering customary usage;

- (a) in the current language; or
- (b) in the *bona fide* and established practices of the trade.

The words ‘of the trade’ should not be construed as applying to both limbs.

46. I was also referred at the hearing to *Merz & Krell GmbH & Co*, Case C-517/99, regarding the interpretation to be placed on the paragraph. The ECJ held in that case that:

“29. The question whether particular signs or indications possess distinctive character cannot, however, be considered in the abstract and separately from the goods or services those signs or indications are intended to distinguish.”

and

“38. In such a case it is not therefore necessary to consider whether the signs or indications in question are descriptions of the properties or characteristics of the goods or services.

39. It also follows that, where the signs or indications concerned have become customary in the current language or in the *bona fide* and established practices of the trade to designate the goods or services covered by the mark, it is of little consequence that they are used as advertising slogans, indications of quality or incitements to purchase those goods or services.

40. 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. It is for the national court to determine in each case whether the signs or indications have become customary in the

current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark.”

47. The mark in that case, Bravo, was considered by the referring Court to be a term of praise and an advertising slogan. However, there appears to be no reason to restrict the scope of (d) to words or combinations that are of the kind referred to in paragraph 39 of *Merz & Krell*.

48. As regards the interpretation to be placed on the words ‘of the trade’ the ECJ in *Björnekulla Fruktingustrier AB and Procordia Food AB*, Case C-371/02, held that:

“23. If the function of the trade mark as an indication of origin is of primary importance to the consumer or end user, it is also relevant to intermediaries who deal with the product commercially. As with consumers or end users, it will tend to influence their conduct in the market.

24. In general, the perception of consumers or end users will play a decisive role. The whole aim of the commercialisation process is the purchase of the product by those persons and the role of the intermediary consists as much in detecting and anticipating the demand for that product as in increasing or directing it.

25. Accordingly, the relevant classes of persons comprise principally consumers and end users. However, depending on the features of the product market concerned, the influence of intermediaries on decisions to purchase, and thus their perception of the trade mark, must also be taken into consideration.”

49. *Björnekulla* was primarily a case involving the interpretation to be placed on Article 12(2)(a) (corresponding to Section 46(1)(c) of the Act) which refers to ‘common name in the trade’. However, there seems to be no reason to construe the words ‘of the trade’ in Article 3(1)(d)/Section 3(1)(d) differently. Furthermore, I note that the ECJ also set out in the judgment the grounds for refusal or invalidity under Article 3(1)(d) presumably because the Court considered that comparable considerations should apply.

50. I was also referred to the Registry’s Practice Amendment Notice, PAN 9/06 in relation to Section 3(1)(d). Although the guidance set out in that Practice Amendment Notice is simply that (guidance) and does not have any legal force, it will be convenient to set out the considerations that the Registry considers may be of relevance in determining issues under this head because Ms Mastrovito referred to one of them by way of anticipating a possible criticism of one aspect of her client’s evidence. They are:

- use of the sign in widely read publications offering the goods/services to the relevant public may carry more weight than limited uses on obscure web sites;
- journalistic use, whilst not irrelevant (because it leads to use by the public), is less relevant than use in the course of trade;
- private use (in ‘chat rooms’ and the like) is of little relevance;

- the size and nature of the market for the goods/services is a relevant factor: the amount of use required to show that a sign has become ‘customary’ or ‘established’ in a specialised market is liable to be less than that which is required to show the same things in relation to a much bigger market for general products or services.
- evidence must normally pre-date the application;
- evidence which post dates the application, but which shows what was happening prior to the date of the application is also relevant.

51. The applicant’s position is, of course, in part dependent on the sort of journalistic use that is referred to in the second indent above. Ms Mastrovito accepted the general thrust of the point but argued that in this particular case I should have regard to the sheer volume of examples of use of SIN placed in evidence and that the absence of use by other traders is explained by the fact that SIN has for many years been a registered trade mark. She also referred me again to the nature of the registered proprietor’s own use of the word SIN and variants.

52. Dr Colley, for MBES, submitted that the word SIN was not understandable outside the context of his client’s diet systems and services. Hence it was specific to MBES, was not customary in the language and unauthorised use has been policed by MBES.

