

12.4.84
File reference No. 671/80

IN THE MATTER of the Trade Marks Ordinance
AND

IN THE MATTER of an Application for
registration of the Trade Mark
"PRESCRIPTIVES" in Class 3 in Part A of
the Register by Estee Lauder Cosmetics Ltd.

DECISION

of

Mr. J.P. Latham acting for the Registrar of Trade Marks at a hearing
held on 21st July 1983

Miss R. Sweetman of Messrs. Baker & McKenzie appeared for the Applicants

On 10th October 1979 Estee Lauder Cosmetics Limited, a Canadian limited liability corporation (hereinafter called "the applicant") applied for a Part A registration under the Trade Marks Ordinance, Cap. 43 (hereinafter called "the Ordinance") of the word mark Prescriptives. The word was in fact written "PRESCRIPTIVES" with an elongated right stroke of the letter "V" but this makes no difference to the case. The application was in Class 3 in respect of perfumes, eau de cologne, skin lotion, body lotion, toilet soap, lipstick, nail polish, personal deodorants and antiperspirants, bath oil, mascara, rouge, eyebrow pencil, preparations for hair care, namely shampoos, curling and setting preparations, hair colouring preparations; face and body powder, and nail polish remover. No user in Hong Kong was claimed and therefore I am only concerned with the prima facie case.

The Registrar initially asked for promotional material concerning the goods which was received by letter dated 5th June 1980 from the applicants solicitors Messrs. Baker & McKenzie. I think I should at this stage describe the contents of this brochure as it does have some importance in this application.

The brochure sets out all the products in the range of cosmetics and skin preparations proposed to be covered by the mark. It gives a description of their use and in most cases the various attributes claimed by the applicants. It is clear from the brochure that the goods break down into 2 main areas. Firstly a range of cosmetics covering usual items such as lipsticks, powder and mascara, and secondly a skin care range. This second range is divided into a number of different areas namely, the Cleansing system to cleanse the skin, the Energizing system (described as the core of Prescriptives) to improve skin quality, the Protective system to protect against the environment and Problem Solvers to deal with skin blemishes. Clearly therefore, the Prescriptives range is much more than a simple range of cosmetics, but deals with areas of skin care which border on medical care and advice.

After consideration of this brochure the Registrar wrote to Baker & McKenzie on 26th June 1980 saying the proposed mark was not acceptable for registration under S. 9(1)(d) of the Ordinance because it had a direct reference to the character or quality of the goods in question. A number of letters followed between Baker & McKenzie and the Registrar which ended with a letter of 3rd September 1982 from the Registrar maintaining the objection under S. 9(1)(d). The applicant then applied for a formal hearing under Rule 18 of the Trade Mark Rules.

At the hearing before me Miss Sweetman of Baker & McKenzie appeared for the applicants and raised a number of arguments.

First she submitted that prescriptives was a word unknown in the English Language although she conceded that it was not an invented word within the terms of S. 9(1)(c) of the Ordinance, and was also very similar to an existing word prescriptive. In fact Websters Third New International Dictionary does list prescriptives and gives the following definitions:-

- (1) serving to prescribe; laying down rules or directions; giving precise instructions.
- (2) acquired by, founded upon, or determined by prescription; established in or as if in law by immemorial use and enjoyment.

- (3) arising from or recognized by long standing custom: established by tradition or usage.

In any event the addition of an "s" to a known word can rarely, if ever, make any difference for the purposes of Trade Marks. The Shorter Oxford Dictionary defines prescriptive in terms virtually identical to that of Websters, and there is no need to repeat the definition. It is clear that the only one of these definitions that could have any reference to the goods is the first one.

Miss Sweetman submitted that this first definition meant giving a specific almost mandatory direction as to the way a thing should be used or carried out. She said the goods do not make any claim to being prescriptive in how they are used by the customer and that no reasonable member of the public could think or believe that cosmetics would be prescriptive in the dictionary definition.

Miss Sweetman then agreed that it was necessary to look at the noun form of the word namely prescription. She quoted to me the definition from the Shorter Oxford Dictionary as follows:-

- 1. The action of prescribing or appointing beforehand; that which is prescribed; written or explicit direction or injunction.
- 2. A direction or formula (usu.) written by a physician for the composition and use of a medicine; the medicine prescribed. In early use, more widely, 'doctor's orders'.
- 3. Restriction, limitation"

She submitted that only definition 2 could really have any reference to the goods and that I should look at how the proposed mark would appear to be public, and in doing this adopt a common sense view. These latter propositions were based on statements in the Charm Case (1928) 45 RPC 421 and the Tastee-Freez Case (1960) RPC 255. She argued that in the public mind the most likely connection would be with a medical prescription. Further, no reasonable person would think of a medical prescription when buying goods at a cosmetics counter. She argued that many medicines were available without a doctors prescription and people only went to a doctor for a prescription when they could not get the medicine or drug themselves.

