

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION Nos 2170633 & 2170636 BY  
RECKITT & COLMAN PRODUCTS LIMITED & RECKITT & COLMAN  
(OVERSEAS) LIMITED TO REGISTER MARKS  
IN CLASSES 3 & 5**

**AND**

**IN THE MATTER OF OPPOSITIONS THERETO UNDER Nos 49542 & 49535  
BY RE. LE. VI. S.P.A.**

## TRADE MARKS ACT 1994

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& 2170636 by Reckitt & Colman Products Limited  
& Reckitt & Colman (Overseas) Limited to register  
marks in Classes 3 & 5**

**and**

**IN THE MATTER OF Oppositions thereto under  
Nos 49542 & 49535 by RE. LE. VI. S.P.A.**

### **BACKGROUND**

1. On 26 June 1998 Reckitt & Colman Products Limited and Reckitt & Colman (Overseas) Limited applied to register the mark **DETTOX FRESH LINEN** in Classes 3 and 5. I note that the applications now stand in the name of Reckitt Benckiser (UK) Limited although nothing turns on this point.

2. The applications were accepted and published for the following specifications of goods:

#### **2170633**

##### **Class 3:**

“Cleaning and polishing preparations; soaps, detergents, none being for export except to the Republic of Ireland”

##### **Class 5:**

“Pharmaceutical and sanitary preparations; deodorants (not for personal use); air freshening preparations, air purifying preparations; disinfectants, germicides; preparations for killing weeds and vermin; antiseptic preparations, anti-bacterial preparations; none being for export except to the Republic of Ireland”

#### **2170636**

##### **Class 3:**

“Cleaning and polishing preparations; soaps, detergents, all being for export except to the Republic of Ireland”

## **Class 5:**

“Pharmaceutical and sanitary preparations; deodorants (not for personal use); air freshening preparations, air purifying preparations; disinfectants, germicides; preparations for killing weeds and vermin; antiseptic preparations, anti-bacterial preparations; all being for export except to the Republic of Ireland”

3. On 2 March 1999 RE. LE. VI. S.P.A of 46040 Rodigo (MN), Italy, filed notices of opposition. The grounds of opposition were extensive but at the Hearing were reduced to:

- (a) under section 3(1) of the Act, because the trade mark applied for is devoid of any distinctive character and/or consists exclusively of signs or indications which may serve in the trade to designate the kind, quality or other characteristics of the goods and/or that it 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
- (b) under section 3(6) of the Act as the mark for which registration is sought was made in bad faith given the opponents’ use of and reputation in the trade mark shown in Annex A to this decision
- (c) under section 5(2) of the Act in that the mark for which registration is sought is similar to the earlier trade mark mentioned above and is to be registered for goods identical or similar to the goods for which the earlier trade mark is protected.

4. The applicants filed counterstatements in which the grounds of opposition are denied.

5. Only the opponents filed evidence in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 6 April 2001. The applicants were represented by Mr Hugo Cuddigan of Counsel instructed by Alexander Ramage Associates, the opponents were represented by Mr Robert Onslow of Counsel instructed by Potts Kerr & Co.

6. Although these two oppositions were not formally consolidated, as the trade marks are identical and the basis of the oppositions, the evidence filed and Counsel’s submissions were similar in both, it is convenient to issue a joint decision.

### **OPPONENTS’ EVIDENCE**

7. I need not summarise this because it has no part to play in my consideration of the issues here or in the decision itself.

### **DECISION**

8. The submissions in relation to these two oppositions were heard at the same time as two other oppositions involving the same parties. My decision in respect of those oppositions, Nos 49541 and 49534 against the mark FRESH LINEN (solus) in Class 5 are attached as

Annex B to this decision. During the course of the composite submissions, Mr Onslow quite properly conceded that the word DETTOX was a distinctive element in this trade mark. Though I have held in the other oppositions that the term FRESH LINEN does lack distinctive character for the bulk of the goods covered by the specifications of those applications for registration, I consider that the addition of the word DETTOX, which as far as I am aware has no meaning (certainly no evidence was adduced to that end), makes the trade marks as wholes acceptable for registration; the first (and distinctive) element sufficiently dominates the non-distinctive nature of the FRESH LINEN elements to give the trade marks more than sufficient distinctive character to enable them to be accepted for registration, prima facie, for all of the goods of the specifications. Consequently the opposition based on Section 3(1) of the Act is dismissed.

9. In so far as the objection under section 5(2)(b) of the Act is concerned, I have already found in the attached decision that the parties respective marks are not confusingly similar. The opponents are in no better position in these proceedings given that both trade marks in suit also include an additional and distinctive element, namely the word DETTOX. Consequently the oppositions based on section 5(2)(b) of the Act are also dismissed.

