

**IN THE TRIBUNAL OF THE REGISTRAR OF TRADE MARKS
TRADE MARKS ACT, NO. 194 OF 1993**

In the matter between:

UNILEVER PLC

Applicant

and

DESIGNER GROUP HOLDINGS LIMITED

Opponent

JUDGMENT

The Applicant is Unilever Plc, a public company incorporated in terms of the laws of the United Kingdom with its principal place of business at Port Sunlight, Wirral, Merseyside, England (the "Applicant"). The Applicant has applied to register trade mark application no. 2004/20128 **SKIN FOOD** in class 3 in respect of the following goods:

"Soaps, cleaning preparations, perfumery, essential oils, aromatherapy products, massage preparations, deodorants and antiperspirants, hair care preparations, non-medicated toilet preparations, bath and shower preparations, skin care preparations, oils, creams and lotions for the skin, shaving preparations, pre-shave and aftershave preparations, depilatory preparations, sun-tanning and sun protection preparations, cosmetics, make-up and make-up removing preparations, petroleum jelly, lip care preparations, talcum powder, cotton wool, cotton sticks, cosmetic pads,

tissues or wipes, beauty masks and facial packs”.

The Opponent is Designer Group (Pty) Limited, a private company with its registered address at 2 Eglin Road, Sunninghill (“the Opponent”).

The Applicant and the Opponent are both manufacturers and distributors of cosmetic products, including hair care, body care and deodorant products.

The opposition to the registration of the Applicant’s mark is based on the provisions of sections 9, 10 (1) and 10 (2)(a), (b), (c) of the Trade Marks Act, Act 194 of 1993 (“the Act”. The relevant provision of the Act provides as follows:

Section 9 – Registrable trade marks:

“(1) In order to be registrable, a trade mark shall be capable of distinguishing the goods or services of a person in respect of which it is registered or proposed to be registered from the goods or services of another person either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within those limitations.

(2) A mark shall be considered to be capable of distinguishing within the meaning of subsection (1) if, at the date of application for registration, it is inherently capable of so distinguishing or it is capable of distinguishing by prior use thereof.”

Section 10 – Unregistrable trade marks:

“The following marks shall not be registered as trade marks or, if registered,

shall, subject to the provisions of sections 3 and 70, be liable to be removed from the register:

(1) a mark which does not constitute a mark,

(2) a mark which-

(a) is not capable of distinguishing within the meaning of section 9,

or

(b) consists exclusively of a sign or an indication which may serve,

in trade, to designate the kind, quality, quantity, intended

purpose, value, geographical origin or other characteristics of

the goods or services, or the mode or time of production of the

goods or rendering of the services,

(c) consists exclusively of a sign or an indication which has become

customary in the current language or in the bona fide and

established practice of the trade.

Provided that a mark shall not be refused registration by virtue of the provisions of paragraph (2) or, if registered, shall not be liable to be removed from the register by virtue of the said provisions if at the date of the application for registration or at the date of an application for removal from the register, as the case may be, it has in fact become capable of distinguishing within the meaning of section 9 as a result of use made of the mark.”

The Opponent contends that the onus rests upon the Applicant to satisfy the Registrar that its trade mark qualifies for registration. If the Applicant is not able to discharge this onus, the application should be refused

(Webster & Page South African Law of Trade Marks para 8.41).

The Applicant has the onus of proving that a trade mark qualifies for registration. If there is any doubt whether the mark should be registered, the application should be refused. What the Applicant has to establish is that there is no reasonable probability, i.e. no likelihood, of consumer deception or confusion **(The Upjohn Company v Merck and Another 1987 (3) SA 221 (T) at 224.**

In essence, the issue in this matter is whether SKIN FOOD is inherently capable of distinguishing the Applicant's goods from those of other traders, or whether it has become so capable of distinguishing as at the date of the trade mark application, or whether SKIN FOOD is merely a descriptive term, alluding to the characteristics and intended purpose of the goods concerned, which is commonly used and has become customary in language in the South African cosmetic industry.

The Opponent's submission is that SKIN FOOD has become a language in common use in the cosmetic industry. The submission is taken further in that, if the subject trade mark application succeeded, it would amount to the Applicant acquiring a statutory monopoly in the mark SKIN FOOD. The mark according to the Opponent, consists exclusively of ordinary English words descriptive of the goods in respect of which the Applicant seeks registration.