She then referred me to the case of the Motorine T.M. (1907). 2 Ch 435 and argued that the word Prescriptives had for less direct reference than Motorine.

I will first deal with my views on the law. S. 9(1)(d) of the Ordinance prohibits registration of a proposed mark if there is a direct reference to the character or quality of the goods. The question of the construction of these words and their application to any mark applied for must necessarily be somewhat subjective. Indeed, as the editors of Kerly's Law of Trade Marks observe at paragraph 8-29 (11th Edition), few of the decided cases are of value in laying down definite principles on S. 9(1)(d) or its UK equivalent and many of the cases are inconsistent in their approach. However some cases do state principles of general application and I have considered a number of these which I feel assist in this decision.

First however, I must consider the 'Motorine' Case (1907) 2 Ch 435 which was the only case referred to at any length by Miss Sweetman. In that case Warrington J. said at pages 446-447:-

"The goods in question consist of lubricating oil. I cannot see how the word 'motorine' has any direct reference to the character and quality of those goods. No doubt it suggests that in some way they are oils which are to be used in connection with a motor but beyond that it has no reference either to the character or quality of the goods and such reference as the use of the two syllables of the word 'motor' in the word 'motorine' has to the character or quality seems to me not to be that direct reference which the Act contemplates"

I find this a strange decision which I do not understand. The learned Judge states that 'Motorine' suggests that the product is oil for use with a motor but then says this is not a direct reference to the character or quality of the goods, a proposition which after his first finding I would have thought impossible. Unfortunately there is no analysis in the judgment about how the words 'direct reference' are being construed and therefore I cannot find any assistance or principle to be derived from this case. I regard it as an authority solely for the fact that the word 'motorine' does not have a direct reference to motor oil and nothing else. It is I think also worthy of comment that the 'Motorine' case was one of first cases to go to the High Court in England after the passing of the 1905 Trade Marks Act where the word 'direct' was introduced for the first time.

I have also considered a number of other cases which while not cited in the arguments, do I think give assistance in the present case.

The first case I have considered is the 'Oomphies' Trade Mark 64 RPC 27. In that case the Registrar refused an application for registration of the word 'Oomphies' in Class 25 for shoes. The evidence showed that the word 'Oomph' was American slang denoting sex appeal, and the Registrar held (inter alia) that the word 'Oomphies' not an invented word and had a direct reference to the character and quality of the goods. On appeal the Evershed J (as he then was) agreed with the Registrar that the word was not an invented one, but he held that it did not have a direct reference to the character and quality of the goods. It was argued before the judge that 'Oomphies' shoes would give the wearer more sex appeal and therefore there was a direct reference to the character or quality of the shoes. In dealing with this argument the judge examined various factors to be considered in deciding whether there was a direct reference and said at page 32:

" I think that, in approaching a problem of this kind, one has to bear in mind that the Court must consider, as the Legislature considered, whether the use of particular marks in reference to particular goods would embarrass or harass other traders, and it seems to me that, where you take an ordinary word in common use properly applicable in its ordinary meaning to the class of goods to which it is sought to be applied by the applicant, the Court must be slow to give to the applicant in effect a monopoly of that epithet.

- 4 -

" Where you take a word which is exceedingly un-
"common by comparison, I think that somewhat different
"considerations apply and if you say that it has a
"direct reference, you are going to assume that this
"word, which I assume not to be an invented word, has
"a much more precise significance and a much greater
"circulation than, I think, on the evidence plainly
"it has.

This passage from the judgment gives guidelines as to how to approach on the one hand common words either in general use or in the particular business and on the other hand very rare words. I do not think prescriptive can be said to be a very rare word and certainly the words prescription and prescribe are common words, and I think the appropriate test in this case is that which Evershed J laid down for common words. This view is strengthened by an advertisement for skin cosmetics from a womens magazine (a copy of which is annexed to this decision) which uses the phrase "Prescribed for you by a leading Dermatologist" and thus shows user in the cosmetics trade.

