

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2202863
BY COLGATE-PALMOLIVE COMPANY TO REGISTER THE MARK
FRESH ENERGY IN CLASS 3**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No 50494
BY BEECHAM GROUP PLC**

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by Colgate-Palmolive Company to register the mark
FRESH ENERGY in Class 3**

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**IN THE MATTER OF Opposition thereto under No 50494
by Beecham Group PLC**

DECISION

1. On 13 July 1999 Colgate-Palmolive Company applied to register the mark FRESH ENERGY in Class 3 for "toothpaste, mouthwash". The application is numbered 2202863.
2. On 8 December 1999 Beecham Group Plc filed notice of opposition to this application. Their original grounds were subsequently amended and certain grounds struck out. The grounds that remain are under Section 3(1)(a), (b),(c) and (d) together with Section 5(2)(b). In relation to the latter the opponents rely on some 38 earlier trade marks, 30 of which are UK registrations and the balance Community Trade Mark applications or registrations. For reasons which I will explain below I do not need to record full details of these registrations/applications but for the record list their numbers in the Annex to this decision. For reasons which escape me the list of marks included in the original statement of grounds appears to have been expanded by the inclusion of the CTMs. I assume (but cannot say with any certainty) that this was not objected to by the applicants. In the circumstances of this case the expansion of the listing of earlier trade marks does not have a material affect on the outcome. I, therefore, need say no more on the point. Finally there is an objection under Section 5(4)(a) that use of the applied for mark is liable to be prevented by the law of passing off.
3. The applicants filed a counterstatement denying the above grounds.
4. Both sides ask for an award of costs in their favour.
5. Both sides filed evidence. In the case of the opponents this consists of a statutory declaration by Georgina Evans, Trade Marks Director and Counsel of SmithKline Beecham Plc. For the applicants I have a statutory declaration by Ann Alexandra Harper, the Company Secretary and a Director of Colgate-Palmolive (UK) Ltd and a witness statement by Caroline Teresa Bonella, the applicants' professional trade mark representative in this matter.
6. Neither side has asked for a hearing. The applicants elected to file written submissions under cover of a letter from Kilburn & Strode, their Trade Mark Attorneys, dated 6 August 2001. Acting on behalf of the Registrar and with all the above material in mind I give this decision.

7. In relation to the objections based on absolute grounds the relevant statutory provisions are:

"1.-(1) In this Act a "trade mark" means any sign capable of being represented graphically which is capable of distinguishing 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."

and

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

- (a) signs which do not satisfy the requirements of section 1(1),
- (b) trade marks which are devoid of any distinctive character,
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it."

8. In AD 2000 Trade Mark [1997] RPC 168 Geoffrey Hobbs QC sitting as the Appointed Person said in relation to Section 1(1) and 3(1)(a)

"..... the requirements of Section 1(1) are satisfied even in cases where a sign represented graphically is only "capable" to the limited extent of being "not incapable" of distinguishing goods or services of one undertaking from those of other undertakings. Such signs are not excluded from registration by Section 3(1)(a)."

9. The opponents put their objection on the following basis in their amended statement of grounds

"In particular the mark FRESH ENERGY is no more than the combination of two words each of which is inherently non-distinctive within the field of oral healthcare. Both words should be available for use as descriptors by other oral healthcare manufacturers particularly in relation to advertising and promotion. The plain text representation of the combination of these two words does not provide a sufficient

degree of distinctiveness and hence the mere combination of these two words would not be seen as having trade mark significance by consumers. The mark as filed cannot therefore be capable of distinguishing as required by Section 1(1) of the Act and should not be allowed to progress to registration."

10. I will come on in what follows to the opponents' evidence and views as to the descriptive character of the mark at issue both in terms of its component elements and the totality. However, I do not find anything in that evidence that comes near to persuading me that the mark is incapable of distinguishing the goods of one undertaking from those of other undertakings for the purposes of Section 1(1) and 3(1)(a).

11. The opponents have not indicated which parts of their evidence are directed towards particular grounds of opposition within Section 3(1). In their statement of grounds they say in relation to Section 3(1)(b) (c) and (d) that "the reasons are the same as those set out in paragraph 4 above" (the latter being the paragraph from which I have quoted dealing with Sections 1(1) and 3(1)(a)).

