

O-223-03

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2271963
by James Forrest**

and

**IN THE MATTER OF Opposition thereto under No 80350
by Performance Brands Inc**

Background

1. On 24 May 2001, James Forrest applied to register the trade mark set out below in relation to the following goods in class 3:

“Cosmetics and toilet preparations; sun tanning preparations and lotions and gels.”



2. The application was accepted and published. On 8 November 2001, Performance Brands Inc filed notice of opposition to the application. The statement of grounds accompanying the notice of opposition sets out four grounds of opposition. These can be summarised as follows:

- a) under section 3(1)(b) of the Trade Marks Act 1994 in that the trade mark the subject of the application is devoid of any distinctive character;
- b) under section 3(1)(d) of the Act in that the trade mark is a mere agglomeration of words which are customary in the current language and in the bona fide and established practices of the trade;
- c) under section 3(6) of the Act in that the applicant has no genuine intention to use the whole mark as applied for in respect of “Cosmetics and toilet preparations”, the wording of the label which constitutes the mark clearly referring to “Sun tanning preparations and lotions and gels” only; and
- d) under section 5(4)(a) of the Act in that its use in the United Kingdom is liable to be prevented by the law of passing off in that it includes the words PRO-TAN, which is an unregistered trade mark belonging to the Opponent and which has been widely used in the course of trade in sun-tanning preparations over a period of years.

3. The applicant filed a counterstatement, admitting that the term TANNING GEL is purely descriptive of a preparation in gel form which is for use as a sun-tanning gel, but the grounds of opposition are denied.

4. Both parties filed evidence in these proceedings and both asked for an award of costs. The matter was heard on 19 March 2003. The applicant was represented by Ms C Rogers of Counsel, instructed by Chancery Trade Marks. The opponent was not represented and did not attend the hearing but filed written submission in a letter dated 17 March 2003.

Evidence

Opponent's Evidence

5. The opponent's evidence consists of two witness statements and five exhibits. The first witness statement, dated 11 March 2002 is from Ms Catherine Ayers. Ms Ayers explains that she is a Trade Mark Attorney employed by Williams Powell & Associates, the agents acting for the opponent's in this case.

6. The opponent has sold goods under the mark PRO-TAN in the United Kingdom since 1987. The goods in respect of which the mark is used are "fake tanning" preparations. Exhibit CA/1 shows a copy of a brochure produced by SK Sport Supplies (one of the opponent's distributors and retailers of their PRO-TAN products) which provides information concerning two of the different products sold under the PRO-TAN mark. Aside from SK Sport Supplies, the opponent has well over 1000 retailers in the UK that stock their PRO-TAN products.

7. Exhibit CA/2 shows copies of statements referring to sales of PRO-TAN products. According to Ms Ayers, the monetary value to the opponent of sales of their PRO-TAN products have in fact averaged \$150,000 per year for the United Kingdom. The earliest invoice/statement is dated 10 November 1994.

8. The predecessors in title of the opponent applied to register the mark PRO-TAN in the United Kingdom in 1990 under No. 1435563. Exhibit CA/3 shows details of that application.

9. Exhibit CA/4 shows a copy of an Internet search carried out by the applicant and is attached to the counterstatement to show that the sign PRO-TAN is entirely non-distinctive and cannot be monopolised by any one trader. Ms Ayers argues that it can be seen from the pages in question that the vast majority of the entries relate to the opponent's products.

10. The second witness statement, dated 11 June 2002 is again from Ms Ayers. Ms Ayers refers to Exhibit CA/5 which is a copy of a 1997 brochure put out by the UK company World Gym Limited. On page 12 of this brochure is a feature devoted to tanning products including references to a number of PRO-TAN products of the opponent.

Applicant's Evidence

11. This consists of a statutory declaration together with five exhibits and a witness statement with one exhibit. The statutory declaration, dated 26 July 2002 is from Mr James Forrest, the applicant. Mr Forrest explains that he is authorised to make the declaration and that the information contained within it comes from his own knowledge or from the records of his company.

12. Mr Forrest states that the applicant did carry out pre-filing searches at the Patent Office. Exhibit JF1 shows details of the marks found at the UK Patent Office, which failed to show any statutory rights by the opponent to the mark "Pro-tan" in any form. Exhibit JF2 shows a copy of the applicant's trade mark application as filed together with a copy of the official examination report.