53. I remind myself that the relevant date is 27 June 2000. As noted above Mr Mason’s evidence in chief contains material from a variety of sources, almost all of which are after that date. Mr Mason deals with this in his reply evidence. I accept that the further material, drawn from various newspapers, shows use of SIN at dates commencing in 1988 and going forward to 1999. The references to SIN are usually isolated ones appearing in lengthy articles. I do not find this material to be particularly relevant in establishing that SIN has become customary in the language etc in relation to the goods and services of the registration. The usages are journalistic ones; often unrelated or only peripherally-related to food (‘Bejam committed the sin of becoming the market leader’ to take the first example from the reply evidence); comparatively small in number considering the scope and period covered by the search; and likely to have made little if any impact on consumers or the trade.

54. What is singularly lacking in this material is evidence as to use or recognition by consumers and/or other traders in the context of the goods and services. The dietary/health/exercise field has spawned a large number of books and publications as any cursory glance at the shelves of any high street bookshop will reveal. In fact there is usually an area within even moderate size bookshops devoted to this subject area reflecting the considerable interest in dieting on the one hand and the health issues associated with over consumption on the other. If SIN had become customary in the language it would be very surprising indeed if it were not possible to find examples of other traders using the word with a consequent effect on consumer recognition. The closest one gets is the reference in the Wikipedia extract at exhibit 28 to usage by Weight Watchers of the expression “where no food is a sin”. It must, however, be noted that it is accompanied by the explanation that “this is a reference to its chief competitor Slimming World’s system of giving some food “sin” values”. The extract itself is dated sometime after the relevant date but should not be dismissed out of hand on that account. In *Alcon Inc v OHIM*, Case C-192/03 at paragraph 41 it was said:

“Moreover, the Court of First Instance could without inconsistency in its reasoning or error of law take account of material which, although subsequent to the date of filing the application, enabled the drawing of conclusions on the situation as it was on that date (see, by analogy, the order in Case C-259/02 *La Mer Technology* [2004] ECR I-0000, paragraph 31).”

55. The real problem with the reference is that, far from establishing that SIN has become customary in the language it is in part an acknowledgement of Slimming World’s own use. Moreover it appears to be an isolated usage which does not in itself advance the applicant’s case.

56. Ms Mastrovito’s answer to this paucity of relevant uses of SIN was to suggest that other traders have been deterred by the existence of MBES’ registrations. Mr Rathbone exhibits, at DR-C, details of his company’s trade mark registrations. None have filing dates earlier than 2000. Yet, writing in 2006 Mr Rathbone claims that SIN has been used as an integral part of the company’s business for over thirty years. It is true that there is no documentary evidence from that time. But there is material from 1986 onwards (see Exhibit DR2) showing use of SIN and the word has been consistently used since then. That is at least 14 years prior to MBES seeking trade mark protection. There was, therefore, a significant period during which other traders could have used the word if they considered they were entitled to do so. But there is no evidence before me that this happened. I do not consider the existence of the registrations offers an explanation for the absence of use by other traders.

57. That brings me back to MBES’ own use. As I have held earlier I consider that the use has been as part of a system of according values to foodstuffs and the dietary plans that are a key part of the Slimming World business. The applicant’s position is that this is not trade mark use. It is not clear how this squares with an objection under Section 3(1)(d) unless it is argued that the word has become customary in the language etc, as a direct result of the proprietor’s own use. Conceptually, I have difficulty in understanding how a word can be said to have become customary in the language as a result of unprotected use when there is such a marked absence of evidence that third parties have chosen to take up and use the word in the relevant area of trade. If, or to the extent that that is the applicant’s position it seems to me that it must fail.

58. The high point of the case against the registered proprietor must be that, as one of the market leaders, along with Weight Watchers, it is in a position to influence consumer recognition and perception of words. Since 1996 MBES/Slimming World is said to have had approximately 600,000 new members per annum though in practice I understand this is a mixture of new members and existing members renewing their membership. The Slimming World magazine also has sales of between 195,000 and 260,000 per edition with a wider ambient readership. This is said to make it the market leader. The principal brand under which this activity (that is to say the slimming groups and the magazine) takes place is Slimming World though I accept that consumers will encounter the use of SIN under the auspices of these activities.

59. It is also said that MBES enjoys a 40% market share. This figure needs to be treated with some caution. Mr Rathbone's actual claim is that "[t]he company enjoys an approximate 40% share of the UK market in providing weight control and slimming advice, education and counselling through a nationwide network of slimming and weight control clubs". The claim does not tell me what proportion of the potential consumer group (the public at large) would be familiar with SIN bearing in mind that only a proportion of dieters (actual or potential) are likely to join clubs of the kind run by Slimming World or to read the Slimming World magazine.