12. I will approach the grounds from the point of view of the evidence filed by Ms Evans. The first part of her declaration (paragraphs 3 to 7 and Exhibits GE1 to GE11) is in support of the proposition that the word "fresh" is widely used in relation to oralcare products (toothpaste and mouthwashes etc.) not least because it is part of the purpose of such products to eliminate bad breath. I do not propose to record or analyse this evidence which largely confirms the view that I would in any case have held as a result of normal consumer contact with such goods. Suffice to say that the exhibits contain products from a number of different trade sources which bear ample testimony to the fact that the breath freshening characteristics of the goods are widely promoted.

13. The applicants were initially circumspect about conceding the descriptive characteristics of the word 'fresh'. In their counterstatement they say "the only common elements [in comparison with the opponents' marks] is the word FRESH which in the context of products for the oral care market is not highly distinctive". That is in my view an understatement. The opponents' view is to be preferred. In fairness to the applicants Ms Bonella's witness statement and their written submissions later acknowledge that FRESH is common to the trade.

14. Ms Evans goes on to comment on the word ENERGY and the combination FRESH ENERGY. She says that the word ENERGY is not sufficiently distinctive to make the otherwise descriptive word FRESH distinctive. In support of this she exhibits

GE12 - an extract from the website of an Indian on-line business paper which states that the company's [Colgate-Palmolive (India)] strategy is to get more focussed on the two main product attributes "Freshness" and "Energy"

GE13 - a sample of COLGATE TOTAL FRESH STRIPE the qualities of which are said to be "..... longer lasting protection and fresh breath between brushings"

- GE14 - a page from the applicants' website advertising COLGATE TOTAL® FRESH STRIPE™ from which I am invited to infer that in the US the applicants have been unable to get protection for the second element. It is suggested that by analogy FRESH ENERGY would not serve as a badge of origin either
- GE15 - extracts from five websites that are said to show the word ENERGY applied to oral care products as follows
- www.justneatstuff.com: Q-DENT toothpaste
 - www.oralsprayswork.com: ENERGY-NOW spray with ginseng
 - www.sprayvitas.com: VITAMIST REVITALIZER spray (in which the first two 'keywords' associated with the product are 'fresh breath' and 'energy')
 - www.ibeaauty.com: LIDDELL travel energy, age-defying energy, brain energy, diet energy, female energy and male energy oral sprays
 - www.karemor.com: a fact sheet setting out that oral absorption of vitamins may be more effective than pills. Under the 'Advantages' heading, it states that 'Convenience created through oral sprays increases the level of your health and energy.'
- GE16 - examples of websites intended to illustrate that FRESH and ENERGY are words that are naturally associated with health and well being in general
- GE17 - examples of websites showing that the phrase FRESH ENERGY is customary in the current language.

15. I do not propose to summarise the applicants' response to this evidence. Ms Harper's declaration is in large measure a commentary on the opponents' evidence and claims. I have also borne in mind the written submissions from Kilburn & Strode.

16. The opponents rely heavily on website material. Most if not all of this evidence appears to relate to searches conducted some time after the relevant date in these proceedings (13 July 1999). Much of it is also derived from websites which are directed at customers and markets outside the UK - see for instance, exhibits GE12, GE14 (probably), GE15 and GE17. There are inevitable problems in trying to draw meaningful conclusions as to the position in this country in July 1999. The opponents have recognised the difficulty. Ms Evans says

- "14. While the majority of the sites annexed as GE17 are US oriented and based, I believe that is the result of the US-lead and dominated nature of the Internet rather than indicating that 'fresh energy' is understood as a common phrase only in the US."

17. I will comment below on the content of what I regard as the key exhibits but I do not think Ms Evans' statement is sufficient to deal with consumer understanding/expectation in relation to the words FRESH ENERGY when proposed for use in relation to specific goods as opposed to the meaning of the words as a general expression.

18. The specific exhibit which is the subject of Ms Evans' statement is intended to show that the phrase 'fresh energy' is customary in the current language. Examples are "Fresh energy and artistic direction came to Utah opera" and, from a music website, "Hip-hop needs fresh energy if it's to survive". The other examples are in the same vein. I find this material to be of little, if any, assistance. It does no more than establish what I accept is likely to be the case that the words "fresh energy" may find a ready usage as an everyday expression. It tells me nothing about the significance of the words in relation to the goods. The opponents have not, therefore, shown that the words FRESH ENERGY have become customary in the current language of the trade. Accordingly the objection under Section 3(1)(d) must fail.

