

Decision File  
31.3.88 (2)

File No. 2953/82

IN THE MATTER of the  
Trade Marks Ordinance (Cap. 43)  
and  
IN THE MATTER of an application  
No. 2953/82 by Maybelline Co.  
for the registration of the  
trade mark "Blooming Colors"  
in Class 3 in Part B of the  
Register in respect of  
"eye shadows"

Statement of Grounds of Decision

Maybelline Co. (hereinafter called "the Applicants") of I-40 and Galloway Interchange, North Little Rock Arkansas, USA through their agents Messrs Wilkinson & Grist, Solicitors applied on the 20th October 1982 for registration of the mark "BLOOMING COLORS" in Class 3 in Part A of the Register in respect of "bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery essential oils, cosmetics, hair lotions, dentifrices."

The Application for Trade Mark on Trade Mark Form 3 was lodged on the 20th October 1982 and the statement in support of the Application which is required to be filed on Trade Mark Form No. 4 was lodged on the 27th January 1983.

On the 20th May 1983 the Registrar of Trade Marks (hereinafter called "the Registrar") refused registration of the mark in Part A of the Register pursuant to section 9(1)(d) of the Trade Marks Ordinance ("the Ordinance") on the grounds that the mark was considered to have a direct reference to the character or quality of the goods.

On the 11th February 1984 Messrs Wilkinson & Grist submitted the following considered reply on behalf of the Applicants.

"We refer to your letter of 20th May 1983 by which you held the subject mark to be descriptive and unregistrable.

We are instructed to submit herewith a principal declaration of use, some sample advertisement and sample goods showing use of the mark on the goods concerned; and some copy invoices for your consideration.

We hope the application is now in order and we look forward to receiving from you the formal notice to advertise."

The Principal Declaration of Use referred to by Messrs Wilkinson & Grist and lodged with their letter dated 11th February 1984 was a Declaration dated 20th September 1983 made by Henri F. Pellegrin and was stated to be in respect of an application in Part B of the Register and contained inter alia the following information.

1. Mr Pellegrin stated that he was the Vice President of the Applicants and had been associated with the Applicants since the year 1972. He further stated that he had a good knowledge of the records and trade of the Applicants.

2. He stated that the Applicants had used the trade mark "Blooming Colors" in respect of preparations for the beautification of the eyes in the United States since 1969 and in Hong Kong since 1979.

3. He gave details of the sales in Hong Kong of the goods bearing the above mentioned Trade Mark for the period from 1979 to 1982 and the figures given for the years 1980 and 1981 are as follows :

1980 - HK\$230,000  
1981 - HK\$250,000

4. He stated that the Applicants had advertised the goods bearing the said Trade Mark in periodicals of world-wide publication and also in the daily press in Hong Kong and that the amount expended in making the goods known in this manner for the years 1979-1982 totalled HK\$85,000.

Mr Pellegrin further stated that samples of advertisements were exhibited to the Declaration but no such samples were in fact so exhibited. Messrs Wilkinson & Grist did however enclose with their letter dated 13th February 1984 a Magazine including the sample of an advertisement, a sample of the goods and some copy invoices. I set out details of these as follows-

(1) Advertisement

The advertisement was contained in "Sisters Pictorial" No. 205 a magazine which was published in Chinese. No translation was attached but the advertisement showed inter alia palates of eye shadows with the words "blooming colors" as well as the word "Maybelline" in English. The rest of the writing was in Chinese characters.

(2) Sample of Goods

The sample of goods was in fact a card to which the goods namely eye shadows had been attached and which showed the words "blooming colors" together with the word "Maybelline" and also included reference to "Blooming Colors Frosts".

(3) Copies of Invoices

There were two copy invoices supplied dated in July 29th 1982 and September 10th 1982 both addressed to Mason International Ltd and issued not by the Applicants but by Plough Consumer Products (Asia) Ltd. Both orders referred, inter alia, to "Blues BLM CLR 3" "FR BNCH BLM CLR" "BLUMS BLM CLR 3" and "ATQUE FR BLM CLR".