The next case I have looked at is the 'Verve' Trade Mark (1958) RPC 3. In this case it was sought to register the word 'Verve' for phonograph records and albums or sets of phonograph records. The hearing officer refused registration under Part A because he considered (inter alia) the mark contravened the English equivalent of S. 9(1)(d) of the Ordinance. On appeal Lloyd-Jacob J. analysed at some length whether the reference to the character or quality of goods was direct or indirect. He said at pages 5 and 6:

" The mark proposed consists of the word 'Verve',
"a word which has an accepted meaning of vivacity, en-
"thusiasm or spirit, particularly in relation to artis-
"tic performances. The goods in respect of which the
"application is made are 'phonograph records and albums
"or sets of phonograph records'. Having regard to the
"fact that such articles are normally marketed as
"carriers for that which is recorded thereon, it is,
"I think, right to construe this classification of
"goods as including 'phonographic recordings for re-
"production'. Such recordings will be characterised
"inter alia by the identity of the work performed and
"the manner of its performance. For example, it could
"be a named 'Beethoven' symphony and played by named
"performers. Such recordings will also possess as-
"certainable qualities. For they may be particularly
"secured as by high fidelity apparatus or particularly
"reproducible as by specially selected equipment.
"The reproduction of the phonographic recording will
"therefore constitute a performance the intrinsic
"features of which may include both character and
"quality. If for simplification the classification
"of goods is re-stated as 'performance means', both
"character and quality will or may be conditioned by
"the performance their actuation will permit, and this
"must necessarily be related to the original perform-
"ance of which they are the record.

" It is, I think, unlikely that the method or means
"of actuation of reproduction could impart vivacity,
"enthusiasm or spirit to a performance which as original-
"ly recorded was not so characterised, but it is plain
"that an original performance of such a character need
"not lose this attribute in the process of reproduction.
"This classification of goods will therefore include
"means for performing in a vivacious, enthusiastic or
"spirited manner, albeit indirectly by phonographic
"reproduction, an artistic work. So stated, the
"attribute is seen to relate specifically to the
"performance, but this, in my judgment, is not assured-
"ly outside the content of the phrase 'character or
"quality' of the goods'. By similar reasoning, so also
"would a reference to the artistic work being performed
"fall within the phrase, as for example symphonic or
"folk song. It is, as I think, impossible to regard
"public usage as sufficiently precise in the use of
"the word 'record' as to permit of a clear differentia-
"tion between the means of securing a performance and
"the performance thus conveniently made available.
"The question posed, therefore, in effect raises the
"question: has the mark applied for a direct reference
"to the character or quality of the performance? If
"synonymous with 'vivacious, enthusiastic or spirited'
"it clearly would. There is not, so far as I know,
"an adjectival use of the word 'verve', nor an adject-
"ive formed from it, so that it is not in actual truth
"a synonym.

" The Hearing Officer has arrived at the conclusion
"that its use in relation to records would connote re-
"cords which would permit performances having the attri-
"butes of vivacity, enthusiasm or spirit, an approach,
"it will be noted, which avoids fine distinctions of
"syntax. Whether this is necessarily appropriate in
"relation to persons whose vocabulary includes the word
"'verve' if used according to any of its dictionary
"meanings may of course be arguable, but I cannot hold
"his conclusion to be without sufficient justification
"and I must conclude, therefore, that the Applicants
"have not discharged the onus of proving that the mark
"applied for qualifies under sec. 9 for registration
"in Part A of the Register."

Lloyd-Jacob J. went on to say at page 7:

"This case to my mind illustrates the value of user in
establishing the reaction of the purchasing public to the
use of an ingeniously selected word. So long as speculation
on that matter is unavoidable, assumptions must be made
and weighed, and the paramount duty of the Registrar to
maintain the purity of the register may well incline him
to place reliance upon possibilities which experience in
actual trade practice may demonstrate to be so far
removed from reality as to be improbable, when the
factual distinctiveness of a mark comes to be measured".

This case is particularly useful in my view because a number of principles having a direct application to the present case can be found in it. These are:

- (a) that the words 'direct reference to the character and quality of the goods' in S. 9(1)(d) of the Ordinance do not have to be narrowly interpreted. If this were the case the only consideration would have been the technical quality of reproduction not the characteristics of the performance.
- (b) that where it is not unreasonable to construe a noun adjectivally if the adjectival use of the word is a direct reference then so will the noun use. This point would also be valid in my view for transpositions to and from other parts of speech.
- (c) it establishes "the paramount duty of the Registrar to maintain the purity of the Register", and the value of user in deciding the effect of an ingeniously selected word.

I have looked at the law in cases not cited to me because at first sight this was not a straight-forward case and therefore an examination of the principles used in previous cases was necessary to establish the approach to be adopted by me.