60. I bear in mind that evidence has been filed from members and consultants of Slimming World groups giving both their own views on SIN and in some cases commenting on their perception of awareness of SIN amongst the public in general. The evidence of the members and consultants suggests that, as one might expect, they themselves are familiar with the use of SIN and confirm their understanding of the term in the context of MBES/Slimming World's activities.

61. The witnesses gave their statements in October 2006 that is to say over six years after the relevant date. Ordinarily that time lag might be a cause for concern in placing reliance on the witnesses' views. However, in my view the nature of the proprietor's usage, which had been long standing by 2000, had not significantly changed by 2006. It is reasonable in those circumstances to accept that the witnesses' views would not have been materially different at the earlier date (most of them knew of Slimming World well before that time).

62. It is more difficult to judge whether they regard the usage as in itself indicative of origin or merely a piece of internal jargon used by Slimming World. None of the witnesses refers to SIN as being a trade mark though, as Dr Colley pointed out, the originating questionnaires quite properly avoided putting any suggestion to this effect in the minds of the witnesses (though I note that the penultimate question on each of the questionnaires made reference to proceedings at the UK Trade Marks Registry).

63. The questionnaires used invited the respondents to say how well known they considered SIN to be within the membership and the public in general and thus provide a potential window onto the views of the public at large. A number of the resulting witness statements express the view that SIN would be well known not just to the membership but also the general public (Ms Blackmore goes so far as to say "could be known to 60% of the public"). That in turn begs the question – recognition as what? The interpretation the parties would choose to place on the statements is predictable and consistent with the positions adopted and explained above.

64. The witnesses were not cross-examined at the hearing. Whilst I have no reason to disbelieve the bare statements made, they do not generally explain the basis for their beliefs in so far as the views of the public at large are concerned; half of the witnesses commented only on membership awareness; and others made guarded references only to public awareness. Where broader claims are made as to public awareness, on what basis do the witnesses consider themselves qualified to make their claims? How did they come to be aware of those views? Can they speak for a representative cross-section of the public?

65. In short I find this evidence inconclusive as to the true extent of public awareness of SIN outside the scope of Slimming World's slimming clubs, magazine and other public manifestations of its business. Nor does the evidence resolve the nature of the membership's or the public at large's understanding of what the word means to them.

66. In terms of the objection under Section 3(1)(d) I have to determine whether in June 2000 SIN should not have been registered because it was either customary in the current language or in the *bona fide* and established practices of the trade. Basing herself on the Oxford English Reference Dictionary, 1995, Professor Annand in *Stash* took "customary" (in the language) to mean "usual; in accordance with custom". On the evidence before me I am unable to say that, by June 2000, SIN had become customary in the current language. Nor has it been established that the word had become customary in the *bona fide* and established practices of the trade to designate the goods and services for which SIN is registered. The 3(1)(d) objection also fails.

Devoid of any distinctive character? (Section 3(1)(b))

67. Ms Mastrovito's skeleton argument referred me to *Cycling Is... Trade Mark*, [2002] R.P.C. 37 and in particular paragraphs 66 to 71 of the judgment. Her submission was that the evidence demonstrates that SIN is not fanciful or cryptic in relation to the relevant goods/services and that SIN is meaningful and would not trigger origin specific perceptions and recollections in the mind of the average consumer. This is again based in part on the proprietor's own use. She noted that there was no trade mark acknowledgment (TM or ® or such like) connected with the proprietor's use. There was also a suggestion that Slimming World has actively encouraged others to use the mark in recipe books etc.

68. It was held in the *Postkantoor* case that:

"86. In particular, a word mark which is descriptive of characteristics of goods or services for the purposes of Article 3(1)(c) of the Directive is, on that account, necessarily devoid of any distinctive character with regard to the same goods or services within the meaning of Article 3(1)(b) of the Directive. A mark may none the less be devoid of any distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive."

69. Thus an objection under (c) (and by implication (d)) also carries through to one under (b). But the opposite is not true because a mark can be devoid of distinctive character for reasons other than that it consists exclusively of a sign or indication that serves to designate a characteristic or that it is customary in the current language etc. The *O2 Holdings Limited* case, O-127-07, was just such a case where the icons, though not indicative of characteristics of the goods and services, were held to impart information about certain of the goods and services such that they were devoid of any distinctive character.

70. There is no additional or different information available to me in relation to this ground of objection. The fact that SIN is occasionally used in a journalistic context to refer to over-indulgence or the adverse associations of certain eating habits does no more than create a tenuous, and at most allusive, link to the particular goods and services that are the subject of the registration.

