

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2259535
BY NEW HORIZONS INC. LTD TO REGISTER A TRADE MARK IN CLASS 21**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No 52392
BY SMITHKLINE BEECHAM PLC**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2259535
by New Horizons Inc. Ltd to register a trade mark in Class 21**

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**IN THE MATTER OF Opposition thereto under No 52392
by SmithKline Beecham Plc**

DECISION

1. On 26 January 2001 New Horizons Inc. Ltd applied to register the mark **2thbrush** for a specification of goods in Class 21 which reads:

"Household or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); brush-making materials, articles for cleaning purposes; toothbrushes; parts and fittings for all aforementioned goods."

2. The application is numbered 2259535.

3. On 20 April 2001 SmithKline Beecham Plc filed notice of opposition to this application. The opponents are manufacturers and merchants of oral healthcare products (including toothbrushes) both in the United Kingdom and worldwide. Opposition is raised against the following part of the applicants' specification:

"brushes, brush-making materials, articles for cleaning purposes and toothbrushes; parts and fittings for the aforementioned goods."

4. The opponents express their objection in the following terms "The Opponent requests that the Application be refused on absolute grounds under Section 3(1)(a), (b), (c) and (d) of the Trade Marks Act 1994 ("the Act") because it is the phonetic equivalent of the word 'toothbrush' which is wholly descriptive and a term that should be free for any trader to use in the course of trade."

5. The applicants filed a counterstatement denying the above grounds and offering a number of observations on their mark.

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

7. Both sides filed evidence. In line with current Registry practice a Hearing Officer wrote to the parties at the conclusion of the evidence rounds having reviewed the papers filed. His view was that there was sufficient information available to enable a decision to be reached without recourse to a hearing. The parties were nevertheless reminded of their right to be

heard or to make written submissions in lieu thereof. In the event neither side requested a hearing or filed written submissions. Acting on behalf of the Registrar and after a careful study of the papers I give this decision.

8. The opposition is brought under Section 3(1) of the Act. This reads

"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."

As the applicants have filed no evidence of use of their mark the proviso to Section 3(1) is included only for the sake of completeness. I have only the prima facie case to consider.

9. The opponents filed a statutory declaration by Georgina Evans containing the following submissions in relation to the objections under Section 3(1)(a) and (b)

- "2. The Opponent requests that the application be denied because it does not satisfy the requirements of Section 3(1)(a) as the mark is phonetically identical to the ordinary dictionary word 'toothbrush'. The letters 'th' is a broadly used and accepted English suffix, used to form ordinal numbers (reference: The New Collins Concise English Dictionary) thereby rendering the numeral 2 and the addition of the suffix 'th' to be read and pronounced as 'two-th'. The phonetically identical word 2thbrush/toothbrush is not capable of distinguishing the opposed goods of the Applicant from those of other undertakings.
- 3. The mark is devoid of any distinctive character under Section 3(1)(b) because it is an identical phonetic equivalent of an ordinary dictionary word. The substitution of the numeral '2' at the beginning of the mark does not indicate, as claimed by the Applicant, 'originality and innovation'. The numeral 2 in this format, or spelt as 'two' or 'too' all represent the same identical phonetic sound, and thus does not add any distinctive character to the mark. The

numeral '2' when combined with the other letters of the mark fails to add any distinctiveness to the mark whatsoever. The combination of the numeral and letters does not suggest any more distinctiveness. However when the mark is considered on its own without any use it simply represents the word 'toothbrush' and would not be considered a trade mark by the public."

10. Section 3(1)(a), which provides the opponents' first ground of objection, refers in turn to Section 1(1) of the Act which reads

"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."

11. I believe that the test under this sub-section establishes a low threshold. In the case of AD 2000 trade mark [1997] RPC 168, the Appointed Person, Geoffrey Hobbs QC stated that:

"... 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). Section 3(1)(a) has the more limited effect envisaged by article 3(1)(a) of the Directive of preventing the registration of "signs which cannot constitute a trade mark" at the time when they are put forward for registration."

