

O-031-05

TRADE MARKS ACT 1994  
IN THE MATTER OF CONSOLIDATED APPLICATIONS  
NO.s 81678, 81679, 81680 & 81681  
BY THE SENSORY COMPANY INTERNATIONAL LIMITED  
FOR A DECLARATION OF INVALIDITY

IN RESPECT OF TRADE MARK Nos 1306865, 1306866,  
1440563 & 2185710  
STANDING IN THE NAME OF  
ROMPA LIMITED

## BACKGROUND

1) The trade marks concerned in this consolidated action are as follows:

Mark	Number	Effective Date	Class	Specification
SNOEZELEN	1306865	09.04.87	9	Optical, electrical and electronic apparatus and instruments; lighting, sound and video apparatus and instruments; parts and fittings for all the aforesaid goods; all included in Class 9.
SNOEZELEN	1306866	09.04.87	28	Toys, games, playthings; parts and fittings for all the aforesaid goods; all included in Class 28.
SNOEZELEN	1440563	19.09.90	11	Apparatus and installations for lighting; parts and fittings for the aforesaid goods; all included in Class 11.
SNOEZELEN WORLDWIDE FOUNDATION	2185710	06.01.99	41	Training services; education services; publication services; provision of information relating to education and entertainment; all relating to sensory activities.
			42	Research services; all relating to sensory activities.

2) The marks were placed on the Register in the name of Rompa Limited.

3) By an application dated 24 March 2004 The Sensory Company International Ltd of Broad Lane Business Park, Westfield Lane, South Elmsall, West Yorkshire, WF9 2JX applied for a Declaration of Invalidity under the provisions of Section 47(1) of the Trade Marks Act 1994. The grounds are in summary:

a) The applicant submits that the term SNOEZELEN is descriptive of a therapy which benefits people with learning disabilities by placing them in an environment which stimulates their senses. It is commonly used worldwide in this context by businesses, therapists and academics. As both parties supply products expressly designed to provide SNOEZELEN therapy, the applicant submits that the mark in suit is descriptive and offends against Sections 3(1)(b) and 3(1)(c) of the Trade Marks Act 1994.

b) Further, the registered proprietor did not invent the term SNOEZELEN and therefore the mark was registered in bad faith offending against Section 3(6) of the Trade Marks Act 1994.

4) The registered proprietor filed a counterstatement denying the applicant's claims.

5) Both sides ask for an award of costs. Both sides filed evidence in these proceedings and the matter came to be heard on 1 December 2004 when the applicants were represented by Mr Donne of Messrs Urquhart Dykes & Lord. The Registered Proprietor was represented by Mr Hill of Messrs A A Thornton & Co.

### **APPLICANT'S EVIDENCE**

6) The applicant filed a witness statement, dated 2 July 2004, by Mr Gareth Jones a Director of the applicant company. He states that he has worked for the company for five years. He states that his company manufactures products designed to help people with learning disabilities. He states:

“Specifically, we are concerned with products which create an atmosphere to stimulate a person’s senses, usually incorporated within a multi sensory room. Examples of such products include, projectors, lighting equipment, fibre optics, sound transmitting and reproduction apparatus, pre-recorded music media, vibrating platforms and aromatherapy/apparatus for producing smells. Including the period prior to joining my Company in 1999, I have been involved in providing such goods for approximately 12 years and I have a great deal of experience in the field of learning disabilities.”

7) Mr Jones states that the treatment of individuals with learning disabilities, by stimulating their senses is called Snoezelen therapy. He states that it was devised in 1978 in the Netherlands by therapists who noticed the positive reactions caused by external stimuli to adults with learning difficulties. He states that Snoezelen is defined by the Royal College of Psychiatrists as “a special room, designed to gently stimulate the senses and to calm the agitated”. At exhibit GJ/1 he provides a print-out from the Royal College of Psychiatrists web-site which includes a glossary of all commonly used standard terms in this area, one of which is the above definition of the mark in suit. The print-out is dated June 2004.

