

O-143-09

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2451146**

**BY ANN SUMMERS LIMITED**

**TO REGISTER THE TRADE MARK:**

**PLATINUM**

**IN CLASS 10**

**AND**

**IN THE MATTER OF OPPOSITION NO 95491 BY**

**LOVEHONEY LIMITED**

## TRADE MARKS ACT 1994

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By Ann Summers Limited to register the trade mark  
PLATINUM in class 10**

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Lovehoney Limited**

### **Background**

1. On 29 March 2007 Ann Summers Limited ("*Summers*") applied to register the trade mark PLATINUM in class 10 of the *Nice International Classification of Goods and Services*. The mark was subsequently published in the Trade Marks Journal solely in relation to "vibrators".

2. Lovehoney Limited ("*Honey*") oppose registration of *Summers*' application under section 3(1)(b) of the Act because:

"The word "PLATINUM" is widely used by sex manufacturers and retailers in the UK to describe any of a number of models of vibrators and consequently cannot be said to be distinctive of the applicant's goods."

3. *Summers* filed a counterstatement denying the ground of opposition. It says that it is not aware of any use by other traders in the relevant field, furthermore, it highlights its own use of the trade mark and, therefore, that it has built up a goodwill and reputation. Both sides filed evidence, a summary of which follows. Neither party requested a hearing. *Honey* filed written submissions, *Summers* did not.

### **Honey's evidence**

#### **Witness statement of Tony Gonzalez**

4. Mr. Gonzalez is the managing director of Apollo Sales Limited ("*Apollo*") who specialise in the wholesale supply of sex toys and other adult products. He has worked for *Apollo* since 2007 and has worked in the relevant field since February 2003.

5. Mr. Gonzalez states that, in his experience, the word "platinum" has been used and is currently used in the sex toy and adult product market only to describe the colour and/or quality of individual products and not to distinguish the products of any one manufacturer, wholesaler or retailer. In particular, he states that *Apollo* has sold vibrators since 2006. He states that this was first discussed

with its Chinese suppliers in about May or June 2006. Exhibit TG2 (the witness statement incorrectly refers to this as TG1) is a sales purchase contract dated 5 July 2006 which includes *Apollo's* purchase of 1000 "TPR Rabbit 7 speed vibes" which, Mr. Gonzalez explains, are its Jessica Rabbit Platinum vibrators. He concedes that this invoice does not use the word PLATINUM but confirms that the packaging did. Exhibit TG1 (the witness statement incorrectly refers to this as TG2) is an extract from its 2006 catalogue which includes a picture of the Jessica Rabbit Platinum vibrator, together with its packaging. Mr. Gonzalez states that the product depicts a platinum colour scheme. Exhibit TG3 is a "check in sheet" (dated 17 November 2006) relating to the purchase shown in TG2.

6. Mr. Gonzalez completes his evidence by stating his belief that *Summers* (or indeed any business) cannot claim that the word "PLATINUM" refers exclusively to its goods or services since this word has been so widely used as a descriptive term. He states that he does not believe that either *Apollo's* wholesale clients or their retail customers would take "platinum" to be the trade mark of any single business but rather a description of the goods in question.

*Witness statement of Richard Longhurst*

7. Mr. Longhurst describes himself as the director and owner of *Honey*. He explains that *Honey* is an online retailer of adult toys, equipment, books, clothing, healthcare and other items including vibrators. He states that, in his experience, the word platinum has only ever been used to describe attributes of various products (e.g. their colour or relative quality) and has not been used by any single manufacturer, wholesaler or retailer to distinguish its products from those of other traders. He states that *Honey* currently stock three products described as "platinum". The products are depicted in Exhibits RL1-RL3 and consist of: 1) "WET Platinum Silicone Lubricant" which he says has been on sale since 2002; 2) A "LoveHoney Platinum Wiggle Wand" which has been on sale since 2007 and is a vibrator with a bendable neck and is, Mr. Longhurst says, predominantly platinum in colour; 3) A "LoveHoney Jessica Rabbit Platinum Vibrator" he states, again, that the product and packaging is predominantly platinum coloured. He states that the third product referred to has changed slightly as it was originally platinum and pink and was called "Jessica Rabbit Platinum" (see Exhibit RL6) but is now entirely platinum coloured (with colourless silicone) and branded "LoveHoney Jessica Rabbit Platinum".

