

**O/115/18**

**TRADE MARK ACT 1994**

**TRADE MARK REGISTRATION No. 3151383**

**IN THE NAME OF VIATOR HEALTH LIMITED**

**AND**

**APPLICATION 501593**

**BY WHOLESOME TRADING LIMITED**

**FOR THE REGISTRATION TO BE DECLARED INVALID**

## **Background and pleadings**

1. This is an application dated 13<sup>th</sup> March 2017 by Wholesome Trading Limited (“the applicant”) to invalidate trade mark registration 3151383 in the name of Viator Health Limited (“the proprietor”).

2. The trade mark consists of the words SO DIVINE. The application to register the mark was filed on 24<sup>th</sup> February 2016 (“the relevant date”). The mark was registered on 27<sup>th</sup> May 2016 in relation to:

Class 3: Soaps; perfumes, essential oils, cosmetics, hair lotions, body lotions, massage oils, massage lotions, shower gels, massage creams, bubble baths, body powders, body paints, lip balms, depilatory preparations.

Class 5: Perfumes, essential oils, cosmetics, hair lotions, body lotions, massage oils, massage lotions, shower gels, massage creams, bubble baths, body powders, body paints, lip balms, depilatory preparations; lubricant substances for use on the penis, anus or vagina; preparations for arousing sexual desire or improving sexual performance; preparations, potions, aphrodisiacs and herbs for medicinal purposes; nutritional preparations; tampons.

Class 10: Massage devices; devices for massaging, vibrating or stimulating the body; devices for aiding copulation, masturbation and sexual arousal, including synthetic reproductions of parts of the male and female anatomy, synthetic reproductions of penises and vaginas, penis rings, nipple clamps, vibrators, dildos, dongs, butt plugs, penis sleeves, penis extensions, harnesses, masturbators, body prostheses, love dolls; vaginal exercisers; condoms.

Class 25: Clothing, footwear, headgear; erotic lingerie; fantasy clothing of leather or latex, body suits, belts, uniforms, straps, hoods, masks, blindfolds, gags.

Class 35: Retail services, mail order retail services, online retail services connected with the sale of sex toys, lubricants, massage gel, candles.

3. The grounds for invalidation are, in summary, that:

- The words SO DIVINE convey the meaning “utmost excellence” and are therefore a sign that may serve, in trade, to designate the quality of the goods and services covered by the trade mark.
- Alternatively, the words constitute a “banal laudatory promotional phrase” are therefore devoid of any distinctive [trade mark] character.
- Registration of the mark was therefore contrary to section 3(1)(b) and/or (c) of the Trade Marks Act 1994 (“the Act”).
- The applicant has used the mark JO DIVINE since 2007 for retail services connected with the sale of adult sex toys and related accessories.
- Use of the contested mark would amount to a misrepresentation to the public that the proprietor’s goods and services are connected with the applicant, which would cause damage to the applicant’s goodwill.
- Registration of the contested mark was therefore contrary to s.5(4)(a) of the Act.

4. The proprietor filed a counterstatement denying the grounds of invalidation. I note, in particular, that:

- The proprietor says that DIVINE has many meanings, including “god-like, sacred, belonging to god” and therefore evades any single inherent meaning.
- The mark cannot therefore be purely descriptive of goods “of supreme excellence of worth” (as alleged).
- SO DIVINE is neither a natural description of the characteristic of the goods/services covered by the contested mark, nor is it a normal industry term.
- As the beginnings of marks make most impact on consumers, the difference between JO DIVINE and SO DIVINE is a material difference.

- JO will be recognised as a forename, therefore JO DIVINE will be recognised as a name, whereas SO DIVINE has no such meaning.
- These differences are sufficient to avoid any deception of ordinary consumers.

## **Representation**

5. The applicant is represented by Baron Warren Redfern, Trade Mark Attorneys. The proprietor is represented by IP Service International Pty Limited. A hearing took place on 14<sup>th</sup> February 2018 at which Mr Max Stacey appeared on behalf of the applicant and Mr Olaf Kretzschmar represented the proprietor via a teleconference link.

## **The evidence**

### The applicant's evidence

6. The applicant's evidence consists of a witness statement by Paul Evans who is one of the two directors of Wholesome Trading Limited (the other being his wife, Samantha Evans).

7. Mr Evans says that the applicant adopted the JO DIVINE brand in 2007. The business is targeted at *"the premium quality driven end of the adult sex toys market."* The business operates as an online retailer of such goods and related products. The jodivine.com website has therefore been operational since late 2007. Exhibit JD2 consists of historical extracts from the applicant's website from the years 2007 to 2016 obtained from the internet archive WayBack Machine. These show use of Jo Divine in plain word and stylised forms (with the letter 'O' of 'Jo' overlaid on the letter 'D' in 'Divine). The products being sold are sex toys and lubricants.

