

**TRADE MARKS ACT 1938 (AS AMENDED) AND  
TRADE MARKS ACT 1994**

IN THE MATTER OF TRADE MARK APPLICATION NO  
1266228 BY KEYSTONE LABORATORIES INC TO REGISTER A TRADE  
MARK IN CLASS 3

AND

IN THE MATTER OF OPPOSITION THERETO UNDER OPPOSITION NO  
38926 BY ULTRA GLOW COSMETICS LTD

IN THE MATTER OF TRADE MARK APPLICATION NO: 1391239 BY  
ULTRA GLOW COSMETICS LIMITED TO REGISTER A TRADE  
MARK IN CLASS 3

AND

IN THE MATTER OF OPPOSITION THERETO UNDER OPPOSITION NO  
39309 BY KEYSTONE LABORATORIES INC

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ULTRA GLOW COSMETICS LTD**

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ULTRA GLOW COSMETICS LIMITED TO REGISTER A TRADE MARK IN  
CLASS 3**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER OPPOSITION NO 39309 BY  
KEYSTONE LABORATORIES INC**

**DECISION**

On the 1 May 1986 Keystone Laboratories Inc (formerly Keystone International Inc) applied under the Trade Marks Act 1938 to register the trade mark ULTRA GLOW in Class 3 of the Register. The application is numbered 1266228.

Following examination of the application, evidence of use was filed and the application was advertised in Part B of the Register under the proviso to Section 18(1) of the Act, for the following specification of goods:

“Cosmetic preparations for skin discolouration; cocoa butter; all included in Class 3”.

The application was advertised on the 4 of November 1992 on page 7963 of Journal 5948.

On the 7 July 1989, Ultra Glow Cosmetics Limited (formerly Ultra Glow Ltd) also applied under the Trade Marks Act 1938 to register the trade mark ULTRA GLOW in Class 3 of the Register. The application is numbered 1391239.

Following examination of the application and after the filing of evidence of the trade mark’s use, the application was advertised in Part A of the Register under the proviso to Section 18(1) and Section 12(2) of the Act, for the following specification of goods:

“Cosmetics, perfumes, non-medicated toilet preparations; soaps; all included in Class 3; but not including any such goods being cosmetic preparations for skin discolouration and any such goods containing cocoa butter.”

The application was advertised on 11 November 1992 on page 8139 of Journal 5949.

Following advertisement of the marks for opposition purposes, each party filed opposition against the other. Both sides asked for the Registrar to exercise his discretion in their favour and they also ask for an award of costs.

The two parties filed evidence in these proceedings and the matter came to be heard on 20 January 1998. Keystone Laboratories Inc, were represented by Mr Christopher Morcom of Queens Counsel instructed by their Agents F J Cleveland & Company and Ultra Glow Cosmetics were represented by Mr James Mellor of Counsel instructed by their Agents Chancery Trademarks.

By the time these matters came to be heard the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 to that Act, however, I must continue to apply the relevant provisions of the old law to these proceedings. Accordingly all references in the latter parts of this decision are references to the provisions of the old Act and the Trade Mark and Service Mark Rules 1986.

#### **OPPOSITION NO: 38926**

#### **APPLICANTS - KEYSTONE LABORATORIES INC**

#### **OPPONENTS - ULTRA GLOW COSMETICS LIMITED.**

In respect of application No: 1266228 in the name of Keystone laboratories Inc. registration is opposed by Ultra Glow Cosmetics Ltd and their predecessors in title Ultra Glow Ltd, on the following grounds:

1. Under Section 11 by reason of the opponents use of the trade mark such that use by the applicant of the trade mark ULTRA GLOW would be likely to deceive or cause confusion or otherwise be disentitled to protection in a Court of Justice.
2. That acceptance of the application is contrary to the provisions of Sections 9 & 10 of the Act.
3. That the application should be refused in accordance with the provisions under Section 12(3) of the Act.

The opponents, Ultra Glow Cosmetics Limited, claim that they are the proprietors of the trade mark ULTRA GLOW in the United Kingdom for a wide range of cosmetic and toiletry preparations. They have used the mark ULTRA GLOW in relation to the goods for which the mark was advertised for a considerable number of years and have thus gained a substantial reputation in the trade for goods sold under the mark. In addition, the opponents claim that the goods for which application No.B1266228 has been advertised, are “goods of the same description” as those of their own application No: 1391231, shown above.

The applicants deny the opponents grounds of opposition. In particular, they dispute the opponents claim that the opponents and their predecessors in title are the proprietors of the trade mark ULTRA GLOW in the United Kingdom in relation to “a wide range of cosmetic and toiletry preparations”. In addition they comment that their application for the mark ULTRA GLOW under No: B1266228 was filed some three years before the opponents’ application, also that they have use of their trade mark in the United Kingdom some nine years prior to either application being filed.

