

O-187-11

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2485208
IN THE NAME OF STEINER BEAUTY PRODUCTS, INC

AND

OPPOSITION THERETO UNDER NO 100057 BY GUINOT

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IN THE MATTER OF application
No 2485208 in the name of
Steiner Beauty Products Inc and
opposition thereto under No 100057
by Guinot

Background

1. Application No. 2485208 is for the trade mark PRO-COLLAGEN and stands in the name of Steiner Beauty Products, Inc. ("Steiner"). It has an application date of 17 April 2008 and registration is sought in respect of the following goods:

Skin creams, facial creams, facial lotions, moisturizers; essential oils and aromatic oils for the face and body; skin buff exfoliating creams; applicator pens and brushes for applying skin creams, facial creams, facial lotions and moisturizers.

2. The application was published in the *Trade Marks Journal* on 30 October 2009. On 25 January 2010, notice of opposition to the registration was filed by Guinot. The grounds of opposition are brought under the provisions of sections 3(1)(a), (b), (c), (d), and 3(6) of the Act.

3. In relation to the objections under section 3(1) of the Act, Guinot states that the mark consists exclusively of words which are descriptive of and non-distinctive for products for use on connective tissue such as skin and is used by other traders to define collagen promotion products and skin care products. Attached to the Notice of Opposition are dictionary extracts for the words 'pro-', 'collagen' and 'procollagen'.

4. In relation to the objection under section 3(6) Guinot states:

[Steiner] must have been aware of the meaning of the words and the use of the words PRO COLLAGEN by other companies in the same area of business when the application was filed. The implication is that the application was filed (sic) in an attempt by the applicant to monopolise a word that should clearly be available for anyone to use to describe their products. Consequently, the application was filed in bad faith."

5. Steiner filed a counterstatement in which it requested the ground of opposition raised under section 3(1)(a) be struck out. Following an exchange of correspondence between the parties and the registrar, the ground of opposition was allowed to remain. The counterstatement also indicates that whilst Steiner does not deny the dictionary meanings provided by Guinot it "makes no admission as to the relevance of this information to the assessment of the distinctiveness of the mark... in relation to the goods applied for". It denies the definition of the word "procollagen has any relevance to the assessment of the distinctiveness of the mark PRO-COLLAGEN" as applied for. It denies or otherwise puts Guinot to proof of the claims made.

6. Both parties filed evidence and the matter came before me for hearing on 11 April 2011. Guinot was represented by Ms Helene Whelbourn of J E Evans-Jackson & Co, its legal representatives in these proceedings. Steiner was represented by Mr Thomas St Quintin of Counsel, instructed by Wildbore & Gibbons, its legal representatives.

The evidence

7. Evidence was filed by Ms Whelbourn on behalf of Guinot and by Ms Parmesan of Wildbore & Gibbons for Steiner.

8. Ms Whelbourn's witness statement is dated 22 July 2010. She states that PRO-COLLAGEN is a common English language term and is used as such in the trade. She exhibits the following:

HW1: Copies of various extracts which she says show use of PRO-COLLAGEN by the scientific community. These are:

- An extract from the Journal of Plastic and Reconstructive Surgery dated July 2004. It is headed 'Matrix Metalloproteinases, Tissue Inhibitors of Metalloproteinases , Aminoterminal Propeptide of Procollagen Type III, and Hyaluronan in Sera and Tissue of Patients with Capsular Contracture after Augmentation with Trilucent Breast Implants. The abstract describes how '[t]he aminoterminal propeptide of procollagen type III (PIIINP) and hyaluronan were analyzed as markers for fibrogenesis...' in a study carried out on women who had undergone breast augmentation or reduction surgery.
- An extract from an article published in the British Journal of Dermatology 2008 volume 158. The article, written by a group of authors affiliated to either the Dermatological Sciences Research Group at the University of Manchester or The Boots Company, is entitled 'Repair of photoaged dermal matrix by topical application of a cosmetic 'antiageing' product'. Discussing the results of the group's study into the effectiveness or otherwise of the use of various 'antiageing' cosmetics, it finds the use of some concentrations 'had little effect on procollagen I or matrix metalloproteinase-1 expression' whereas others 'increased the deposition of fibrillin-1 and procollagen I'.
- An extract from the Journal of Investigative Dermatology published in 1974. The extract is entitled 'Skin Procollagen Peptidase in normal and pathologic conditions'. It is in the form of an abstract which discusses how '[p]rocollagen peptidase is a specific endopeptidase which excises the polypeptide extensions of procollagen to convert it into collagen'.
- An extract from Dermatology Times, self-described as 'The Leading Newsmagazine for Dermatologists' and dated

September 2002. The article shown is entitled 'Studies demonstrate value of procollagen fragment Pal-KTTKS'. Reporting on a study undertaken by Procter & Gamble it states how the application of palmitoyl-pentapeptide 3 'improved regularity of collagen IV' and 'improves the appearance of photodamaged skin by stimulating collagen production' .

- A copy of Avon Products Inc International patent no WO 03/041636 A2 filed under the Patent Cooperation Treaty. It is entitled 'Topical Cosmetic composition with skin rejuvenation benefits'. The description of the invention explains that "There is active contemporary interest in the cosmetics industry to develop products that may be applied topically to the skin that provide anti-aging, hydrating, and/or skin texturizing benefits." These benefits, it goes on to explain, can be manifested in many ways including by "improvement in procollagen and/or collagen production".