71. In paragraph 70 of *Cycling Is... Trade Mark*, [2002] R.P.C. 37, Mr Hobbs indicated that:

“The relevant perspective is that of the average consumer who does not know there is a question, but who is otherwise reasonably well-informed and reasonably observant and circumspect”.

72. I must, therefore, put myself in the place of someone who encounters the mark SIN used in relation to all or any of the goods of the registration and determine how they would react. It also seems to point to a position where I should not determine the matter solely on the basis of whatever ambivalence may be said to exist in the nature of the proprietor’s own use. It is the reaction of the average consumer that must inform my view of the matter and not just the proprietor’s own customers.

73. SIN is, of course, an ordinary word of the English language with a well known meaning. But it conveys no obvious information about the goods and services. Even if it is not fanciful or cryptic, to take Ms Mastrovito’s words, it is not in any real sense meaningful. There is, moreover, no requirement that a mark must display a particular level of invention or originality – (*Bank für Arbeit und Wirtschaft AG v OHIM Case T87/00* at paragraph 39). I am inevitably drawn to the conclusion that the average consumer “who does not know there is a question” would not consider SIN to be devoid of any distinctive character and would have no reason to suppose that it could not function as an indication of origin.

74. As to the proprietor’s failure to indicate that SIN or its variants is claimed as a trade mark, that cannot be decisive one way or the other. There is no requirement to attach a TM or ® symbol to marks or to otherwise indicate their intended status. Finally, I do not consider the evidence shows that the proprietor has allowed others to use the mark or not prevented others from using it. That state of affairs is denied by Mr Rathbone. More importantly, there is no evidence that other traders in this field are using the word. The single instance in the evidence is by Weight Watchers some time after the relevant date and has not been shown to be part of anything like a regular pattern of use by that trader or indicative of wider use by others in the field such that it might impinge on consumer perception of the word. Where the word is used in recipe books etc these are usually collaborative efforts (e.g. the *Celebrity Cookbook*, the publication with Avon and the *Quick Cuisine* booklet with Steven Saunders). In each case it is clear that Slimming World is behind, or jointly involved with, the publications. These other factors, taken individually or collectively do not change my view of the matter. The outcome is that the Section 3(1)(b) objection fails.

COSTS

75. The applications for the registration to be revoked or declared invalid have both failed. The registered proprietor is entitled to a contribution towards its costs. The three cases that were heard on 21 November 2007, although involving different issues of law, have been decided on the basis of substantially the same evidence. I propose to apportion costs relating to the evidence between the revocation and invalidity actions on the one hand and the opposition on the other. Accordingly, I order the applicant to pay the registered proprietor the sum of £2250. 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.

76. Two additional short points on costs arose at the hearing. The first related to grounds that were withdrawn in the applicant's skeleton argument. I indicated at the hearing that I was unlikely to penalise the applicant for sensible concessions albeit that they were made late in the day. In any case even if the grounds had not been pleaded in the first place it is highly unlikely that the proprietor's evidence would have been materially different. That remains my view of the matter.

77. The second point related to what is said to amount to displacement activity caused by having to deal with a late request by the applicant to either plead additional grounds of revocation or to stay these cases pending the filing and completion of a separate action. The applicant was quickly advised that the request appeared to be untenable and Ms Mastrovito did not pursue the matter at the hearing. I cannot see that this can have proved to be a material distraction to MBES and its advisers. I have not made allowance for either of these costs issues in the above award.

Dated this 17th day of December 2007

**M REYNOLDS
For the Registrar
The Comptroller-General**

Annex A

NAME	STATUS	YEARS' KNOWLEDGE OF SLIMMING WORLD	UNDERSTANDING OF SIN	REACTION TO SIN & SLIM
Tracey Hedges	Member	8 years plus	“The term SIN is used as part of the backbone of Slimming World’s diet plans. SIN is used to refer the energy value in relation to calories, fat etc for certain foods in Slimming worlds FOOD OPTIMISING plan.”	Not come across it in relation to diet plans, but would consider it misleading and a rip off of Slimming World.
Christine Blackmore	Consultant	11 years plus	“SIN or SINS is a term used in relation to the Slimming World diet for different types of food. The number of SINS or the SIN value given to different foods is worked out for us by a nutritionist.”	Not come across it but would automatically think it referred to Slimming World.
Nikki Randall	Member	Over 10 years	“SIN is used in the context of Slimming World’s eating plans to relate to foods that are not “free” and that you have to count as part of the eating plan. These foods are given a SIN value to assist someone on the diet plan to count the intake of such goods.”	No comment.
Jean Rowland	Member	20 years	“SIN is used in the Slimming World diet plans in the context of “extra foods” you can enjoy and count as part of your diet.”	Not come across it but would be confused.
Helen Ogundele	Member	3½ years	“SIN is used in relation to foods which are not FREE or are not deemed a	No comment.