8. The applicant promotes its business through advertisements in magazines and through Google Adwords. In the period November 2009 to February 2016, the applicant spent between £5.5k and £36.1k per annum on such promotions.

Examples of advertisements in magazines between 2011 and 2016 are in evidence.<sup>1</sup> They include Good Housekeeping, She, Woman & Home, Cosmopolitan, Marie Claire, Men's Fitness, Harper's Bazaar and FHM and other well known titles.

9. The applicant's annual turnover in goods sold through the JO DIVINE retail business varied between £175k and £240k in the years 2011 to 2016.

10. Mr Evans provides copies of extracts from the Collins and Oxford dictionaries and The Oxford Thesaurus.<sup>2</sup> The 4<sup>th</sup> entry for 'divine' in Collins is "*of supreme excellence or worth.*" The fifth entry is "*Informal: splendid; perfect.*" I note that the first three entries give meanings related to religion or God. The first entry in the Oxford Dictionary also gives a meaning related to God. The second entry is "*a. more than humanly excellent, gifted or beautiful. b. colloq excellent, delightful.*" The entries in The Oxford Thesaurus are similar. The entries for 'so' show that it can be used as an intensifier, e.g. "*It's so lovely.*"

11. Mr Evans also provides some examples of 'divine' or 'so divine' being used in a descriptive manner.<sup>3</sup> These consist of (1) an email from the proprietor to the applicant dated 30<sup>th</sup> November 2016 offering to supply the proprietor's SO Divine products, which includes the strapline "*Sex toys just got a little bit more divine*"; (2) pages from the proprietor's website from 2017 with 'Top Tips for Valentine's Day', which include the statement "*Romance is so divine when you get it right*"; (3) An extract from an online blog on the website 'theprimgirl.com' from 2015 with the heading "*OH OSCAR! THE DRESSES ARE SO DIVINE!*".

12. Finally, Mr Evans provides documents obtained from the website of the EUIPO showing that the proprietor's application to register SO DIVINE as an EU trade mark was refused under article 7(1)(b) of the EU Trade Mark Regulation (which is equivalent to s.3(1)(b) of the Act).

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<sup>1</sup> See exhibit JD4

<sup>2</sup> See exhibit JD11

<sup>3</sup> See JD12

## The proprietor's evidence

13. The proprietor's evidence consists of a witness statement by Andrew Wills, who is a director of the proprietor. Mr Wills provides extracts from the online versions of the Collins, Oxford and Merriam-Webster dictionaries.<sup>4</sup> These broadly reflect the meanings shown in the applicant's evidence. I note that in the 'Learner' version of Collins, the third meaning of 'divine' states that "*People use divine to express their pleasure or enjoyment of something.*" There is an indication that this meaning is "old fashioned". The same entry goes on to state that 'divine' can be used as a graded adjective; the example given is "*..divinely glamorous singer Jeffrey McDonald.*"

14. Mr Wills provides additional pages from the website 'theprimgirl.com', which show that 'divine' was used on that site in the specific context of vintage clothing, i.e. goods where old fashioned language may be appropriate.

15. Exhibit AW04 to Mr Wills' statement consists of print-outs of online articles and reviews of the proprietor's products. He makes the point that SO DIVINE is used as a trade name in these documents. The documents in question date from 2017. They show SO DIVINE used as a trade name for sex toys. Most of the pages are from websites focused on sex aids. There is one entry from the Daily Mail online, but this appears to be the Australian version. However, most of the reviews show that the proprietor's products are priced in pounds sterling, indicating that they were available in the UK in 2017. Mr Wills himself says nothing at all about the proprietor's marketing of goods/services under the SO DIVINE trade mark.

16. According to Mr Wills, the applicant's JO DIVINE products are available for sale to people in the Republic of Ireland and Europe as well as in the UK.<sup>5</sup> Exhibit AW05 consists of a page from the applicant's website which bears this out. However, I note that the goods are priced in pounds sterling and delivery outside the UK is presented as the exception rather than the rule.

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<sup>4</sup> See exhibit AW01

<sup>5</sup> Exhibit AW05 consists of a page from the applicant's website which bears this out.

17. Finally, Mr Wills provides extracts from the applicant's website showing that Jo Divine is used as the name of a fictional female character in order to market sex toys under that name.<sup>6</sup>

### **The descriptiveness/non-distinctiveness grounds**

18. The relevant law is shown below.

"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.

