

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2102840 IN THE NAME OF  
UNIVERSAL PRODUCTS (LYTHAM) MANUFACTURING LIMITED**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NUMBER 46316 IN THE NAME OF  
BIOGLAN LABORATORIES LIMITED**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF application No 2102840 in the name of  
Universal Products (Lytham) Manufacturing Limited**

5

**and**

**IN THE MATTER OF opposition thereto under No 46316  
in the name of Bioglan Laboratories Limited**

10

**Background**

On 15 June 1996, Universal Products (Lytham) Manufacturing Limited, of Fairfield, Bradshaw Lane, Greenhaigh, Kirkham, Preston, Lancashire, R3 3JA, applied to register the trade mark COSMECEUTICAL in Classes 3 and 5 in respect of the following goods:

15

**Class 3**

20

Toiletries and cosmetics; non-medicinal preparations for the hair and for the care and treatment of the skin; non-medicinal preparations for the cleaning, care and grooming of the hair; hair lotions; all included in Class 3

**Class 5**

25

Pharmaceutical preparations and products; medicated cosmetic preparations for the care of the skin and hair; all included in Class 5

On 28 January 1997, Bioglan Laboratories Limited filed notice of opposition to this application. The grounds of opposition are in summary:-

30

1. **Under Section 1 & 3** Because the opponents assert that the term COSMECEUTICAL is a used in the pharmaceutical industry to describe a product that falls somewhere between a cosmetic and a pharmaceutical product. Accordingly the opponents contend that the Mark applied for is a sign which does not satisfy the requirements of Section 1 and 3 of the 1994 Trade Marks Act
2. **Under Section 3(1)(a)&(b)** Because the mark applied for is devoid of any distinctive character as a whole
3. **Under Section 3(1)(c)** Because the mark applied for consists exclusively of signs or indications which may serve in the trade to designate the kind, quality or other characteristics of the goods specified

35

40

45

4. **Under Section 3(1)(d)** Because the mark applied for 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

5

5. **Under Section 3(3)(b)** Because the mark applied for is of such a nature as to deceive the public

6 **Under Section 3(6)** Because the applicant is aware that the name COSMECEUTICAL is in common use in the United Kingdom as a legitimate generic term to describe a product that falls somewhere between a cosmetic and a pharmaceutical product, and accordingly the application was made in bad faith.

10

15

The opponents say that prior to filing the opposition they had drawn the applicant's attention to their objections.

20

The applicants accept that the opponents contacted them but had not provided any evidence to support the allegations made. They deny all the grounds of opposition and ask that the application be allowed to proceed.

Both sides ask for an award of costs in their favour.

25

Both sides filed evidence in these proceedings. The matter came to be heard on 16 July 1999, when the applicants were represented by Ms Denise McFarland of Counsel, instructed by Potts, Kerr & Co, their trade mark attorneys, the opponents were represented by Mr Michael Edenborough of Counsel, instructed by Venner Shipley, their trade mark attorneys.

30

### **Opponents' evidence**

35

This consists of a Statutory Declaration dated 24 July 1997, executed by Terence Ian Sadler, Chairman and Managing Director of Bioglan Laboratories Limited, the opponents in these proceedings. Mr Sadler says that he has been associated with the opponents' company for many years and that the information set out in his Declaration has been obtained from their records and from his own personal knowledge

40

Mr Sadler begins saying that his company is engaged in the research, manufacture and merchandising of pharmaceuticals and have been operating in the industry for over 60 years. He goes on to set out the sequence of events following his company becoming aware of the publication of the application in the Trade Marks Journal. He refers to exhibit TIS1 which consists of a letter dated 2 December 1996 from Venner, Shipley & Co (the opponents' trade mark attorneys) to the applicants, informing them of their clients' objections to the application, and to exhibit TIS2 which consists of the reply sent by Potts, Kerr & Co (the applicants' trade mark attorneys) confirming that in the absence of evidence to support the objections, their clients' intention to proceed with the application.

45

Mr Sadler goes on to give his views on the origins of the mark COSMECEUTICAL which he says is a combination of two meaningful abbreviations; COSME an abbreviation of COSMETIC and CEUTICAL which is meaningful of PHARMACEUTICAL, and saying that the mark as a whole is devoid of any distinctive character for the goods concerned and contrary to Section 3(1)(b) of the Act.

