

O/032/12

**THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 2008 AND  
TRADE MARKS ACT 1994**

**IN THE MATTER OF INTERNATIONAL REGISTRATION NO 1 060 608**

**IN THE NAME OF ETAT PUR**

**AND APPLICATION TO EXTEND PROTECTION IN THE UK TO THE TRADE  
MARK: IN-SKIN IN CLASS 01**

**AND**

**OPPOSITION THERETO UNDER NO 72 262**

**BY ISDIN S.A.**

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**The Background and Pleadings**

1. Etat Pur (the applicants) applied to protect the international trade mark registration, IN-SKIN on 25<sup>th</sup> November 2010. The application was registered in the Trade Marks Journal on 21<sup>st</sup> January 2011 in respect of the following goods in Class 01:

Chemical products for use in industry, science; biological preparations, other than for medical or veterinary purposes; composites of active agents, raw materials and molecules (chemical products) for the formulation of dermatological and cosmetic products.

2. ISDIN S.A. (the opponents) oppose the protection in the UK of the registration on the basis of the following grounds:
  - Section 3(1)(b) of the Trade Marks Act 1994 ("the Act") as IN-SKIN is non-distinctive and inherently unregistrable as it is simply a combination of two generic and non-distinctive terms. Registration of IN-SKIN would, according to the opponents result in uncertainty as to whether others who are active in the skincare field could safely use the term descriptively without fear of infringing.
  - Section 3(1)(c) of the Act as IN-SKIN is a term that others would wish to use to indicate that the products in question can be a) used in the skin or b) can be used to manufacture cosmetic and dermatological products and preparations which would then be used in the skin.
3. The applicants filed a counterstatement, denying the grounds of opposition. It contends that IN-SKIN must be appreciated as a whole and though potentially evocative, is not descriptive, nor devoid of distinctive character. Further, that on seeing the mark, the public cannot immediately and unequivocally determine the products protected. Both sides filed evidence, with the

applicants also filing written submissions, all of which has been fully taken into account in reaching this decision. Neither side requested a Hearing and so this decision is taken following a thorough reading of the papers.

### **The opponents' evidence**

4. This is a Witness Statement, dated 8<sup>th</sup> August 2011, from Lucy Mills, a trade mark attorney with Potter Clarkson LLP, the opponent's representatives in these proceedings. Much of the Witness Statement comprises submissions which mirror and extend those outlined above and so will not be summarized here. In any case, they have fully been taken into account. The following evidence is contained in the statement:
  - Exhibit LM1 is a copy of search results from the UK, Community Trade Mark and International Registers showing numerous applications and registrations incorporating one or other of the terms IN and/or SKIN in classes 01 such that it is, according to Ms Mills, clear that such terms are commonly used within the cosmetic and/or dermatological industry.
  - Exhibit LM2 is the result of searches carried out on the search engine "Google" which, according to Ms Mills, disclose numerous examples of use of the use of IN and SKIN in relation to the skincare/dermatological industry, including examples of both terms together.
  - Exhibit LM3 shows extracts from the applicants website which refer to use of IN-SKIN in France, Corsica and Monaco. This is included by Ms Mills to demonstrate that the mark has not been used in the UK and so cannot have acquired distinctiveness through use.

### **The applicants' evidence**

5. This is a Witness Statement, dated 10<sup>th</sup> October 2011 from Alison Jane Cole, a trade mark attorney with Graham Watt & Co LLP, the applicant's representatives in this matter. The Statement is comprised entirely of submissions and so will not be summarized here, save to say that the evidence provided by the opponents and its relevance is refuted and that it does not demonstrate that the grounds of opposition have been successfully made out.

### **DECISION**

6. Section 3(1) (a) (b) (c) and (d) of the Act reads:

"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) .....

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.

7. The relevant date at which the assessment as to whether any, or all, the grounds of objection is, or are, made out is the date of application to extend protection to the UK, namely 25<sup>th</sup> November 2010.