## **OPPONENTS’ EVIDENCE**

The opponents’ evidence consists of two Statutory Declarations. The first dated 8 February 1995 is by Paul Anthony Manley who is both a Director and the Company Secretary of Ultra Glow Cosmetics Ltd. He explains that he has been associated with the company since 1987 and has been a Director and Company Secretary since March 1992 and February 1993 respectively.

Mr Manley explains various changes in name and ownership of the company since 1981, culminating in its current title Ultra Glow Cosmetics Limited. Exhibit PAM1 is a copy of an agreement dated 10 March 1992, between Sharmabrook Ltd and Oval (786) Ltd, predecessors in title to Ultra Glow Cosmetics Ltd.

Mr Manley explains that his company and its predecessors in title are the true proprietors in the United Kingdom of the mark ULTRA GLOW and adds that the mark was first used in the United Kingdom by Ultra Glow Limited in 1981. He states that the trade mark has been used continuously since that date, first in relation to cosmetic powder for application to all areas of the skin and to brushes used to apply the powder. Later new products were sold under the trade mark as follows:

1983 - non-medicated preparations for moisturising and for cleansing the skin.

1984 - lipsticks.

1986 - a translucent powder, a pressed version of the original powder was introduced together with a range of bronzing gels.

1988/1989- nail polishes, mascara, liner pencils and a liquid tint cosmetic were sold under the mark.

Mr Manley explains that sales of goods bearing the trade mark ULTRA GLOW are made through the following national retailers: Boots The Chemists, House of Frazer, Debenhams, Beatties, Alders and Superdrug. Sales have also been made through independent chemists and wholesalers. He estimates that this represents sales through approximately seven hundred and seventy two retail outlets. In addition, Mr Manley comments that the trade mark has been marketed in a number of overseas countries via a network of distributors and adds that the mark has been registered in Class 3 in most of those countries.

Mr Manley then goes on to give approximate wholesale and retail sales from 1982 onwards. He also provides figures for sums spent on advertising the trade mark and the cost of employing demonstrators. All these are shown below.

<u>Year</u>	<u>UK Wholesale</u>	<u>UK Retail</u>	<u>Advertising</u>	<u>Cost of demonstrators</u>
1982	£372,205	£744,410	£85,868	£32,877
1983	£765,738	£1,531,476	£57,752	£172,421
1984	£1,106,586	£2,213,172	£87,111	£345,188
1985	£2,450,000	£4,900,000	£132,548	£228,438
1986	£1,900,000	£3,800,000	£26,000	£451,515

Mr Manley adds that the trade mark has appeared in a wide range of publications and national and regional newspapers. At Exhibit PAM2, specimens of these advertisements are given. I note that these show use of the trade mark continuously from as early as 1982 on makeup designed for use on the face and as a body bronzer, eye shadow, eye liner, blusher and shaper and nail and lip colour.

At Exhibit PAM3, Mr Manley provides a range of promotional literature bearing the trade mark and price lists showing the range of cosmetic goods sold under the trade mark. The price lists supplied are however after the material date (dated 1992 and 1993) and as such are of little assistance. The promotional material is (as far as I can establish) undated and as such can be given little if any weight in these proceedings. Mr Manley states that it is his company's policy to use in-store demonstrators to promote and advertise goods sold under the trade mark, and Exhibit PAM4 provides examples of such in store displays. Once again the examples are undated and as such are of little assistance in establishing what use there was of the trade mark in the relevant period.

The second Statutory Declaration dated 8 February 1995 is by Mr Colin Pollard who explains that he is the Brand Manager of Ultra Glow Cosmetics Limited and has held this position since 1992. Prior to this, he explains, he was a Director of the company's predecessor in title Ultra Glow Limited, and he was responsible within that company for the product development, design and marketing of their range of ULTRA GLOW cosmetics products from 1987 to 1992.

Mr Pollard comments that Ultra Glow Limited first used the mark ULTRA GLOW in 1981 in relation to a cosmetic powder which was designed and could be used for application to all areas of the skin. He adds that in subsequent years the range of cosmetics sold under the mark ULTRA GLOW was broadened to include toilet preparations for moisturising and cleansing the skin, lipsticks, bronzing preparations, further cosmetic powders, nail polishes and cosmetics for tinting the skin. During the period 1981 to 1992, Mr Pollard states that goods were sold on a substantial scale throughout the United Kingdom through the following outlets: Debenhams, Lewis's, Selfridge's, Bentalls, House of Frazer, Alders, Beatties, Boots The Chemists and through approximately one thousand other outlets.