8. Mr. Longhurst states that sales of the Jessica Rabbit Platinum vibrators were first made on 21 November 2006 and he produces the first four sales invoices (RL4). He states that these would have been ordered from its supplier in June or July 2006. In relation to sales, *Honey* sold 318 Jessica Rabbit Platinum vibrators in 2006 worth £9,476. In 2007 there were 3281 sales worth £89,512.

9. He refers to the availability on its website of a facility for customers to post reviews of its products. He refers to RL5 which is the first review posted for the

“Jessica Rabbit Platinum” vibrator dated 13 February 2007. He states that *Apollo* supply its Jessica Rabbit vibrators and refers to Exhibit RL6 which shows an extract from *Apollo’s* sales brochures (the same extract in Mr. Gonzalez’s TG1), he highlights the use of the word PLATINUM as part of the product name and colour scheme. He lists three other retailers who “currently”<sup>1</sup> stock this product. Evidence in RL7 shows the retail by these other traders, but, I note that the prints were obtained on 21 April 2008.

10. Reference is then made to Exhibit RL8 which consists of the results of a search using *Google.co.uk* for references to “PLATINUM VIBRATOR” on websites based in the UK. He says that this indicates how widely used the word is and that it is predominantly used in a descriptive manner. In relation to these search results I note that the vast majority (13) relate either to the “Jessica Rabbit Platinum” or the “LoveHoney Jessica Rabbit Platinum”. However, three relate to a product called “PLATINUM ECLIPSE”, three relate to an “Omazing Rabbit Platinum vibrator”, 1 relates to “Platinum Rampant Rabbit” (*Summers’ product*), one questions which is the better rabbit, a thruster or platinum, and one reference to “50% of Platinum vibrators” and one simply to “Platinum vibrators”. He concludes that the word “platinum” has been (and is being) used as a descriptive term for the relevant products and it could not be used by the applicant to distinguish its goods or services from those of others and that purchasers would not recognise the word as anything other than a description of a particular product and certainly would not associate it with any single supplier.

### **Summers evidence**

#### **Statutory declaration of Praful G Unadkat**

11. Mr. Unadkat is *Summers’* company secretary. He states that the trade mark PLATINUM was first used by *Summers* in July 2004 and it has been used extensively on or in relation to vibrators. Turnover figures for goods sold under the mark are: 2004-2005 £196,872; 2005-2006 £195,297; 2006-2007 £146,917; 2007-2008 (to date<sup>2</sup>) £82,723.

12. Exhibit PGU1 contains various material showing use of the mark, the material consists of:

- a) A print (with a hand written date of September 2005) from *annsummers.com* featuring six products one of which is a “Platinum Rabbit”.
- b) An extract from what appears to be a brochure produced by *Summers* (undated) the page is headed Rabbit World. Four rabbit vibrators are featured on this page, namely, Rampant Rabbit Platinum, Rampant

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<sup>1</sup> His evidence is given on 21 April 2008

<sup>2</sup> His evidence is given on 24 July 2008

Rabbit Deluxe, Rampant Rabbit & Buzz Bunny. Two non rabbit vibrators (Ultra Seven & Big Ben) are featured on the side of the page. This also has some commentary in which the readers of the brochure are introduced to the best rabbit ever THE PLATINUM RABBIT.