He goes on to say that the mark is contrary to Section 3(1)(c) since it consists exclusively of signs or indications which may serve in the trade to designate the kind, quality and intended purpose of the goods, saying that the combined effect of the two abbreviations describes cosmetic preparations which may have medicinal qualities. Mr Sadler next refers to exhibit TIS3 which he says is a page from the Internet site of the United States Food & Drug Administration Centre for Food Safety and applied Nutrition. The page is headed as a fact sheet dated 3 February 1995 issued by the Office of Cosmetics and refers to COSMECEUTICAL, saying “While the Food, Drug and Cosmetics Act does not recognize the term COSMECEUTICAL,” the cosmetics industry has begun to use the word to refer to cosmetic products that have drug-like benefits.”.

Mr Sadler continues saying that by virtue of the points made in the previous paragraph, the trade mark COSMECEUTICAL would also be contrary to Section 3(1)(d) as a sign or indicator which has become customary in the current language or in the bona fide and established practices of the trade. He refers to exhibit TIS4 which he describes as “copies of brochures showing use of the word COSMECEUTICAL in accordance with established practices of the trade.”. The exhibit consists of printed matter obtained from several different sources, part of which originates from the Internet web sites of companies trading in cosmetic products via the Internet. While some references appear to use the term COSMECEUTICAL as a description, other instances could be taken as trade mark use, for example, the first page of the exhibit contains the statement “So unique and specific are VAXA'S products in their function, we call them “Cosmeceutical!” which could be taken as laying claim to the invention of the term. The pages are, however, undated and relate to use outside of this jurisdiction so cannot be given much, if any weight.

Part of the exhibit relates to an International Industry Conference on COSMECEUTICALS for the cosmetics, pharmaceutical and medical industries held in East Rutherford, New Jersey between 29 - 31 January 1997. This is again after the relevant date and is outside of this jurisdiction so cannot be given much, if any weight. The remainder of the exhibit consists of a report called “The Market for Cosmeceuticals” which is stated to have a publication date of January 1995 and relates to pharmaceuticals and cosmetics, including COSMECEUTICAL. The report pre-dates the date of application although originates in the United States. No circulation details have been provided and it is not certain whether any were distributed in the United Kingdom. Consequently, this part of the exhibit cannot be given much, if any weight.

Mr Sadler next says that from the evidence filed it is clear that the term COSMECEUTICAL is being used on a world-wide basis to describe a particular type of product, saying that the applicants must have been aware of this use prior to filing the application and consequently acted in contravention of Section 3(6). He concludes by requesting that the application be refused to protect the legitimate activities of members of the trade.

### **Applicants' evidence**

5 This consists of a Statutory Declaration dated 22 January 1998, executed by Michael P Peters, Managing Director of Universal Products (Lytham) Manufacturing Limited, a position he has held for 15 years.

10 Mr Peters begins by refuting the opponent's claim that the mark COSMECEUTICAL is devoid of any distinctive character for the goods concerned. He says that the mark is not a combination of two meaningful abbreviations since CEUTICAL is not, as far as he is aware, an abbreviation for PHARMACEUTICAL. In support of this he refers to exhibit MP1 which consists of an extract from Webster's New International Dictionary noting that there is no entry for CEUTICAL, and that PHAR is an accepted abbreviation meaningful of PHARMACEUTICAL.

15 He continues saying that he did not concur with the opponents' submission that COSMECEUTICAL is directly descriptive of cosmetic preparations which may have medicinal qualities, or that use of the term in relation to the goods covered by the application would deceive the public. Mr Peters concludes saying that as far as he is aware, COSMECEUTICAL is not a generic term used by the trade in the United Kingdom to describe the goods covered by the application, or that this is established by exhibit TIS4 to the Declaration filed by Terence Ian Sadler as part of the opponents evidence.

### **Opponents' evidence in reply**

25 This consists of a Statutory Declaration dated 8 April 1998, and executed by Terence Ian Saddler, and is the same person that executed the Declaration dated 24 July 1997 referred to earlier in this decision.

30 He refers to exhibit TIS1 which consists of a copy of an article by Victoria Ward entitled "Cosmeceutical and Neutraceuticals" which Mr Sadler says appeared in the 16 March 1998 edition of The Financial Times, although the exhibit itself is not dated. He says that the article contains many instances of generic use of the term COSMECEUTICAL, some of which he sets out in the Declaration. The article makes reference to COSMECEUTICAL having a "heritage dating back to 1961" although does not mention the term in relation to the United Kingdom, and as an article which clearly dates from well after the relevant date cannot be given much, if any weight.

