

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2032996
by The Boots Company PLC to register a trade mark
in Class 3**

**AND IN THE MATTER OF Opposition thereto under
No 44713 by Revlon (Suisse) S.A.**

Background and Pleadings

1. On 8 September 1995, The Boots Company PLC applied to register the trade mark BOOTS AQUAMARINE in respect of "Non-medicated toilet preparations; cosmetics; soaps; perfumery; essential oils; body sprays" in Class 3.
2. On 11 June 1996, Revlon (Suisse) S.A. filed notice of opposition.
3. The grounds of opposition (insofar as they were pursued before me) are:-
 - (a) Under Section 5(2)(b) of Act based upon four UK trade mark registrations in Class 3 in the opponent's name for the mark REVLON AQUAMARINE;
 - (b) Under Section 5(4)(a) of the Act on the basis that the opponent enjoys a reputation under the marks REVLON AQUAMARINE and AQUAMARINE for toiletry, personal or hair care products, and use of the applicant's mark at the date of the application was liable to be prevented by the law of passing-off;
 - (c) Under Section 3(6) of the Act as the application was made in bad faith because:-
 - (i) At the time of making the application the applicant had been actively

engaged in the promoting of the opponent's shampoo and conditioner range under the mark AQUAMARINE; in these circumstances the applicant's actions fell below the standards of acceptable commercial behaviour; and

- (ii) The applicant had no bona fide intention to use the mark across the full width of the specification of goods.

4. The opponent points out that three of the opponent's four registrations of REVLON AQUAMARINE in Class 3 carry a disclaimer of any exclusive right to the use of the word AQUAMARINE. The applicant accepts that the opponent has used REVLON AQUAMARINE on a small scale in relation to shampoo and conditioners. The grounds of opposition are otherwise denied.

5. Both sides seek an award of costs.

6. The matter came to be heard on 4 December 2000 when Ms F Clark appeared as Counsel for the opponent, and Ms M Morris of Boots legal department appeared on behalf of the applicant.

The Evidence

7. The applicant's evidence consists of a statutory declaration dated 17 August 1998 by Ian Alexander Hawtin, who is the Company Secretary of The Boots Company PLC.

8. The opponent's evidence consists of two affidavits dated 20 February 1998 and 11 June 1999 by Archibald M Ahern, who is the Director of Trade Marks for the Revlon group of companies. The latter affidavit is in reply to Mr Hawtin's evidence. The opponent also filed a statutory declaration dated 30 July 1999 by Claire Christina Hutchinson, who is a Trade Mark Attorney with the GSCP Partnership who act for the opponent in the UK. Ms Hutchinson's evidence is also said to be in reply to Mr Hawtin's evidence.

9. I have reviewed this evidence and reached the following conclusions:-

- (a) The opponent has not made out its claim to have also sold a lotion deodorant and anti-perspirant under the mark AQUAMARINE "since the early 1960s"
- (b) The opponent has been selling a range of hair shampoos and conditioners under the mark AQUAMARINE since about 1990;
- (c) These products also carried the housemark REVLON, which was applied to the goods in a prominent manner running sideways virtually from the top to the bottom of the container for the goods;
- (d) The mark REVLON also appeared prominently in the opponent's promotional material for its AQUAMARINE hair care products;
- (e) At some time around the beginning of 1995 the applicant engaged in a special promotion of the opponent's hair products, offering its customers 35 pence off their next purchase of AQUAMARINE shampoo and conditioners;
- (f) Although the promotion was of REVLON AQUAMARINE products, the money-off voucher to be retained and returned by the customer referred only to AQUAMARINE shampoo and conditioner;
- (g) About a month after the date of the application the applicant put the mark AQUAMARINE into use as a secondary brand for one of a range of body lotion products;
- (h) These products also carried the BOOTS housemark in a smaller but quite prominent logo form.

Decision

10. I turn first to the ground of opposition under Section 5(4)(a). It is common ground that in order to succeed under this heading the opponent has to establish that, on the balance of probability, it would have succeeded in a passing-off action against the applicant at the date of the application for registration (the material date). If the opponent would have succeeded in respect of some goods but not others, the opposition should succeed to that extent. I must consider all "normal and fair" use of the applicant's mark in assessing whether the opponent had a passing off right.

11. The essential requirements for an action of passing off are not in dispute. The necessary elements of the action for passing off are that:

- (a) the plaintiff's goods or services have acquired a goodwill in the market and are known by some distinguishing feature;
- (b) there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services of the defendant are those of the claimant; and
- (c) the claimant has suffered or is likely to suffer damage as a result of the defendant's misrepresentation.