The Opponent made reference to sample of examples taken from the market place. The purpose of examples alleges the Opponent were to illustrate that

the word FOOD in the cosmetic industry, was often used to describe cosmetics that have an added feature of a multi-vitamin complex to feed the skin with nutrients and vitamins. In support of this contention, the Opponent referred to **Annexures A2 – A5** on pages 15 to 19 of the records as examples use in South Africa of the phrase SKIN FOOD. The Opponent submits that it is used to describe the characteristics and quality of body lotions. In this regard it is the Opponent's contention that SKIN FOOD does not distinguish any supplier's goods from the goods of other traders. One of the examples referred to was LIME SKIN FOOD.

The Opponent further submits that the word "FOOD" has a broad meaning and may have a more specific indication when it is used in a descriptive context. The context in which the word "FOOD" food is used according to the Opponent, varies depending on the item in relation to which the word is used. As an example the Opponent submitted that the term "hair food" has been used for several years by traders in cosmetic products to identify products that are sold to maintain and improve the condition of hair. In this regard reference was made to **Annexure A7** on pages 20 – 26 of the records showing examples of seven established hair food products that are sold in the South Africa market. The Opponent referred to other examples as per **Annexure 8 – 9**, such as WELEDA SKIN FOOD, LIME SKIN FOOD and BEE YUMMY SKIN FOOD.

According to the Opponent, the Applicant itself uses the word "food" in such descriptive terms in relation to the advertisement of its VASELINE

INTENSIVE CARE skin product. In this regard the Opponent made reference to **Annexure 4** at pages 61 – 74. What appears on the respective pages is according to the Opponent the descriptive phrases “FOOD FOR YOUR BODY”, “FOOD FOR YOUR SOUL” and “FOOD FOR YOUR SKIN”. It is with respect clear that when consumers see such phrases, the message conveyed would obviously make them think of skin products. I am inclined to agree that “SKIN FOOD” is descriptive of the Applicant’s products. The Opponent in this regard cited **Estee Lauder Cosmetics Ltd v Registrar of Trade Marks 1993 (3) SA 43 (T)**, where McCreath J, remarked as follows [at 47 – 48B]:

“It is a well established principle that a laudatory epithet cannot be made the subject of trade mark monopoly since it would involve an undue limitation on the rights of others to the free choice of language in describing and advertising their goods”.

Some words are so apt for normal description that no trade mark use and momentary distinctiveness can justify a permanent monopoly (**Dunlop Rubber Co’s Application (1942) 59 RPC 134 at 157**). In **Judy’s Pride Fashions (Pty) Ltd v Registrar of Trade Marks 1997 (2) SA 87 (T) at 96B-D**, it was remarked that:

“ It has long been the law that even with evidence of use, it is generally not possible to register a mark that is a ‘laudatory epithet’, the name of the product, common to trade, or appropriate to describe some attribute of the product”.

In **Joseph Crosfield & Sons Ltd’s Application (1909) 26 RPC 837 (A)** at 854 – 5 it was stated that: “Wealthy traders are habitually eager to enclose

part of the great common of the English language and to exclude the general public of the present day and of the future from access to the enclosure”.

With reference to the above it is the Opponent’s submission that, SKIN FOOD is not inherently capable of distinguishing the Applicant goods from those of other traders, as it is wholly descriptive.

According to the Opponent, apart from being non-distinctive, SKIN FOOD is a term in common use in the cosmetic trade or industry. In practice this means that a word or phrase in common use in the trade or reasonably required for use in trade could never become registrable through use. The phrase

“common to the trade” means matter which is in common use in the trade.

However, even if the matter is not commonly used in the trade or reasonably required for use therein, it may nevertheless be of a non-distinctive character **[Distillers Corporation (SA) Ltd v South African Breweries Ltd & Another 1973 (4) 154]**.

It has been held that the prohibition only applies when the whole mark propounded for registration is reasonably required for use in the trade. If only one element of the composite mark is so required, the mark is not necessarily disqualified, but may be registered subject to the entry of a disclaimer in respect of the matter so required **[Kentucky Tobacco Corp (Pty) Ltd v s Registrar of Trade Marks 1984 (2) SA 335 (T) at 340, Estee Lauder Cosmetics Ltd v Registrar of Trade Marks 1993 (3) SA 43 (T)]**. The words SEVEN STARS were held not to be registrable in respect of clothing and that the phrase constituted a laudatory epithet which was required for use in the trade **[Star Shirt and Clothing Factory Natal (Pty) Ltd v Registrar of Trade**

Marks 1972 (1) SA 572 (T)].