8) Mr Jones states that Snoezelan therapy is used worldwide and that many UK hospitals have Snoezelan rooms. At exhibit GJ/2 he provides printouts from various UK NHS and Local Authority web sites which refer to such facilities as Snoezelan rooms or refer to using Snoezelan therapy. The print-outs are dated June 2004.

9) At exhibit GJ/3 Mr Jones provides print-outs from various UK University web-sites which refer to Snoezelan either as a therapy or a room. Whilst the print-outs are dated June 2004 there are references within them to other dates such as articles printed in 1992 and 1998. Only one, by Simone Gumtau of the University of Portsmouth and dated June 2002 refers to the origins of the methodology. In this print-out it is claimed that the concept was “developed by Jan Hulsegge and Ad Verheul in Holland in the 1970ies”. Later the paper states “This concept spread in the 1980ies to Belgium, Germany and the UK and in the 1990ies became a worldwide phenomenon.”

10) At exhibit GJ/4 is a copy of extracts from a book which has a copyright date of 1986 titled “SNOEZELEN Another World” by Jan Hulsegge and Ad Verheul. In the foreword the authors state “We came to writing this book because of all the questions we were asked about “snoezelen” through the years.” Later they state “During a period of more than seven years “snoezelen” has developed into an activity

specifically meant for the severely retarded.” This book was translated and published in the UK in 1987 by the registered proprietor company. The book states that the term “snoezelen” is “a contraction of two Dutch words, the equivalents for English “sniffing” and “dozing” coined by two young men working at the recreation department of the Haarendael institute in Holland. These two words call up a vague, undefinable and drowsy feeling.” On the front cover the word “SNOEZELEN” has a small “TM” printed with the upstrokes of the last letter “N”.

11) At exhibit GJ/5 Mr Jones provides an extract from the book “A Practical Guide to the Use of Multi-Sensory Rooms” published in 1995 by TFH. This also refers to the therapy being devised in the Netherlands in the 1970s. At page five of the book it states: “They named their idea Snoezelen from the two Dutch words “Sniffen” to smell and “Doozelen” to sleep or doze. Now a word in its own right in Holland it has been used in the UK as a trade name by one of the companies who introduced some of the Dutch ideas into the UK”.

12) At exhibit GJ/6 is an extract from a book “Multisensory Environments” written by Paul Pagliano a Senior Lecturer in Special Education at James Cook University, Australia. The book acknowledges the inventors of the concept and talks of their “snoezelen philosophy”. In this book it states:

“Snoezelen became the registered trade mark for a UK company ROMPA marketing MSE equipment. This company dominated MSE developments for several years, although now a variety of other companies also manufacture and market MSE equipment. In order to avoid association with any commercial interests, the term “snoezelen” was discarded in the literature and the term ‘multisensory environment’ was adopted instead. Unshackling the MSE from the narrow definition imposed by commercial interests resulted in a freeing up of the use of the MSE, especially in the education of children with disabilities.”

13) At exhibit GJ/7 Mr Jones provides a number of print-outs from various public bodies in the UK where reference is made to Snoezelen rooms, Snoezelen Therapy, Snoezelen (relaxation area), User Groups: Snoezelen, and Snoezelen facilities by HM Prison, Moorland; residential homes run by Bournemouth Council, and The Royal Borough of Kensington and Chelsea. Dumfries and Galloway Council and the BMA.

14) At exhibits GJ8-GJ10 Mr Jones provides evidence to show that Mr George Carmel is a Director of Rompa Limited and also Talaos Limited. In addition he is the President of a US company Flaghouse a company whose website talks of the development of the “Snoezelen approach”, “the concept of Snoezelen”, “SNOEZELEN practice”, and:

“Over the past fifteen years, SNOEZELEN has grown into a worldwide movement in over 30 countries with thousands of installations, a worldwide foundation ([www.swwf.com](http://www.swwf.com)), national and international conferences, and international research projects. SNOEZELEN has already built an impressive and credible history. However, we are still at the beginning of exploring applications for this extraordinary and successful concept and, of understanding

the responses of people with disabilities and other limiting conditions to these stimulating and fascinating sensory environments.”

