

O-071-09

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO 1106253B

IN THE NAME OF REDWIN IND PTY LTD

IN RESPECT OF THE TRADE MARK:

ETHOS

IN CLASSES 3 & 5

AND

AN APPLICATION FOR REVOCATION ON THE GROUNDS OF NON-USE

UNDER NO 82950

BY STARBUCKS CORPORATION

TRADE MARKS ACT 1994

**IN THE MATTER OF Registration no 1106253B
in the name of Redwin Ind Pty Ltd
in respect of the trade mark EHTOS in classes 3 & 5**

and

**An application for revocation on the grounds of non-use
under no 82950
by Starbucks Corporation**

Background

1. On 23 August 2007, Starbucks Corporation ("*Starbucks*") applied for the above trade mark registration to be revoked on the ground that it had not been put to genuine use in the five year period 27 July 2002 to 26 July 2007; this claim is based on the provisions of section 46(1)(b) of the Trade Marks Act 1994 ("the Act").
2. Redwin Ind Pty Ltd ("*Redwin*") filed a counterstatement denying the above claim. Its counterstatement was accompanied by evidence of use of the trade mark. The evidence was filed in the form of a witness statement (together with accompanying exhibits) from Mr Alan John Venner; Mr Venner appears to be *Redwin's* trade mark attorney. I will refer to the evidence in more detail later in this decision.
3. At the time of *Starbucks* application, the trade mark was registered in classes 3 & 5 in respect of the following goods:

Class 3: Soaps, perfumes and cosmetics

Class 5: Pharmaceutical preparations and vitamins

4. I note that on 24 January 2008 *Redwin* filed a Form TM23 to partially surrender the registration in relation to the class 5 goods. The partial surrender was actioned by the Registrar. Despite this, I still intend to deal with the class 5 goods given that *Starbucks* sought revocation with effect from 27 July 2007 i.e. prior to *Redwin's* partial surrender.
5. Neither side requested a hearing. *Starbucks* did, however, file written submissions via its trade mark attorneys at Jeffrey Parker and Company. No submissions were received from *Redwin* or its representatives.

The legislation

6. The relevant part of the Act reads¹:

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

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c)

(d)

The class 3 goods

7. The goods at issue are:

“Soaps, perfumes and cosmetics”

8. In its written submissions, *Starbucks* makes the following statement:

“The applicant does not argue that the witness statement of Venner is insufficient to prove that bona fide use of the trade mark took place in the relevant period”

9. I take this as a concession that the genuineness of the use set out in *Redwin's* evidence is not at issue. This is re-enforced by the remainder of *Starbucks's* submissions which highlight that the issue it has is whether the goods on which the mark has been used are goods covered by the registration. This is, therefore, what my decision will focus on.

10. The primary goods set out in evidence are types of moisturisers, serums, creams and cleansers. *Starbucks* say that none of these goods are soaps, perfumes or cosmetics (the goods of the registration). This, I agree, is the issue that needs to be addressed. However, if I find that any of these goods can be categorised as soaps, perfumes or cosmetics then I will also need to consider what would be a fair specification for the use shown (and accepted as shown). In relation to what I should construe from terminology used in specifications, I note the decision in *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267 where Mr Justice Neuberger stated:

¹ *Starbucks's* claim is made on the basis of section 46(1)(b), but section 46(1)(a) is detailed as this is necessary for context.

“I should add that I see no reason to give the word "cosmetics" and "toilet preparations" or any other word found in Schedule 4 to the Trade Mark Regulations 1994 anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context. In particular, I see no reason to give the words an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor.”

11. It is, therefore, the natural meanings of the terms that I must consider. I will approach the registered terms one by one. In relation to soaps, a dictionary² definition defines soap as:

“Cleaning or emulsifying agent made by reacting animal or vegetable fats or oils with potassium or sodium hydroxide. Soaps often contain colouring matter and perfume and act by emulsifying grease and lowering the surface tension of water, so that it readily penetrates open materials such as textiles.”

12. The evidence refers to goods such as “cleansers”, this strikes me as the closest type of product that could, arguably, be classified as a soap. I am aware from my own experience that soaps are no longer purely bar like products (I am aware that liquid soap now exists), however, I doubt whether a cleanser (certainly not the type shown in evidence), despite having a similar purpose, would be regarded as a type of soap. The definition above, and my own understanding of what soap is, indicates a quite precise and narrow product. Cleaners may be similar, but they are not, literally, soaps. **There is, therefore, no evidence of use in relation to soaps.**

13. In relation to the term “perfumes”, the same dictionary defines perfume as:

“A mixture of alcohol and fragrant essential oils extracted from flowers etc., or made synthetically, used esp. to impart a pleasant long-lasting scent to the body etc.”

14. Perfumes have at their heart no real purpose other than to give one’s body a pleasant smell. Whilst some of the goods set out in evidence may be perfumed, this does not mean that they would be categorised as a perfume. **There is, therefore, no evidence of use in relation to perfumes.**

15. In relation to “cosmetics”, this is defined as:

“Any preparation applied to the body, esp. the face, with the intention of beautifying it.”