Counsel for the Opponent submitted that in view of the authorities referred to above, SKIN FOOD was in fact a term other competitors in the trade may wish to use. A further submission was that there was no justification why the Applicant should be given exclusive rights in the phrase, as it was in common use in the trade and had become customary in the current language. As to the acquired distinctiveness, the Applicant submitted that even if SKIN FOOD was not capable of distinguishing before, it had become capable through use. In this regard the Applicant submitted that it should be allowed registration.

The evidence of acquired distinctiveness has been disputed vehemently by the Opponent. The evidence according to the Opponent is not use of the mark SKIN FOOD, but is relation to its VASELINE INTENSIVE CARE product range. What is prominent on the advertisement according to the Opponent is the mark VASELINE which is the name or mark the consumers associate with the Applicant. What distinguishes the Applicant's product according to the Opponent, is not SKIN FOOD standing alone but VASELINE and VASELINE INTENSIVE CARE used together with SKIN FOOD.

The advertising revenue provided by the Applicant is also challenged by the Opponent in that it doesn't contribute to showing the mark is distinctive. In **Pleasure Foods (Pty) Ltd v TMI Foods CC t/a Mega Burger and Another** 2004 (4) SA 181 (T) at 190, it was stated that " The fact that applicant has expended a large sum in advertising its large burgers, does not create the distinctiveness which the term lacks".

In **Joseph Crosfield & Sons Ltd's Application (1909) 26 RPC 837 (A)** at **854 – 5** it was stated that: “ Wealthy traders are habitually eager to enclose part of the great common of the English language and to exclude the general public of the present day and of the future from access to the enclosure. Whenever there has been long continued and extensive use as a trade mark, that circumstances should, in ordinary use, suffice to establish a right to proceed. But mere user is not necessarily decisive, it is apparent that no word can be registered unless it is distinctive, that is to say, is “adapted to distinguish” the goods of the proprietor from the goods of other persons.

There are words that cannot have a secondary meaning as indicating only goods of the Applicant”. For a word or words to be really distinctive of a person's goods, it must generally speaking be incapable of application to the goods of anyone else **The Canadian Shredded Wheat Co. Ltd v Kellogg Co. Canada Ltd]**.

It is the Opponent's submission, in view of the principles enunciated above, that the Applicant use of SKIN FOOD was not as a trade mark, and has certainly not been so perceived by the public. It has therefore, not become distinctive of the goods of the Applicant.

The Applicant contends that SKIN FOOD irrespective of its inherent or *de facto* registrability, has clearly been used by the Applicant as a trade mark i.e to perform the function of a badge of origin. According to the Applicant if SKIN FOOD fulfils the requirements of section 10(2), then it cannot at the same time fall foul of the provisions of section 10(1) of the Act. The evidence

The evidence submitted according to the Applicant clearly shows its mark is registrable.

Regarding section 10(2)(a) Counsel on behalf of the Applicant argued that, in many cases the courts have been concerned with highly laudatory or purely descriptive matter. He further argued that courts refrained from attempting to exhaustively define the meaning of the expression "adapted to distinguish". Applicant's Counsel contends further that there is nothing objectionable in a trade mark alluding to the character or quality of goods, particularly if done in a somewhat indirect and colourful way and in a manner that is not in everyday linguistic.

Insofar as the dictionary meaning is concerned, the Applicant contends that SKIN FOOD is not the type of product which is intended and used to be taken internally as a person would with "food" in the normal sense of the word. The primary definition understood by the public according to the Applicant is that, the word "food" in relation to humans means something either eaten or drunk and not something that is "absorbed" in the manner in which "plants" absorb their food. At worst Applicant's Counsel submits it would allude in a fanciful manner, to the qualities and characteristics of the Applicant's products. The Applicant further disputes the submission that SKIN FOOD describes the characteristics and quality of body lotions.

The Applicant in the present case relies on the use of SKIN FOOD. It is my respectful finding that the phrase is generic to the industry in question and not distinctive. Accordingly, SKIN FOOD is not sufficient to distinguish the

Applicant's goods from the goods of competitors in the same industry. It should further be noted that SKIN FOOD as per the evidence filed, has always been used in conjunction with the trade mark VASELINE. The Applicant has always advertised its products by using the combination as it is shown on the billboards.

The Applicant on the evidence before this Tribunal has failed to prove that the mark as applied for qualifies to be registered. To grant a monopoly considering the circumstances in this matter will interfere with other traders to describe goods as such. There is a likelihood that other traders in the cosmetic industry would desire to use SKIN FOOD in the ordinary course of their trade.

In view of the above, the following judgement is made:

- (i) the opposition is upheld with costs
- (ii) the registration of trade mark no. 2004/20128 is refused.



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DEPUTY REGISTRAR OF TRADE MARKS

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