

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2237923
by David Charles Jones and Jenifer Ann Jones to
register a trade mark in classes 3 and 42**

**AND IN THE MATTER OF Opposition thereto
under No 51774 by L'Oreal S.A.**

Background

1. On 30 June 2000, David Charles Jones and Jenifer Ann Jones applied to register the trade mark SPECIAL EFFECTS in Classes 3 and 42 in respect of:-

Class 3; Soaps, perfumery, essential oils, cosmetics of all kinds for face and body, shampoos, conditioners and hair lotions.

Class 42; Beauty and cosmetic therapies, treatments and services.

2. On 23 November 2000, L'Oreal S.A. filed notice of opposition to the registration of the trade mark. The grounds of opposition are, in summary, that registration would offend:

- Section 3(1)(a) of the Act because the words SPECIAL EFFECTS are non-distinctive in relation to cosmetics in Class 3 and cosmetic therapies, treatments and services in Class 42 in that SPECIAL EFFECTS make-up has a meaning that would be recognised by the public as make-up that is used to produce a special effect such as that used in films and TV, and that the trade mark is laudatory in that it suggests that the products will provide a special effect.

- Section 3(3)(b) because the mark would be deceptive if the products do not produce a special effect.

- Section 5(4)(a) because the opponent has used a trade mark consisting of the letters FX since September 1995 in relation to a trade in the UK in relation to hair products. It has further used the trade mark SPECIAL FX in relation to the same products. In view of the goodwill and reputation that the opponent enjoys as a result of this use, use of the applicants' mark is liable to be restrained by the law of passing off.

- Section 5(2)(b) because the opponent is the proprietor of earlier trade mark numbers 2015288, 2148612 and 2148615, which are all composite trade marks incorporating the letters FX. The details of all three earlier marks are shown in Annex A. All three trade marks are registered in Class 3 with effect from a date that is earlier than the date of the application in suit. All three earlier trade marks are registered in respect of goods which are identical to those for which the applicants seek registration.

3. The applicants admit the existence and validity of the opponent's earlier trade marks but

otherwise deny the grounds of opposition.

4. Both sides seek an award of costs.

Evidence

5. The applicants filed a joint statutory declaration dated 11 October 2001. The opponent filed two declarations by José Monteiro of L’Oreal dated 10 July 2001 and 3 January 2002.

Hearing

6. The matter came to be heard on 8 August 2002 when the applicants were represented by Mr J Clegg of fJ Cleveland, and the opponent was represented by Mr D Castle of Castles.

Amendment of grounds of opposition

7. The day prior to the hearing the opponent’s trade mark attorney wrote to the applicants and to the Registrar, seeking to amend the grounds of opposition. The amendment sought was the substitution of the ground of opposition based upon Section 3(1)(a) of the Trade Marks Act 1994 with Section 3(1)(b) of the Act. The opponent’s explanation for the amendment was that an error had been made in drafting the original grounds of opposition, and that it had always been the intention to include a ground of opposition under Section 3(1)(b). The explanation put forward for the delay in seeking to amend the error is that it was only noticed at the time of drafting the opponent’s skeleton argument for the hearing. The opponent maintains that the wording of the original grounds of opposition showed that a Section 3(1)(b) objection was always intended.

8. Mr Clegg’s skeleton argument recognised that the opponent’s original ground of opposition under Section 3(1)(a) of the Act was incorrectly pleaded, and that the opponent probably intended to plead one of the other sub-sections of Section 3(1) of the Act. Nevertheless he objected to the opponent’s request to amend the grounds of opposition, principally on the grounds of the lateness of the request, and also because of the potential prejudice that his clients may suffer.

9. I decided to allow the grounds of opposition to be amended. It was plain from the notice of opposition that the opponent’s objection under Section 3(1) of the Act was based upon a claim that the applicants’ trade mark was descriptive. Because of this, I invited Mr Castle to consider whether his client’s objection in fact fell most appropriately under Section 3(1)(c) of the Act. He agreed that it did. The grounds of opposition were therefore amended by the substitution of Section 3(1)(c) for Section 3(1)(a) of the Act.