Dealing first with the meaning of the word 'prescriptives' I would be more inclined to accept the arguments of Miss Sweetman in relation to the make up part of the goods, but they do not seem to me to be correct for the skin care goods. In the promotional material supplied to the Registrar the following sentences were used to describe the cleansing system - "Prescriptives Cleansers are part of the three dimensional system recommended for you by a Prescriptives Analyst. Each of the cleansers is tailored to meet individual needs. Used as prescribed (my underlining) they cleanse tone and exfoliate in one process". Later to describe the energizing system the following was written - "Daily Dose has been recommended for you in a specific strength based on your skins individual needs". The description of the problem solvers contained the following - "Each problem has its own specific problem solver that is used only when and where it is needed, right on the problem spot. Each was made to be more effective because it is precise in its function and confined in its use".

If these various statements are looked at then it is quite clear that the idea of this skin care system is that an individual has their skin examined by, to quote the brochure "a trained Prescriptives Analyst", who then recommends certain of the skin care products and gives specific instructions about their use. It is only if these specific directions are followed will the best results be obtained. This is exactly the first dictionary definition of the word 'prescriptives' and there is, therefore in my view a direct reference to the character and quality of the goods.

This approach is based on that of the judge and hearing officer in the 'Verve' case in that while the skin lotions and creams do not themselves give the directions, the salesperson and no doubt the containers do give the precise instructions. This conforms with the wider interpretation of the phrase 'direct reference to the character and quality of the goods' used in the 'Verve' case.

While the words prescriptives and prescriptive are not very common words they do I think have a sufficiently precise significance to have a direct reference to these goods.

I must now turn to consider the meanings of the other grammatical forms namely prescribe and prescription which I must do in following the 'Verve' case. While no argument was put to me on the verb form prescribe I must also consider this in view of its fairly common usage. Prescribe is defined by the Shorter Oxford Dictionary as follows:-

1. To write to describe beforehand.
2. To write or lay down as a rule or direction to be followed; to appoint, ordain, direct, enjoin. To lay down a rule; to dictate, appoint, direct.
3. To advise or order the use of (a medicine, etc.) with directions for the manner of using it.
4. To limit; to confine within bounds."

Clearly the third definition of prescribe and the second definition of prescription given above are the ones which are most likely apply in this case although the second definition of prescribe and the first definition of prescription also could be relevant. The word prescription is most commonly used in connection with a written direction for the use of a particular medicine, but does not only apply to this or equally just to restricted drugs only obtainable with a doctors authority. It can mean a direction or formula for the composition and use of a medicine. If therefore any of the goods in the applicants 'Prescriptives' range of goods can be properly described as medicines then I think there must be a direct reference to the character or quality of goods both in the manufacture and the sale. It seems clear to me that the Energizing System which is designed and formulated to improve skin quality and the Problem Solvers which cure skin blemishes such as spots and pimples can without stretching the definition of medicine be so described.

The word prescribe, which is the verb form, has its definition set out above. Looking at the third definition this is exactly what happens with these products. A purchaser is advised by a beautician to use the particular product and given directions as to its use. The dictionary definition shows that its use in this form is far less restricted to prescribing by a physician than the word prescription, but is also commonly used for prescribing of other sorts. This view is reinforced by the applicants use of the word 'prescribed' in their brochure on the Prescriptives range of goods as set out earlier on page 6. I therefore find that the verb form prescribe also has a direct reference to the character or quality of the goods.

I have also considered the question of whether the proposed mark contravenes Section 12(1) of the Ordinance in that it is likely to deceive. I have come to the conclusion that it does not, in that prescriptive and its other grammatical forms are not solely linked to a direction from a physician, and that a reasonable member of the public is unlikely to be deceived into thinking that goods sold at a cosmetics counter are prescribed by a physician.

There are two other arguments raised at the hearing with which I must deal. First Miss Sweetman referred me to five Trade Marks in Hong Kong which she submitted had far greater direct reference to the goods covered than the Applicants proposed mark. Three of these are very similar, namely 'Revlon Formula 2', 'Charles of the Ritz prescribed skin care' and 'Charles of the Ritz Les Prescrisoins' all for cosmetics in class 3. In each of these three cases the words after the manufacturers house mark were disclaimed. This shows the practice of the Trade Mark Registry to allow additions to a manufacturers house mark of words which in themselves might well offend some part of S. 9 of the Ordinance with a disclaimer of those words. If the applicants had applied for the mark 'Estee Lauder Prescriptives' with a disclaimer of 'Prescriptives' then this similarly would probably have been allowed.