No explanation as to the relationship between Plough Consumer Products (Asia) Ltd. and the applicants was given.

The Declaration was stated to be in support of an application in Part B of the Register. No formal request for transfer to Part B was made but the mark has been considered as an application in Part B since that date.

On the 16th March 1984, the Registrar wrote requesting further copies of invoices for the years 1979, 1980 and 1981, to substantiate the applicants claim of use since 1979.

On the 7th May 1984 Messrs Wilkinson & Grist wrote enclosing copies of invoices for the years 1980 and 1981 and stating that their clients could not locate further invoices dated earlier than 1980 and requesting the Registrar to accept the evidence submitted on the basis that this was an application for registration in Part B of the Register.

The further invoices consisted of four invoices dated between June & November 1981 issued not by the applicants but by Plough Consumer Products (Asia) Ltd. and addressed to Mason International Ltd. and Chong Fat Hong in Hong Kong and the other to Xian Hong Cycle Ply Ltd. of Singapore. These referred inter alia to "Blooming Blues BLM CLR" as well as in the manner referred to in the other invoices referred to above.

On the 30th June 1984 the Registrar wrote to Messrs Wilkinson & Grist as follows -

"On the strength of the evidence of user adduced, the mark is considered to be acceptable for registration in Part B of the Register in respect of the actual goods viz. "eye shadows" subject to a disclaimer of the word "COLORS" except as associated with the word "BLOOMING".

On the 6th August 1984, the Applicants lodged Form TM-33 requesting that the specification of goods be amended to "eye shadows".

On 1st October 1984 the Registrar wrote to Messrs Wilkinson & Grist indicating that the application had been considered further and commenting as follows :

"On reconsidering the acceptability of the subject mark in Part B of the Register, the words "BLOOMING" and "COLORS" should be separately disclaimed since both of them are descriptive words on their own which should be open to free use by all in the trade. "Capacity to distinguish" has partly been resulted from having "BLOOMING COLORS" used in combination. Attached please find a notice to advertise the application containing a revised condition relating to the separate disclaimers of "BLOOMING" and "COLORS".

Leave to advertise was issued on the 29th September 1984, together with the letter dated 1st October 1984, for the registration of the trade mark "Blooming Colors" in Part B of the Register in Class 3 in respect of "eye shadows". The leave to advertise was issued subject to the condition that "registration of this trade mark shall give no right to the exclusive use, separately, of the words "blooming" and "colors".

On the 20th November 1984 Messrs Wilkinson & Grist replied in the following manner -

"We refer to your letter of 1st October 1984, by which you requested separate disclaimers of "BLOOMING" and "COLORS".

Our clients have no objection to disclaim the word "COLORS". However, we are instructed to submit that "BLOOMING" meaning "having blooms unfolding, thriving in health" has no reference or relationship to its use in association with "eye-shadows". Actually, "BLOOMING COLORS" is an invented term and imposition on a disclaimer of the word "BLOOMING" is not entirely fair especially after we have submitted proof of at least two years use of the mark in Hong Kong.

In this connection, we hope you reconsider the application and waive the disclaimer of the word "BLOOMING". We return herewith notice to advertise dated 29th September 1984 for your amendment and we look forward to your reply."

On the 28th November 1984, the Registrar replied stating that :-

"It was at the direction of the Assistant Registrar General, upon approving the mark for Part B registration that both of the words "BLOOMING" and "COLORS" will have to be separately disclaimed. "BLOOMING" in Webster's Third New International Dictionary is defined as "to become colored usu. brown or red; to make glowing or radiant, brighten". Having these descriptive connotations which are directly applicable to "eye shadows", it is considered that "BLOOMING" should also be disclaimed separately."

On the 7th December 1984 Messrs Wilkinson & Grist wrote to the Registrar asking the Registrar to give written grounds of his objection that the word "blooming" should be disclaimed, in the light of the fact that evidence of distinctiveness had been filed. This was followed up by a formal request on Form TM-5 lodged on the 4th January 1985.