Section 3(1)(c)

10. Section 3(1)(c) of the Act (insofar as relevant) is as follows:

“3.-(1) The following shall not be registered -

- (a)
- (b)
- (c) *trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,*
- (d)”

11. It was common ground before me that the test to be applied is that set out by the European Court of Justice (ECJ) in their judgement in the case of **Procter & Gamble Co v Office for Harmonisation of the Internal Market (Baby-Dry)**. The Court said (at paragraphs 35 to 37 of its judgement) that:

“35 Under Article 7(1) of Regulation 40/94, trade marks are not to be registered if they are devoid of distinctive character (sub-paragraph (b)) or if they consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, time of production of the goods or of rendering of the service, or other characteristics of the goods or service (sub-paragraph (c)).

36 Under Article 12 of Regulation 40/94, the rights conferred by the trade mark do not entitle the proprietor to prohibit a third party from using, in the course of trade, indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of the goods or the time of rendering the service, or other characteristics of the goods or service, provided he uses them in accordance with honest practices in industrial or commercial matters.

37 It is clear from those two provisions taken together that the purpose of the prohibition of registration of purely descriptive signs or indications as trade marks is, as both Procter & Gamble and the OHIM acknowledge, to prevent registration as trade marks of signs or indications which, because they are no different from the usual way of designating the relevant goods or services or their characteristics, could not fulfil the function of identifying the undertaking that markets them and are thus devoid of the distinctive character needed for that function.”

The Court concluded that:

“The signs and indications referred to in Article 7(1)(c) of Regulation number 40/94 are thus only those which may serve in normal usage from a consumer’s point of view to designate, either directly or by reference to one of their essential characteristics, goods or services such as those in respect of which registration is sought.”

12. The opponent has two objections. Firstly, that special effects is a generic term for cosmetics and cosmetic treatments associated with the production of special effects in films,

TV and similar forms of entertainment. Secondly, that the words special effects are descriptive according to the ordinary meanings of the words ‘special’ and ‘effect’, and that independently of any established generic use of the term, the words signify cosmetics of a kind that would produce any type of special effect for the user.

13. The opponent’s evidence is directed exclusively at establishing its own use of the trade marks FX and SPECIAL FX. It provides no support for the section 3(1) ground of objection. The applicants’ evidence includes a definition of the term SPECIAL EFFECTS from the Concise Oxford Dictionary. The term appears in that dictionary as meaning “*Scenic illusions created by props and camera work*”.

14. Mr Castle attached to his skeleton argument copies of the definitions of the words EFFECTS, SPECIAL EFFECTS and the letters FX, which are to be found in Collins English Dictionary. The second entry for the word “effects” is “*lighting, sounds etc., to accompany and enhance stage, film or broadcast production*”. The term SPECIAL EFFECTS is defined as “*in films, techniques used in the production of scenes that cannot be achieved by normal techniques*”. The letters FX appear in the same dictionary as “*informal, in films, for special effects*”.

15. Although I cannot exclude the possibility that cosmetics may play some role in producing special effects in films, TV etc, this is not within my personal knowledge. I do not find the dictionary entries to which my attention has been drawn to be of any great assistance in determining the matter. I note that they refer variously to the use of “techniques”, “props” and “camera work” to produce special effects in the film industry, but none of the dictionary entries indicate that cosmetics play any part in this respect.