13. Use of the applicant's trade mark commenced in the United Kingdom in May 2001. Exhibit JF3 shows samples of packaging, literature, advertisements showing use of the mark the subject of these proceedings. The applicant also advertises the goods in the pharmaceutical publication "Chemist and Druggist", a publication used regularly by all chemists and many other category retailers to locate products requested by their customers. Exhibit JF4 shows copies of the listings held with the Chemist and Druggist group. Any alterations or updates are immediately logged and no instances of confusion have occurred, to the best of Mr Forrest's knowledge and belief.

14. In relation to the opposition filed, Mr Forrest argues in relation to the applicant's trade mark, the house mark and source of origin of the goods can be seen as the mark Apres Sport dominates the label. Usage of "pro tan" is widely made in the trade as indicating that the product is used to promote a tan. Exhibit JR5 shows the result of an Internet search, which demonstrates that the words "Pro-Tan" are generic and widely used by numerous companies in a descriptive sense.

15. In reply to the two witness statements dated 11 March 2002 and 11 June 2002 by Ms Catherine Ayers, Mr Forrest states that having set out proof that numerous other companies use "pro tan" as an abbreviation for promoting tan, the example shown in Ms Ayers' declaration of 11 June 2002 (page 12) is headed up "MUSCLE-UP The Ultimate Tanning Products". Both of the pictures of these products show the house mark "MUSCLE-UP" above the words pro tan and therefore clearly it indicates where the product originates from.

16. Mr Forrest finally argues that no evidence has been filed to support the opponent's claim that there have been sales in the UK. The only mention is the sum of "US dollars 150,000" in paragraph 4 of Ms Ayers' declaration of 11 March 2002 and the copies attached in Exhibit CA/2 all show US dollar amounts. Any use of the opponent's mark that has been made in the UK is of limited value and has been directed to one company- World Gym Limited in Birmingham, which is insufficient to show such a reputation in the mark as to lead to confusion.

17. The witness statement, dated 1 August 2002 is from Ms Sally Ann Schupke. Ms Schupke explains that she is a trade mark agent employed by Chancery Trade Marks, the agents representing the applicant in this case. Ms Schupke states that she carried out an Internet search for references on the Internet of “pro-tan” as shown in Exhibit SAS1. The search shows that the words pro tan are used by various other companies.

Opponent’s Evidence-in-Reply

18. This consists of a witness statement together with three exhibits, dated 6 December 2002, from Ms Catherine Ayers. Ms Ayers makes the following comments in relation to the evidence of the applicant:

- Regarding the non-distinctive character of PRO-TAN, Ms Ayers refers to Exhibit CA/6, which are copies of catalogues produced by Bliss organisation. Bliss is the trading name of Beauty Leisure Supplies and Services Ltd, an important UK supplier of tanning related products. These catalogues feature advertisements for the opponent’s PRO-TAN products, which, Ms Ayers argues, show use of PRO-TAN as a brand name.
- Exhibit CA/7 shows a copy of Musclemag International Magazine dated March 1991, which is distributed in the UK. At pages 130 and 131, there is a 2 page advertisement for products sold by the Muscle Up organisation, including a number of references to PRO-TAN sun care and self-tanners. The name PRO-TAN appears prominently on the packaging of the products in question and the brand PRO-TAN is used on its own throughout the text of the advertisement indicating that the name is an indication of origin rather than a product descriptor.
- In relation to the Internet search supplied by Ms Sally Ann Schupke, Ms Ayers comments that Ms Schupke only supplied one page of the three downloaded from the www.bodybuilding.com website. Exhibit CA/8 shows a full copy of the materials from this website. It can be seen that information regarding the opponent’s PRO-TAN brand is supplied together with the information that PRO TAN INSTANT COMPETITION COLOR is probably the most popular tanning product of its kind.

19. That concludes my review of the evidence.

Decision

20. The grounds of opposition refer to sections 3(1)(b), and (d) and to section 3(6) and 5(4)(a) of the Trade Marks Act 1994. The relevant provisions read as follows:

- “3.- (1) The following shall not be registered -
- (a)

- (b) trade marks which are devoid of any distinctive character,
- (c)
- (d) trade marks which consists 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.”

“3(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

21. Section 5(4) reads:

“5(4) 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) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

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.”