12. The applicant disputes that the opponent enjoyed a "substantial" goodwill under the mark REVLON AQUAMARINE at the material date. I think this is misconceived. As Ms Clark pointed out, there is no rule of law as to the use that is necessary to found a passing off action. In Wadlow's Law of Passing-Off it is said (at 6.08) that:-

"A mark can only become distinctive by user, but there is no rule of law as to what kind or amount of user is necessary or sufficient to found the action. What is in issue is whether there has been a material misrepresentation, which in turn depends on

whether the mark has become distinctive to a sufficient proportion of the public. In general, the plaintiff's case will be strengthened by user which has lasted a long time and been on a large scale, but neither is essential. Cases in which the plaintiff has genuinely failed because of inadequate user have been rare in modern times. Occasionally, decisions have referred to periods of several months, or even years, as being inadequate to appropriate marks of very low inherent capacity to distinguish. Although inherently distinctive marks will be protected after a shorter period than ones which are descriptive or otherwise non-distinctive, it may be doubted if the marks in question would have been protected whatever the length of use."

13. The opponent has promoted its goods under the mark REVLON AQUAMARINE since 1990. The opponent's sales of hair shampoo and conditioner in 1994 amounted to £598K and it spent £199K promoting the product. This is plainly not de minimis use. Further, I do not accept that the word AQUAMARINE is non-distinctive for hair shampoo and conditioner. The applicant points out that its goods are sold in containers of the colour aquamarine. However, the applicant's mark is not the colour aquamarine but the word. Other traders do not need to use the word 'aquamarine' on a product simply because it comes in a container of that colour. It does not describe any characteristic of shampoo and conditioner. It may not be the strongest mark in the world but the word AQUAMARINE is capable of distinguishing the opponent's hair shampoo and conditioner.

14. The second leg of the applicant's argument is that the opponent's hair shampoos and conditioners are known by the mark REVLON AQUAMARINE not AQUAMARINE alone. Examination of the opponent's product lends some support to this contention. Although REVLON and AQUAMARINE are used as separate marks and not as a composite single mark (the mark REVLON running at a right angle down the side of the container) the mark REVLON is indisputably very prominent - more so than with most 'house' marks. However, the mark AQUAMARINE is also prominent and (as I have noted in my findings above) the applicant saw no need to include the word REVLON on the money-off voucher it issued to its customers in 1995 to promote the opponent's products. This suggests that, at least without further indication, the word AQUAMARINE identified REVLON's shampoo and conditioners

to Boots' staff in 1995. I see no reason to suppose that Boots' customers would have held a different view.

15. The opponent also claims to have made longstanding use of the mark AQUAMARINE in relation to a lotion deodorant and anti-perspirant product. The evidence to support this claim is essentially a single sentence in Mr Ahern's first affidavit to the effect that:-

"Revlon has manufactured and sold a product called AQUAMARINE since the early 1960's in the United Kingdom."

Exhibited to Mr Ahern's affidavit is a sample of the product (which looks quite old to me) together with a warning letter issued by the opponent in 1970 referring to its use of the mark AQUAMARINE.

16. The onus is on the opponent to make out its case under Section 5(4)(a). The opponent's evidence regarding its use of the mark in relation to a deodorant lotion is, in my view, little more than an assertion. Ms Clark suggested that it should be accepted because the applicant made no request to cross examine Mr Ahern on his evidence. She further suggested that the opponent might have had difficulty in providing details of its sales of the deodorant lotion under the mark AQUAMARINE because of the complex structure of the Revlon group of companies.

17. I observe that:-

- (a) The opponent has put in no evidence to support the latter assertion;
- (b) If the opponent was using the mark in relation to deodorants/anti-perspirants at the material date, it seems very odd that it can find records from 1970 but not more recent records;
- (c) Accepting the suggestion that a mere assertion should be accepted in the

absence of cross examination would be turning the onus of proof on its head;

- (d) The applicant says it has investigated the position in the market and could find no use of the opponent's AQUAMARINE deodorant product (although Ms Morris very fairly accepted that the opponent had recently told them where they could purchase the product).

18. I conclude that there is no or no sufficient evidence to justify the opponent's claim to have owned a goodwill at the material date under the mark AQUAMARINE in respect of any goods other than hair shampoos and conditioners.