16. In **Euro lamb** 1997 [RPC] 279, Mr Geoffrey Hobbs QC, as Appointed Person, said that the Registrar has to exercise a judgement as to whether a trade mark meets the requirements for registration. Nevertheless, when determining a ground of objection in an opposition, the Registrar is required to act in accordance with her role as a quasi judicial tribunal. This generally requires the Registrar, or the Hearing Officer acting on her behalf, to determine matters on the basis of the materials filed in evidence. Unless a fact is so well known that judicial notice may probably be taken of it, an allegation that a phrase has become generic in a particular trade can only be made out through the filing of appropriate evidence. In the absence of such evidence, a finding that there exists a category of cosmetics and cosmetic treatments known generically as “special effects”, could only be as the result of conjecture on my part. As Mr Geoffrey Hobbs QC noted in another case in which he was acting as Appointed Person, **Corgi Trade Mark** [1999] RPC 549 at pages 560 and 561, it is important to recognise the distinction between inference and conjecture. As Mr Hobbs noted, referring back to a speech by Lord MacMillan in **Jones v Great Western Railway Co.** [1930] 144LT.194 at page 202, “*a conjecture may be plausible but it is of no legal value, for its essence is that it is a mere guess*”.

17. Mr Castle attempted to cure the omission of any relevant evidence by seeking to introduce evidence from the results of his searches of the Internet. After I had stopped him from introducing this evidence in the guise of submissions, he made an application for leave to introduce the results of his various Internet searches in the form of additional evidence. Not

surprisingly, Mr Clegg resisted this application. I rejected it because:

- (a) no attempt had been made to submit any evidence that went to the ground of opposition during the periods allowed for filing such evidence;
- (b) if, as contended, the opponent's objection was present from the outset there was no reason why it should not have been addressed in the evidence that the opponent had already filed;
- (c) no explanation had been put forward for the delay in filing this evidence;
- (d) no application had been made for leave to introduce this evidence prior to the commencement of the Hearing, despite Mr Castle having filed a skeleton argument only the day before;
- (e) allowing it to be introduced during the course of the Hearing would have resulted in the applicants justifiably feeling that they had been "ambushed" with new factual information, to which they should properly have been given a chance to respond in evidence;
- (f) allowing the introduction of such evidence would therefore have almost certainly required an adjournment of the hearing;
- (g) that could not be justified in the circumstances.

18. In the absence of evidence showing that special effects is a generic term for a category of cosmetics or cosmetic services used in television, films, etc., the first of the opponent's objections under Section 3(1)(c) must be rejected.

19. It is, of course, the case that descriptiveness can be assessed by reference to the ordinary meanings of words, which can be found in dictionaries. An opponent does not have to show that a mark is already generic in a trade in the goods or services in order to make out an objection under Section 3(1)(c). However, the trade mark SPECIAL EFFECTS does not, to my mind, convey any specific information about the quality or the intended purpose of the goods or services listed in the application. It is an ambiguous term open to various interpretations. In my view, it is more likely that the average consumer would regard it as a fanciful use of a term normally associated with film making.

20. Mr Castle drew my attention to a number of so-called precedents, consisting of decisions of the Registrar and of the Appointed Person dealing with the registrability on absolute grounds of various other trade marks. I do not find these precedents of any great assistance in determining the matter before me. As Jacob J. stated in **Treat** [1996] RPC page 281, the state of the Register is, in principle, irrelevant to the question of the registrability of a new trade mark. Mr Castle asked me to pay particular attention to the decision of Mr Geoffrey Hobbs QC, again as Appointed Person, in refusing an application to register the trade mark ADAPTIVE in relation to cosmetics and creams in Class 3. Decisions of the Appointed Person are, of course, to be treated with considerable respect. However, I do not regard the

trade mark at issue in that case to be on all fours with the trade mark which is the subject of this opposition. Furthermore, Mr Hobbs' decision was not only pre- BABY-DRY, but was in fact a decision under the previous 1938 Act.

21. Taking the best view I can of the matter on the basis of the sparse material before me, my judgement is that the trade mark SPECIAL EFFECTS is not an indication which may serve, in trade, to designate the quality or intended purpose or other characteristics of the goods or services. The opponent's second objection under section 3(1)(c) therefore also fails.