Section 3(1)(b)

22. The question under this section is whether the mark in question is devoid of any distinctive character. A mark will be devoid of distinctive character if it cannot perform the function of a trade mark, that of identifying the trade origin of the goods or services in question. The opponent’s case is that the mark is made up of various elements which in themselves are not distinctive for the goods in question. They note that the mark consists of the French words APRÉS SPORT, which in the view of the opponent will be understood by the average consumer as being a reference to use “after sport”. The opponent filed no evidence in respect of either of their grounds of opposition under section 3(1). In their written submissions they acknowledge this stating that it was felt that these were grounds in relation to which no evidence could usefully be filed. The applicant points out firstly, that the mark should not be dissected in this way but must be assessed as a whole. They note that the words are arranged against a background of a

device consisting of various tones radiating in oblique sections across the main text from bottom right to top left. Secondly, they argue that in any case, elements of the mark are registrable in their own right noting that the element APRÉS SPORT is already a registered trade mark in their name, in the United Kingdom.

23. It seems to me that on any view, the mark presented for registration:



cannot be said to be “devoid of any distinctive character” the mark consists of a number of elements, some of which may or may not be un-possessed of distinctive character but I must assess the mark as a whole. Assessed as such, it seems to me clear that the mark does possess distinctive character. The opponent is correct to submit that the mere fact that an element of the mark APRÉS SPORT is already a registered mark is in no way determinative of the inherent distinctiveness or otherwise of the mark, but in my view, when assessed as a whole, the mark is not “origin neutral”; per Mr Hobbs in *Cycling Is...*[2002] R.P.C. 37. When applied to goods it would, it seems to me, perform the function of a trade mark and enable consumers to differentiate between the goods of one trader and another. If another trader were to use the same mark on the same goods, that is double identity of marks and goods, then in my view confusion as to origin could be assumed. **The opponents’ ground under section 3(1)(b) is therefore dismissed.**

Section 3(1)(d)

24. As noted above, the applicant did not file any evidence to show that the mark presented for registration, “consists exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade”. The applicant concedes that some elements taken individually may have been customary in the language of the trade, they argue that there is no allegation that any traders use the applicant’s house mark or distinctive device.

25. As with my consideration under section 3(1)(b) I must consider the mark presented for registration as a whole. Does it consist exclusively of such elements? I think that the answer must be no. It is made up of a number of elements some of which may or may not be customary in the language of the relevant trade, however, taken as whole, it cannot be said to consist exclusively of elements which have become customary in the trade.

Therefore, on the basis of the evidence before me, I find the opponent has failed to show that the trade mark presented for registration was at the date of application, one which had become customary in the current language of the trade. The ground of opposition under section 3(1)(d) is dismissed.

Section 3(6)

26. The opponent based their claim under this section on the assertion that the applicant can have no intention of using the product on the full range of goods for which registration is sought because in his evidence, Mr Forrest describes use on tanning preparations only. Indeed, the mark presented for registration includes the words “tanning gel”. Furthermore, they submit that Mr Forrest’s argument that the term pro tan is widely used in the trade to indicate products for promoting tan indicates that he would regard use of the term pro tan on anything other than a tanning preparation to be misleading to the consumer. They state that the applicant can only intend to use the product on tanning preparations.

27. There is I think, some merit in this argument. The mark clearly includes the words “pro tan” and “tanning gel”. However, there are a number of such products on the market. Some may aid and accelerate tan, some may delay the process, some may give the appearance of a tan, a fake tan product. All could it seems to me be described as “pro tan” or a “tanning gel” the addition of further information would inform the consumer of the true nature of the product. Therefore, it seems to me that the limitation suggested by the opponent is too narrow. Goods which could properly be sold under the trade mark would fall outside the specification. The applicant argued that there was nothing improper, covetous, or overly vague about the specification sought. In Ms Roger’s submission the specification represents the manner in which the average consumer might reasonably be expected to describe the products. There was nothing dishonest or reprehensible in the applicant’s conduct. It seems to me, taking things in the round, that the current wording of the specification is not overly broad, and the opponent has failed to show that the trade mark has been applied for in bad faith.

28. The ground of opposition under section 3(6) is dismissed.

Section 5(4)(a)

29. The requirements for this ground of opposition have been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] RPC 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

- (1) that the opponents’ goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the applicants (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the applicants are goods or services of the opponents; and

- (3) that the opponents have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the applicants' misrepresentation.

30. Assuming notional and fair use, I must assess whether use of the applicant's mark, was as at the date of application, liable to be prevented by the law of passing off. In making that assessment, the onus is on the opponent to show that their ground of opposition is made out.