19. Approaching the matter on this footing, would normal and fair use of BOOTS AQUAMARINE have amounted to a misrepresentation at the material date? Ms Clarke drew my attention to *Tavener Rutledge Ltd v Specters* 1959 RPC 83 and 355, *Lever and Goodwin* (1887) 4 RPC 492 and *United Biscuits v Asda Stores* 1997 RPC 513 as support for the proposition that the presence of a distinguishing word mark (in this case BOOTS) is not a barrier to the opponent's case. In the first two of these cases there was evidence of the defendant using deceptive get-up. In the more recent of the two - *Tavener Rutledge* - the distinguishing word marks were nowhere near as prominent as the (identical) get-up. I do not find these cases of much assistance. The *United Biscuits* case is more relevant because it demonstrates (see headnote 9 and page 538) that there is passing-off if the similarities between the respective signs causes a substantial number of persons to wrongly suppose that the respective goods are manufactured by the claimant - even if they would be aware that the ASDA PUFFIN is not the McVITES PENGUIN. For her part, Mrs Morris relied upon *Fisons v Godwin* 1976 RPC 653 as support for her submission that the presence of different and prominent 'house' marks on competing products will normally be sufficient to avoid a misrepresentation even if there are similarities between the other signs of identification used by the parties. I believe that this case is also of assistance, although each case turns on its own facts.

20. It is common ground that I must consider the effect of normal and fair use of the

applicant's mark in respect of all the goods covered by the application. However, the parties do not agree about what would count as normal and fair use of the applicant's mark. Ms Clark suggested that use of BOOTS and AQUAMARINE in different locations on the applicant's goods (eg with BOOTS at the top and AQUAMARINE at the bottom of the container) might represent normal and fair use. Mrs Morris thought that the use of the words BOOTS and AQUAMARINE would have to be in fairly close proximity to constitute normal and fair use of the composite mark BOOTS AQUAMARINE. I believe Ms Morris is correct about this. In this connection, Ms Morris submitted that the use that the applicant had so far made of the mark, as exemplified in exhibit IAH3 to Mr Hawtin's evidence, was normal and fair use of the mark applied for. Ms Clark disagreed. Curiously, not on the ground that AQUAMARINE was too prominent in this example, but on the ground that AQUAMARINE was not being used in a trade mark sense. I disagree. I believe it is an example of normal and fair use of the mark applied for.

21. The high point of the opponent's case is that at the beginning of 1995 the applicant engaged in a special promotion of the opponent's REVLON AQUAMARINE shampoo and conditioner. The money-off voucher issued to the public by the applicant, which was to be retained and returned to BOOTS carried only the name AQUAMARINE to identify the opponent's shampoos and conditioners. The applicant's specification includes hair care products under the generic term "non-medicated toilet preparations." It seems to me that the appearance of a BOOTS AQUAMARINE hair shampoo and conditioner in September 1995 was likely to have resulted in a substantial number of BOOTS customers believing that either the BOOTS hair shampoo/conditioner was the one they had purchased previously or that the opponent was now manufacturing an equivalent product for BOOTS.

22. The same reasoning extends to other hair care products, but I see no reason to believe that a substantial number of members of the public would have had cause to reach a similar conclusion as a result of the use of the mark BOOTS AQUAMARINE in respect of the other goods in the specification. For example, I see no reason to suppose that a member of the public familiar with the opponent's AQUAMARINE hair products would expect a BOOTS AQUAMARINE body spray to originate from, or otherwise be connected in trade with, the

opponent. The word AQUAMARINE (being the name of a gemstone as well as the colour) is typical of the sort of names used for personal care products usually, as in this case, as a secondary means of identification in a trade mark or quasi trade mark sense. It is not so distinctive in this market that the public would inevitably be lead to expect some trade connection between any two undertakings using that word as a mark for different (albeit similar) goods carrying prominent distinguishing 'house' marks.

23. If I am right that use of the applicant's mark in relation to hair products would have amounted to a misrepresentation at the material date, I believe that a finding of likely damage to the opponent's goodwill follows in this case. A false belief that a BOOTS AQUAMARINE hair product was manufactured by REVLON was likely to result in diversion of sales. It follows that the opponent's case under Section 5(4)(a) succeeds in respect of 'hair products' but not otherwise.

24. I approach the opposition under Section 5(2) of the Act taking account of the following guidance from the European Court of Justice (ECJ) in *Sabel BV v Puma AG* (1998 RPC 199 at 224), *Canon v MGM* (1999 ETMR 1) and *Lloyd Schufabrik Meyer & Co GmbH v Klijsen Handel BV* (1999 ETMR 690 at 698) and *Marca Mode CV v Addidas AG & Others* (2000 ETMR 723):

- a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- b) the matter must be judged through the eyes of the average consumer, of the goods/services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind;
- c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components;

e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it;

g) mere association, in the strict sense that the later mark simply brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2);

h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

i) but if the association between the marks results in a likelihood that the average consumer will wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the Section.