19. There has been recent guidance from the European Court of Justice in relation to Article 7(1)(c) of Council Regulation 40/94 on the Community Trade Mark in BABY-DRY Case C-383/99P. Article 7(1)(c) is equivalent to Section 3(1)(c) of the Trade Marks Act 1994. The findings of the Court are set out in paragraph 35 et seq of the judgment. Paragraphs 39 and 40 serve to illustrate the approach adopted by the Court

"39. The signs and indications referred to in Article 7(1)(c) of Regulation No 40/94 are thus only those which may serve in normal usage from a consumer's point of view to designate, either directly or by reference to one of their essential characteristics, goods or services such as those in respect of which registration is sought. Furthermore, a mark composed of signs or indications satisfying that definition should not be refused registration unless it comprises no other signs or indications and, in addition, the purely descriptive signs or indications of which it is composed are not presented or configured in a manner that distinguishes the resultant whole from the usual way of designating the goods or services concerned or their essential characteristics.

40. As regards trade marks composed of words, such as the mark at issue here, descriptiveness must be determined not only in relation to each word taken separately but also in relation to the whole which they form. Any perceptible difference between the combination of words submitted for registration and the terms used in the common parlance of the relevant class of consumers to designate the goods or services or their essential characteristics is apt to confer distinctive character on the word combination enabling it to be registered as a trade mark."

20. The question I have to ask myself is whether the words FRESH ENERGY used in relation to toothpaste and mouthwash may serve in normal usage to designate an essential characteristic of the goods. In answering that question I must approach the matter from the consumers' standpoint. I take consumers in the context of these goods to include the public at large.

21. I have already indicated that I accept the opponents' contention that FRESH is commonly used in the trade to designate a characteristic of the goods. That is to say it may indicate a fresh taste and/or fresh breath. In the final analysis I must have regard to the mark as a whole and not just its component elements. But I must first return to that part of the opponents' evidence bearing on the element ENERGY. Three exhibits in particular are of potential relevance. The first is GE12. It suffers from the deficiencies identified earlier being directed it would seem at the Indian market and being after the relevant date. Even setting aside those difficulties the message of freshness and energy contained in the website promotional article reflects, rather as the applicants suggest, a certain amount of advertising launch hyperbole and not any directly meaningful reference to the characteristics of the goods.

22. Next is Exhibit GE16 which is intended to show that the words FRESH and ENERGY are naturally associated with health and well being in general. The first of the four website examples given is an advertisement for Energy Drinks and contains a reference to 'fresh juices'. It is not surprising that the words are used in relation to such goods though I note that they are not used together. The other three examples are or may be drawn from US websites. One relates to Feng Shui questions (the reply to one of the questions uses the words fresh energy), one to Reiki healing and the final one to a nutrition advisory programme. None of these examples is of assistance in shedding light on how the words in combination can be said to designate a characteristic of the goods at issue.

23. Exhibit GE15 is intended to demonstrate that ENERGY is used in relation to oral care products. It is in my view potentially the most relevant of the opponents' exhibits. The website extracts start with the disadvantage that they are from US sites and were collected after the relevant date. That might not be a fatal disadvantage if there were other material to confirm that US usage was commonly understood in this country. But there is not.

24. In other respects too the evidence is not persuasive. Four of the five references appear to relate to oral sprays containing plant herbs, essential vitamins or other nutritional supplements the primary purpose of which is to give an energy boost. The other website is of more direct interest. It features a toothpaste containing coenzyme Q10. It is said that Q10 "appears to provide the heart with more energy" and "that boost of energy may also help in your mouth. Clinical trials with small numbers of patients have shown that Q10 treatments improved the health of gums. The results, which should be seen as preliminary, are nonetheless very consistent and impressive." Whether or not Q10 toothpaste also performs a breath freshening function is not clear but it is, I think, the high point of the opponents' case that it associates energy giving qualities with a toothpaste. It would seem that the concept is relatively new, may or may not have been in existence in July 1999 and is in the early stages of clinical trials in the US. It does not demonstrate the combination FRESH ENERGY may serve to designate a characteristic of the product in this country.

25. It was said of the mark BABY-DRY

"..... whilst it does unquestionably allude to the function which the goods are supposed to fulfil, [it] still does not satisfy the disqualifying criteria set forth in paragraphs 39 to 42 of this judgment. Whilst each of the two words in the combination may form part of expressions used in everyday speech to designate the function of babies' nappies,

their syntactically unusual juxtaposition is not a familiar expression in the English language, either for designating babies' nappies or for describing their essential characteristics."