Goodwill and Reputation

31. Ms Rogers argued that the opponent's claim to a goodwill was based on its alleged use in the United Kingdom of the term "Pro Tan" words which in her view were descriptive when used in relation to the goods for which registration was sought. In her submission, such use as had been shown by the opponent was use in a descriptive sense. She pointed out that the opponent admits in their amended statement of grounds at paragraph 3.2 that the term "pro tan" is arguably by its nature descriptive. As such she submits that members of the public would not naturally see it as a trade mark. Absent evidence of use I would be inclined to agree with Ms Rogers on this point. It seems that everyone is in agreement that in relation to the products in question, the term "pro-tan" carries a descriptive meaning. It was suggested that it implied "professional" tan but in my view, as an average consumer, it could also mean to me a short hand for promote, that is a product that promotes tanning. Either way, it carries in my view a descriptive message about the nature of the product.

32. Ms Rogers argued that where a sign is highly descriptive of the product on which it is used, there is a heavy onus on the opponent to demonstrate that they have acquired the necessary reputation. I agree, the case law indicates that in such circumstances it is harder for the opponent to show that their 'descriptive' sign has acquired a goodwill and reputation amongst the public. I am reminded of the judgment of Mr John Randall Q.C., sitting as a Deputy Judge of the High Court in *Radio Taxicabs (London) Limited v. Owner Drivers Radio Taxi Services Limited* (12 October 2001). The case concerned a passing off claim on the basis of goodwill in the name RADIO CABS. In that case, the judge noted that the court was faced with '*the total absence of evidence from members of the wider public*'; paragraph 87. The judge went on to find that the burden of proving reputation with the general public lay on the claimant and that this was all the more so as the name was a descriptive one. At paragraph 89 the judge stated:

"I consider it possible that the claimant may have built up a sufficient reputation in the ways relied on but I cannot conscientiously put it any higher in the claimant's favour than that..... Thus one is left to speculate. Speculation is not enough. At the end of the day the burden of proving on the balance of probabilities, the requisite reputation with the general public in the name "Radio Taxis" lies on the claimant and I find that the claimant has not discharged it."

33. Mr Rogers also referred me to the judgment of Lord Simons in *Office Cleaning Services Ltd v Westminster Window & General Cleaners* [1946] 63 RPC 39 at 43 where he stated:

"It comes in the end, I think, to no more than this, that where a trader adopts words in common use for his trade name, some risk of confusion is inevitable. But that risk must be run unless the first user is allowed unfairly to monopolise the words. The Court will accept comparatively small differences as sufficient to avert confusion. A greater degree of discrimination may fairly be expected from the public where a trade name consists wholly or in part of words descriptive of the articles sold or the services to be rendered."

34. Laddie J, in *Associated Newspapers Limited and another v Express Newspapers* [2003] EWHC 1322 (Ch) also stated:

"25. The jurisprudence to the effect that it is difficult if not impossible to succeed in a passing off action where the mark relied on is descriptive is based on the principle that no trader should be allowed to secure a monopoly over words which customers would regard not as an indication of origin but as merely descriptive of the type of goods or services being offered and which, for that reason, other traders are likely to want to use. Where a mark possesses the ability to convey to the customer an indication of a particular trade origin for goods made available under it, it can be protected by passing off proceedings."

35. The applicant in their written submission refer to their evidence claiming use of the mark "PRO TAN" in the United Kingdom since 1987 in relation to self-tanning preparations. They refer to an undated brochure, details of UK distributors, average sales figures in relation to sales to these distributors and copies of statements from a range of years, the earliest being 1994. They also refer to catalogues submitted as exhibits. Taken together they submit that this demonstrates considerable goodwill in the PRO-TAN mark. Such sales having been made to a small number of UK distributors who in turn sell the product direct to the ultimate consumer. Whilst the products are primarily aimed at bodybuilders, they argue that a large proportion of the UK engage in some type of physical activity and many make use of self-tanning products.

36. Ms Rogers took me to the opponent's evidence and argued that it was not sufficient to show that they had acquired the necessary reputation and goodwill in the United Kingdom in relation to the sign "pro tan". She made several criticisms of the evidence. She noted that no actual packaging had been exhibited and that no evidence from the public or relevant trade had been filed. Further, she took me to the exhibits and argued that the use shown of the mark showed the term "pro tan" under a "house mark" 'Muscle Up' and that there were a range of products. These included, Muscle Up Skin Scrub, Muscle Up Hair Away, Muscle Up Pro Tan, as set out in the 1997 World Gym catalogue at exhibit CA5 and the 1991 "Musclemag", exhibit CA7. Thus the use shown was, in her submission, of the trade mark MUSCLE UP together with a descriptor, HAIR AWAY,

SKIN SCRUB or PRO TAN. Ms Rogers noted that more recent use on a slimming diet supplements showed the term “pro tan” together with a sunshine device.