No further submissions or documents were lodged in support of the application by Messrs Wilkinson & Grist and no request was made for a formal hearing and there has been no such hearing.

I have considered the application acting for the Registrar General as the Registrar of Trade Marks and I give the grounds of my decision pursuant to section 13(4) of the Ordinance and Rule 20(1) of the Trade Marks Rules.

Section 9 of the Ordinance provides for registration of a trade mark in Part A of the Register and section 9(1)(d) of the Ordinance provides that a trade mark shall contain or consist of a word or words having no direct reference to the character or quality of the goods and not being according to its ordinary signification, a geographical name or a surname.

S. 10 of the Trade Marks Ordinance ("the Ordinance") was amended by the Trade Marks Amendment Ordinance 1984 with effect from the 1st September 1986 but as at the date of the application namely 20th October 1982 s. 10(1) & (2) of the Ordinance provided as follows :-

"10(1) Where any mark has for not less than two years been bona fide used in the Colony upon or in connexion with any goods (whether for sale in the Colony or exportation abroad), for the purpose of indicating that they are goods of the proprietor of the mark by virtue of manufacture, selection, certification, dealing with or offering for sale, the person claiming to be the proprietor of the mark may apply in writing to the Registrar in the prescribed manner to have the mark entered as his registered trade mark in Part B of the register in respect of such goods.

(2) The Registrar shall consider every such application for registration of a trade mark in Part B of the register, and if it appears to him, after such search, if any, as he may deem necessary, that the application is inconsistent with the provisions of subsection (1) of section 12 or section 20, or if he is not satisfied that the mark has been so used as aforesaid, or that it is capable of distinguishing the goods of the applicant, he may refuse the application, or may accept it subject to conditions, amendments, or modification as to the goods or classes of goods in respect of which the mark is to be registered, or to such limitations, if any, as to mode or place of user or otherwise as he may think right to impose, and in any other case he shall accept the application."

I will accordingly when referring to s. 10 of the Ordinance in this decision be referring to the former provisions as set out above.

Messrs Wilkinson & Grist in their submission have merely asked me to provide written grounds in the light of the fact that evidence of distinctiveness has been filed. I feel however I should deal with an argument which has been put forward on other occasions namely that for the purposes of section 10 of the Ordinance if there is a minimum degree of capacity to distinguish then provided there is 2 years

evidence of user the Registrar is not concerned with the extent of such user and is required to register that mark in Part B.

This proposal was considered at some length by the Hearing Officer in the Decision in respect of Application No. 1512/1981 in the matter of an application to register the trade mark mark " 救 心, Kyushin". This consideration commenced on page 6 of the Decision and on page 8 the Hearing Officer after considering the submissions and the case law and in particular the decision of Mr Justice Cruden in the Virginia Slims case (MP 1985 No. 2214), came to the conclusion that the Applicant had to establish not only that the mark had been used for two years prior to the application but also that the mark had some inherent capacity to distinguish and that if she considered that the Chinese characters " 救 心, " did fall into the category of "laudatory epithets" or the like as envisaged by Lord Wilberforce then she did have a discretion to refuse registration of this mark even if it was established that the mark had become, in fact, 100% distinctive.

I consider therefore that on an application under the former provisions of s. 10 of the Ordinance as set out above I do have a discretion whether or not to accept the mark for registration in Part B and it is bearing this in mind that I consider the mark applied for in this application namely "Blooming Colors" in Class 3 in respect of "eye shadows".

I consider first the meanings of the words "to bloom", "blooming" and "colors" given in the following dictionaries.

In Webster's 3rd New International Dictionary  
(Webster)

The verb "to bloom" is defined inter alia as

- to produce or yield blossoms
- to attain undergo or acquire bloom; especially; to flourish especially in youthful beauty, freshness or excellence
- to become coloured usually brown or red
- to make glowing or radiant

and in Collins English Dictionary (Collins) the verb "to bloom" is defined in similar manner but is also given the meaning of

- youthful or healthy rosiness in the cheeks or face, glow.