			HEALTHY EXTRA, but must be counted as part of the Slimming World “diet”.	
Michelle Cardall	Member	13 years	“SIN or SINS is used in relation to treats you can have on a daily basis as part of the Slimming World eating plan. Foods like chocolate, crisps, cake, certain breads, meat pasta and basically anything that is not classed as a HEALTHY EXTRA or FREE FOOD under the Slimming World diet, are referred to as SINS”.	Has come across it being used in relation to diet plans and understood it to be part of Slimming World.
Chris Condon	Member	18 months	“ it is used in relation to certain types of foods you eat in the diet plan. Slimming World give certain goods a SIN value in the Slimming World eating plan, which is generally higher the more fattening the food.”	No comment.
Sarah Fox	Member	11 years	“SIN is used to refer to food items not FREE or HEALTHY EXTRAS that must be counted to a maximum amount daily. SIN can relate to food or drink (or supplement medication ie evening primrose oil) or cooking supplements (ie oil or butter) not FREE or a HEALTHY EXTRA A or B.”	Not come across it but reaction would be that this is part of Slimming World.
Eirwen Thomas	Member	Several years	“SIN is used as part of the Slimming World	Not come across it but

			diet in relation to foods that you have to count and that cannot be eaten freely. You used to watch how much of such goods you eat and limit them as part of the diet.”	would assume they have copied Slimming World.
Carol Welsh	Member	“For years”	“The term SIN is used as part of the Slimming World diet to relate to goods that are not on the A or B list and that are not designated FREE FOODS under the Slimming World eating plans.”	No comment.
Alison Adams	Member	‘since about the year 2000’	“SIN has, as far as I am aware, always been used by Slimming World in relation to its products and services in the UK and I consider it of vital importance in connection with the Slimming World diet plan.	Not come across it but reaction would be one of confusion and that someone was jumping on Slimming World’s bandwagon.
Christine Warren	Consultant	15 years	“SINS -orSYNS- are foods that members of Slimming World enjoy yet we are still in control of the diet plan. All goods that are “free” have a SIN (SYN) value.”	No comment.
June Patterson	Consultant	2½ years	“SIN is used as part of Slimming World eating plan to refer to foods that can be eaten as treats as part of the eating plan.”	No comment.
Jennifer Parker	Consultant	7 years	“SIN (now spelt SYN) is a means of fitting certain foods into Slimming World’s diet plans, including their FOOD OPTIMISING plan.	Has become aware of another company’s use of SIN AND SLIM in relation to diet

			<p>Certain/most foods are given SIN values (now SYN) to help members within our groups to make choices about what foods to eat.”</p>	<p>plans. Reaction is that another company is trying to use Slimming World’s success to line their own pockets.</p>
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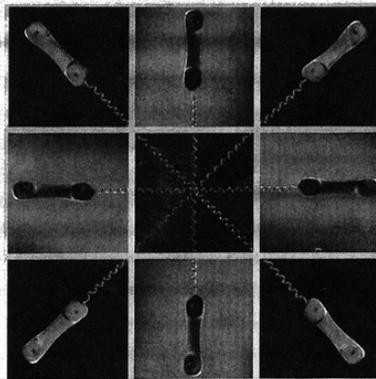
Annex B

Want to eat and don't know the Sin value?
Just call the Slimming World...

Sins Enquiry Hotline

OVER
27,000
PRODUCTS
ON OUR SIN
SYSTEM!

Service available
9am to 7pm
Monday to Friday,
9am to 5pm
Saturday.



This unique telephone enquiry line is especially for Sin values – you will be given the most up-to-date and accurate Sin value from a database which contains thousands of products.