## **APPLICANTS' EVIDENCE**

The applicants evidence consists of two Statutory Declarations. The first dated 27 September

1995 is by Melinda Menke Burns. Ms Burns explains that she is the President of Keystone Laboratories Inc and is authorised to make the declaration on their behalf. She adds that her association with the company and its predecessors in title Keystone International Inc goes back as far as she can recall, since the business was formed and has been owned and managed by her family for three generations. Ms Burns adds that her formal employment with the company began on 1 October 1982, and she held the position of Vice President of Sales and Marketing until 1988 when she became President of the company. She was appointed Chairman of the Board in January 1992.

Ms Burns refers to her company’s application under No: B1266228 for the trade mark ULTRA GLOW, which was originally filed in the name of Keystone International Inc, a closely associated company in the same family ownership as the present applicants, Keystone Laboratories Inc. Ms Burns explains that having been wound down, all of the assets, intellectual property rights and goodwill of Keystone International Inc. were transferred to Keystone Laboratories Inc.

Ms Burns then refers to Exhibit MMB1 which is a copy of the declaration and exhibits of Michael A Turk which was filed in support of the application at the examination stage. Ms Burns explains that Mr Turk held the position of Marketing Director of both Keystone International Inc and Keystone Laboratories Inc at the time the declaration was made. She confirms that to the best of her knowledge the information in the declaration is accurate and she then goes on to provide additional information on her company’s use of the trade mark since Mr Turk’s declaration was made. She confirms that the trade mark ULTRA GLOW was first used by her company in the United Kingdom in December 1976 in relation to:

“Cosmetic preparations for skin discolouration, cocoa butter, medicated lotions, moisturising creams and soaps”,

She adds that the trade mark has been continuously used in the United Kingdom up to the present date and confirms that sales under the trade mark in the United Kingdom during the period 1977 to 1987 are as shown in paragraph 7 of Mr Turk’s declaration. These are as follows:

<u>Year</u>	<u>U.S (\$)</u>	<u>UK (£)</u>
1977	\$10,181	£5,817
1978	\$11,768	£6,724
1979	\$3,968	£2,267
1980	Not available	
1981	\$8,319	£4,753
1982	\$13,310	£7,605
1983	\$18,077	£10,329
1984	\$13,045	£7,454
1985	\$27,634	£15,790
1986	\$37,241	£21,280
1987	\$29,163	£16,664

Ms Burns explains that her company has regularly advertised goods under the trade mark in the UK, and provides details of sums spent on advertising during the period 1986 to 1994. These

figures (with the exception of 1986 up to the date of application) are not relevant to the proceedings. However, I note from Mr Turk's original declaration that the company spent some £3,793 promoting its goods in the United Kingdom in 1986 and although neither Ms Burns or Mr Turk can confirm with any accuracy advertising spends during the period 1982 to 1985, Ms Burns confirms that advertising did take place during this period. Furthermore, Ms Burns confirms that her company sold and advertised a skin care product in the United Kingdom called ULTRA BLEACH AND GLOW during the period 1972 to 1976, and she considers that this has contributed to the association in the minds of the public between the trade mark and her company.

In the context of the trade mark's promotion, Ms Burns refers to the exhibits supplied with Mr Turk's original declaration. Exhibit MMB2 is a selection of advertising and promotional material, and a point of sale leaflet and product literature which is, as far as I can establish undated. The advertisements in Black Beauty magazine (January/February 1987) and ROOTS magazine (October 1986) are after the material date and are therefore of little assistance. Some of these magazines are of US origin and if they are circulated in the UK their circulation may be rather limited. I do however note that the trade mark did appear in the December/January 1986 edition of Black Beauty magazine, a UK publication

Ms Burns concludes her declaration by expressing her belief, that, in relation to the goods mentioned earlier in this decision, and by virtue of the trade mark's long use in the UK, the trade mark ULTRA GLOW has become distinctive of the goods of her company.

The second declaration dated 12 October 1995 is by Lee Martin Curtis who is a Trade Mark Assistant at the firm of F J Cleveland & Company, the applicants agents, a position he has held since October 1993. Mr Curtis comments extensively on the agreement between Sharmabrook Limited and Oval (786) Limited who are the predecessors in title to Ultra Glow Cosmetics Limited. The facts and information provided have no direct relevance to the pleadings or these proceedings in general, in my view. I have not therefore taken this piece of evidence into account.

## **OPPONENTS EVIDENCE IN REPLY**

The opponents filed one Statutory Declaration in reply.

The declaration dated 24 June 1996 is by the same Paul Anthony Manley mentioned earlier in this decision and is a direct response to the declaration of Mr Curtis. For the reasons given in respect of Mr Curtis' declaration I take no account of this declaration of Mr Manley.