15) Mr Jones claims that these references illustrate that Snoezelen is purely descriptive of a type of therapy, featuring sensory stimulation through optical, electronic apparatus, lighting apparatus, audio and visual apparatus, games and playthings.

## **REGISTERED PROPRIETOR’S EVIDENCE**

16) The registered proprietor filed a witness statement, dated 16 August 2004, by Stuart George Britland the Managing Director of the registered proprietor company a position he has held since 1989, and a Director of Talaos Limited (the owner of Rompa).

17) Mr Britland states that although the trade mark registrations have changed ownership the goods and services covered by the registrations have always been promoted and sold by a business or company trading as “Rompa”. Therefore, as far as customers are concerned the goods and services have always emanated from a single source.

18) Mr Britland states that his company sells goods and services which create a multi-sensory room or environment. At exhibits SGB1 –SGB3 he provides extracts from publications by the Learning and Skills Development Agency, the British Educational Communications and Technology Agency (BECTA), the University of Manchester and the National Institute for Clinical Excellence (NICE) which all refer to “Sensory/ multi-sensory” when discussing rooms, environments, impairment, approach or therapy. Similarly at exhibit SGB4 he provides samples of tenders from local authorities throughout the UK which refer to “sensory rooms, sound and light room, soft play and sensory room and multi-sensory room”. He comments that no mention is made in any of these documents to the word Snoezelen.

19) At exhibit SGB5 he provides copies of correspondence from a number of clients regarding quotes, post quote enquiries or order enquiries. Mostly these refer to “sensory/ multi-sensory” rooms/activities, facilities or areas. Some refer to white/dark/quiet/light therapy rooms.

20) Mr Britland states that his company did publish the book “Snoezelan: Another World” in 1987, stating that Rompa BV, a Dutch partner, worked with the two Dutch therapists Jan Hulsege and Ad Verheul. He also states that neither opposed the registration of the term by Rompa as a badge of origin for its proprietary products. He also states that the mark is registered in a large number of countries world-wide. He claims that the mark in suit has been used, in conjunction with the symbol of a letter “R” in a circle which is recognised as meaning that the mark is registered, on documentation and marketing materials since 1992. At exhibit SGB6 he provides brochures dated between 1991-2004 which show this use.

21) Mr Britland states that there are only a few companies who deal in the multi-sensory market. He names four other companies who, along with his company, have 90% of the market. He also mentions the applicant company as being amongst “other

suppliers”. He provides, at exhibits SGB9-13, brochures and internet printouts from the four other major companies and other smaller suppliers in the sector and states that they all refer to their products as being “sensory or multi-sensory” along with words such as “room”, “environment”, “concepts”, “developments”, “products” or “studios”.

22) Mr Britland claims that the applicant company was only incorporated in February 2002 and so Mr Jones could not have been a Director since 1999, he also questions whether Mr Jones has been involved in the business for twelve years as asserted, claiming that Mr Jones has only been involved in the industry since 1997.

23) Mr Britland claims that most of the local authority websites shown in the applicant’s evidence as using the term “Snoezelen” are actually customers of his company. At exhibits SGB15-SGB18 he provides invoices which show the supply of equipment to a number of the units mentioned in the applicant’s evidence. He also points out that his company supplies to middlemen so that his company will not always be aware of the final destination of its products.

