
October 2009

Review

Intellectual Property



Wella fails to tame CFI

Wella AG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)

Case T-471/07

Background

Since January 2006, Wella AG (“Wella”) have owned an international registration of the mark TAME IT in class 3 for “soaps, perfumes, essential oils, cosmetics, hair lotions, dentifrices” (the “Mark”). In April 2006, OHIM received a request for territorial extension of the Mark to the European Community under the Madrid Protocol.

OHIM subsequently issued a notification that the designation had been provisionally refused because that the Mark lacked distinctive character within the meaning of Article 7(1)(b) of Council Regulation (EC) 40/94 (the “Regulation”) and hence was incapable of identifying the commercial origin of the goods in question.

Despite a response by Wella challenging the provisional refusal, the examiner confirmed the refusal. Wella appealed against the examiner’s decision.

OHIM’s Second Board of Appeal allowed the appeal in part, finding that the examiner’s decision was correct in so far as it had refused the extension request in relation to hair lotions, cosmetics and essential oils (the “Products”) as the Mark was devoid of distinctive character in relation to such goods. The relevant public, being English speaking consumers in the Community would understand the expression “tame it” to be a promotional message in relation to the Products. However, in relation to “soaps, perfumeries and dentifrices”, it could not be said that the Mark lacked distinctive character and the designation was allowed to proceed for these goods.

Wella appealed to the CFI in respect of the refusal to allow the registration of the Mark for the Products.

The CFI judgment

Wella argued that the meaning of the expression “tame it” varies depending on how the word “it” is interpreted by consumers. Hence there was a degree of discretion regarding that to which a consumer would interpret “it” as referring.

Where the sign is comprised of words, its distinctiveness or otherwise should be assessed in its entirety

Agreeing with OHIM, the CFI found that distinctiveness cannot be assessed in the abstract and must be assessed by reference to the goods in respect of which protection is sought. Accordingly, in relation to the Products which may be used on hair, the relevant public is likely to perceive “tame it” as a promotional message, inciting consumers to use the Products and informing consumers of the positive characteristics and the desired effects of using the Products, namely that they will soften, control or make the hair more manageable. The Court found that it was irrelevant that when considered independently of the Products, the expression “tame it” may have other meanings.

Wella also argued that OHIM’s Second Board of Appeal had disregarded the overall impression created by the Mark. The Court found that the combination of words followed the rules of ordinary English composition and spelling. According to case law, where a sign is comprised of words, the distinctiveness of each element taken separately may be assessed but there should also be consideration of the sign in its entirety. This was the approach that OHIM’s Second Board of Appeal had taken.

As such, OHIM’s Second Board of Appeal was right to refuse the designation for essential oils, cosmetics and hair lotions. The CFI therefore dismissed the appeal and awarded costs against Wella.

This decision is not particularly surprising, since the concept of “taming” hair is in common parlance, although the phrase “tame it” may in fact be sufficiently remote from “taming” per se to be distinctive, assuming that there were evidence that it is not in widespread use in the sector.

FURTHER INFORMATION

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