This concludes my review of the evidence filed in respect of Opposition No: 38926

## **OPPOSITION NO: 39309**

### **APPLICANTS - ULTRA GLOW COSMETICS LIMITED**

## **OPPONENTS - KEYSTONE LABORATORIES INC**

In respect of application No. 1391239 in the name of Ultra Glow Cosmetics Limited (formerly Ultra Glow Ltd), registration is opposed by Keystone Laboratories Inc and their predecessors in title Keystone International Inc which can be summarised as follows:

1. Registration of the application would be contrary to the provisions of Sections 9 and 10 of the Act.
2. By reason of the use made by the opponents of the trade mark ULTRA GLOW, registration of the applicants trade mark would be contrary to the provisions of Section 11 of the Act.
3. The applicants are not the true proprietors of the trade mark. This ground goes to Section 17 of the Act.

The applicants deny all of the opponents grounds of opposition. In particular, they draw attention to their own application for the mark ULTRA GLOW filed under No: 1391239 and advertised in Journal 5949. They also comment that the opponents have only used their mark on a very limited range of specialised goods in Class 3, namely the goods for which the mark was originally advertised.

## **OPPONENTS EVIDENCE**

The opponents evidence consists of a Statutory Declaration and exhibits dated 11 April 1995 by Melinda Menke Burns. The declaration and exhibits are identical to those documents filed in respect of Opposition 38926 (and summarised under the heading Applicants Evidence earlier). Consequently, I do not see any need to set out the relevant details again.

## **APPLICANTS EVIDENCE**

The applicants evidence consists of two Statutory Declarations. The first dated 18 October 1995 is by the same Colin Pollard mentioned earlier in this decision. He states that he has read the declaration of Ms Burns.

He explains that he has made specific enquiries in the trade to try and find any chemist shops which stocked Keystone's ULTRA GLOW product. He specifically targeted chemists in areas of London with a high concentration of West Indian and Afro-Caribbean population. He goes on to say that he contacted twenty chemist shops and of these he could only find four who had heard of the Keystone ULTRA GLOW product. He then visited all four of these shops and found that two of them had no stock of any Keystone products and the remaining two shops had only a couple of items each.

As a result of his investigations, Mr Pollard states that he has cause to doubt the sales and advertising figures quoted by Ms Burns in her declaration, and he believes that the figures could not be supported. He concludes by saying that if Keystone have any reputation at all in this country it is effectively in respect of just one product, namely a skin lightening cream.



The second declaration also dated 18 October 1995, is by the same Paul Anthony Manley mentioned earlier in this decision. He explains that he too has read Ms Burns declaration. He goes on to give some information as to his background in the cosmetic industry and in particular the extensive contact which takes place between himself and a wide range of distributors and customers. As a result of this contact and his extensive knowledge of the business, he concludes that he has an excellent knowledge and feel for the market for cosmetics in the United Kingdom.

With this in mind, Mr Manley goes on to consider the nature of the products he believes Keystone to be selling and the market for which they are intended. It is his view that this is a very specialised market (a view he feels is supported by the manner in which the product is marketed - as shown in the exhibits to Ms Burn's declaration). In short, Mr Manley disputes the level of advertising which Ms Burns claims.

Mr Manley then goes on to contrast the nature of the cosmetic products sold by the two companies, concluding that while his companies products are in the mainstream of the cosmetic market, the opponents goods are highly specialised falling on the very edges of the cosmetic market; indeed he feels they may be more properly described as medical preparations. He considers that there is almost no awareness of the Keystone product, and has recently made specific enquiries to check this general impression. Exhibit PAM1 is a company search on Coral Associates Limited, which is indicated in some of Keystone Laboratories Inc's evidence as being Keystones' distributor in the United Kingdom. Mr Manley comments that the business of Coral Associates Limited is very limited indeed.

In addition Mr Manley has contacted two wholesalers mentioned in Keystone's evidence. The outcome of which was that both companies namely, Double Gee Hair Fashions and Dyke and Dryden both of London, confirmed that while they may once have stocked Keystone's product they had not done so for a very long time. It appears that they gave up carrying the line as there was very little demand.

Mr Manley then refers to the investigations of his Brand Manager Mr Pollard mentioned above and draws the same conclusions i.e., that the figures mentioned in Ms Burn's declaration could not be supported. Mr Manley concludes by saying that if Keystone have any reputation in the United Kingdom at all, it is in respect of one product, a skin lightening preparation which is sold to a very specialised market on a very limited scale.

## **OPPONENTS' EVIDENCE IN REPLY**

The opponents filed four Statutory Declarations in reply.