In Webster the adjective "blooming" is also described as

- having blooms unfolding
- thriving in health beauty and vigor; exhibiting the freshness and beauties of youth or health.

I would point out that the meaning given to the word "blooming" in the letter dated 28 November 1984 from the Registries is in fact the meaning given to the verb "to bloom".

In Webster the word "color" or "colour" has many definitions but is primarily described as

- any of a manifold phenomena of light (as red, brown, pink, gray, green, blue or white) or of visual sensation or perception that enable one to differentiate objects even though the objects may otherwise appear identical/as in size form or texture.

Webster also refers to the use of the word "color" in relation to the appearance, the complexion etc.

Webster also defines "colors" as

- a variagation of hues, tints or shades, or a basic hue marked with spots, patches, bands or streaks of one or more shades

- the use or combination of colors.

In Collins the word "colour" or in the form used in the U.S. "color" is inter alia given the meaning of

- to give or apply color to (something).
- a substance such as a dye, pigment or paint that imparts colour to something.

No evidence was submitted as to the use or purpose of eye shadows but I am aware that they are used on the eyelid or below the eye to accentuate the eye and enhance the appearance of the face. Eye shadows come in many colours and impart colour to the eye. I have no hesitation in saying that the word "colors" is descriptive of the product and of its use in that the eye shadows are of different colours and imparts colour to the eye lid when used. I note for example from the sample already referred to that the card on which the product is sold refers to Blooming Colors Frosts as "fun to use" and more relevant refers to the fact that "there are shades to shadow, contour & highlight".

I consider that for the goods in question the word "colors" on its own is a word that would fall into the category of marks that are too highly descriptive to be capable of registration per se. The word "colors" should be free to all traders involved in the production or sale of eyeshadows to use. This view appears to be accepted by the Applicants in view of their acceptance of the disclaimer of the word "colors" alone.

The word "bloom" and "blooming" have the meanings attributed to it as indicated. The word is not so directly descriptive as the word "colors" but its secondary meaning i.e. glowing, giving an impression of youthfulness does give

the impression that the eye shadow itself is glowing or particularly bright or that using it would give an appearance of youthfulness to the person using it.

No evidence has been produced by the Applicants as to the method of advertising and description of goods in the cosmetic industry. Notwithstanding this I consider I can take note of matters of which I am aware and in this respect I consider that the cosmetics industry does use fanciful wording to describe their goods. In support of my view I have seen references to such fanciful words as "shimmering" shadows, or "shimmering, glimmering" colours and shades of "different shimmers". Having noted this I do no more than bear it in mind when considering the use by traders in these goods of words such as "blooming" and "colors".

Having considered the two words separately I now consider the mark as a whole namely "Blooming Colors". I take the view that the mark as whole clearly gives the impression that the eye shadow are of particularly radiant or glowing colours and as such are directly descriptive of the goods. I consider therefore that the mark is not adapted to distinguish the goods and should be refused registration in Part A.

I turn to consider the evidence of user submitted by the Applicants in support of an application for registration in Part B of the Register under the former provisions of s. 10 of the Ordinance. It is well settled that the evidence should be considered as at the date of the application namely 20th October 1982.

The Applicants claim total sales of eye shadows sold under the mark for the year 1980-81 of \$480,000 which for the two years up to the end of 1981 shows average sales of \$240,000 per annum. The sales figures for both the years 1980-81 and for 1982 are very similar but with a slight but steady increase. No indication has been given as to the unit price on the retail market although according to the invoices the invoice price is US\$20.60 per dozen i.e. US\$1.7 per unit. If one takes the rate of exchange as HK\$1 to US\$7.78 this is approximately HK\$13 per unit. The cost per unit even in 1980-81 is likely to have been much higher on resale in the retail market. The sales figure are fairly average for goods of this sort but can be in no way be considered as very substantial. The invoices show use but it is not clear as to the relationship between the issuers and the Applicants and the reference to the marks is in an abbreviated form.