12. Furthermore, according to the Opinion of Advocate General Ruiz-Jarabo Colomer in the Court of Justice of the European Community in Case C-299/99 Philips Electronics NV v Remington Consumer Products Ltd [2001] RPC 38 page 754 paragraph 43 and 44, there is not a category of marks which are *incapable* of acquiring a distinctive character, that would not otherwise be excluded by Section 3(1)(b) and (c) of the Act. In my view, the basis for the Section 3(1)(a) objection in respect of the trade mark at issue here is not made out. Having regard to the authorities, I do not believe that it is so hopeless that it fails under Section 3(1)(a) of the Act and I dismiss this ground accordingly.

13. I note from Ms Evans' submissions that no mention is made of the objections under paragraphs (c) or (d) of Section 3(1). Both are concerned with marks which consist exclusively of signs or indications that may serve in trade to designate a characteristic of the goods or have become customary in the language of the trade. I do not consider that the mark presented here for registration can be said to consist exclusively of such matter. Success under paragraph (d) would be likely to require evidence directed towards the position in trade. No such material is before me. The wording of paragraph (c) may be thought to imply an element of futurity to the extent that it implies some assessment of the extent to which signs or indications are likely to be so required even if they do not already fulfil that function. I cannot see any rational basis for reaching the view that this is the case here. In the BABY-DRY Case, C-383/99 P the European Court of Justice dealt with the scope and purpose of

Article 7(1)(c) of the Community Trade Mark Regulation (equivalent to Section 3(1)(c) of our Act) and stated

"39. The signs and indications referred to in Article 7(1)(c) of Regulation 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."

14. Consistent with that guidance I consider that the mark applied for is presented in a way that distinguishes it from the usual way of designating the goods concerned.

15. It is nevertheless Ms Evans' position that the mark at issue is devoid of distinctive character for the reasons given in the passage from her declaration quoted above. In "Cycling IS...." Trade Mark dated 28 November 2001 Geoffrey Hobbs QC, sitting as the Appointed Person noted that the BABY-DRY decision dealt specifically with Article 7(1)(c) (Section 3(1)(c)) and confirmed that in his view that decision should not be taken as denying the independent operation of Section 3(1)(b) (his reasoning is set out in paragraphs 43 and 44). He went on to consider how distinctiveness should be assessed (paragraphs 54 to 61). In particular he concluded (by reference to the authorities referred to in these paragraphs) that the question whether a particular sign possesses a distinctive character cannot be considered in the abstract; it must be considered in relation to the goods or services requested; a mark must possess enough of a distinctive character to be regarded as an indication of trade origin by the relevant class of persons or a significant proportion thereof; in this respect the average consumer is deemed to be reasonably well informed, observant and circumspect but does not normally pause to analyse marks etc; it is relevant to have regard to the various methods and practices of marketing that the average consumer is likely to encounter; and regard should also be had to the characteristics of the sign including whether it contains an element descriptive of the goods or services.

16. In the context of the series of marks before him in the "Cycling IS..." case Mr Hobbs concluded

"67. The case for allowing registration rests upon the proposition that the signs are cryptic to a degree which makes it more likely than not that they would carry connotations of trade origin (whatever other connotations they might also carry) in the minds of the relevant class of persons or at least a significant proportion thereof.

68. The case for refusing registration rests upon the proposition that the signs are visually and linguistically meaningful in a way which is more likely than not to relate the goods and services to the activity of cycling without also serving to identify trade origin in the minds of the relevant class of persons.

69. The difference between these two positions resides in the question whether the perceptions and recollections the signs would trigger in the mind of the average consumer of the specified goods and services would be origin specific or origin neutral."