#### **APPLICANT’S EVIDENCE IN REPLY**

24) The applicant filed a witness statement, dated 7 September 2004, by Alan Michael Fiddes, the applicant’s Trade Mark Attorney. Mr Fiddes claims that the registered proprietor has never used the word “SNOEZELLEN” as a trade mark. At exhibit AMF/1 he provides a print-out from the registered proprietor’s website. He states that throughout, SNOEZELLEN is used descriptively, as in “Complete Snoezelen Solutions”. This phrase alone, he claims, “implies that Rompa produce goods to allow others to provide Snoezelen therapy. I cannot find one instance where Rompa have actually applied the SNOEZELLEN mark to their goods, or use it as a badge of origin”.

25) Mr Fiddes states that whilst he agrees that the term “multi-sensory room” is the correct term for a facility, the applicant’s claim is that SNOEZELLEN is descriptive of a therapy.

26) At exhibit AMF/2 he provides an excerpt from the British Educational Communications and Technology Agency (BECTA). This web-site was also referred to by the registered proprietor. However, Mr Fiddes states that far from not referring to SNOEZELLEN, as claimed by the registered proprietor, the Agency uses the word “descriptively, to refer to an institution which provides SNOEZELLEN therapy”. The part of the web-site where this reference occurs is headed “How MSE’s developed”. The first paragraph under this heading states:

“There is a rather complex history behind the development of multisensory environments (MSEs). Part of the complexity arises from the variety of routes that culminate in what are now described as MSEs. Most information points to the Snoezelen leisure facilities in Holland as a primary influence on what are now described as multisensory environments.”

27) Mr Fiddes claims that the evidence previously filed by the applicant showing descriptive use of SNOEZELLEN by Universities and the NHS is decisive.

28) Mr Fiddes states that the book SNOEZELEN ANOTHER WORLD shows clearly that the term relates to a type of therapy. He also provides evidence, at exhibit AMF/3 that SNOEZELEN is registered in France by T.F.H. societe a responsabilite limtee. He also claims that the registered proprietor's pending Community Trade Mark Application is being opposed by this French company. This claim is backed up by a print-out from the OHIM website produced at exhibit AMF/4. Mr Fiddes points out that TFH are named by the registered proprietor as one of the major companies in the field and that it was claimed that they did not use the term SNOEZELEN. However, as TFH have the mark SNOEZELEN registered as a trade mark in France these assertions are suspect. He also claims that in the registered proprietor's evidence at SGB/10 there is use of the word SNOEZELEN in a descriptive manner at page six. The reference reads: "This is a concept in sensory work, which has evolved out of the use of *snoezelen*, multi-sensory rooms and interactive light and dark rooms."

29) That concludes my review of the evidence. I now turn to the decision.

## **DECISION**

30) The request for the declaration of invalidity is made under the provisions of Section 47(1) of the Act which states:

"47.-(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered."

31) I shall first consider the ground of invalidity under Section 3(6) which reads:

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

32) Section 3(6) has its origins in Article 3(2)(d) of the Directive the Act which implements Council Directive No. 89/104/EEC of 21 December 1988 which states:

"Any Member State may provide that a trade mark shall not be registered or, if registered, shall be liable to be declared invalid where and to the extent that....

(c) the application for registration of the trade mark was made in bad faith by the applicant."

33) The Directive gives no more clue as to the meaning of "bad faith" than the Act. Subsequent case law has avoided explicit definition, but has not shirked from indicating its characteristics. In *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367, Lindsay J stated at page 379:

“I shall not attempt to define bad faith in this context. Plainly it includes dishonesty and, as I would hold, includes also some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined. Parliament has wisely not attempted to explain in detail what is or is not bad faith in this context; how far a dealing must so fall-short in order to amount to bad faith is a matter best left to be adjudged not by some paraphrase by the courts (which leads to the danger of the courts then construing not the Act but the paraphrase) but by reference to the words of the Act and upon a regard to all material surrounding circumstances.”