On considering the evidence of use and the advertisements produced by the Applicants it seems clear that the mark "Blooming Colors" is always used in conjunction with the Applicants Trade Mark "Maybelline" with, in my view greater prominence being given to the trade mark "Maybelline". Thus on the back of the card on which the goods would be attached one can see reference to the marks in the following form -

- Maybelline -
- BLOOMING COLORS FROSTS -

and in the front of the card and across the top

BLOOMING COLORS  
FROSTS

and MAYBELLINE along the side at right angles in much larger size and letters.

In the advertisement in Sisters Pictorial the advertisement appears in the following format -

- Maybelline
- blooming colors
- MAYBELLINE

In such cases I have to consider whether the evidence shows that the mark "Blooming Colors", even though always used with the word Maybelline, has been so used on the goods by itself so as to show that it is used as a trade mark to identifying the goods of the proprietor.

On considering the evidence of use supplied I would consider that it is sufficient to show that the mark "Blooming Colors" has been used as a trade mark. The evidence and particularly the supporting evidence is not strong but I am satisfied that the mark "Blooming Colors" on its own has been bona fide used for not less than two years prior to the date of the application for the purposes of s. 10(1) of the Ordinance.

On that basis I have to consider whether the mark is capable of distinguishing for the purpose of s. 10(2) of the Ordinance. I have taken note of the Sheen case (13 RPC 1936 p. 355) and I note that in that case Mr Justice Luxmoore, in considering the appeal from the Registrar, referred to the "Perfection" case and set out at p. 367 the principles he determined should be taken into account when considering the registration of a non-invented word. That case dealt with an application in Part A but I believe the principles can apply to an application in Part B and I set these out in relation to this case as follows :

(1) If the word or words are not within para. 9(1)(d) (having no direct reference to the character or quality of the goods) of the Ordinance then there must be a careful consideration of the merits of the particular case.

(2) The onus of satisfying the Registrar that the word or words are suitable is on the applicant.

(3) The applicant may discharge this onus by arguments based on the word or words itself and on the nature of the goods and by evidence sufficient to prove that by user the mark has become identified with the applicants goods and has acquired distinctiveness.

(4) The extent of proof required depends on the actual word to be registered. If the objections are not very strong then less evidence of use may be accepted.

(5) Certain words coming in the context of ordinary laudatory epithets such as "best" may not be capable of registration.

(6) The registration in question must not affect the use of other traders in any honest description of their goods.

In considering whether the mark as applied for is in fact capable of distinguishing the goods I have noted that the onus is on the applicants to satisfy me that the mark is capable of distinguishing so as to enable me to allow registration in Part B . The evidence of use actually supplied is limited and the arguments put forward have not been extensive.

It seems clear that I have to look at all the circumstances of the case and I have to decide, as a question of fact, whether the mark as applied for and as bona fide used is capable of distinguishing the goods in question. Having decided that I then have to decide whether I should refuse the application or whether I may accept it subject to conditions.

The evidence shows use of the mark "Blooming Colors" as a whole and no evidence has been shown of any use other than of the two words together and on one line. In this respect I am satisfied that there is no bona fide use for the purposes of s. 10(1) of the Ordinance of either of the words "Blooming" or the word "Colors" on their own and that the bona fide use for the purposes of s. 10(1) of the Ordinance is in fact of the two words together "Blooming Colors". In particular I am not satisfied that the evidence shows that the word "Blooming" on its own has been used as a trade mark for the purposes of s. 10(1) of the Ordinance.

I consider that there is a small element of distinctiveness in the phrase "Blooming Colors" which is an unusual combination and use of the two words and I consider on the basis of the evidence that the mark "Blooming Colors" as a whole has been shown by the evidence as having become capable of distinguishing the goods of the applicant.

I have decided that there has been bona fide user of the mark "Blooming Colors" and that the words together have become capable of distinguishing the applicants goods but the

mark includes the word "Colors" which is highly descriptive of the goods and which should be available to other traders to use in the ordinary course of their business.