HW2: This exhibit consists of extracts filed to show use of the term pro-collagen by a number of companies including Steiner to define collagen promoting skin care products. There is:

- The first page (actually printed over two pages) of results of a Google search carried out in 12 May 2010. The search term used is shown as "pro collagen" –elemis which Ms Whelbourn says is for "the element "pro collagen" but without the term "Elemis" [as] "Elemis" is the Trade mark used on the applicant's pro-collagen products". The results include: Pro-Collagen Youth Serum and Pro-Collagen Night Concentrate both by The Sanctuary, Ipg Pro-Collagen Firming Cream available from Harrods, Pro-Collagen by Provera and Provera Pro-Collagen both apparently available via a shopping website and the MEdik8/Pro Collagen Anti Ageing Augmentation Effect Lip Filler.
- A print out downloaded on 24 November 2009. The page highlights the 'Crème Procollagène Super-Active de Les Naturelles'. The page is taken from the French website beaute-test.com. and indicates in relation to the product that "il stimule la formation de collagène et d'elastine".
- An undated extract from the benuts.com website offering Pro-Collagen capsules for sale. The price is shown in dollars.
- An undated extract from the beautynhealth.com website showing various containers of epicuren's Pro Collagen III Serum Amplifier.
- An extract downloaded on 12 May 2010 from the lorealparis.ca website. It shows L'Oréal's Collagen remodeler which is described as its 'first Daily Contouring Moisturizer for face and

neck [which] features the breakthrough ingredient Pro-Collagen' which is a 'natural alfalfa extract that biologically recharges skin's natural collagen production".

- An undated extract from the lpgsystems.com website showing LPG's Pro-Collagen Firming cream which describes how its ingredients "stimulates cellular division to boost natural collagen production which is responsible for skin firmness" and 'maintains skin elasticity by fighting collagen fiber glycation".
- An extract downloaded on 3 December 2009 from the beautyflash.co.uk website offering for sale the Medik8 Hydr8 Pro Collagen SPF 25 Hydrator which is a "light pro-collagen daily hydrating formula". The price is shown in £ sterling.
- An extract downloaded on 3 December 2009 from the worldwideshoppingmall.co.uk website offering for sale Provera's Pro-Collagen anti-wrinkle gel. The price is shown in £ sterling. It explains how "Pro-Collagen improves water retention for the skin and visibly regenerates and improves quality of skin, Restores and regenerates Collagen fibres, reduces hardening of skin and visible signs of aging"
- An undated extract from thesanctuary.co.uk website offering for sale its Pro-Collagen Youth Serum. The ingredients are said to "stimulate collagen synthesis and reduce wrinkle depth and hydrate and protect the skin. The price is shown in £ sterling.
- An extract downloaded on 3 December 2009 from thebeautyspot-shop.co.uk website based in Mansfield Nottinghamshire and offering for sale Pro-Collagen SPF 25 Hydrator by Medik8. Again the price is shown in £ sterling.
- An extract downloaded on 3 December 2009 from the web.winltd.com website showing WINSpa™ Pro-Collagen Wrinkle Serum.

HW3: Extracts said to have been filed to show Guinot's descriptive use of the words pro-collagen. The exhibit consists of fourteen pages.

The first three were downloaded from the gala.fr website on 3 December 2009 and show:

1. The text is in French and refers to a plant which "favorise la synthèse de collagène"
2. Shows a picture of Guinot's "Liftosome" lifting cream. The accompanying text is presented in French and indicates that "Le Pro-collagène contenu dans sa formule raffermir l'épiderme et"

3. I can see no mention of the words pro-collagen on this page.

The remaining pages of this exhibit appear to be from a variety of sources.

4. Is undated and appears to be some sort of promotional leaflet which shows pictures of a box of Guinot's "Liftosome" lifting cream and a sachet of its face concentrate. The lifting cream box displays the words PRO-COLLAGÈNE and PRO COLLAGEN whilst the face concentrate sachet bears the words PRO COLLAGÈNE
5. Whilst this page refers to GUINOT LIFTOSOME and refers to PRO-COLLAGÈNE and Pro-Collagen-t, the text appears in a language I am not familiar with and no translation is provided. It was downloaded from the guinotkozmetika.com website on 3 December 2009.
6. Dated autumn/winter 2008, this page is in Italian but I am unable to see any reference to Pro Collagen
7. A page identical to that at 6 above
8. Again in Italian but undated, I can see no reference to Pro Collagen
9. Again in Italian and undated, I can see no reference to Pro Collagen
10. Again in Italian and undated, I can see no reference to Pro Collagen
11. Again in Italian and undated, I can see no reference to Pro Collagen
12. Again in Italian and undated, and referring to the LIFTOSOME product, the graphic shows the word ProCollagene. The text refers to Pro-Collagene and pro collagene
13. A page downloaded from the kolagen.cz website on 3 December 2009. Whilst the page bears an image of a box of bearing the words PRO COLLAGÈNE Marin Gel, I have no idea what the rest of the text on the page means.
14. This appears to be a continuation of page 13 of the exhibit. Again I can see no reference to the words Pro Collagen in the text and have no idea what it means.

HW4: This exhibit consists of a copy of a witness statement by Mr Sean Charles Harrington which Ms Whelbourn states was filed by Steiner in the course of its application. I do not intend to summarise Mr Harrington's witness statement here but will do so later in this decision.

HW5: This is a page taken from the Elemis.com website and is undated. It shows the Elemis Pro-Collagen Oxygenating Night Cream Anti-Ageing and describes how, through its use "the tell-tale signs of premature ageing are delayed, whilst the skin's natural collagen network is supported, helping to promote skin elasticity and hydration".