17. I have set out Ms Evans' view of the matter above. The applicants filed two witness statements. The first is by Karen Nicholson, one of their Directors. The most important point I draw from her statement is that toothbrushes are self serve consumer items - a point supported by Exhibits showing displays of such goods. She suggests, therefore, that toothbrushes are usually chosen as a result of a visual selection process and that her company's mark relies on visual appeal. Phonetic equivalence to the word 'toothbrush' is in her view of no consequence. Consumers will, she suggests, be struck by "the clever and comical play on words which will leave a lasting impression upon them."

18. The other witness statement filed on the applicants' behalf comes from Norman Pattullo, their professional trade mark representative. His main submission is as follows

"6. The Opponent makes reference to the common nature of the suffix "th" and its common use to form ordinal numbers. However the ordinal form of "2" is not "two-th" but "second". The suffix used to form the ordinal number from the cardinal number 2 is not "th" but "nd". Use of the "th" suffix will appear as an error. If interpreted as an ordinal number, the Mark would be viewed as "secondbrush". However, the apparent error in the suffix use will be overwhelmingly obvious and will not marry with the interpretation of the first syllable as "second". This allusion and interpretation all add to the distinctive quality of the Mark which will readily be interpreted as being a Trade Mark."

19. As noted by Mr Hobbs in "Cycling IS...", the mark is not to be considered in the abstract but rather in the context of the goods concerned and the normal trading circumstances pertaining thereto. In this respect I accept the applicants' submissions that toothbrushes (the goods on which the objection is focussed) are overwhelmingly self serve consumer items or at least selected for purchase on the basis of visual inspection. The applicants' exhibits showing displays of toothbrushes are not untypical of what I would expect to see in a retail outlet. Consumers would make their selection from a range of competing goods from different manufacturers and on the basis of the particular and preferred characteristics of the individual items on offer. It is appropriate, therefore, to give full weight to the visual characteristics of the mark applied for in determining whether it can be said to be devoid of distinctive character.

20. My own impression is that the mark applied for consists of an unusual and arresting combination of a numeral and suffix, 2th, and the word brush. It is unusual both because the numeral is substituted for 'too' rather than 'two' and because the first part of the mark plays on the idea of an ordinal number but produces the unexpected element 2th rather than 2nd. As Ms Nicholson suggests, it results in a clever and comical play. Whilst the authorities caution against any expectation that consumers will analyse marks for hidden meanings, I would suggest that this mark does actually invite the consumer to reach the intended meaning. The underlying meaning is not far below the surface but is presented in an unexpected manner.

21. Ms Evans suggests that the substitution of the numeral 2 for 'too-' does not indicate originality and innovation. I would, with respect, disagree with that submission, whilst at the same time noting that it has been held by the Court of First Instance that "the absence of distinctive character cannot arise merely from the finding that the sign in question lacks an additional element of imagination" (see EUROCOOL - Case T-34/00 referring also in paragraph 45 of that decision to a number of other Court of First Instance decisions).

22. It should nevertheless be borne in mind that numbers are sometimes substituted for words particularly in an advertising context. Consumers are not unaccustomed to seeing 2 for 'two' (or 'to') or 4 instead of 'for'. The development of text messaging is perhaps best seen as reinforcing rather than starting that practice. The result is that it is right that marks incorporating numerals should be assessed with trading/advertising practices in mind. However, I am satisfied that the mark in issue here is not one which is open to objection on the basis that it is a normal abbreviation of the kind mentioned above or normal usage of such an abbreviation. Even if it is accepted that 2thbrush is phonetically equivalent to toothbrush the unusual visual representation of the numeral/suffix/word combination produces a mark which cannot in my view be said to be devoid of distinctive character. I have little hesitation in concluding that it can serve the primary function of a trade mark that is to say as an indication that goods sold under the mark will be taken as originating from the same trade source. The opposition fails accordingly.

23. The applicants have been successful and are entitled to a contribution towards their costs. I order the opponents to pay them the sum of £1250. 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 06 day of June 2002

M REYNOLDS
For the Registrar
the Comptroller-General