(2) The registration of a trade mark may be declared invalid on the ground-

- (a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or
- (b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2A) – 2F -

(3) -

(4) -

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<sup>6</sup> See SW06 and AW07

(5) Where the grounds of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made.

Provided that this shall not affect transactions past and closed.”

19. Section 3(1) of the Act is as follows.

“3(1) The following shall not be registered –

- (a) signs which do not satisfy the requirements of section 1(1),
- (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 consist 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.”

20. The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation ) was summarised by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc*<sup>7</sup> as follows:

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<sup>7</sup> [2012] EWHC 3074 (Ch)



“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks ( OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94 . Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia, *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44, paragraph 45, and *Lego Juris v OHIM* (C-48/09 P), paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley*, paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94 , it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie*, paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland* , paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94, the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to

believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56).”

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97].”

## Discussion

21. At the hearing, Mr Kretzschmar reminded me that the burden of proof is on the applicant. This is true because s.72 of the Act states that registration shall be *prima facie* evidence of validity. However, a decision maker should not resort to the burden of proof unless he or she finds it impossible to make a decision on the weight of the evidence.<sup>8</sup> I must therefore strive to decide the matter on the materials before me. Nevertheless, I accept that it is necessary for the applicant to establish a *prima facie* case that the contested mark was registered contrary to sections 3(1) or 5(4)(a) of the Act. If it has done so, I must decide whether the proprietor has rebutted that *prima facie* case.

22. The applicant claims that SO DIVINE is descriptive of the quality of sex toys and all the other goods and associated services covered by the registration of SO DIVINE. In this connection, it relies primarily on the dictionary meanings of ‘divine’ coupled with the fact that ‘so’ can be used as an intensifier. The dictionary meanings of ‘divine’ as a laudatory word and ‘so’ as an intensifier are sufficient, in my view, to present a *prima facie* case that the contested mark is capable of being used as a description of the quality of the goods/services covered by the registration.

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<sup>8</sup> See *Stephens v Cannon* at [46(b)] and *Verlander v Devon Waste Management Ltd* [2007] EWCA Civ 825

23. The proprietor does not appear to strongly dispute that 'so' can be used as an intensifier, but it denies that 'divine' may be used, in trade, to describe the quality of the goods/services at issue. The proprietor relies on (1) the fact that 'divine' has multiple meanings, the most usual of which have religious connotations, (2) that 'divine' is an old fashioned term, and (3) that the laudatory definitions of 'divine' are based on its primary religious meanings and therefore unsuitable for use in the context of sex toys and related goods/services.

24. The first point is irrelevant. It is well established that a descriptive indication does not cease to be caught by s.3(1)(c) because it also has non-descriptive meanings, or because that there are more usual ways of describing the goods or their characteristics, or because there is no evidence that the mark is already in use as a description: See *OHIM v Wrigley* (also known as *Doublemint*) and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (also known as *Postkantoor*). It is sufficient that the mark could be used as a descriptive indication of the goods/services (or their characteristics) in the future and would be understood as such by relevant consumers.

25. As regards the second point, I note that although 'divine' may be an old fashioned laudatory term, it is not archaic and is plainly still used as such. For example in the Collins Dictionary entry for learners of English "...*divinely glamorous singer Jeffrey McDonald.*"

26. The third point is also irrelevant insofar as the validity of the contested mark in relation to general items such as *soaps*, *perfumes* and *clothing* (which includes vintage clothing) are concerned. I see a little more force in the proprietor's third point when considered in the context of sex toys etc. Although plainly of relevance, I do not find the proprietor's own use of the word 'divine' in its strapline "*Sex toys just got a little bit more divine*" to be decisive in this respect. This is because trade mark owners often try to work references to their trade mark into their marketing straplines. I am therefore cautious about whether this is an example of 'natural' descriptive use of the word 'divine' in relation to sex toys. Turning to the dictionary meanings of 'divine', I note that the proprietor's reason for submitting that 'divine' is inappropriate as a description of the quality of sex toys appears to be based on the

formal laudatory meaning of the word, as in “*of supreme excellence or worth*” and “*more than humanly excellent, gifted or beautiful.*” However, both Collins and Oxford dictionaries have further references going to the informal or colloquial laudatory meaning of the word ‘divine’, i.e. “*Informal: splendid; perfect*” and “*colloq excellent, delightful.*” These less formal meanings are not tied to the original God-like meaning. They therefore indicate the general usability of ‘divine’ as a laudatory term. Consequently, I reject the proprietor’s third point too.