9. Ms Parmesan's witness statement is dated 22 October 2010. The witness statement simply introduces five exhibits. These are:

GP1: A selection of packaging samples which she says show the mark as used. The first is a pot. On the front of the pot is printed Elemis. On the back, and on separate lines one above the other, is printed Pro-Collagen, Wrinkle Smooth, Anti-Ageing. The second is cardboard outer packaging. The front has Elemis at the top. At the bottom, and again on separate lines one above the other, is printed Pro-Collagen, Quartz Lift, Serum, Anti-Ageing. The third is cardboard outer packaging showing Elemis again separated from Pro-Collagen, Oxygenating, Night Cream, Anti-Ageing. The fourth is cardboard outer packaging showing Elemis at the top with Pro-Collagen, Hand and Nail, Cream, Anti-Ageing below. Lastly, there is a cardboard outer package with Elemis at the top and Pro-Collagen, Body Serum, intensive lift, Anti-Ageing below.

GP2: Ms Parmesan attaches another copy of the witness statement of Mr Harrington as already filed by Ms Whelbourn which, she confirms, was filed in support of the application during the examination process.

GP3: Certificates giving circulation details of 'the majority' of the publications included as exhibit 4 to Mr Harrington's witness statement.

GP4: A copy of the letter sent by the Intellectual Property Office during the examination process indicating that following the filing of evidence of use of the mark the officer considering the matter was prepared to allow the application to proceed on the basis that the mark had acquired distinctiveness through the use shown of it. Whilst the registrability of the mark may have been considered previously as part of the examination process, that consideration was an ex parte one which I am not bound to follow. Indeed, I am required to consider matters afresh as part of these opposition proceedings, taking into account all of the evidence now before me.

GP5 The first page of results of a Google search carried out on 6 October 2008 for the search term (pro-collagen skincare). Ms Parmesan says it shows that "All but 2" of these results relate to Steiner's products. Most of the results refer to Elemis. There is a reference to the Pro-Collagen

skincare range offered by The Sanctuary and another to the Givencyman Pro-Collagen Emulsion Wrinkle Smoothing care product.

10. Ms Whelbourn filed a further witness statement as evidence in reply. As the witness statement does not contain evidence of fact but is instead commentary and submission, I do not summarise it here but do take it into account and will refer to it as necessary in this decision.

11. As I indicated above, both parties have filed copies of evidence originally filed during the ex parte examination of the application. It consists of a witness statement of Sean Charles Harrington and is dated 13 August 2009. For ease of reference, I intend to use the page numbering of this evidence as shown in the exhibit to Ms Parmesan's evidence. Mr Harrington states that he is the Managing Director of Elemis Limited, a sister company of Steiner. He states that Elemis Limited is responsible for the sale and marketing of PRO-COLLAGEN products in the UK. He states that the mark was launched on the UK market in May 2003 and has been in continuous use in the UK since that date. He states the mark is in use in relation to a range of anti-ageing retail products and products aimed at professional beauty therapists.

12. At SH2 Mr Harrington exhibits printouts showing the range of products available. The pages show the Elemis anti-Ageing range and Elemis Pro-Collagen marine cream. There are pictures said to be of Pro-Collagen Lifting Treatment Neck and Bust, Pro-Collagen Marine Cream, Pro-Collagen Quartz Lift Mask, Pro-Collagen Oxygenating Night Cream, Pro-Collagen Wrinkle Smooth, Pro-Collagen Wrinkle Smooth pen and Pro-Collagen Quartz Lift Serum. Mr Harrington says that approximate annual turnover in goods offered under the mark is £1m in 2003, £2,035,000 in 2004, £2,980,000 in 2005, £4,050,000 in 2006 and £7,395,000 in the period 2007 to March 2008. Approximate annual advertising for the same periods are said to be £50,000, £101,800, £149,000, £352,500 and £419,750. PRO-COLLAGEN products are said to have been featured in numerous national magazines and newspapers.

13. A selection of these advertisements is exhibited at SH4 and includes publications such as The Daily Mail, Sunday Express, The Telegraph, The Times, Womens Health, You, Grazia, Good Housekeeping, Metro, Tatler and More as well as Professional Beauty, Professional Hairdresser and Health & Beauty Salon. The extracts range in date from May 2003 to March 2008 (though I cannot discern a date or source for some and others I cannot read at all). Most are in the form of advertorials showing a number of products from different companies though others are more recognisable as advertisements. The advertorials show a variety of products including Elemis Pro-Collagen Marine Cream (pages 45 and 50), Pro-Collagen Lifting Treatment by Elemis (page 47), Elemis Pro-Collagen Lifting Treatment (page 49), Elemis Pro-Collagen Lifting Treatment Neck & Bust (pages 52 and 53), Elemis Pro-Collagen Wrinkle Smooth Pen (page 55), Elemis Aromapure Pro-Collagen Wrinkle Smooth (page 56), Elemis Pro-Collagen Eye Lift Cream (page 64), Elemis Pro-Collagen Eye Renewal (page 68), Elemis Pro-Collagen Quartz Lift Serum (page 70), Quartz Lift Serum from Elemis (page 74), Elemis Pro-Collagen Oxygenating (page 77), Elemis Pro-Collagen Oxygenating Night Cream (page 82), Elemis Pro-Collagen Hand and Nail Cream (page 84), Pro-Collagen Radiantly

Smooth Body Cream from Elemis (page 85) and Elemis Anti-Ageing Pro-Collagen Hand and Nail Cream (page 86). Page 91 shows the Elemis Pro-Collagen Quartz Lifting Serum which is described as the 'jewel of the Pro-Collagen Collection. Other pages refer to the Pro-Collagen range (page 93).