The first dated 8 August 1996 is by the same Melinda Menke Burns mentioned earlier in this decision. Ms Burns explains that the positions she has held in the company have involved a great deal of contact with a wide range of distributors and customers in the United States and elsewhere, including the United Kingdom. Ms Burns disputes Mr Manley's claims that the ULTRA GLOW products sold by Keystone Laboratories Inc are only suitable for and marketed to a very specialised market. In addition she contests the view that the reputation of the ULTRA GLOW products sold by her company does not extend to moisturising creams and soaps. Ms Burns adds that her company has marketed a cleansing or beauty bar under the ULTRA GLOW

trade mark since 1976. Ms Burns then describes other products sold by her company under the ULTRA GLOW trade mark and in particular she refers to skin tone creams which include skin moisturising components and can therefore, in her view, be accurately described as moisturising creams.. Ms Burns concludes that in her opinion her company's reputation under the trade mark ULTRA GLOW extends much further than that admitted by Mr Manley. To support this contention, Ms Burns refers to Exhibit KL1 which consists of examples of packaging bearing the ULTRA GLOW trade mark and used in relation to a cleansing bar and skin tone cream. Ms Burns adds that these goods have been sold by her company in the United Kingdom for a number of years. Having reviewed the packaging material, I note that it is either undated or bears copyright markings of 1991 and 1993, which is after the material date in these proceedings. However, I note that in Ms Burn's declaration dated 10 October 1996, Ms Burns states that these goods have been sold in the United Kingdom since 1976.

Ms Burns then comments on her company's turnover and advertising figures, given earlier, for goods sold under the trade mark. She confirms that these records have been extracted by her company's Sales and Marketing Department and are as accurate as the existing records of her company allow. She confirms that they represent a true and accurate reflection of her company's business in the United Kingdom for the relevant period. Ms Burns adds that she has located a further collection of relevant invoices for the period May 1982 to January 1987 and these are attached as Exhibit KL2. Having reviewed these invoices I note that the invoices include some goods sold under the ULTRA GLOW trade mark.

In respect of advertising goods sold under the ULTRA GLOW trade mark, Ms Burns comments that her company has extensively advertised ULTRA GLOW products in the United Kingdom. She refers to Exhibits 3-12 in Mr Turk's original declaration (in support of the application at examination stage), which was annexed to Ms Burns first declaration in these proceedings as Exhibit MMB2. Ms Burns goes on to say that this material was by no means exhaustive and Exhibit KL3 is a range of further advertisements featuring the trade mark, dating from 1978 to 1994. Ms Burns goes on to say that the figures in her first declaration are true and accurate and at Exhibits KL4 and KL5 she provides further examples of the how the mark has been promoted all of which, she suggests, shows a significant and sustained advertising campaign by her company.

Having reviewed Exhibits KL3, KL4 and KL5 it is clear that a number of the advertisements shown are after the material date in these proceedings. While I note that a number of the advertisements do predate the material date in these proceedings, it is not clear if they appeared in publications actually circulated in the United Kingdom.

Ms Burns criticises the "survey" conducted by Mr Manley both in terms of its methodology and the size of the sample questioned. Ms Burns continues that over the years her company has exported goods bearing the trade mark to a large number of retailers and distributors in the United Kingdom. In the case of distributors, Ms Burns points out that her company's products are then sold on to a large number of retailers. Ms Burns then points to three retailers/distributors, which she says are a representative sample. The companies mentioned are: Phil's Wholesale of 24/40 Goodwin Road, Shepherds Bush, London, W12 9JW, Beauty Care Supplies of 108/9 Bissell Street, Birmingham, B5 7HP and Dooa Cosmetics of 191 Stonehouse Street, London, SW4 6BA. In respect of Mr Manley's comments regarding Coral Associates Limited, Ms Burns points out

that while Coral Associates Limited did distribute her companies products they were at no time the exclusive distributor of her companies goods in the United Kingdom. She adds that at any one time there were a number of distributors of her companies products in the United Kingdom.

The second declaration dated 13 September 1996 is by Kanubhai K Patel who explains that he is a Director of Beauty Care Supplies Limited of 108/9 Bissell Street, Birmingham B5 7HP, who are wholesalers and distributors of a very wide range of beauty and cosmetic products. He adds that he has held this position since 1988 and that the facts in his declaration come from his own knowledge or from the records of his company.

He explains that his company have distributed goods in the United Kingdom produced by Keystone Laboratories Inc and bearing the ULTRA GLOW trade mark since 1980. These goods have taken the form of a range of cosmetics and skincare products including skin tone creams packaged in a variety of forms, beauty bars soaps, cleansing bar soaps and cocoa butter.