27. In my view, there is nothing inapt or inappropriate about using ‘divine’ as a description of the quality of sex toys, massage oils/creams, soaps, perfumes, general or erotic/fantasy clothing, or any of the other goods and services covered by the contested mark. I accept the applicant’s submission that the word ‘so’ may be used as an intensifier of the meaning of the word that follows it. It follows that SO DIVINE may be used as a description of the quality of the goods and services at issue. If it were so used, I find that average consumers of the goods/services would immediately grasp the descriptive and laudatory message conveyed by the mark.

28. Mr Kretzschmar’s skeleton argument suggested that if ‘So Divine’ were to convey any meaning in relation to the proprietor’s goods, it would be to describe one consequence of the operation or use of sex aids etc., rather than to describe or commend them. Mr Kretzschmar therefore submitted that, at most, ‘So Divine’ describes the consumer’s experience consequent to using sex aids. He therefore accepted that ‘SO DIVINE’ is a term that may be used by some consumers of sex aids, but maintained that it was unlikely to be needed by other traders selling similar goods. In this regard he relied on *RADIATION Trade Mark*.<sup>9</sup>

29. Before dealing with this argument, I should point out that *RADIATION Trade Mark* (and several other cases relied upon by Mr Kretzschmar) was decided under the Trade Marks Acts of 1905 and 1938. Although the basic principles of trade mark law have not changed the current law is set out in the Trade Marks Act 1994, which is derived from the EU Trade Mark Directive rather than earlier UK law.

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<sup>9</sup> (1930) 47 RPC 37. The case concerned an application to register RADIATION as a trade mark for gas appliances.

Consequently, specific legal tests adopted under the earlier Acts of Parliament are no longer applicable. The current relevant case law is set out above.

30. Returning to the substance of the argument, I have already given my reasons for finding that SO DIVINE may be used, in trade, to designate the quality of the goods/services covered by the contested mark. However, even if I am wrong about that, and SO DIVINE is a term that is only likely to be used to describe one of the effects of using sex aids, it does not follow that it is therefore unsuitable for use in trade as a description of a characteristic of such goods. In this respect, I note that one of the characteristics specifically listed in s.3(1)(c) is the 'intended purpose' of the goods or services. I accept that not every description of the effect of using goods/services can be regarded as describing their intended purpose, but many such descriptions will fall into this category. For example, 'sexual satisfaction' clearly describes the intended purpose of sex aids and would therefore constitute a characteristic of such goods for the purposes of s.3(1)(c). This is consistent with the policy behind s.3(1)(c), which is to ensure that descriptive signs that may be used in the marketing of the goods or services can be freely used by all. In order to achieve this policy, s.3(1)(c) must be interpreted broadly so as to cover all descriptions of the goods/services and their characteristics. However, as the applicant has not argued that SO DIVINE describes the intended purpose of the goods/services (or any other characteristic, other than quality), it is not necessary for me to decide whether it does.

31. For the reasons given above, I find that registration of the mark was contrary to s.3(1)(c) of the Act. If I am right about that, it follows that the mark is also devoid of any distinctive character and therefore excluded from registration by s.3(1)(b) of the Act too.

32. In case I am wrong about s.3(1)(c) applying, I will also consider whether there are other grounds for refusal under s.3(1)(b). The principles to be applied under article 7(1)(b) of the EUTM Regulation (which is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act) were conveniently summarised by

the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG*<sup>10</sup> as follows:

“29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67).”

33. Mr Stacey submitted that the mark was likely to be recognised by consumers as merely laudatory advertising puff and not as a designation of the trade source of the goods. I agree. In particular, if ‘so divine’ is likely to be recognised by average consumers of sex aids as characterising the pleasure obtained from using the products, it seems unlikely that such consumers would view the words *prima facie* as simultaneously designating the trade source of the goods or associated retail services. This is because words which describe the kind and extent of the sexual pleasure resulting from the use of sex aids are likely to be viewed as having a purely

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<sup>10</sup> C-265/09 P



promotional significance in the marketing of those goods and related goods/services. Consequently, I find that registration of the trade mark was contrary to s.3(1)(b) of the Act.

34. There is no evidence of use of the contested mark in the UK prior to the date of the application for invalidation. Consequently, there is no question of the registration being saved by application of the proviso to s.3(1) of the Act.