14. Mr Harrington states that the PRO-COLLAGEN products have been immensely successful with PRO-COLLAGEN Marine Cream voted the best anti-ageing moisturiser by the magazines Star in 2005 and Cosmopolitan in 2007 and by handbag.com in 2007. He states that PRO-COLLAGEN Quartz Lift Facial was voted the anti-ageing facial of the year in 2008. Extracts showing these awards are also provided though due to the poor quality of photocopying I cannot see exactly what some of these pages show. The Grazie award pages shows the winner to be ELEMIS Pro-COLLAGEN QUARTZ LIFT FACIAL, the Star Award names the best anti-ageing product to be the ELEMIS Aromapure PRO-COLLAGEN Marine Cream, whilst the handbag.com printout shows the ELEMIS PRO-COLLAGEN marine cream.

15. That completes my summary of the evidence filed in these proceedings to the extent I consider necessary.

Decision

The objection under section 3(1)(a)

16. Section 3 of the Act states:

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

(a) signs which do not satisfy the requirements of section 1(1),

17. For its part, section 1(1) of the Act states:

“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.”

18. In its Notice of Opposition, Guinot sets out its objection under section 3(1)(a) in the following terms:

“The trade mark consists exclusively of the descriptive and non-distinctive word PRO-COLLAGEN. According to Collins English Dictionary, the prefix PRO- means “in favour of” or “acting as a substitute for”, amongst other things. The word COLLAGEN is the name of “a fibrous sclerprotein of connective tissue and bones that is rich in glycine and proline...”. The Merriam-Webster Inline Medical Dictionary describes “collagen” as “an insoluble fibrous protein of vertebrates that is the chief constituent of the fibrils of connective tissue (as in skin and tendons)” and “procollagen” as a

molecular precursor of “collagen”. Copies of the extracts from the dictionaries referred to are attached hereto as Annex 1. The application is for products for use on the skin. The trade mark PRO-COLLAGEN is descriptive and non-distinctive for any products for use on connective tissue such as skin and as a result is incapable of distinguishing the goods or services of one undertaking from those of other undertakings.”

19. Section 1(1) defines a trade mark and requires a sign to be capable of being represented graphically. It also requires a sign to be capable of distinguishing goods of one undertaking from another. The mark the subject of this application consists of two words separated by a hyphen. Clearly, they *are* represented graphically and thus the first requirement is met. As to the second requirement, I take note of the comments of the CJEU in *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* Case C-299/99:

“36. It is true that Article 3(1)(a) of the Directive provides that signs which cannot constitute a trade mark are to be refused registration or if registered are liable to be declared invalid. However, it is clear from the wording of Article 3(1)(a) and the structure of the Directive that that provision is intended essentially to exclude from registration signs which are not generally capable of being a trade mark and thus cannot be represented graphically and/or are not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

37. Accordingly, Article 3(1)(a) of the Directive, like the rule laid down by Article 3(1)(b), (c) and (d), precludes the registration of signs or indications which do not meet one of the two conditions imposed by Article 2 of the Directive, that is to say, the condition requiring such signs to be capable of distinguishing the goods or services of one undertaking from those of other undertakings.

38. It follows that there is no class of marks having a distinctive character by their nature or by the use made of them which is not capable of distinguishing goods or services within the meaning of Article 2 of the Directive.

39. In the light of those considerations, the answer to the first question must be that there is no category of marks which is not excluded from registration by Article 3(1)(b), (c) or (d) and Article 3(3) of the Directive which is none the less excluded from registration by Article 3(1)(a) thereof on the ground that such marks are incapable of distinguishing the goods of the proprietor of the mark from those of other undertakings.”

20. In my view, the objection under section 3(1)(a) is not well founded. The mark is represented graphically and is one which is capable, in appropriate circumstances and if only “to the limited extent of being “not incapable””, of distinguishing goods of one trader from another. That being the case, the opposition based on section 3(1)(a) is dismissed.

The objections under section 3(1)(b)(c) and (d)

21. The relevant parts of Section 3 of the Act state:

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

- (b) trade marks which are devoid of any distinctive character,
- (c) trade marks which consist exclusively of signs or indication 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.”

22. Whilst the opposition is based on grounds under section 3(1)((b) (c) and (d), I intend to consider the objection under section 3(1)(c) in the first instance.

23. In *JanSport Apparel Corp v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-80/07*, the General Court (GC) gave a helpful summary of the considerations to be taken into account in relation to Article 7(1)(c) of the regulation (that being the equivalent of section 3(1)(c) of the Act. It said:

“18 Under Article 7(1)(c) of Regulation No 40/94, ‘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 or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service’ are not to be registered. In addition, Article 7(2) of Regulation No 40/94 (now Article 7(2) of Regulation No 207/2009) states that, ‘paragraph 1 shall apply notwithstanding that the grounds of non-registrability obtain in only part of the Community’.

19 By prohibiting the registration of such signs, that article 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 (Case C-191/01 P *OHIM v Wrigley* [2003] ECR I-12447, paragraph 31).

20 Furthermore, the signs covered by Article 7(1)(c) of Regulation No 40/94 are signs regarded as incapable of performing the essential function of a trade mark, namely that of identifying the commercial origin of the goods or services, thus enabling the consumer who acquired the product or service to repeat the experience, if it proves to be a positive, or avoid it, if it proves to be negative, on the occasion of a subsequent acquisition (Case T-219/00 *Ellos v OHIM (ELLOS)* [2002] ECR II-753, paragraph 28, and Case T-348/02 *Quicj v OHIM (Quick)* [2003] ECR II-5071, paragraph 28).