- c) Another extract from what appears to be *Summers'* web-site with a hand written date of May 2007. Four vibrators are depicted under the banner Rampant Rabbits, the main one is "The Ultimate Rampant Rabbit Thruster", the others are "Platinum", "Thriller" & "Elite".
- d) A page similar to the above with the "Platinum", "Thriller" & "Elite" vibrators depicted under the heading "Rampant Rabbits", with a handwritten date of April 2007.
- e) Another page similar to the above carrying a date (handwritten) of March 2007
- f) Another print from annsummers.com (dated May 05 handwritten) on which key products are featured, one of the products is a "Platinum Rabbit".
- g) An Ann Summers brochure (Autumn/Winter 2006). There is another use of "Rabbit World", with commentary referring to the "Rampant Rabbit" family having just got stronger with the "Platinum" and "Thruster" for the more adventurous user. The "Rampant Rabbit Platinum" is then depicted together with four other members of the "Rampant Rabbit" range.
- h) A promotional flyer for "Ann Summers Parties" which states that Platinum Rabbits are exclusively available through this. The words "Platinum Rabbit" are the largest words on this flyer.

13. He states that over the last two years marketing costs have been £687,404 but this cannot be broken down by product type. He states that the use and promotion by *Summers* means that the mark is identifiable as a trade mark belonging to it. He states that other traders are seeking to trade off *Summers* use and reputation by misappropriating the word PLATINUM. He believes that his company first launched vibrators under this name and as a result of this use it has acquired distinctiveness as a trade mark of *Summers*.

Witness statement of Sally Ann Schupke

14. Ms Schupke is a trade mark attorney working for Chancery Trade Marks, *Summers'* representatives in this matter. Her evidence is given to introduce into the proceedings six letters from customers who "know and recognize the trade mark under no. 2541146 PLATINUM being used in relation to vibrators by the

applicant". All these letters are dated during July 2008 and are all headed "to whom it may concern". All of these "customers" actually work for *Summers* but it is not particularly clear in what capacity, however, it seems to be on the basis of organisers of what are known as Ann Summers Parties. They all state, in some way, that they are only aware of the mark PLATINUM being used by *Summers*.

### **Honey's reply evidence**

15. No reply evidence was filed. However, I note that *Honey*, in its letter dated 5 September 2008, invited the tribunal to disregard Ms Shupke's evidence because the "to whom it may concern" letter writers have not filed evidence themselves and, therefore, Ms Shupke's evidence is nothing more than hearsay. Furthermore, that each of the letter writers is a customer and representative of *Summers* and their comments are made on the basis of their involvement with *Summers*. Also highlighted is the fact that the letters are worded in a very similar manner which suggests collaboration with *Summers* for the purpose of the opposition. Although I will return to this point, if necessary, later, I add that I agree with *Honey* that Ms Shupke's "evidence" from the letter writers has little by way of evidential weight.

16. Before assessing the relevant ground of opposition, I note that *Summers* has filed evidence to demonstrate that its mark has acquired a distinctive character through use. However, I will consider the ground of opposition *prima facie* and then, if the ground succeeds, will consider whether the mark has acquired a distinctive character through use.

### **The law and the leading authorities**

17. Section 3(1)(b) of the Act states that the following shall not be registered:

"trade marks which are devoid of any distinctive character"

18. The test to be applied under this ground has been dealt with by the European Court of Justice ("ECJ") in a number of its judgments, notably in Joined Cases C-53/01 to C- 55/01 *Linde AG, Winward Industries Inc and Rado Uhren AG* (8 April 2003). The test equates to assessing the impact that the sign will have on the average consumer when used in relation to the goods at issue and then deciding whether they will see it as something that is identifying to them goods originating from a particular undertaking.

19. *Honey's* pleaded case is that the mark is devoid of distinctive character because PLATINUM is a term widely used in the relevant industry and, as such, it cannot act as a distinguishing sign of origin. It should be noted that prior to writing this decision, I wrote to *Honey* asking for clarification of its pleadings given reference in them to "descriptive use". The position was clarified in a response dated 16 April 2009 from Thring Townsend Lee & Pembertons (*Honey's*

representatives in this matter). It is clear from this response that the mark is considered to be devoid of distinctive character purely because it has been “widely used”, indeed, it clarified “while we note that such use has often had a descriptive element to it, this does not form part of the opposition as pleaded”.