40 Mr Sadler next refers to exhibit TIS2 which he says are extracts obtained from the DIALOG database. The DIALOG extract includes an International Patent Registration which uses the term COSMECEUTICAL in the abstract and although appearing to cover the United Kingdom it is unclear as to whether it pre-dates the date of application. The remainder of the exhibit refers to two publications, USA TODAY dated 28 February 1989 and The Washington Post dated 12 June 1990. Both make reference to the term COSMECEUTICAL and date from before the relevant date. Although these publications originate from, and refer to use in the United States, Mr Sadler says that he believes that they are distributed in the United Kingdom, but does not give any evidence to confirm that this was the case at the relevant date, or any other information such as circulation figures by which to gauge the impact. Consequently this exhibit can be given little, if any weight.

Mr Sadler next gives his opinion on the origins of the term COSMECEUTICAL, which he says evolved alongside NEURACEUTICAL and DERMACEUTICAL stating that these are also terms which have “generally apprehended significance in the fields of pharmaceuticals, cosmetics and dermatology.”. He goes on to say that the widespread usage of COSMECEUTICAL evidenced in his declarations leads him to the view that the applicants cannot fail to have been aware of the use being made and that the application was filed in bad faith to secure a monopoly and preclude legitimate use by other traders. He concludes by requesting that in the interests of the public, public health and safety, biotechnological research and the pharmaceutical and cosmetics fields the application should be refused.

### **Decision**

I will turn first to consider the objection founded under Section 3(1), which by the construction of that section will encompass and determine the ground under 1(1) the Act. Section 3(1) reads 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,
- © 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), © 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.

Section 1(1) in turn reads:

**1-(1)** In this Act “trade mark” means any sign capable of being represented graphically which is capable of distinguishing the goods or services of one undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.

There is no suggestion that the mark is not represented graphically so the objection relates to the inherent capacity of the mark to distinguish the applicants' goods. The question is whether the term COSMECEUTICAL can perform the function of a trade mark and in this respect have

regard to Canon Kabushiki Kaisha v Metro-Goldwyn -Mayer Inc (1999) FSR 332 in which it was said:

5 “...according to the settled case-law of the court, the essential function of the trade mark is to guarantee the identity of the origin of the marked product to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin. For the trade mark to be able to fulfil its essential role in the system of undistorted competition which the Treaty seeks to establish, it must offer a guarantee that all goods bearing it have originated under the control of a single undertaking which is responsible for their quality.”  
10

I begin by looking at how the law stands. In the British Sugar Plc v James Robertson & Sons Ltd (TREAT) trade mark case, (1996) RPC 9, Mr Justice Jacob said:

15 “...I begin by considering the “not a trade mark” point. Section 1(1) has two parts, *sign*, and *capable of distinguishing*. *Sign* is not an issue: a word is plainly included within the meaning of *sign* as the remainder of Section 1 indicates. But what about *capable of distinguishing*? Does this add any requirement beyond that found in section 3(1)? Section 3(1)(b) bars the registration of a mark which is *devoid of any distinctive character* unless it has *in fact acquired a distinctive character*. I cannot see that the closing words of the first sentence of section 1(1) add anything to this. If a mark on its face is non-distinctive (an ordinary descriptive and laudatory words fall into this class) but is shown to have a distinctive character in fact then it must be *capable of distinguishing*. Under section 10 of the old Act, for a mark to be registerable in Part B, it also had to be *capable of distinguishing*. But the Pickwickian position was that some marks, even though 100% distinctive in fact, were not regarded as *capable of distinguishing* within the meaning of that provision. I do not think the Directive and the 1994 Act takes a more limited meaning over.  
20  
25

30 Thus, *capable of distinguishing* means whether the mark can in fact do the job of distinguishing. So the phrase in Section 1(1) adds nothing to section 3(1) at least in relation to any sign within sections 3(1)(b)-(d). The scheme is that if a man tenders for registration a sign of this sort without any evidence of distinctiveness then he cannot have it registered unless he can prove it has a distinctive character. That is all. There is no pre-set bar saying no matter how well it is proved that a mark has become a trade mark, it cannot be registered. That is not to say that there are some signs which cannot in practice be registered. But the reason is simply that the applicant will be unable to prove the mark has become a trade mark in practice - “Soap” for “Soap” is an example. The bar (no pun intended) will be factual not legal.  
35  
40