21 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 (see the judgment of 9 July 2008 in Case T-323/05 *Coffee Store v OHIM (THE COFFEE STORE)*, not published in the ECR, paragraph 31 and the case-law cited). Accordingly, a sign's descriptiveness can only be assessed by reference to the goods or services concerned and to the way in which it is understood by the relevant public (Case T-322/03 *Telefon & Buch v OHIM-Herold Business Data (WEISSE SEITEN)* [2006] ECR II-835, paragraph 90).

22 It follows that, for a sign to be caught by the prohibition set out in that provision, there must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the goods and services in question or one of their characteristics (see Case T-19/04 *Metso Paper Automation v OHIM (PAPERLAB)* [2005] ECR II-2383, paragraph 25 and the case-law cited).

23 It must finally be pointed out that the criteria established by the case-law for the purpose of determining whether a word mark composed of several word elements is descriptive or not are identical to those applied in the case of a word mark containing only a single element (Case T-28/06 *Rheinfelsquellen H. Hövelmann v OHIM (VOM URSPRUNG HER VOLLKOMMEN)* [2007] ECR II-4413, paragraph 21).

24. The Court of Justice of the European Union (CJEU) in Case C-363/99 stated:

“98. As a general rule, a mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics for the purposes of Article 3(1)(c) of the Directive. Merely bringing together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned.”

“102. It is also irrelevant whether the characteristics of the goods or services which may be the subject of the description are commercially essential or merely ancillary. The wording of Article 3(1)(c) of the Directive does not draw

any distinction by reference to the characteristics which may be designated by the signs or indication of which the mark consists. In fact, in the light of the public interest underlying the provision, any undertaking must be able freely to use such signs and indications to describe any characteristic whatsoever of its own goods, irrespective of how significant the characteristic may be commercially.”

25. In *Alcon Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-192/03 P* it was held that use after the date of the application could be used to draw conclusions as to the position at the date of application. Such use can also go to the issue of foreseeability in relation to use of the term (see *Wm Wrigley Jr Company Case C-191/01P*).

26. Guinot’s evidence exhibited at HW1 has been taken from technical, scientific or medical journals. Whilst Ms Whelbourn indicates that it has been filed to show use of PRO-COLLAGEN in the scientific community, I have to take into account what the average consumer would make of the mark. The goods for which registration is sought are skincare products –goods for application to the skin to e.g. cleanse or moisturise. They are everyday goods that will be used by the general public. These then are the average consumer of the goods.

27. There is no dispute that ‘pro-’ is a prefix meaning in favour of, supporting or acting as a substitute for (something). Neither is there any dispute that ‘collagen’ is a protein which forms the chief constituent of the fibrils of skin. Despite the somewhat technical nature of collagen, as shown in the extracts exhibited at HW1, I consider the average consumer would be aware of collagen being a constituent of skin and of its importance and role in the hydration, firmness and appearance of skin. As the evidence shows, goods such as those for which registration is sought, are frequently promoted on the basis of their scientific or quasi-scientific benefits and the use of information of a somewhat technical nature is commonplace. For example Ms Parmesan’s evidence includes the following:

- Page 46. An extract from Slimming magazine which advertises a competition to win “a gaggle of luxurious Elemis goodies”. The extract itself is undated but refers to a competition with a closing date of 30 October 2004. The text indicates that the Pro-Collagen Marine Cream “contains collagen-boosting marine algae and other natural extracts that help boost cellular renewal, skin firmness and elasticity, and protect against free-radicals”. Other products shown on the page are said to have an “enzyme action [to] brighten and clarify the complexion”.
- Page 47. An extract from In Style magazine of December 2004, indicates that “The skin on the neck has fewer sebaceous glands than that on your face....”
- Page 75. An extract from Tatler of May 2007 states: “Pro-Collagen Quartz Lift Serum by Elemis contains high levels of the alga *Padina pavonica* which encourages the production of glycoaminoglycans, molecules made up of hyaluronic acid—a substance that can hold up to 1,000 times its weight in moisture”.

- Page 82. An extract from the Daily Mail of 10 May 2007 which indicates that the 'Elemis Pro-Collagen Oxygenating Night Cream includes anti-ageing ingredients Padina Pavonica, Leminana Digitata, Red Coral and Hexapeptide'.
- Page 83. An extract from Health and Beauty Salon of April 2007. Referring to the Elemis Pro-Collagen Quartz Lift Serum it says it contains 'an algae extract that creates calcium crystals that have an anti-ageing effect on skin as well as stimulating the production of glycosaminoglycans (to firm and moisturise); Quartz and rhodochrosite-minerals that preserve cellular performance and help preserve the fibroblast cells responsible for skin firmness; galactoarabinan, a polysaccharide extracted from the larch tree which stimulates cell removal.....'.
- Page 91. An extract from Tatler of April 2007. It explains that the Elemis Pro-Collagen Quartz Lift Serum contains 'Mineral boosting actives, Rhodochrosite and Quartz [which] help optimise cellular activity...' and 'galactoarabinan, a highly effective Polysaccharide from the North American Larch tree [which] stimulates cell renewal...'