20. Being “widely used” requires a factual assessment. I also consider this claim to be similar to one under section 3(1)(d) of the Act relating to signs or indications which have “become customary in the current language or in the *bona fide* and established practices of the trade”. On this, I note the decision of Professor Annand (sitting as the Appointed Person) in *Stash* (BL O–281-04) where she stated at paragraph 33:

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

### **Has the sign been widely used?**

21. The relevant date at which to make this assessment is the date on which *Summers* applied for its mark, namely, 29 March 2007. Looking at the evidence in totality there are, at the very least, two products from different undertakings that use the sign PLATINUM in some capacity. They are the use by *Summers* on its range of goods, and the use by *Honey* as part of the designation “Jessica Rabbit Platinum vibrator” with such goods being supplied to it by *Apollo*. These vibrators may also be sold by other traders (Mr Longhurst says as much) but there is no evidence of this prior to the relevant date and, in any event, this is the same product but simply being sold by a different retailer. The managing director of *Apollo*, Mr Gonzalez, states that the sign has been, and is currently in use, in the relevant field, but he then particularises this only to *Apollo*’s own wholesale use. I can, therefore, take little else from Mr Gonzalez’s statement.

22. Much of Mr Longhurst’s evidences focuses on its own use (the “Jessica Rabbit” use) but little by way of corroborative detail is provided in relation to use by any other traders. A *Google* print was filed as an exhibit but, as mentioned in the evidence summary, most of this relates to the “Jessica Rabbit Platinum” vibrator or to *Summers*’ product, this, therefore, does not add to its case. Of the other references, three relate to “PLATINUM ECLIPSE” and three relate to “Amazing Rabbit Platinum vibrator”. There are two other references, one seems to link to a discussion page which is asking “which is the better rabbit a thruster or platinum”; on the basis of *Summers*’ evidence (they sell thrusters and platinums) the web-site seems to be discussing *Summers* goods. The other is a

sponsored link to “50% off Platinum vibrators”. However, the fundamental problem with all this evidence is that no prints from the web-sites that underpin these search results have been filed in evidence. I cannot, therefore, see how the sign is used and what impact it would have had on the public. Furthermore, the *Google* search was conducted after the relevant date. For these two reasons, I find it difficult to place any significance on this evidence to establish that the term is widely used.

23. The only other evidence I can possibly rely on is the “WET Platinum Silicone Lubricant” which *Honey* has sold since 2002 and the “LoveHoney Platinum Wiggle Wand vibrator” which *Honey* has sold since 2007. Given that the latter has only been on sale since 2007, this does not particularly help given the relevant date here; even if the product had gone on sale early in 2007 I doubt that it would have had sufficient impact to enhance the alleged widely used nature of the sign. Whilst the former has been on sale since 2002, it is, nevertheless, for a different product and, furthermore is on sale by *Honey* rather than another trader in the relevant field – this, therefore, does not strike me as particularly persuasive evidence to support the proposition that *Summers’* trade mark is unable to distinguish because it is already a sign in wide use.

24. Having considered the evidence in totality, the only evidence which can really support *Honey’s* claim is *Summers’* own use, and the use by *Apollo/Honey* as part of the “Rampant Rabbit” range (and also its silicone lubricant). In my view, this falls well short of proving that the term has been widely used. If there are other uses (*Honey’s* witnesses appear to think so), the evidence does not prove this. Even if I am wrong on my assessment of the significance of *Honey’s* evidence, there is a further problem, namely, that *Honey’s* first sales were only made in November 2006, some four months prior to the relevant date. I doubt whether the capacity of the sign to distinguish would have been significantly affected in such a short period of time. For all these reasons, I cannot say that the term PLATINUM is widely used in the relevant field and, therefore, I cannot say that the mark is devoid of distinctive character for this reason. Consequently, the opposition must fail. In the circumstances, I do not need to address acquired distinctiveness.

### **Costs**

25. *Summers* having been successful is entitled to a contribution towards its costs. I hereby order Lovehoney Limited to pay Ann Summers Limited costs on the following basis.

Considering notice of opposition	£200
Filing counterstatement	£300
Considering <i>Honey’s</i> evidence	£200
Filing evidence	£400
<b>Total</b>	<b>£1100</b>



26. The above sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 21<sup>st</sup> day of May 2009**

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