25. The opponent has four registrations in Class 3 of the mark REVLON AQUAMARINE. These are numbered 806059, 836265, 1442770 and 1442774. These are all 'earlier trade marks' for the purposes of Section 5(2)(b) of the Act.

26. I find it convenient to consider the matter first on the basis of the opponent's registration number 836265, which is registered in respect of 'perfumed cologne'. These goods are included within the applicant's specification. The respective goods can therefore be considered identical.

27. The respective marks are clearly not identical. Both marks incorporate the word

AQUAMARINE, but the first word in each mark - REVLON and BOOTS respectively - is entirely different. On the face of it I fail to see how the average consumer - who is deemed to be reasonably observant and circumspect - could mistake one mark for the other in normal and fair use.

28. The opponent's case is primarily that there is a likelihood of indirect confusion through association. Put plainly, that the public will believe that BOOTS AQUAMARINE is an 'own brand' version of REVLON AQUAMARINE made by REVLON for BOOTS.

29. Unlike the situation with hair care products, there is no evidence that the opponent has any reputation under the mark REVLON AQUAMARINE in respect of 'perfumed cologne', so there can be no suggestion that the inherent distinctiveness of the word AQUAMARINE has been enhanced by such use.

30. In these circumstances, the average consumer would have had no reason to go beyond the obvious message sent by these marks - that BOOTS AQUAMARINE cologne comes from BOOTS and REVLON AQUAMARINE cologne comes from REVLON. The position might have been different if the common word in the marks was highly distinctive (such as an invented or unusual word) or if the opponent had a registration for AQUAMARINE solus - which would have required me to assume that that word alone was distinctive of the opponent's cologne.

31. For the reasons given above, I find that the opposition under Section 5(2)(b) based upon earlier trade mark 836265 fails.

32. The opponent's other registrations of REVLON AQUAMARINE in Class 3 cover a wider range of goods. Each of these registrations includes a disclaimer of any exclusive right to the use of the word AQUAMARINE. Ms Clark urged me to ignore the disclaimers, the reason for which was unclear. At least two of the registrations cover cosmetics. The names of colours are plainly not distinctive for goods such as eye shadow or nail polish and this may be the reason for the disclaimers. But whether there is a good reason for these disclaimers or not

(judged by today's market conditions and requirements for registration), the existence of these disclaimers is a matter to be taken into account for the reasons I gave in PACO/PACO LIFE IN COLOUR 2000 RPC 451. Nothing which was said in this case persuades me that my earlier findings were wrong. Taking the disclaimers into account the opponent's case based upon its earlier trade marks 806059, 1442770 and 1442774 is bound to fail. However, in the light of my finding in respect of earlier trade mark 836265 it is doubtful whether my decision would have any different if the disclaimers were ignored.

33. This brings me to the opponent's grounds of opposition under Section 3(6) of the Act. The first ground is that the applicant's conduct in making the application falls below acceptable standards of commercial behaviour having regard to the applicant's previous knowledge and active promotion of REVLON AQUAMARINE products. That can only apply to hair products. I have already found for the opponent in respect of hair products under Section 5(4)(a) of the Act. The opponent's case under Section 3(6), based upon the same facts, does not succeed to any greater extent.

34. The second ground of opposition under Section 3(6) is that, contrary to the statement on the form of application, the applicant had no bona fide intention to use the mark in respect of all the goods listed in the specification. The applicant denies this ground of opposition. The applicant has clearly used the mark in respect of a body spray product. Beyond that there is no evidence which assists me either way. The specification is not so wide as to itself give rise to doubt as to whether the statement on the application form can be true. In these circumstances I look to the party which carries the burden of proof - the opponent. The burden of proof has not been discharged with the result that this ground of opposition also fails.

35. The opposition under Section 5(4)(a) has succeeded in respect of 'hair products'. The other grounds of opposition have failed.

36. If the applicant files a Form TM21 within 28 days amending the specification by the addition of the words "; but not including hair products", this application will be allowed to proceed to registration. In the absence of such an amendment the application will be refused

in total.

37. This brings me to the question of costs. The opposition has partly succeeded and partly failed. In the circumstances I make no order about costs.

Dated this 5 Day of January 2001

Allan James

For the Registrar

The Comptroller General