28. All of these extracts are taken from magazines and newspapers in general circulation in the UK well before the relevant date in these proceedings. And I am further supported in my view by Steiner own's advertising material exhibited at SH2 to Mr Harrington's evidence. Again using the page numbering as shown in that exhibited to Ms Parmesan's witness statement, the promotional material at pages 8 and 9 indicates that the Elemis Pro-Collagen Marine Cream is anti-ageing and provides 'accelerated collagen support'. The text shown at page 10 indicates that 'Formulations are designed to...boost collagen support through cell communication...'. At page 11, the text explains the 'three distinct actions needed for effective Anti-Ageing' one of which is 'Extra-Cellular Restructuring' where "collagen supporting and cell plumping actives are formulated to target and strengthen the outer skin matrix'. At page 12, rapid results are said to be achieved as '[t]his powerful Anti-Ageing cream dramatically increases collagen support, skin firmness and elasticity.....' The extracts from the Elemis website exhibited at HW5 suggest that by using the products the "skin's natural collagen network is supported, helping to promote skin elasticity and hydration".

29. 'PRO-' meaning 'supporting' is a commonly used prefix (e.g. pro-choice, pro-democracy, pro-life). Collagen is a component of skin, its existence and function often forming part of the advertising material of many traders, as the evidence shows. When considering the mark as a whole I do not consider the mark PRO-COLLAGEN was, at the relevant date, in any way syntactically unusual when used in relation to products which are intended for use on the skin to support the skin's own collagen nor do I consider that the average consumer would have needed any explanation of the mark to understand its meaning. It describes the goods as supporting collagen. In my view this is exactly how the average consumer will see the mark-as an indication that the goods support collagen with the aim of improving the appearance of the skin. I believe there is (and was at the relevant date) a 'direct and specific' relationship between the words which make up the mark and all of the goods included within the specification.

30. Taking all matters into account, I find that the mark was registered in breach of section 3(1)(c) of the Act in relation to all goods.

31. In *Koninklijke KPN Nederland NV v Benelux Merkenbureau* the ECJ stated:

“86. In particular, a word mark which is descriptive of characteristics of goods or services for the purposes of Article 3(1)(c) of the Directive is, on that account, necessarily devoid of any distinctive character with regard to the same goods or services within the meaning of Article 3(1)(b) of the Directive. A mark may none the less be devoid of any distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive.”

32. Article 3(1)(b) of the Directive is the equivalent of section 3(1)(b) of the Act. Insofar as I have found that registration of the trade mark was contrary to section 3(1)(c) of the Act I must find that it was also contrary to section 3(1)(b) of the Act. That said, I intend to consider the objection under section 3(1)(b) of the Act on its own merits.

33. In *Develey Holding GmbH & Co Beteiligungs KG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-238/06 P* the CJEU stated:

“79. According to consistent case-law, the distinctive character of a trade mark within the meaning of Article 7(1)(b) of Regulation No 40/94 means that the mark in question makes it possible 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 those of other undertakings (Joined Cases C-473/01 P and C-474/01 P *Procter & Gamble v OHIM* [2004] ECR I-5173, paragraph 32, and Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 42). That distinctive character must be assessed, first, by reference to the products or services in respect of which registration has been applied for and, second, by reference to the perception of the relevant public (*Procter & Gamble v OHIM*, paragraph 33, and Case C-24/05 P *Storck v OHIM* [2006] ECR I-5677, paragraph 23).”

34. The GC in *Rewe Zentral AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-79/00* described the issue in a clear and practical manner:

“26. The signs referred to in Article 7(1)(b) of Regulation No 40/94 are signs which are regarded as incapable of performing the essential function of a trade mark, namely that of identifying the origin of the goods or services, thus enabling the consumer who acquired them to repeat the experience, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent acquisition.”

35. The mark as applied for has no particular stylisation. Given the descriptive nature of the trade mark, the average consumer will not perceive it as originating from a particular undertaking but will see it as describing the purpose of the product sold

under it. That being so, and separate from the finding under section 3(1)(c) of the Act, the trade mark is devoid of any distinctive character for the goods claimed and thus offends against section 3(1)(b) of the Act.

36. In respect of the objection under section 3(1)(d) of the Act I take note of the GC's comments in *Telefon & Buch Verlagsgesellschaft mbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-322/03* where it stated:

“49 Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Mertz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma (BSS)* [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public's perception of the mark (*BSS*, paragraph 37).

50 With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (*BSS*, paragraph 38).

51 Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and *BSS*, paragraph 39).”

37. In order to succeed under this ground, Guinot must establish that at the date of application, the term PRO-COLLAGEN was in usage in trade sectors covering the trade in the goods of the application. Much of the evidence filed by Ms Whelbourn at HW2 and HW3, as set out above, is not in English and no translations have been provided. These pages are obviously taken from foreign websites and so do not assist Guinot. Also at HW2 and HW3 there is evidence taken from the beautyflash.co.uk website offering a moisturiser described as a 'light pro-collagen daily hydrating formula' under the name Medik8 Hydr8 Pro Collagen SPF 25 Hydration. The price is shown in £ sterling. There is also reference within these exhibits (pages 40 and 41) to Provera's Pro-Collagen anti-wrinkle gel, Ipg's Pro-Collagen Firming Cream and the Sanctuary's Pro-Collagen Youth Serum, all offered in £ sterling. This material, however, was downloaded on either 3 December 2009 or 12 May 2010, both well after the relevant date.

38. Guinot has failed to establish that at the date of application the term PRO-COLLAGEN was in usage in trade sectors covering the trade in the goods of the application. The ground of opposition brought under section 3(1)(d) fails.