26. Even if, contrary to what I consider the evidence establishes, I were to accept that the goods at issue had an energy giving or enhancing capability along with a fresh taste or breath freshening quality it does not follow that FRESH ENERGY is a natural way of capturing those characteristics. It would most likely be seen as a syncopated combination which alluded to separate characteristics of the goods in an unexpected way. I conclude that the mark applied for does not fall foul of Section 3(1)(c).

27. There remains the objection under Section 3(1)(b)

In British Sugar Plc James Robertson and Sons Ltd case (the "TREAT" case) (1996) RPC 281, Mr Justice Jacob said

"Next, is "Treat" within Section 3(1)(b)? What does devoid of any distinctive character mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark? A meaningless word or a word inappropriate for the goods concerned ("North Pole" for bananas) can clearly do. But a common laudatory word such as "Treat" is, absent use and recognition as a trade mark, in itself (I hesitate to borrow the word "inherently" from the old Act but the idea is much the same) devoid of distinctive character."

28. In Barter International Group Ltd's opposition to Boxer Holdings Inc's application (for a smiley face device), Geoffrey Hobbs QC on appeal (reference 0-313-01) considered that absent use, the mark at issue was "meaningful (as an origin neutral expression of amiability) to a degree which makes it unacceptable for registration under Section 3(1)(b)." Although those remarks were made in the context of a device mark there may also be words or word combinations which will be devoid of distinctive character (notwithstanding that they might not be objectionable under Section 3(1)(c)) because, absent use, they lack the capacity to perform the essential function of a trade mark that is to act as a guarantee of trade origin. However, in the circumstances of this case I am satisfied that no different or separate objection arises against the mark FRESH ENERGY which would lead me to reject it under Section 3(1)(b).

29. The opponents have also raised two objections based upon relative grounds. The first is under Section 5(2)(b) which reads

"(2) A trade mark shall not be registered if because-

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

- (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

30. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

31. I also bear in mind but do not propose to record the contents of Ms Bonella's witness statement dealing with the objection under Section 5(2)(b).

32. The basis for the opponents' objection is a large number of UK and CTM registrations. All consist of or contain the word AQUAFRESH. Most have that word in combination with other descriptive or non-distinctive matter. Typically they are registered for or have specifications covering dentifrices and mouthwashes. Some cover broader categories of goods such as non-medicated toilet preparations in Class 3. The applicants' goods are without doubt either identical and/or closely similar to the goods of the opponents' AQUAFRESH registrations.

33. In relation to the Section 3 grounds the opponents have contended and I have accepted that FRESH is a word in common usage in relation to oral care products. The applicants' written submissions also concede as much. Where an element within a mark is descriptive /non-distinctive and will be recognised by customers as indicating a characteristic of the goods it is likely to have a limited (if any) capacity to act as a feature on which customers place reliance for the purposes of distinguishing between the marks of rival traders. In this case the word FRESH is an extremely weak element. Attention is therefore likely to be focussed on other elements and/or the totalities of the marks concerned. At its simplest that comparison is between AQUAFRESH and FRESH ENERGY. On any reasonable basis of comparison and having regard to their visual, aural and conceptual characteristics those marks are quite different. I regard further detailed analysis to be unnecessary. Even allowing for the fact that identical and/or closely similar goods are involved there is no likelihood of confusion. The Section 5(2)(b) objection fails.

34. The opponents' case under Section 5(4)(a) is based on the claim that they have been using the mark AQUAFRESH in the UK since the 1970s in respect of toothpaste and later, other oralcare products. This use is said to have been supported by extensive advertising and promotion and to have generated considerable goodwill. The claims have not been substantiated in evidence and do not in any case appear to place the opponents in a materially different or better position than the ground based on Section 5(2)(b). This ground also fails.

35. The opposition as a whole has failed. The applicants are entitled to a contribution towards their costs. I order the opponents to pay them the sum of £600. 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 09 day of November 2001

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

Earlier trade marks relied on by the opponents

UK

Mark	Mark	Mark	Mark	Mark
989818	1458766	2020792	2113989	2130310
1056082	1487128	2023806	2113992	2132415
1077833	2019772	2023812	2113995	
1258698	2019775	2023825	2130298	
1266245	2019776	2057036	2130302	
1332627	2019779	2100617	2130304	
1458764	2019780	2100621	2130308	

CTM

Mark	Mark
654574	654772
654608	654798
654640	654749
654673	1144757

Full details of all the above are attached to the opponents' statement of grounds.