Mr Patel then lists the turnover by year for the period 1990 to 1995 for goods sold under the mark ULTRA GLOW by his company. Clearly these figures are after the material date in these proceedings and are not relevant. He adds that his company's records prior to 1990 are not documented and as such no figures are available for the period 1980-1989. He does however confirm that his company has sold Keystone Laboratories Inc ULTRA GLOW products since 1980.

Mr Patel then goes on to say that as a wholesaler his company sells and distributes products to a very wide range of retailers. He provides a list of sixty five retailers to whom his company has supplied goods bearing the ULTRA GLOW trade mark. Mr Patel concludes his declaration by commenting that ULTRA GLOW products produced by Keystone Laboratories Inc are widely referred to by customers and that in Mr Patel's view the trade mark ULTRA GLOW has become synonymous with the goods offered by Keystone Laboratories, Inc.

The third declaration dated 2 October 1996 is by Mark Davis who is the Managing Director of Phil's (Wholesale) Limited of 24-40 Goodwin Road, Shepherds Bush, London W12 9JW. He explains that his company is a wholesaler and distributor of a very wide range of beauty and cosmetic products. Mr Davis goes on to explain that he has held his current position since 1986 and that the facts in his declaration come from his own knowledge or from the records of his company.

Mr Davies explains that his company has distributed goods produced by Keystone Laboratories Inc and bearing the ULTRA GLOW trade mark in the United Kingdom since 1976. These goods have also taken the form of a range of cosmetics and skin care products including skin tone creams packaged in a variety of forms, beauty bar soaps, cleansing bar soaps and cocoa butter. Mr Davies then goes on to give turnover figures for goods sold under the ULTRA GLOW mark for the period 1990 to 1995. Once again these figures are after the material date in these proceedings and are of no assistance.

Mr Davies provides details of twenty three retailers to whom Keystone's ULTRA GLOW products have been supplied and, like Mr Patel above, comments that in his view the trade mark has become synonymous with the products of Keystone Laboratories Inc.

The fourth and final declaration dated 10 October 1996 is by the same Melinda Menke Burns mentioned earlier in this decision. The declaration was filed to clarify three points arising from Ms Burns second declaration dated 8 August 1996. The first two points refer to paragraph 3 of Ms Burn's declaration. Here she confirms that when she referred to the fact that a cleansing or beauty bar had been marketed by her company since 1976, it was her intention to make it clear that sales of the product had taken place since that date. The second point, also in respect of paragraph 3 refers to the packaging at Exhibit KL1. Ms Burns clarifies that some of the packaging at Exhibit KL1 has been used in the UK since 1978 with the remainder introduced subsequently.

Ms Burns final point is in respect of paragraph 6. Ms Burn's confirms that Dooa Cosmetics have distributed ULTRA GLOW products in the United Kingdom since as early as 1985.

That concludes my summary of the evidence filed in respect of Opposition No: 39309 and of all evidence filed in these proceedings.

I turn to the grounds of opposition, which are essentially the same in each set of proceedings, commencing with those based upon Section 9 and 10 of the Act, which states:-

**9.-(1)** In order for a trade mark (other than a certification trade mark) to be registrable in Part A of the register, it must contain or consist of at least one of the following essential particulars:-

- (a) the name of a company, individual, or firm, represented in a special or particular manner;
- (b) the signature of the applicant for registration or some predecessor in his business;
- (c) an invented word or invented words;
- (d) a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname;
- (e) any other distinctive mark, but a name, signature, or word or words, other than such as fall within the descriptions in the foregoing paragraphs (a), (b), (c) and (d), shall not be registrable under the provisions of this paragraph except upon evidence of its distinctiveness.

(2) For the purposes of this section "distinctive" means adapted, in relation to the goods in respect of which a trade mark is registered or proposed to be registered, to distinguish goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.

(3) In determining whether a trade mark is adapted to distinguish as aforesaid the tribunal may have regard to the extent to which-

- (a) the trade mark is inherently adapted to distinguish as aforesaid; and
- (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact adapted to distinguish as aforesaid.

**10.**-(1) In order for a trade mark to be registrable in Part B of the register it must be capable, in relation to the goods in respect of which it is registered or proposed to be registered, of distinguishing goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.

(2) In determining whether a trade mark is capable of distinguishing as aforesaid the tribunal may have regard to the extent to which-

- (a) the trade mark is inherently capable of distinguishing as aforesaid; and
- (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid.

(3) A trade mark may be registered in Part B notwithstanding any registration in Part A in the name of the same proprietor of the same trade mark or any part or parts thereof.