The opponents contend that the term COSMECEUTICAL has become customary in the current language or in the bona fide and established practices of the trade in relation to the goods for which registration is sought, and consequently offends against sub-section (d) of Section 3. To establish this objection in inter-parte proceedings requires evidence to substantiate that the term is actually in use. The opponents also say that COSMECEUTICAL is a sign or indication which may serve in the trade to designate the kind, quality or other characteristics of the goods specified, and in conflict with sub-section © of that Section. The wording of sub-section © imposes a less  
45

5 stringent test than under sub-section (d) going to whether the mark is sufficiently descriptive of a characteristic of the goods/services for there to be a reasonable likelihood that it may be used by other traders. This is a question which in this case can be determined by a consideration of the inherent qualities of the mark itself and without recourse to evidence showing that the mark is actually in use.

10 The opponents say that COSMECEUTICAL is an amalgamation of two meaningful elements; COSME being an abbreviation of COSMETIC, and CEUTICAL being meaningful of PHARMACEUTICAL. The applicants in turn deny that these are recognised words or abbreviations, pointing to the fact that the terms do not appear in a dictionary. In The Eastman Photographic Materials Company Ltd's application 15 RPC 476 (the Solio case) Lord Herschel said:

15 “If the word be an “invented” one, I do not think the quantum of invention is at all material. An invented word is allowed to be registered as a trade mark, not as a reward of merit, but because its registration deprives no member of the community of the rights which he possesses to use the existing vocabulary as he pleases.”

20 In the Phillips Electronics NV v Remington Consumer Products Limited trade mark case, (1998) RPC 283, Jacob J stated:

25 ‘Now it is of course the case that a mark (particularly a word mark) may be both distinctive of a particular manufacturer and yet also convey something by way of meaning of the goods....But you can take this argument too far. There are words which are so descriptive that they cannot be trade marks - “soap” for “soap”. The difference is one of degree, but important nonetheless. There are degrees of descriptiveness ranging from skilful but covert allusion to the common word for the goods. On the scale of distinctiveness you come to a point when a word is so descriptive that it is incapable of distinguishing properly, even if it does so partially. If that the position then it is “incapable of distinguishing” within the meaning of Article 2 of the Directive. And likewise the mark is then devoid of distinct character...’

35 Given the nature of the goods for which registration is sought it is not difficult (at least for a person used to considering the construction and derivation of trade marks) to work out that COSMECEUTICAL is an amalgamation of part of the ordinary English words **COSMETIC** and **PHARMACEUTICAL**. However, there is no evidence to show that COSME or CEUTICAL have any meaning independent of this usage, and I come to the conclusion that if there is a valid objection against the capacity of COSMECEUTICAL to function as a trade mark, it can only be because it is a term commonly used in the trade

40 The opponents' evidence includes exhibits showing use of the term COSMECEUTICAL, primarily from the Internet web sites of companies and organisations based in the United States. The exhibits also contain details of a report and conference itinerary relating, inter alia, to COSMECEUTICAL, and the results of a Dialog search and a copy of an article from a publication. Each has its own particular relevance and problems and consequently require separate consideration.

The report bears the title “THE MARKET FOR PHARMACEUTICALS - AN ANALYSIS OF EMERGING WORLD MARKETS”, which is recorded as having been published in January 1996 and to originate from The Leading Edge Group, a company based in New York. Mr Edenborough submitted that the description emerging markets and the inclusion of details for foreign orders indicated that the report would have been available in the United Kingdom. Ms McFarland in turn highlighted the reference in the report to the “European share of the Worldwide market” and to sales of toiletries and cosmetics in “France” and “Germany”, noting and drawing conclusions from the absence of any mention of the United Kingdom. Mr Edenborough made particular reference to a list of companies in the report, stated as having a “potential interest” in the COSMECEUTICAL market drawing to my attention that the list included a number of companies incorporated in, or that have a commercial interest in the United Kingdom and the United States, arguing that this showed that the term COSMECEUTICAL was known in the United Kingdom. Ms McFarland quite rightly drew to my attention that the list was that of companies with a “potential” interest in the COSMECEUTICAL market and it is not certain whether they were in fact ever contacted.