Acquired distinctive character through use

39. As I indicated above, Steiner submit that if and to the extent that I find against them under section 3(1), then the mark has acquired distinctiveness through the use made of it. In *Windsurfing Chiemsee Produktions-und Vertriebs GmbH (WSC) v Boots-und Segelzubehör Walter Huber and Franz Attenberger* Joined Cases C-108/97 and C-109/97, the ECJ stated:

“51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.

52. If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied. However, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data such as predetermined percentages”.

40. In *Bach and Bach Flower Remedies Trade Marks* Morrit LJ stated, at paragraph 49:

“First, use of a mark does not prove that the mark is distinctive. Increased use, of itself, does not do so either. The use and increased use must be in a distinctive sense to have any materiality.”

Earlier, in the same judgment, he said:

“45. If to a real or hypothetical individual a word or mark is ambiguous in the sense that it may be distinctive or descriptive then it cannot comply with the requirements of the Act for it will not provide the necessary distinction or guarantee. It is in that sense that a common or descriptive meaning must be displaced. It is also in that sense that I accept the second submission made by counsel for HHL before Neuberger J.”

41. In the same judgment, Chadwick LJ states, on page 535 at line 11 et seq:

“As Morrit L.J. has pointed out, a reasonably well informed and reasonably observant and circumspect consumer would know, if it be the case, that the words or word are widely used in a generic or descriptive sense-even if he is,

himself, aware that they are also used in a distinctive sense. With that knowledge, it seems to me impossible for him to say that the words identify, for him, the goods as originating from a particular undertaking. Knowing, as he does, that the words may be intended as descriptive, he cannot assert that he understands them as necessarily distinctive.”

42. In *Rautaruukki Oyj v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-269/06, the GC stated:

“43 Article 7(3) of Regulation No 40/94 provides that the absolute grounds for refusal do not preclude the registration of a trade mark if it has become distinctive in relation to the goods or services for which registration is requested in consequence of the use which has been made of it. In the circumstances referred to in Article 7(3) of Regulation No 40/94, the fact that the sign which constitutes the mark in question is actually perceived by the relevant section of the public as an indication of the commercial origin of a product or service is the result of the economic effort made by the trade mark applicant. That fact justifies putting aside the public interest considerations underlying Article 7(1)(b) to (d), which require that the marks referred to in those provisions may be freely used by all in order to avoid conceding an unjustified competitive advantage to a single trader (*Shape of a bottle of beer*, paragraph 21 above, at paragraph 41, and *Shape of a sweet*, paragraph 21 above, at paragraph 55).

44 First, it is clear from the case-law that the acquisition of distinctiveness through use of a mark requires that at least a significant proportion of the relevant section of the public identifies the products or services as originating from a particular undertaking because of the mark. However, the circumstances in which the condition as to the acquisition of distinctiveness through use may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data, such as specific percentages (see *Shape of a sweet*, paragraph 21 above, paragraph 56, and case-law cited)...

46 Third, in assessing, in a particular case, whether a mark has become distinctive through use, account must be taken of factors such as, inter alia: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the significance of the investments by the undertaking to promote it; the proportion of the relevant class of person who, because of the mark, identify the goods as originating from a particular undertaking and statements from chambers of commerce and industry or other trade and professional associations. If, on the basis of those factors, the relevant class of persons, or at least a significant proportion thereof, identifies the goods as originating from a particular undertaking because of the trade mark, it must be concluded that the requirement for registering the mark laid down in Article 7(3) of Regulation No 40/94 is satisfied (see *Shape of a sweet*, paragraph 21 above at paragraph 58, and case-law cited).”

43. I also take note of the comments of the GC in *CNH Global NV v Office for Harmonization in the Internal Market (Trade Marks and Designs)*(OHIM) Case T-378/07 where it stated:

“54 As regards, secondly, sales volumes and advertising material, it must be pointed out that, according to the case-law, they constitute secondary evidence which may support, where relevant, direct evidence of distinctive character acquired through use, such as provided by the affidavits. Sales volumes and advertising material as such do not show that the public targeted by the goods in question perceives the sign as an indication of commercial origin. Accordingly, as regards the Member States for which no other evidence has been produced, proof of distinctive character acquired through use cannot be furnished by the mere production of sales volumes and advertising material (see that the effect Texture of a glass surface, paragraph 41).”

44. The mark PRO-COLLAGEN has an obvious descriptive relevance to goods which support collagen which is the way the average consumer will view the mark. The more descriptive or non-distinctive a mark is, the more important it is to consider what, if anything, the proprietor has done to educate consumers that the mark is, in fact, a trade mark.

45. Mr Harrington gives evidence that the mark PRO-COLLAGEN was launched on the UK market in May 2003 and has been used on a range of anti-ageing products. Turnover has steadily increased from an approximate annual figure of £1m in 2003 to over £4m in 2006 with a figure for the 15 month period ending March 2008 given as £7.3m.

46. I have no evidence from the trade or from the public to show how they view the mark. What is shown in the evidence is a range of advertising material. Approximate annual advertising costs are given as ranging from between £50k to £352K and £419K for the same periods. The turnover and advertising figures both amount to significant sums though I am given no information which allows me to consider them in terms of the relevant market, which must be of immense size. Advertising has appeared in a significant number of magazines and publications on general circulation and over a period of time. Certain products within the range have won awards from some of these advertisers.