34) In *Harrison v Teton Valley Trading Co* [2004] EWVA Civ 1028, the Court of Appeal confirmed that bad faith is to be judged against a combined objective and subjective test. At paragraphs 25 and 26 of their decision they said:

“25. Lord Hutton went on to conclude that the true test for dishonesty was the combined test. He said:

“36. ....Therefore I consider.....that your Lordships should state that dishonesty requires knowledge by the defendant that what he was doing would be regarded as dishonest by honest people, although he should not escape a finding of dishonesty because he sets his own standards of honesty and does not regard as dishonest what he knows would offend the normally accepted standards of honest conduct.”

26. For my part, I would accept the reasoning of Lord Hutton as applying to considerations of bad faith. The words “bad faith” suggest a mental state. Clearly when considering the question of whether an application to register is made in bad faith all the circumstances will be relevant. However, the court must decide whether the knowledge of the applicant was such that his decision to apply for registration would be regarded as in bad faith by persons adopting proper standards.”

35) Both sides accept that the concept of stimulating severely retarded individuals using lights, sounds, smells and touch was pioneered by therapists in the Netherlands in the 1970s. These same therapists wrote a book titled “SNOEZELEN Another World”. This book was published, in 1987, by the registered proprietor. It is also accepted by both sides that the word was formed from two Dutch words for “sleeping/dozing” and “smelling/sniffing”.

36) In the statement of grounds the applicant for invalidity alleged that the registered proprietor did not invent the word “Snoezelen” and therefore it had been registered in bad faith. At the hearing this was expanded to a proposition that the registered proprietor knew that the word was invented by someone else and that it referred to the therapy and not the products. Further, in the face of this knowledge the registered proprietor sought to monopolise the word in relation to the goods and therefore monopolise the goods that would be sold in respect of the therapy.

37) The registered proprietor does not contest that its trade mark was invented by two Dutch therapists at some point in the 1970s. However, the fact that the term was



invented by someone else does not, of itself, constitute bad faith. Moving onto the issue of whether the term “SNOEZELEN” was the name of a therapy, prior to any of the application dates, the evidence is far from convincing. The book, published at some point in 1987 shows the use of the term SNOEZELEN together with the letters “TM”. Thus, at the first use shown of the word in the UK, it is clearly viewed as a trademark. Given that the book was written by the acknowledged inventors of the word I think it is reasonable to assume that the authors were aware of the layout of the front page and the use of the “TM” indicator and its meaning.

38) From the evidence of both parties it is clear that the term “SNOEZELEN” was invented between 7-17 years prior to the publication of the book in the UK. Had the term become synonymous with the therapy of stimulating those described as being severely retarded with lights, sounds, smells and tactile experiences then the applicant should have been able to file evidence of use of the term at the relevant date for the first two applications (9 April 1987). To my mind it is not clear that even by the date of the last application, 6 January 1999, that the term was in common use as a description for the therapy. Such evidence could have taken the form of statements from consultants, copies of medical journals etc. Instead the applicant filed evidence which, at best, could be said to be capable of other interpretations. The evidence from the Royal College of Psychiatrists glossary of commonly used standard terms is not, in my view, conclusive. In a similar way the word “Hoover” is used as both a trade mark but also has a meaning of vacuuming. The glossary is also dated seventeen years after the trade mark was first registered and used. The use of the term by the registered proprietor has also come under scrutiny. However, my opinion on the registered proprietor’s use is that phrases such as “the Snoezelen approach”, “the concept of Snoezelen” and “Snoezelen practice” can all be taken as use of the word “Snoezelen” as a trade mark.

39) Taking all of the above into consideration I have come to the conclusion that the registered proprietor did not act in bad faith when applying for the trade mark. No evidence has been provided which shows that the registered proprietor’s behaviour fell short of the standards of acceptable commercial behaviour. The ground of invalidity under Section 3(6) fails.