09068 518 518

Sins Enquiry Hotline

09068 518 518

CLIP OUT & KEEP

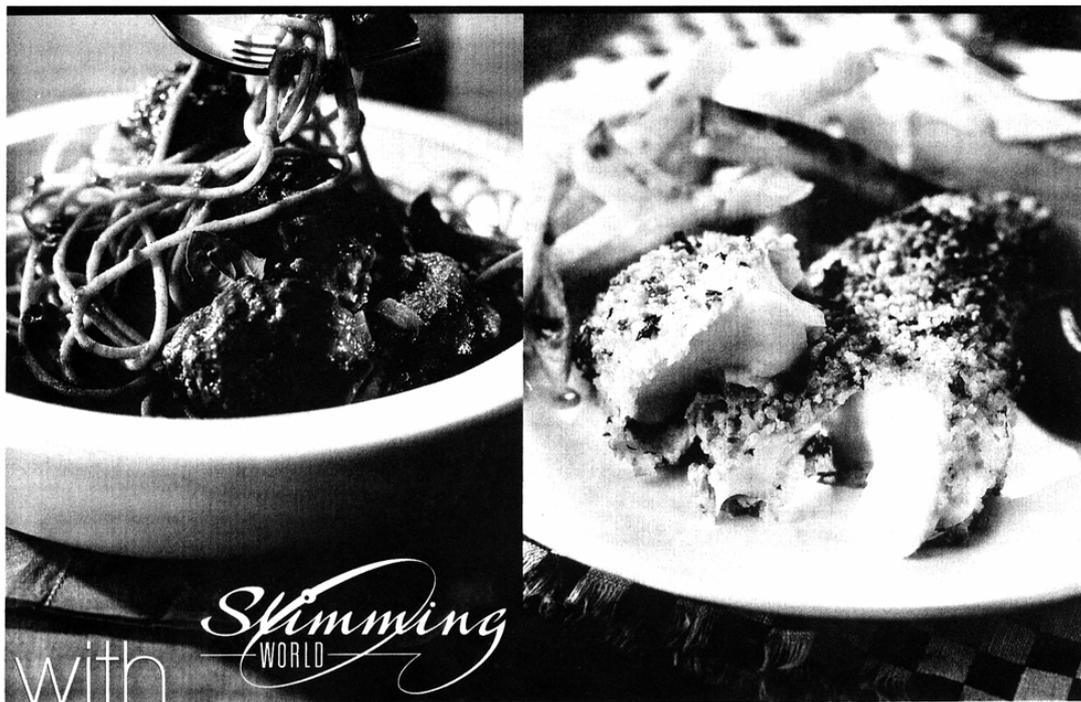
Slimming
WORLD

Service available 9am to 7pm Monday to Friday,
9am to 5pm Saturday.
All calls are charged at 60p per minute.

Slimming
WORLD

All calls are charged at 60p per minute.

As product formulations can change, please have the packaging of the product you're querying on hand when you call so we can double-check that the information on the packaging corresponds with that on our database.



Q What exactly are Healthy Extra choices?

A In addition to all those Free Foods, each day we ask you to choose from a huge list of Healthy Extra foods, which ensure you are getting all the vital vitamins, minerals and fibre your body needs. Healthy Extra choices on both Green and Original days include dairy products for calcium, and wholemeal bread, soups and breakfast cereals for fibre. Healthy Extra choices are built into the menus in our Choose & Lose eating plan (p19).

Q And what are Sins and where do they come in?

A Sins is the light-hearted term we use to ridicule the idea that there is anything bad about food, or about anyone who enjoys eating all manner of foods. Foods on the Sin list are those that are too energy-dense, or simply don't have the required filling power, to make losing weight easy. Including some Sins in your eating plan every day is a great way to feel good about yourself and to ensure that you never feel deprived or guilty around food – the two main enemies of losing weight successfully and keeping it off. All food that isn't Free has a Sin value – you can choose how to spend your Sins each day. For steady

weight loss many people opt for around 10 Sins a day. To keep you up to date with Sin values Slimming World publishes a Food Directory, has a Sins Online service (visit www.slimming-world.com) and has a Sins Enquiry Hotline (see below).

WHY NOT JOIN US IN CLASS?

Taking part in a warm, friendly Slimming World class is the best way to find out more about Food Optimising!
To find your nearest Slimming World class simply call

08700 754 666

or visit www.slimming-world.com

There is one charge of B's National Rate. Please note there are currently no Slimming World classes in Northern Ireland.

PHOTOGRAPHS: SIMON SMITH, JON WHITAKER, GUS FLEGGIE

**SINS ENQUIRY HOTLINE
09068 518 518**

Service available 9am to 7pm Monday to Friday, 9am to 5pm Saturday.

All calls are charged at 60p per minute.

As product formulations can change, please have the product you're querying on hand when you call so we can double-check that the information on the packaging corresponds with the information we hold on our database.