The evidence filed shows how the mark is promoted both by Steiner itself and by third parties: it overwhelmingly shows the mark PRO-COLLAGEN to have been used with the sign ELEMIS. The examples of packaging supplied also show the sign ELEMIS prominently, with the words PRO-COLLAGEN positioned elsewhere on that packaging along with other, clearly descriptive, words for example “PRO-COLLAGEN Oxgenating Night Cream Anti-Ageing” and “PRO-COLLAGEN HAND and Nail Cream Anti-Ageing” (see GP1).

47. In *Société des Produits Nestlé SA v Mars UK Ltd* Case C-353/03, the CJEU stated:

“29 The expression ‘use of the mark as a trade mark’ must therefore be understood as referring solely to use of the mark for the purposes of the identification, by the relevant class of persons, of the products or services as originating from a given undertaking.

30 Yet, such identification, and thus acquisition of distinctive character, may be as a result both of the use, as part of a registered trade mark, of a component thereof and of the use of a separate mark in conjunction with a registered trade mark. In both cases it is sufficient that, in consequence of such use, the relevant class of person actually perceive the products or services, designated exclusively by the mark applied for, as originating from a given undertaking.

32 In the final analysis, the reply to the question raised must be that the distinctive character of a mark referred to in Article 3(3) of the Directive, may be acquired in consequence of the use of that mark as part of or in conjunction with a registered trade mark.”

48. Steiner’s evidence of use shows prominent and consistent use of the mark ELEMIS. Whilst use with other matter can be taken into account, use of the mark PRO-COLLAGEN is, as set out above, overwhelmingly used in a descriptive manner. The positioning of the words PRO-COLLAGEN on the packaging with other descriptive words, for example, reinforces its use as a descriptor.

49. Steiner has not established that, at the date of application, its trade mark had acquired distinctiveness as a result of the use made of it.

The objection under section 3(6) of the Act

50. Whilst my finding in respect of the grounds of opposition based on section 3(1)(b) and (c) of the Act effectively determine these proceedings, objection has also been brought under the provisions of section 3(6) of the Act. I intend to deal with this objection quite briefly.

51. Section 3(6) states:

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

52. In *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367, Lindsay J considered the meaning of ‘bad faith’ and stated:

“I shall not attempt to define bad faith in this context. Plainly it includes dishonesty and, as I would hold, includes also some dealing 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.”

53. I set out above at paragraph 2 the basis of Guinot’s objection under this ground. It is, in effect, twofold. First, it is claimed that Steiner must have been aware of the

meaning of the words making up the mark and that it must have been aware of the use of these words by other companies in the same area of business and secondly, that the implication to be taken from this is that Steiner was attempting to monopolise a word that should be free for others to use.

54. Guinot cannot rely on “implication”. In *Royal Enfield Trade Mark* [2002] RPC 24, Simon Thorley QC sitting as the Appointed Person, said:

“An allegation that a trade mark has been applied for in bad faith is a serious allegation. It is an allegation of a form of commercial fraud. A plea of fraud should not lightly be made (see Lord Denning MR *Associated Leisure v Associated Newspapers* [1970] 2 QB 450 at 456) and if made should be distinctly alleged and distinctly proved. It is not permissible to leave fraud to be inferred from the facts (see *Davy v Garrett* (1878) 7 Ch D 473 at 489). In my judgment precisely the same considerations apply to an allegation of bad faith made under Section 3(6). It should not be made unless it can be fully and properly pleaded and should not be upheld unless it is distinctly proved and this will rarely be possible by a process of inference.”

55. The evidence filed by Guinot does not support its claimed ground of opposition. There is no evidence of what use, if any, other companies were making of the words PRO-COLLAGEN at the relevant date. Even if others were using it, I take into account the comments of Arnold J in *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited and others* [2008] EWHC 3032 (Ch) where it was stated:

“189. In my judgment it follows from the foregoing considerations that it does not constitute bad faith for a party to apply to register a Community trade mark merely because he knows that third parties are using the same mark in relation to identical goods or services, let alone where the third parties are using similar marks and/or are using them in relation to similar goods or services. The applicant may believe that he has a superior right to registration and use of the mark. For example, it is not uncommon for prospective claimants who intend to sue a prospective defendant for passing off first to file an application for registration to strengthen their position. Even if the applicant does not believe that he has a superior right to registration and use of the mark, he may still believe that he is entitled to registration. The applicant may not intend to seek to enforce the trade mark against the third parties and/or may know or believe that the third parties would have a defence to a claim for infringement on one of the bases discussed above. In particular, the applicant may wish to secure exclusivity in the bulk of the Community while knowing that third parties have local rights in certain areas. An applicant who proceeds on the basis explicitly provided for in Article 107 can hardly be said to be abusing the Community trade mark system.”

56. The objection founded on section 3(6) of the Act fails.

Summary

57. The opposition fails under section 3(1)(a) and (d) and section 3(6) of the Act but succeeds in relation to grounds brought under section 3(1)(b) and (c) of the Act.

Costs

58. Guinot's opposition has succeeded, albeit under limited grounds, and consequently it is entitled to an award of costs in its favour. I take into account that fact that both sides filed evidence and that a hearing has taken place. I also bear in mind that there was a duplication of some of that evidence and that some of the evidence filed on behalf of Guinot was not relevant given that it was in a foreign language. I award costs on the following basis:

Preparing a statement and considering the other side's statement:	£200
Fee:	£200
Preparing evidence and considering the other side's evidence:	£600
Preparing for and attendance at the hearing:	£500
Total:	£1500

59. I order Steiner Beauty Products, Inc to pay Guinot the sum of £1500. 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 03 day of June 2011

**Ann Corbett
For the Registrar
The Comptroller-General**