40) I therefore move to consider the ground of invalidity under Section 3(1)(b). When considering this ground I adopt the approach taken by the European Court of Justice in its judgment in Joined Cases C-53/01 to C-55/01 *Linde AG, Windward Industries Inc. and Radio Uhren AG* (8 April 2003) which state:

“37. It must first of all be observed that Article 2 of the Directive provides that any sign may constitute a trade mark provided that it is, first, capable of being represented graphically and, second, capable of distinguishing the goods and services of one undertaking from those of other undertakings.

.....

39. Next, pursuant to the rule 1 Article 3(1)(b) of the Directive, trade marks which are devoid of distinctive character are not to be registered or if registered are liable to be declared invalid.

40. For a mark to possess distinctive character within the meaning of that provision it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from products of other undertakings (see *Philips* [2002] ECR I-5475, paragraph 35).

41. In addition, a trade mark's distinctiveness must be assessed by reference to, first, the goods or services in respect of which registration is sought and, second, the perception of the relevant persons, namely the consumers of the goods or services. According to the Court's case-law, that means the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and circumspect (see Case C-210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 31, and *Philips*, paragraph 63).

.....

47. As paragraph 40 of this judgment makes clear, distinctive character means, for all trade marks, that the mark must be capable of identifying the product as originating from a particular undertaking, and thus distinguishing it from those of other undertakings."

41) It is clear from the above that I must assess the mark's distinctiveness in relation to the goods and services for which they are registered. The specifications are quite broad and encompasses audio and visual apparatus, toys services and research all centred around sensory activity. I must also take into account the perception of the relevant consumer of the goods which, to my mind, predominantly means the medical profession as purchasers of the original equipment and the general public as purchasers of the services provided by said equipment, effectively end users.

42) The applicant contends that the word "Snoezelen" would be taken by both the medical profession and the general public as referring to a type of therapy. The applicant refers to the original book written by the two Dutch therapists who developed the concept of using multi-sensory stimulation on those who are severely retarded. Clearly, these two men invented the term "snoezelen". However, when the book was published, at least seven years after the term was first coined, it appeared with a trade mark notification attached. The applicant also produced in evidence copies of extracts from two other books which refer to the use of the word "snoezelen" initially as relating to the type of therapy in the Netherlands but as a trade mark in the UK. One of these books also states that the term "Multi-sensory" is now used to describe the treatment, equipment and area where the treatment is carried out. This evidence does not establish the contention that the word was in use as a term for a type of therapy at the time that the original marks were applied for, and it shows clearly that the term was established as a trade mark at the time of the subsequent applications.

43) The applicant also seeks to rely upon the use of the word "snoezelen" by the registered proprietor and various users such as councils. In all of the instances filed it would seem to me that the references are used to identify that the facility was provided by the registered proprietor. On the part of the councils etc it maybe that

they believe that there is a cache to having a “snoezelen” room/facility rather than simply a multi-sensory room. Those that make such a claim have been shown to be customers of the registered proprietor. Manufacturers are wont to use the phrase “the original and best” and I view the usage of the term “snoezelen” by the registered proprietor and its clients as making this type of statement.

44) It follows from the above that, in my view, the average consumer would see the mark as being origin specific and would attach trade mark significance to the mark. Prima facie the mark has distinctive character and the opposition under Section 3(1)(b) fails.

45) I next consider the position under Section 3(1)(c). In considering this ground I look to the guidance given by 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* [2001] ETMR 75. 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 judgement. Paragraphs 37, 39 and 40 serve to illustrate the approach adopted by the Court.

“37. It is clear from those two provisions taken together that the purpose of the prohibition of registration of purely descriptive signs or indications as trade marks is, as both Proctor & Gamble and the OHIM acknowledge, to prevent registration as trade marks signs or indications which, because they are no different from the usual way of designating the relevant goods or services or their characteristics, could not fulfil the function of identifying the undertaking that markets them and are thus devoid of the distinctive character needed for that function.

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 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 is apt to confer distinctive character on the word combination enabling it to be registered as a trade mark.”