The objections under these Sections arise because each side considers that the evidence filed by the other party at the examination stage and since either does not show use of the respective trade marks on the range of goods in respect of which the application has been advertised, or that the evidence itself may be deficient. Each side therefore considers that the other's trade mark is either not adapted to distinguish or not capable of distinguishing the goods of the applicant. In both cases I have been provided with a great deal of evidence which indicates that both Ultra Glow Cosmetics Limited and Keystone Laboratories Inc have used the same trade mark ULTRA GLOW on goods which fall within class 3. Some evidence however, falls outside the material date ie. the date of application for registration in each case. Nevertheless after a careful study of all the relevant evidence, I am satisfied that the application by Keystone Laboratories was correctly advertised for the specification of goods as follows:

‘Cosmetic preparations for skin discolouration cocoa butter; all included in class 3.

Therefore the ground of opposition pleaded by Ultraglow Cosmetics Ltd and based upon Section 10 in respect of Keystone Laboratories Inc's application No. 1266228 is dismissed.

I consider, however, that the specification of goods advertised in respect of Ultra Glow Cosmetics Limited's application is broader than the evidence filed indicates. After a study of all the material filed, there is, in my view, no evidence to show that the trade mark ULTRA GLOW has been used

by Ultra Glow Cosmetics Limited on either perfumes or soap. Mr Mellor's request at the hearing therefore for me to exercise the Registrar's discretion to allow these items to remain within the specification of goods covered by the application is not therefore justified. In my view Ultra Glow Cosmetics Limited's trade mark is not adapted to distinguish or capable of distinguishing all the goods covered by the application, namely soaps and perfumes. The grounds of opposition based upon Sections 9 and 10 to Ultra Glow Cosmetics Limited's application are therefore successful. The objection can however be overcome by the deletion of soaps and perfumes from the specification so that it reads as follows:

“Cosmetics; non medicated toilet preparations; all included in Class 3; but not including any such goods bearing cosmetic preparations for skin discolouration and any such goods containing cocoa butter”.

I turn next to the grounds of opposition based upon Section 11 of the Act which states:

“11. It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.”

The established test in respect of opposition based upon this Section of the Act is that set down in *Smith Hayden & Co Ltd's* application but as adapted by Lord Upjohn in the *BALI* trade mark case (1969) RPC 496. Adapted to the matters in hand in each case the test may be expressed as:

“Having regard to the user of the opponents' mark *ULTRA GLOW*, is the tribunal satisfied that the mark applied for, *ULTRA GLOW* if used in a normal and fair manner in connection with any goods covered by the registrations proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?”

In my view the respective trade marks are the same and I am satisfied that *Keystone Laboratories Inc* coined and used the trade mark *ULTRA GLOW* from a date in 1976 on cosmetic preparations for skin discolouration and cocoa butter. *Ultra Glow Cosmetics Limited* on the other hand started to use the trade mark *ULTRA GLOW* in 1981 initially on cosmetic powder and subsequently on other cosmetic products. On the face of it therefore use by *Ultra Glow Cosmetics Limited* of the trade mark is likely to cause confusion and deception amongst a substantial number of people. However, *Ultra Glow Cosmetics Limited's* evidence seeks to indicate, and Mr Mellor at the Hearing submitted, that in fact the goods of the respective specifications are different. Whilst *Ultra Glow Cosmetics Limited's* goods were 'mainstream' cosmetics *Keystone Laboratories Inc's* product was essentially a skin lightener which achieved its results by chemical action rather than straightforward application. I took note of these points but take the view that however the result was obtained *Keystone Laboratories Inc's* products were used for cosmetic purposes as were *Ultra Glow Company Limited's*. Therefore, I confirm the statement in *Ultra Glow Company Ltd's* own Notice of Opposition, that the respective goods covered by the specifications of goods of the application in suit are the same or of the same description.

Notwithstanding the fact that sales of *Keystone Laboratories Limited's* products amounted to only £27,000 by the time that *Ultra Glow Cosmetics Limited's* goods under the trade mark

ULTRA GLOW were placed on the market in 1982 I am satisfied that the former had established a reputation amongst a section of the purchasing public.

In the circumstances I consider that it is Ultra Glow Cosmetics Limited's use of the trade mark ULTRA GLOW which was liable to cause deception and confusion amongst a substantial number of relevant people. I therefore hold that the opposition based upon Section 11 by Keystone Laboratories against Ultra Glow Cosmetics Limited's application succeeds and consequently Ultra Glow Cosmetics Limited's opposition against Keystone Laboratories application, on the same ground, fails.

My findings under Section 11 of the Act are not the end of the matter since the Ultra Glow Cosmetics Limited's application was proceeding under the provisions of subsection 2 of Section 12 of the Act.