### **Section 3(1)(c)**

8. There are now a number of judgments from the Court of Justice of the European Union (CJEU) which deal with the scope of Article 3(1) (c) of First Council Directive 89/104 (recoded and replaced by Directive 2008/95/EC on 22 October 2008) and Article 7(1) (c) of the Community Trade Mark Regulation (“the CTMR”), whose provisions correspond to Section 3(1) (c) of the UK Act. The following main guiding principles, relevant to this case, are 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, Article 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;

- Section 3(1) (c) of the Act excludes signs which may serve, in trade, to designate the kind of goods or other characteristics of goods. It follows that in order to decide this issue it must first be determined whether the mark designates a characteristic of the goods in question;

- to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say in trade and or amongst average consumers of the said goods or services, reasonably well-informed and reasonably observant and circumspect, in the territory in respect of which registration is applied for - *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04 at paragraph 24;

- a sign’s descriptiveness may only be assessed, first, in relation to the goods or services concerned and, secondly, in relation to the perception of the target public, which is composed of the consumers of those goods or services – *Ford Motor Co v OHIM (as above)*.

9. I must decide whether, at November 2010, it was likely that the average consumer would have perceived the elements IN-SKIN as designating a characteristic of the goods applied for in Class 01. In this regard, I must assess who is the average consumer of these goods. They are all either chemicals for use in industry etc or are raw materials which will be included as components and/or ingredients in skin care products. The average consumer is therefore a specialist one, those who use chemicals etc in industry and those who manufacture skin care products. It is the perspective of this consumer which is the key consideration in these proceedings.
10. I take note of the content of the evidence filed by the opponents in these proceedings. However, to my mind, it can be subject to significant criticism. Firstly, in respect of the state of the register evidence provided, I note that the existence of several trade mark registrations is not *per se* particularly conclusive, as it does not necessarily reflect the situation in the market. In other words, on the basis of data concerning a register only, it cannot be assumed that all such trade marks have been effectively used. It follows that the evidence filed does not demonstrate that consumers have been exposed to widespread use of, and have become accustomed to trade marks which include the words IN and/or SKIN. Further, I note that the examples provided differ from the trade mark in question here in terms of actual content in that there are different and/or additional words and elements present or the words IN SKIN appear as a part of a complete sentence which notably alter their meaning as context is then provided, for example “....the most trusted name in skin refrigerants.....”. They are therefore not on a par with the relevant trade mark in these proceedings.
11. In addition, the evidence provided in Exhibit LM2 is unconvincing as the examples provided materially differ from the trade mark in question here in the same manner as already described in respect of the Register entries above. For example, some hits display sentences such as “peptides in skin care”, “small changes in skin care routine.....”. Further, the full articles/ information behind these hits are not provided and so the exact context is not always clear. In any case, even when clear, it does not, in my view demonstrate that IN-SKIN in the abstract designates a characteristic of the goods applied for. Indeed, the denomination applied for, does not, in the abstract, make any clear sense. It is, at worst remotely allusive that the items may be something to do with the skin, but bearing in mind that the goods applied for are not skin care products for the public at large, but raw materials which will be used in skin care and chemicals each with a specialist consumer base, this allusion becomes ever more spurious. Any link is certainly not immediate and obvious. I am content therefore that IN-SKIN does not designate a characteristic of the goods in question. The opposition based upon Section 3(1)(c) therefore fails.

## Final Remarks

12. I note that the opponents argue that the trade mark should be refused protection so as to prevent other traders fearing they are infringing when using the words IN and SKIN. While it is true that Section 3(1)(c) functions to ensure that descriptive terms are left free for use by other traders, I have already found that the term is not descriptive and its use in a sentence (as shown in the evidence filed by the opponents) is clearly not infringing use. As such, this claim is unconvincing and must be set aside.