16. A cosmetic is, therefore, a preparation, the purpose of which is to beautify the face or body. Whilst cosmetics such as lipstick, mascara and eye shadow may be the first and most obvious type of goods that come to mind if one were asked to consider the type of goods that fall within this category, I do not consider that this is all the term covers. For example, preparations whose intended effects are to reduce wrinkles would be classified as a cosmetic preparation given that it aims to have a

² Collins English Dictionary (5th Edition)

cosmetic impact on the appearance of the user. To this extent, I note from *Redwin's* evidence that the packaging of some of the goods describes its intended purpose as:

“promotes a clean, healthy complexion” (cleansing milk)

“..helps to improve skin's texture and reduce the appearance of fine lines”
(face moisturiser)

“...helps to diminish the appearance of fine lines, dark circles and puffiness”
(eye serum)

17. There are other examples of similar intended purposes. The general purpose of the goods, therefore, appears to be aimed at giving the user an improved complexion and/or reducing the signs often associated with the aging process etc. Given my understanding of the term “cosmetics” as identified above, it seems to me that goods of this nature can correctly be classified as cosmetics, as they all, in some way, improve/maintain beauty in terms of the physical appearance of the user. I am fortified in this view by the decision of Mr Justice Neuberger in *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* where, on the facts of the case before him, he found that a dry skin lotion was a cosmetic. **The evidence, therefore, relates to goods that are cosmetics.**

18. I should add that *Redwin's* evidence (see the invoices in Exhibit AJV001) also refers to goods such as exfoliants, masques, body scrubs, nail cream, lotions, and body bars. With the exception of body bars (I do not know what such a product is) and nail creams (I do not know whether this has a cosmetic function) these other types of goods also strike me as serving a cosmetic purpose for the reasons I have already given.

The class 5 goods

19. I have already described the background issue in relation to the class 5 goods. The goods have been surrendered from the registration, but I still need to consider the revocation from a date earlier than *Redwin's* surrender. The goods at issue are:

“Pharmaceutical preparations and vitamins”

20. There is nothing at all in *Redwin's* evidence that relates to vitamins *per se*. I note that some of the goods contain vitamins but this is not use in relation to vitamins. **There is, therefore, no evidence of use in relation to vitamins.**

21. In relation to pharmaceutical preparations, whilst similar types of preparations to those set out in evidence may perform a medical function and, therefore, may arguably be classified as pharmaceuticals, there is nothing in the evidence to suggest that this is the case with *Redwin's* goods. **For these reasons, there is no evidence of use in relation to pharmaceutical preparations.**

A fair specification

22. Having concluded that the goods set out in evidence are cosmetics, I am left to consider what would be a fair specification to reflect such use. In determining this, I take into account the helpful guidance provided in a number of cases. In *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 Aldous LJ stated at paragraph 31:

“Pumfrey J. in *Decon* suggested that the court’s task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view the task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use.”

23. In *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-126/03 the CFI stated:

“42 The Court observes that the purpose of the requirement that the earlier mark must have been put to genuine use is to limit the likelihood of conflict between two marks by protecting only trade marks which have actually been used, in so far as there is no sound economic reason for them not having been used. That interpretation is borne out by the ninth recital in the preamble to Regulation No 40/94, which expressly refers to that objective (see, to that effect, *Silk Cocoon*, cited at paragraph 27 above, paragraph 38). However, the purpose of Article 43(2) and (3) of Regulation No 40/94 is not to assess commercial success or to review the economic strategy of an undertaking, nor is it to restrict trade-mark protection to the case where large-scale commercial use has been made of the marks (Case T-334/01 *MFE Marientfelde v OHIM – Vétoquinol (HIPOVITON)* [2004] ECR II-0000, paragraph 32, and Case T-203/02 *Sunrider v OHIM – Espadafor Caba (VITAFRUIT)* [2004] ECR II-0000, paragraph 38).

43 Therefore, the objective pursued by the requirement is not so much to determine precisely the extent of the protection afforded to the earlier trade mark by reference to the actual goods or services using the mark at a given time as to ensure more generally that the earlier mark was actually used for the goods or services in respect of which it was registered.

44 With that in mind, it is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2) to earlier national marks, as seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established.

45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories relating to which the goods or services for which the trade mark has actually been used actually belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.

.....

53 First, although the last sentence of Article 43(2) of Regulation No 40/94 is indeed intended to prevent artificial conflicts between an earlier trade mark and a mark for which registration is sought, it must also be observed that the pursuit of that legitimate objective must not result in an unjustified limitation on the scope of the protection conferred by the earlier trade mark where the goods or services to which the registration relates represent, as in this instance, a sufficiently restricted category."

24. In *Animal Trade Mark* [2004] FSR 19 Jacob J held:

"20 The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a picky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for threeholed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description"

is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made."

25. Whilst I have found that the goods in question are cosmetics, it is clear from the evidence that these are in the nature of cosmetic skin and body care type preparations rather than cosmetics such as lipstick etc. Given that the goods are a distinct sub-set of cosmetics, I do not consider that such use supports continued registration for the term cosmetics at large. However, *Redwin's* use is in relation to a reasonably wide range of goods that fall into the sub-set that I have identified. Taking these factors into account, I consider that a fair description of the goods, that is neither pernickety nor overly broad, would be:

"Cosmetic skin and body care preparations"

Conclusion

26. The application for revocation is partially successful. *Redwin's* registration is hereby revoked under the provisions of section 46(6)(b) of the Act with effect from 27 July 2007 for all of its goods other than:

"Cosmetic skin and body care preparations"

Costs

27. Both sides have achieved a measure of success. Therefore, I do not propose to favour either party with an award of costs.

Dated this 17th day of March 2009

**Oliver Morris
For the Registrar
The Comptroller-General**