That subsection states:-

(2) In case of honest concurrent use, or of other special circumstances which in the opinion of the Court or the Registrar make it proper so to do, the court or the Registrar may permit the registration by more than one proprietor in respect of:-

- a. the same goods
- b. the same description of goods or
- c. goods and services or descriptions of goods and services which are associated with each other.

of marks that are identical or nearly resemble each other, subject to such conditions and limitations, if any, as the Court or Registrar, as the case may be, may think it right to impose.

I do not think it is disputed that Section 12(2) can be considered in this case and that in appropriate cases Section 12(2) can be utilised to overcome a finding as to possible confusion under Section 11 of the Act. This point was confirmed by Mr Justice Falconer in the CHELSEA MAN cas (1989) RPC 111 at page 121 line 41 where he said:

“In the Spillers’ case, Danckwerts J after considering the decisions of the House of Lords in Bass, Ratcliffe & Gretton Ltd -v- Nicholson & Son Ltd (1932) 49 RPC 85 and in Alex Pirie & Sons’ Application (1933) 50 RPC 147, stated, at page 337, line 15 of the report:

“It seems to me that the construction put by the House of Lords in the cases to which I have referred” - and I interpolate, those were the Bass, Ratcliffe -v- Nicholson and Pirie cases - “on sections 11, 19 and 21 of the 1905 Act must also apply to sections 11 and 12 of the 1938 Act, and lead to the conclusion that cases where the Court or Registrar thinks fit to exercise the discretion conferred by section 12(2) do not fall within the general prohibition contained in Section 11.

And again at page 122 line 25:

In *Berlei -v- Bali* case, Megarry J had to consider whether section 12(2) could override a section 11 objection. After setting out section 12(2) he stated (at page 476):

“I think it is plain that this subsection” - that is section 12(2) - “provides a discretionary path to registration notwithstanding section 12(1) and also notwithstanding section 11”

Having established my view as to the applicability of Section 12(2) the main matters for consideration under this Sub section were laid down by Lord Tomlin in *Pirie’s Trade Mark* (1933) 50 RPC 147 at 159. They are:-

- i. The extent of use in time and quantity and the area of trade.
- ii. The degree of confusion likely to ensue from the resemblance of the marks, which is, to a large extent, indicative of the measure of public inconvenience.
- iii. The honesty of the concurrent use.
- iv. Whether any instances of confusion have been proved.
- v. The relative inconvenience which would be caused if the mark in suit was registered, subject if necessary to any conditions and limitations.

At the relevant date the extent of Ultra Glow Cosmetics Limited’s use of the trade mark was significant both in terms of volume and geographical coverage. There would appear to be no evidence of any confusion, at least none that was presented to the tribunal. This may well give some weight to Ultra Glow Cosmetics Limited’s submissions that the respective goods do in fact have different purposes.

No evidence has been filed to cast doubt upon the honesty of Ultra Glow Cosmetics Limited and it would seem to me that in all of the circumstances Keystone Laboratories Inc would not be inconvenienced by the registration of Ultra Glow Cosmetics Limited’s trade mark (alongside their own).

In the light of this it appears to me that Ultra Glow Cosmetics Limited are entitled to the benefit of Section 129(2) of the Act. It follows therefore that Keystone Laboratories success under Section 11 is of no benefit to them.

Finally I deal with the ground of opposition based upon Section 17(1) pleaded by Keystone Laboratories Inc in respect of Ultra Glow Cosmetics Ltd’s application, which relates to the proprietorship of the trade mark. No evidence has been placed before me on this point but as I have indicated already in this decision, there is no reason, in my view, to doubt the honesty of Ultra Glow Cosmetics Limited in the matters of coinage, use or proprietorship of the trade mark, ULTRA GLOW.



In summary, Keystone Laboratories application No. 1266228 may proceed to registration, all grounds of opposition having been unsuccessful. Ultra Glow Cosmetics Limited's application No. 1391239 may also proceed to registration, but only if the specification of goods is limited by the removal of perfumes and soaps from the specification of goods. Ultra Glow Cosmetics Limited are allowed one month from the date of the decision in which to file a form TM21 to do so. In the event that the specification is not so amended the application by Ultra Glow Cosmetics Limited stands refused for the reasons stated.

In view of the decisions I have reached in these proceedings I see no reason for the exercise of the Registrar's discretion.

Ultra Glow Cosmetics Limited failed on all their grounds of opposition against Keystone Laboratories Inc's application, whereas Keystone Laboratories Inc were partly successful in their grounds against Ultra Glow Cosmetics Limited. In the circumstances I order that Ultra Glow Cosmetics Limited pay to Keystone Laboratories the sum of £500 towards their costs.

**Dated this 27 day of February 1998**

**M KNIGHT**  
**For the Registrar**  
**the Comptroller General**