### **Section 5(4)(a) – the passing-off right ground**

35. Section 5(4)(a) states:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) [.....]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

36. The relevant case law is well established and not in dispute. In order to succeed the applicant must show:

- a) The existence of goodwill or reputation in its business;
- b) Misrepresentation by the proprietor that has led, or is likely to lead, the public to be deceived about the origins of the proprietor’s goods and services as being those of the applicant; and
- c) That it has suffered, or is likely to suffer, damage to the goodwill in its business.

## Discussion

37. In the absence of any earlier use of the proprietor's mark, the relevant date remains the date of the application to register the contested mark (i.e. 24<sup>th</sup> February 2016).

38. The proprietor disputes that the applicant has shown that it had acquired a goodwill in the UK under JO DIVINE by the relevant date. I reject this submission. At the relevant date the applicant had operated a business selling sex aids and related goods, such as lubricants, for over 8 years. It was a small-but-not-trivial business. The business had been promoted through classified advertisements placed on a regular basis in a number of major UK magazines and on the internet through Google Adwords. It is true that the applicant's sales were not restricted to customers in the UK, but looking at the evidence as a whole it is obvious that the UK was the primary focus of its business. I have no doubt that the applicant had acquired a protectable goodwill in the UK under the name JO DIVINE by the relevant date.

39. Turning next to the question of misrepresentation, the test is whether a substantial number of the applicant's customers or potential customers are liable to be deceived by use of the contested mark.<sup>11</sup> The highpoints of the applicant's case are, in my view, that there is only one letter difference between SO DIVINE and JO DIVINE and the parties' trade in the same field of activity, i.e. sex aids. According to the applicant, this creates a risk of deception through consumers misreading or mishearing SO DIVINE as JO DIVINE and/or through imperfect recollection of the applicant's mark.

40. Dealing with the latter point first, I reject the submission that there is a likelihood of a substantial number of the applicant's customers or potential customers being deceived through imperfect recollection. As Mr Stacey was constrained to accept, JO DIVINE looks like a name. And as Mr Kretzschmar pointed out, the applicant promotes JO DIVINE on the basis that it is also the name of a fictional female, thus serving to reinforce its significance as a personal name. SO DIVINE is obviously not

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<sup>11</sup> *Reckitt & Colman Products Ltd. v. Borden Inc. [1990] R.P.C. 341 at page 407*

the name of a person. In these circumstances, it seems highly unlikely that a substantial number of customers will imperfectly recollect JO DIVINE as SO DIVINE.

41. I accept that there is more to be said for the argument that consumers might simply misread or mishear SO DIVINE for JO DIVINE. However, there are a number of factors which, in my view, mitigate the likelihood of this happening. Firstly, as Mr Kretzschmar pointed out, the beginnings of marks tend to make more of an impact on consumers than the ends, and the first letter of the mark usually makes a distinct impression on consumers. In this connection, I note that the letter 'J' is not particularly visually or phonetically similar to the letter 'S' (unlike (say) the visual similarity between V and W). Secondly, the obviously different meanings of JO DIVINE and SO DIVINE together with the familiarity of the individual words will help consumers to avoid misreading one mark for the other. Thirdly, in the area of commerce where the proprietor's goods/services overlap with the applicant's retail services, i.e. the trade in sex aids, the goods are likely to be selected with an above average degree of care and attention so as to ensure that they are suitable for the consumer's personal needs and are safe to use.<sup>12</sup> These goods are not impulse purchases. Taking all these factors into account I find that there is no likelihood of deception amongst a substantial number of the relevant class of consumers. I do not rule out the possibility of occasional momentary instances of confusion amongst a few consumers. However, I do not consider that such instances are likely to be substantial in number. Further, I do not consider that any such confusion is likely to persist throughout the selection process and result in damage to the applicant's goodwill.

42. I therefore find that use of the contested mark would not have constituted a misrepresentation at the relevant date. The s.5(4)(a) case fails accordingly.

## **Outcome**

43. The registration is invalid and will be cancelled in total.

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<sup>12</sup> As Mr Stacey submitted at the hearing.

## **Costs**

44. The applicant has succeeded and is entitled to a contribution towards its costs. I will take into account that the application under s.47(1) succeeded, but the application under s.47(2) failed. I therefore calculate the appropriate costs as follows:

- £200 for the filing fee for an application for invalidation;
- £200 for filing the application and considering the counterstatement;
- £300 for filing evidence and considering the proprietor's evidence;
- £350 for attending a hearing and filing a skeleton argument.

45. I order Viator Health Limited to pay Wholesome Trading Limited the sum of £1050. This sum to be paid within 14 days of the end of the period allowed for appeal or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings (subject to any order by the appellant tribunal).

**Dated this 21<sup>st</sup> day of February 2018**

**Allan James  
For the Registrar**