46) I also take into account the comments of Advocate General Jacobs in the *Doublemint* case, dated 10 April 2003, where he said:

“91. That last consideration leads me to the question of the extent to which Article 7(1)(c) of the Trade Mark Regulation must be interpreted in the light of the aim referred to in the *Windsurfing Chiemsee* judgment, namely that descriptive signs and indications should be freely available to be used by all traders in relation to the relevant goods.

92. In my opinion in *Baby-Dry*, (39) I took the approach that in the scheme of the Community Trade Mark Regulation a trade mark could include signs or indications designating product characteristics but could not consist exclusively of them. By virtue of Article 12(b), the trade mark cannot prevent other traders from using such signs for descriptive purposes. The aim of Article 7(1)(c) is to avoid the registration of descriptive brand names for which no protection could be available rather than to prevent any monopolising of ordinary descriptive terms. A very similar view was taken by the Court at paragraph 37 of its judgment.

93. In the present case, both the Office and the United Kingdom Government have expressed reservations about that approach, which has also been criticised in the literature. (40) It appears, they have pointed out, to represent a departure from the Courts statement in *Windsurfing Chiemsee* that Article 7(1)(c) of the Trade Marks Directive “pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the categories of goods or services in respect of which registration is applied for may be freely used by all and that Article 6(1)(b) (which corresponds to Article 12(b) of the Regulation) does not have a decisive bearing on that interpretation”.

94. It may be feared that the approach in question is liable to shift the balance of power in favour of a trade mark owner with monopolistic ambitions who may assert, or threaten to assert, his rights against an alleged “infringer who merely seeks to use descriptive terms descriptively and honestly”. In the real world, a defence under Article 12(b) might be worth rather less than its ostensible value in law.

95. That danger cannot be ignored. A trade mark owner wishing to monopolise not only his trade mark but the area around it may threaten unmeritorious proceedings against a competitor, who may capitulate rather than incur the costs of litigation as well as risk an adverse outcome.

96. However, for the reasons already given, I do not think that the *Baby-Dry* case, properly understood, does shift the balance in the way that has been suggested. And the danger mentioned will be obviated if the criterion of “perceptible difference” in paragraph 40 of the *Baby-Dry* judgment is applied as I have suggested above, so that a mark is accepted for registration only when it is apparent to both traders and consumers that as a whole it is not suitable, in the ordinary language of trade, as a designation of characteristics of the product in question.

97. In any event, it seems clear that there was no intention, in the *Baby-Dry* judgment, to depart from the view in *Windsurfing Chiemsee* that it is in the

public interest that descriptive signs may be freely used by all. Very recently, in *Linde*, (42) the Court has expressly reaffirmed that position.”

47) This opinion was confirmed by the European Court of Justice in *Doublemint* Case C191-01 (*Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr* [2003] WL101985) which said:

“31. By prohibiting the registration as Community trade marks of such signs and indications, Article 7(1)(c) of Regulation No 40/94 pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all. That provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks.”

48) It is clear from the above that I must determine whether, assuming notional and fair use, the marks in suit, will be viewed by the average consumer to directly designate the essential characteristics, “kind” and “intended purpose”, of the goods and services for which registration is sought. Only if the marks are no different from the usual way of designating the relevant goods or their characteristics can it be debarred from registration.

49) From my analysis of the evidence filed at paragraphs 39,40, 44 & 45 above it is clear that, to my mind, the opponent has failed to show that the term “snoezelen” has ever been used in the UK in a descriptive sense. In my opinion, the marks in suit could not be said to be the normal way of describing the types of goods and services, or their characteristics, included in their specifications. The ground of opposition under Section 3(1)(c) fails.

50) The application for invalidity having failed the registered proprietor is entitled to a contribution towards costs. I therefore order the applicant to pay the proprietor the sum of £2,500. This sum 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 3rd day of February 2005

George W Salthouse  
For the Registrar  
The Comptroller-General