The next mark I was referred to was Directionale for bleaching preparations and other substances for laundry use; cleaning polishing scouring and abrasive preparations; soap; perfumes, essential oils, cosmetics hair lotions and dentifrices in class 3. I cannot see any direct reference to the goods in this mark. The last mark was 'Preparation H' for medical ointment and suppositories in class 5. There was a colour limitation imposed and a disclaimer of the right to use the word 'Preparation' or the letter 'H' separately. This mark was applied for in 1956 and registered in January 1957. The practice of the Registry has grown more strict with the increasingly greater numbers of Trade Marks applications and there are many old marks on the Register which if looked at afresh today might well be disallowed or only be allowed in Part B. I therefore ignore the registration of this mark in arriving at my decision, since each application must be looked at on its own merits. This approach is confirmed by the 'Madam' Trade Mark Case (1966) RPC 541 where Mr. G.H. Tookey QC said at page 545:

"Although uniformity of treatment is of course desirable as far as possible where examination of applications is concerned, I agree with the Registrar that each application must be dealt with on its merits".

Finally it was argued that the mark Prescriptives had been registered in Part A in U.S.A., South Africa and Canada and had been accepted for Part A registration in Australia and Ireland. I enquired what the position was in England and was told the mark had been accepted for a part B registration.

I was presented with no evidence of what Trade Mark law was in any of these countries nor was there any evidence on the basis of acceptance in that no letter or decision in writing setting out the grounds for acceptance was shown to me.

The approach to be used in respect of foreign registrations is set out in several cases, but is perhaps most clearly stated by Mr. D. Falconer Q.C. in the Needle Tip Trade Mark (1973) RPC 113 at pages 117 and 118 when he said:

"It was stated on behalf of the applicants that this mark has already been registered in Canada, South Africa, Eire and the United States of America and in each case so I was also informed, registration was effected without proof of user in the country concerned.

It was strongly argued that in considering the registerability of the mark in this country the fact of such registration in countries in which, so it was stated, the regulations governing the registration of trade marks are substantially the same as in this country, was a matter to be taken into account as showing that the mark is one qualified for registration in this country also. In support of this argument reference was made to a passage in the judgment of Lord Parker LCJ in Swifts Application (1962) RPC 37 (a patent case) the passage referred to being at page 47 lines 43-47.

It seems to me that the mere fact that a mark has been registered in a foreign country has little or no bearing on whether the mark is capable of distinguishing the goods of the applicant in this country. Registration in the foreign country will have been allowed according to the law and practice of that country which may differ from that of this country and may have been allowed in the light of particular circumstances and trading conditions in that country and which may be very different to those obtaining in this country. It may be that in a case where a mark applied for here has already been registered in a foreign country with a system of trade mark law similar to our own, if a written decision of the foreign tribunal allowing registration in the foreign country, and which showed the grounds of the decision and the matters taken into consideration were to be adduced on the application here, it might be persuasive as a piece of reasoning as to whether the mark should be registered here if but only if similar considerations applied in this country; but that, it seems to me is as far as registration in a foreign country could be relevant to registerability here. It is to be noted that in Swifts case the Divisional Court was influenced by what was referred to as "a scholarly and persuasive judgment of the Full Court of the High Court of Australia". On the present appeal, however all that has been relied upon is the mere fact of registration in the countries mentioned and that mere fact, as I have already stated is of little or no bearing on whether the mark is capable of distinguishing the applicants goods in this country".

This view has previously been followed in Hong Kong even in respect of UK registrations. In the 'Cosmotron' Case an opposition case (File No. 798/69) Mr. P. Murphy the Hearing Officer said at page 27:-

"However the co-existence of the marks in the UK registry obviously is a consideration to which I have to give considerable weight as our respective systems of registration of trade marks are in most respects basically the same. At the Hearing, however, no evidence was led by either party as to the circumstances which led to the co-existence of

the marks in the United Kingdom. I therefore feel that I cannot regard the bare fact that both marks have been registered in the United Kingdom as binding on me. In the absence of evidence that similar circumstances and considerations applied in the United Kingdom, I cannot regard the co-existence of the marks as justifying me in departing from the conclusions which I have reached on the basis of the evidence and the submissions made at the Hearing".

Mr. Murphy then went on to cite the 'Needle-Tip' case as authority for this view quoting part of the passage I have set out above.

Adopting this approach to the present case I have therefore taken no account of the various part A registrations put to me by Miss Sweetman.

For the reasons stated the application for registration is refused under Section 13(2) of the Ordinance as the proposed mark 'Prescriptives' fails to comply with Section 9(1)(d) of the Ordinance.

The 12th of April, 1984.

J.P. Latham

(J.P. Latham)
Senior Solicitor
p. Registrar General
(Registrar of Trade Marks)