37. Turning to the claim of use by the opponent and the volumes of sales under the mark, she notes that these are unsubstantiated. She argued that the information was not within the personal knowledge of the witness, Ms Ayers who is the opponent’s agent. As such, the evidence was hearsay and should be excluded. Whilst there is force in Ms Roger’s submission on the hearsay point, it should not be excluded, the question is one of weight, I must assess the weight to be given to such evidence. Clearly the weight to be given to it will not be as great as if the evidence was from one with direct knowledge of the sales of the opponent but the evidence is supported by the statements at exhibit CA/2 showing sales to the UK. It is claimed that sales amount to \$150000 per year. The statements do show sales to the UK but from them it is hard in my view to identify the mark under which the products were sold, they include the product shown as “PRO TAN” shown along side those such as “BIKINI BITE”, “ULTRA BRONZE”, “MUSCLE SHEEN” and “SKIN SCRUB”. From these it is not clear to me whether they are merely describing the product on the statement. As noted by Ms Rogers no actual packaging was exhibited and I only have the evidence of the various brochures and magazines to show how the mark was used.

38. The question of evidence before the registrar in proceedings under section 5(4)(a) has been the subject of comment in an appeal to the High Court. Mr Justice Pumfrey in *South Cone Incorporated* stated:

“12.....As Mr Hobbs QC said in *Wild Child TM* [1998] R.P.C. 455, the registrar is often required to act upon evidence that might be regarded as less than perfect when judged by the standards applied in High Court proceedings. The second question follows: how cogent must the evidence be upon which the registrar should act in upholding an opposition on this ground?”

13. There is one major problem in assessing a passing off claim on paper, as will normally happen in the registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a *prima facie* case that the opponent’s reputation extends to the goods comprised in the applicant’s specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s 11 of the 1938 Act (see *Smith Hayden (OVAX)* (1946) 63 RPC 97 as qualified by *Bali* [1969] RPC 472. Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

14. Evidence of reputation comes primarily from the trade and the public and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date.....”

39. Many of Ms Roger's criticisms of the opponent's evidence were justified, there was no evidence from the trade or public, the evidence was also not directly from the opponent. Further, such use that was shown did not, in my view, show consistent use of the opponent's sign "PRO TAN" as a trade mark. Some use is shown of the mark "Pro Tan" solus but they have not shown that the mark was used consistently in this way across a period of time. The mark in many of the advertisements appears with the words "MUSCLE UP". The other products in the range are marked in a similar way with descriptors used to identify the product, and the statements at exhibit CA/2 were also inconclusive in showing how the mark was used. As noted above, where an opponent is seeking to rely on goodwill and reputation in a descriptive term then they must produce evidence which shows that their sign has acquired that goodwill and reputation. In my view, the opponent's evidence on this case does not come near to clearing that hurdle. They have failed to show the necessary goodwill and reputation and the claim under section 5(4) falls to be dismissed.

40. I should deal with one final point on section 5(4)(a), the opponent's claim to a fraudulent intent on the part of the applicant in filing the application. They note that Mr Forrest admits carrying out a search of trade marks in which he identified the application filed by the opponent's predecessor in title in 1990. This application did not proceed to registration. They also submit that he must have been aware of their use through internet searches. This claim is in my view entirely unsubstantiated. The fact that he identified an application which did not proceed to registration for an element of the mark can in no way imply a fraudulent intent on the part of the applicant in including that as an element of his mark. Equally, there is no evidence of the internet searches carried out before application and the extent, if any, to which use was shown of "pro tan" and indeed, whether such use was in the UK. As I found that the opponent's had failed to show a goodwill and reputation in the mark then this allegation has no bearing on the outcome but as it was raised and submissions were made by the applicant in defence, I felt that I should ventilate my views on the issue.

Conclusions under section 5(4)(a)

41. I reach the view that the opponent has failed to show a goodwill or reputation in the words PRO TAN and that this ground of opposition under section 5(4)(a) falls to be dismissed.

Conclusions

42. The opponents has failed on all four of their grounds of opposition and the opposition is dismissed.

Costs

40. The applicant has been successful and is entitled to a contribution towards their costs. **I order that the opponent pay the applicant the sum of £1700-00 as a contribution towards their costs.** This sum is to 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 7th day of August 2003

**S P Rowan
For the Registrar
the Comptroller General**