In these circumstances I consider I have a discretion under the provisions of s. 10(2) of the Ordinance to decide whether I should refuse the mark or accept it subject to conditions.

I turn now to consider whether the mark "Blooming Colors" can be allowed for registration in Part B in respect of eye shadows subject to a suitable condition.

S. 16 of the Ordinance provides that if the trade mark contains matter common to the trade or otherwise of a non-distinctive character the Registrar may require as a condition of its entry on the Register that the proprietor shall make, inter alia, such disclaimer as the Registrar may consider necessary for the purpose of defining the rights of the Applicants under the registration.

Under the provisions of ss. 27 & 28 of the Ordinance the registration of a person in Part A or B gives to that person the exclusive right to the use of the trade mark in relation to the goods for which it is registered and the right shall be deemed to be infringed by any person who uses a mark identical with it or so nearly resembling it as to be likely to deceive or cause confusion unless the right is restricted by any conditions or limitations.

In Chapter 9 of Kerly's Law of Trade Marks & Trade Names (12th Edition) consideration is given to the imposing of conditions by way of Disclaimer and in particular I refer to para. 9-01 as follows -

"Marks are not these days normally with additions; rather, it is usual to register the minimum combination of features that the Registrar will accept as distinctive. Prima facie, then, only the whole of what is registered is protected. But since - see Chapter 14 - a registration may be infringed by taking one of its "essential features", if some part of what is registered is prominent enough to look like a trade mark on its own, the public generally may be in doubt as to whether that part enjoys separate protection. A disclaimer may then be appropriate to remove such doubts."

I consider first the condition imposed by the Registrar in the leave to advertise issued on the 29th September 1984 namely that "registration of the trade mark shall give no right to the exclusive use, separately, of the words "Blooming" and "Colors"."

The effect of imposing such a condition is to restrict the rights given on registration of the mark "Blooming Colors" in the form in which it is shown to have been used by the Applicants and registration with such condition would not inhibit the right of other traders to use the words "colors" or "blooming" separately in the normal course of their trade. Thus there would be no doubt as to the rights enjoyed by the Applicants as a result of the registration.

I consider next the condition proposed by the Applicants to the Registrar that the mark "Blooming Colors" be allowed on the Register in Part B with a total disclaimer of the word "Colors". If I were to accept the mark with this condition the applicants would have exclusive rights to the use of the word "Blooming" on its own. I have decided that this word is descriptive of the goods and that there has been no user of the mark on its own. I have already decided that there has in fact been no bona fide user of the word "Blooming" on its own for the purposes of s. 10(1) of the Ordinance. I consider therefore that the fundamental requirement of s. 10(1) of the Ordinance, namely that the mark has been used for two years immediately prior to the application has not been established and for this reason I could not accept the mark "Blooming Colors" in Part B with a disclaimer of the word "Colors". If I am wrong in my interpretation of the provisions of s. 10(1) of the Ordinance then I am still of the view that the mark may not be registered in this form as I am not satisfied that there is sufficient evidence of use of the word "Blooming" to overcome the descriptive nature of the mark for the goods in question and so as to become capable of distinguishing these goods as the goods of the applicant.

Having considered the evidence, the submissions and all the circumstances of the case I consider that the mark "Blooming Colors" can be allowed for registration in Part B subject to a condition that registration of the Trade Mark shall give no right to the exclusive use, separately of the words "Blooming" and "Colors".

I would mention, for the record, that I understand that the trade mark "Maybelline Blooming Colour" has been registered in the United Kingdom in Part B of the Register in Class 3 in respect of eye shadows under number 100 842 with a condition as to disclaimer but I have no details of the actual terms of the disclaimer and I have taken no note of this fact in arriving at my decision.

I would also mention that the mark might be capable of registration under the new provisions of s. 10 of the Ordinance if evidence were filed to satisfy me the mark "Blooming" on its own had become capable of distinguishing but any new application made under the provisions of s. 10 of the Ordinance (as amended) would have to be considered on its own facts.



A.C. Waters (Miss)  
Acting Assistant Registrar General

Dated: 31st March 1989