## Section 3(1)(b)

13. Anna Carboni, sitting as the Appointed Person in O-363-09 *COMBI STEAM Trade Mark*, conveniently summarised the leading case law in respect of this part of the Act:

“ It has been said that lack of distinctive character is the essence of any objection under section 3(1)(b), (c) or (d) of the Act and that, despite its position in the list, section 3(1)(b) performs “a residual or sweeping-up function”, backing up the other two provisions, which contain specific and characteristic examples of types of marks that lack distinctive character: *Procter & Gamble Ltd’s Trade Mark Application* [1999] RPC 673 (CA) per Robert Walker LJ at 679. If a trade mark is entirely descriptive of characteristics of goods or services (and thereby prohibited from registration under section 3(1)(c)), it will also be devoid of any distinctive character under section 3(1)(b): *Case C-363/99 Koninklijke KPN Nederland BV v Benelux-Merkenbureau (POSTKANTOOR)* [2004] ETMR 57 (ECJ) at [86]. However, the converse is not true: a mark which is not descriptive may nevertheless be devoid of distinctive character for other reasons (*ibid.*)”.

When a trade marks examiner assesses the distinctiveness of a trade mark within the meaning of section 3(1)(b), s/he must do so firstly by reference to the goods or services listed in the specification, and secondly by reference to the perception of the mark in relation to such goods or services by the relevant public, which consists of average consumers of the goods or services in question, who are deemed to be reasonably well informed, observant and circumspect: *Joined Cases C-53/01 to C- 55/01 Linde AG, Winward Industries Inc and Radio Uhren AG* [2003] ETMR 78 at [41].

It is not necessary to show that a mark has a particular level of creativity or originality in order to establish distinctive character: *Case C-329/02P SAT. 1 Satelliten Fernsehen GmbH v OHIM* [2005] ETMR 20 (ECJ) at [41]. While the Court of First Instance (“CFI”) has repeatedly referred to “a minimum degree of distinctive character” as being sufficient to avoid article 7(1)(b) of the CTMR/article 3(1)(b) of the Directive (for example, *Case T-34/00 Eurocool Logistik GmbH & Co. KG v OHIM (“EUROCOOL”)* [2003] ETMR 4 at [39]; *Case T-128/01 Daimler Chrysler Corp v OHIM* [2003] ETMR 87 at [33]; *Case T-320/03 Citicorp v OHIM (“LIVE RICHLIY”)* at [68]), the ECJ has not adopted

this wording and has deemed it unnecessary to give any more precise definition to the possible dividing line between lack of distinctiveness and the minimum distinctiveness to which the CFI refers: *Deutsche Krankenversicherung AG v OHIM* (“COMPANYLINE”) [2002] ECR I-7561 at [20].

The ECJ approaches the issue of distinctiveness by reference to the underlying purpose of article 3(1)(b) of the Directive / 7(1)(b) CTMR, which in the Court’s view is to preclude registration of trade marks that are incapable of performing the essential function of guaranteeing the identity of the origin of the marked product to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin: *SAT.1 v OHIM* at [23]; Case C-37/03 P *BioID AG v OHIM* [2005] ECR I-7975 (ECJ) at [27]”.

14. The opponents do not rely on any additional evidence in respect of Section 3(1)(b) other than that already referred to and discussed above. The persuasive and evidential burden is on the opponent to demonstrate why a registration (in this case an international registration), which is deemed to be prima facie valid<sup>1</sup>, is indeed invalid. The main crux of the opponent’s arguments appears to be that IN and SKIN are generic, non-distinctive words which, when placed together create a non-distinctive trade mark. I disagree and consider that the opponent has failed to discharge its evidential burden as it has relied solely upon Trade Mark Register entries and unfocussed internet hits, all of which have already been soundly criticised above. As such, the discharge of its persuasive burden has also failed. IN-SKIN, in the abstract, is capable of ensuring identity of origin in respect of these goods. The opposition based upon Section 3(1)(b) also fails.

## **COSTS**

15. The applicants have been successful and so are entitled to a contribution towards its costs. Neither party sought costs off the normal scale and I am of course mindful that neither party sought a hearing. In the circumstances I award the applicant the sum of £900 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing counterstatements and considering statement of case -£300

Filing evidence and submissions and considering the opponent’s evidence -  
£600

Total - £900

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<sup>1</sup> See Section 72 of the Trade Marks Act 1994

16. 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 31<sup>st</sup> day of January 2012**

**Louise White**

**For the Registrar,**

**The Comptroller-General**