Turning to the conference itinerary which promotes a conference described as “DRUG DISCOVERY APPROACHES FOR COSMECEUTICALS” to be held in New Jersey on 29-31 January 1997. Although dated after the relevant date, Mr Edenborough submitted that the preparations for an international conferences would have been made prior to the actual conference dates, and also referred to the attendance of a lecturer from the United Kingdom which indicated the penetration of the term COSMECEUTICAL into this country. Ms McFarland pointed out that there was no evidence to confirm that the lecturer actually attended the conference.

The article, said to be from an edition of The Financial Times published on 16 March 1998, is headed “PHARMACEUTICALS 5 - COSMECEUTICAL AND NEUTRACEUTICALS” and refers to COSMECEUTICAL as a class of goods that are, in essence, a hybrid of food, cosmetics and medicines. The article appears to relate to the United States market for such goods and although post-dating the application, it makes reference to COSMECEUTICAL as “having a heritage which dates back to 1961 when it was defined by Raymond Reed, founding member of the Society of Cosmetic Chemists.” although it is not clear whether the article is saying that 1961 is the year that Mr Reed coined the term COSMECEUTICAL, or the date that he first conceived the goods now said to be described as COSMECEUTICALS.

The Dialog search for use of the term COSMECEUTICAL came up with three published articles in which the term has been used; an extract from an International Patent Registration, and articles that appeared in USA Today (US) and The Washington Post. While the extract from the Patent Registration's refers to “cosmetic/COSMECEUTICAL composition” as a class of goods, it is uncertain whether the Patent pre-dates the relevant date in these proceedings. The article in USA Today is dated 28 February 1989 and refers to a product called Rogaine saying “this could be the first in a line of COSMECEUTICAL products,”. The Washington Post article is dated 12 June 1990 and is headed “IT'S A CREAM, IT'S A DRUG, IT'S A COSMECEUTICAL” and goes on to use the term COSMECEUTICAL as a description for a class of goods. While both publications originate in the United States, the opponents say that they are available in the United Kingdom and therefore establishes use in this country well before the relevant date although there is no evidence which goes to this point.

This leaves the details obtained from the Internet. With the exception of one page taken from the United States Food and Drug Administration (FDA) web site, these have been obtained from the sites of commercial organisations offering products for sale. The page from the FDA appears to be a fact sheet issued on 3 February 1995, is headed COSMECEUTICALS and goes on to say  
5 “While the Food, Drug and Cosmetic Act does not recognise the term “COSMECEUTICAL”, the cosmetic industry has begun to use this word to refer to cosmetic products that have drug-like effects.” from which it would not be unreasonable to infer that at that date, if the term COSMECEUTICAL was not generic, it was heading in that direction, at least in the United States. Mr Edenborough submitted that pages from the commercial organisations show that these  
10 companies use the term COSMECEUTICAL to describe a class of goods they are offering for sale, although Ms McFarland considered that some of the use shown could arguably be taken as trade mark use. I consider both submissions to have some substance.

The Internet is an ever increasing and important repository of information and is far more responsive to trends and changes than printed matter. Being a “global” system it is not constrained by national boundaries and has streamlined the process by which information becomes available and by which terminology passes into common usage. However, while the Internet can be an invaluable source of up to date information, evidence obtained from this source is subject to the  
15 same scrutiny and criticism as evidence provided from other sources.

In proceedings where information from the Internet is being used to support an allegation that a term may, or has become part of the current language of the trade, it must establish that this is the case in respect of the goods or services for which it is sought to be registered, and that this was the position at the date of application to register the term as a trade mark. In these proceedings  
20 much of the evidence is either undated or post dates the application date and while it contains examples showing the term being used to describe goods covered by the application, some examples could be taken as trade mark use. For example, page 1 of exhibit TIS4 to Mr Sadler’s declaration says - “So unique and specific are VAXA’S products in their function, we call them  
25 “COSMECEUTICAL” which could be taken as saying that COSMECEUTICAL is a name which VAXA alone use, although without further details it cannot be determined whether this is as a badge of origin. It does, however seem to infer that a company involved in the relevant trade in the United States did not consider or was not aware that the term COSMECEUTICAL is used by  
30 others within the industry.