10. This leaves the objection under section 3(6) of the Act. In their notice of opposition the opponents pleaded this objection in the following terms:

“Registration or use of the trade mark applied for would be contrary to the provisions of Section 3(6) of the Act in that the application is made in bad faith in view of the Opponents’ use of and reputation in the trade mark”.

11. At the Hearing Mr Onslow sought to modify the basis of this objection. This was foreshadowed in his skeleton argument in the following terms:

“It is accepted that DETTOX is distinctive of the applicant. If FRESH LINEN is held to be descriptive, these words should by rights be disclaimed. Therefore, if the applicant makes a conditional offer to disclaim FRESH LINEN should the Hearing Officer hold in the judgement that FRESH LINEN is descriptive, then the registration can go ahead on that basis. By the same token, if the Hearing Officer holds that the words FRESH LINEN are distinctive, the opponent accepts DETTOX FRESH LINEN is also registrable. But if FRESH LINEN is descriptive, and no offer of disclaimer has been made, the mark should be refused. Otherwise the registration could be deployed against a person using FRESH LINEN simpliciter under s10(2), notwithstanding the fact that the Registrar has held that those words to have been descriptive. The opponent invites the Hearing Officer to reject the advice to examiners in the Work Manual Chapter 6 Section 14.1 principle (i), and to indicate to the applicant that the mark will be refused unless the disclaimer is volunteered (see Kerlys Law of Trade Marks 13<sup>th</sup> ed. Para 7-15). S13 of the 1994 Act operates to ensure that a disclaimer is effective to restrict the rights conferred by the resulting registration ie. the Act expressly contemplates that a registration without disclaimer might confer rights which are too wide. The arbiter of whether the rights conferred would be too wide is the Registry. It is well established that if the specification of goods is too wide, the

application will be rejected under s3(6) as being not made in good faith (see Roadrunner [1996] FSR 805). The same provision can and should be used to reject an application which contains descriptive subject matter which the applicant refuses to disclaim”.

12. Not surprisingly in my view Mr Cuddigan resisted this modification to the grounds of opposition. It was not mentioned (even obliquely) in the ground originally pleaded and was not a ground he had been required to meet. I indicated to both Counsel that I would be prepared to allow them to address me on this point, although I made it quite clear that I was not inclined to deal with it in the context of a valid objection to these applications for registration. Alternatively I gave both parties an opportunity to provide written submissions. In the event nothing has been received.

13. As originally pleaded the ground of opposition under section 3(6) of the Act does not even begin to get off the ground and as such is easily dismissed. In so far as the modified objection is concerned strictly speaking I need not consider it. However it is in my view a short point and for the sake of completeness I will do so.

14. Section 13 of the Act reads as follows:

“13.- (1) An applicant for registration of a trade mark, or the proprietor of a registered trade mark, may-

- (a) disclaim any right to the exclusive use of any specified element of the trade mark, or
- (b) agree that the rights conferred by the registration shall be subject to a specified territorial or other limitation;

and where the registration of a trade mark is subject to a disclaimer or limitation, the rights conferred by Section 9 (rights conferred by registered trade mark) are restricted accordingly.

(2) Provision shall be made by rules as to the publication and entry in the register of a disclaimer or limitation.”

15. Mr Cuddigan commented that in his view the registrar has no power to order the disclaimer envisaged by the opponents (and made it clear that the applicants had no intention of offering one). Simply put I agree. The wording of Section 13 makes it quite clear that a disclaimer can only be entered on the register at the request of the applicant for registration of a trade mark or the proprietor of a registered trade mark. Under the 1994 Trade Marks Act the registrar has (unlike under section 14 of the 1938 Trade Marks Act) no power to request that an element or elements of an otherwise acceptable mark be disclaimed. Indeed any request by the Trade Marks Registry to that effect (or any offer of a disclaimer by an applicant) can have no effect on the acceptability or otherwise of an application for registration. Grounds for refusal on absolute grounds are entirely contained within Section 3 of the Act and a disclaimer of any specified element in a trade mark can not make an otherwise unacceptable trade mark acceptable for registration.

16. As the oppositions to the applications have failed the applicants are entitled to a contribution towards their costs. I have already commented on the manner in which the evidence was served and the cases pleaded in the attached decision and do not need to repeat those comments again here. I order the opponents to pay to the applicants the sum of £1,000 in respect of these cases. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of these cases if any appeal against this decision is unsuccessful.

**Dated this 03 day of August 2001**

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

Annex A: Order a copy

Annex B: Decision 0/334/01