It is well established that the question of whether a mark is capable of distinguishing means capable in the United Kingdom (see Ford-Werkes AG’s application (1955) RPC 10). Accordingly, the evidence should be from United Kingdom Internet web sites. However, evidence obtained from web sites in other English speaking countries can be of use, although will at most indicate that a mark may be generic in the United Kingdom and support an objection under Section 3(1)(c). I do  
35 not consider that it is necessary to show that a non UK site has been accessed from the UK (although this could be persuasive), but the use shown in the evidence will need to be sufficiently widespread to indicate that there is a reasonable likelihood that the term may have transferred and would be recognised in the United Kingdom.  
40

The nature of the relevant goods or services and services may be a factor to be taken into account. For example, the airline industry is global with companies often providing the same products and services under the same trade mark in many different countries, and consequently, it is more likely  
45

that a term will transfer from one market to another than in an industry such as rail transportation services which tend to be provided within regional or national boundaries.

5 Mr Edenborough referred to the Jeryl Lynn trade mark case (1999) FSR 7 in which the registered trade mark was found to be generic and declared invalid. In that case there was a considerable amount of convincing evidence from United Kingdom sources. In these proceedings there is only one piece of evidence which originates in the United Kingdom, and that relates to the market in the United States.

10 Given the size of the cosmetics/pharmaceutical industry in the United States, the number of instances of descriptive use shown in the evidence is very limited, and while it indicates that the term COSMECEUTICAL is being used to describe goods that are a cross between a cosmetic and a pharmaceutical, in my view falls short of establishing that the term is generic in that country, let alone that it may be in the United Kingdom. Mr Edenborough's submission that the company names listed in the report and the attendance of an academic at a conference supported an assertion that the term would be known in this country would have been more effectively made had evidence been obtained from these parties, and without such evidence I am being asked to infer too much. The evidence filed by the applicants is not of much help, essentially denying that the term is generic but giving very little beyond this in their defence. Had the opponents shown more widespread use of the term in the United States dating from before the date of application, I would have been hard pressed to find in the applicants favour.

25 Taking the best view that I can, I find that the evidence is not sufficient to establish that, at the date of application, the term COSMECEUTICAL was a sign or indication which served in the trade to designate a characteristic of the goods, or that it is or was a generic description in the United Kingdom. In the absence of such evidence, I conclude that the mark is capable of distinguishing the applicants' goods and that the opposition under Section 1(1) and Section 3(1)(a)(b)(c) and (d) fails.

30 Turning to the remaining objections under Section 3(3)(b) and Section 3(6) of the Act. In my view, the ground under Section 3(3)(b) stands or falls on the opponents establishing that the term COSMECEUTICAL is a description for a particular type of goods, for if it is not then it seems to me that the mark will not give rise to any expectations and will not deceive the public. As I have already found that the opponents have not established that the term COSMECEUTICAL is a description of a class of goods, the objection under Section 3(3)(b) fails accordingly.

40 This leaves the matter of the objection under Section 3(6). The opponents say that the applicants were aware that the term COSMECEUTICAL is in common use in the United Kingdom to describe a particular class of product, and that they have nonetheless tried to appropriate it for themselves. In support of this they point to the use of COSMECEUTICAL in the publications USA Today and The Washington Post saying that they were available in the United Kingdom, and consequently the applicants would have been aware of the relevance of the term. Overseas newspapers are commonly available in this country and while it is possible that these two publications were on sale there is no evidence to substantiate this. Setting aside the question of whether the publications were actually available, I have considerable difficulty in the opponent's argument that if they were this proves that the applicants were aware of the descriptive use of COSMECEUTICAL in them. Such an argument requires an assumption that the applicants were

readers of the publications in the first place, and that they actually read the two editions in which the articles relating to COSMECEUTICAL appeared.

5 An objection that an application was made in bad faith implies some deliberate action by the applicants which they know to be wrong. It is a serious objection which places a heavy burden of proof upon the party making the allegation. I find the evidence, such as it is, goes nowhere near to establishing a case of bad faith and the objection under Section 3(6) fails also.

10 The opposition having failed on all grounds I order the opponents to pay the applicants the sum of £635 as a contribution towards their costs.

**Dated this 8 day of October 1999**

15

20

**Mike Foley  
for the Registrar  
The Comptroller General**