22. Further, even if my conclusion on the first of the opponent's two objections is wrong, with the result that SPECIAL EFFECTS would be recognised by the average consumer within the film or television industries as designating a specialist cosmetic or cosmetic service, it does not, in my view, follow that it will be seen that way by the average consumer of beauty products/services. In relation to the sorts of cosmetics and cosmetic services that are likely to be found in the High Street, the term SPECIAL EFFECTS would still have no more than an allusive and fanciful reference to the properties of the goods and services. This may become relevant if I am subsequently found to be wrong on the first of the opponent's objections because Mr Clegg confirmed that the applicants were trading in beauty products and services. Consequently, it may, if it becomes necessary, be possible for the applicants to restrict their specification so as to avoid the first of the opponent's objections under Section 3(1)(c).

Section 3(3)(b)

23. Section 3(3)(b) of the Act is as follows:

“(3) A trade mark shall not be registered if it is -

(a)

(b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).”

24. The opponent argues that the applicants' mark would be deceptive if used in relation to cosmetics that do not produce a special effect. This is really the flip side of the opponent's case under Section 3(1)(c), I found under Section 3(1) that the applicant's mark has no specific descriptive message. Consequently, there is no likelihood of the public being deceived by the use of the mark. The objection fails accordingly.

Section 5(2)(b)

25. Section 5(2)(b) is as follows:

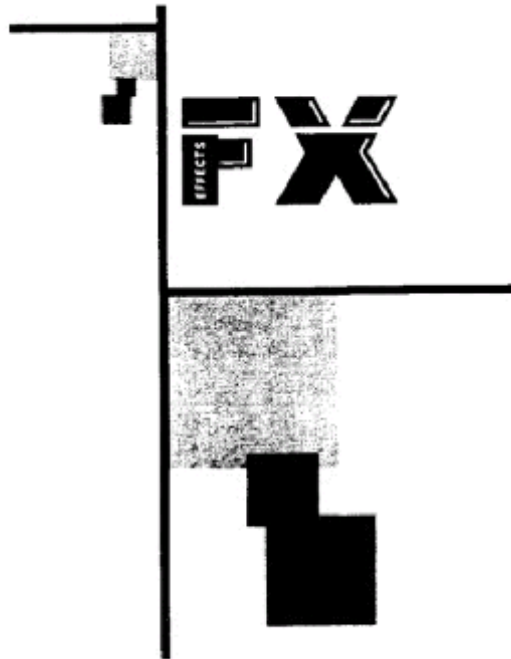
“(2) A trade mark shall not be registered if because -

(a)

(b) it is similar to an earlier trade mark and is to be registered for goods

or services identical with or similar to those for which the earlier trade mark is protected,”

26. Mr Castle agreed that his client’s best case rested in the registration of earlier trade mark 2015288. A representation of that mark and of the applicants’ mark is shown below:



27. I approached the matter taking account of the guidance from the ECJ in **Sabel BV v Puma AG** [1998] RPC 199, **Canon v MGM** [1999] ETMR 1 and **Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.** [1999] ETMR at 698.

28. I acknowledge that the goods listed in Class 3 of the application are identical to those listed in the earlier trade mark, and I bear in mind that the ECJ has said that a lesser degree of similarity between two trade marks may be offset by a greater degree of similarity between the goods.

29. I turn next to the distinctive character of the earlier trade mark. Although it has a number of figurative elements, the letters FX are a prominent feature of the earlier mark. I do not regard the letters FX as having a highly distinctive character per se. It is therefore necessary to consider the effect of the use that the opponent claims to have made of this mark upon its distinctive character at the date of the application.

30. Mr Monteiro says that his company has been using the trade mark FX in the United Kingdom since September 1995 in relation to a number of hair products. He provides turnover figures for products sold under this trade mark in the United Kingdom between 1995 and early in the year 2000. The figures indicate that the opponent sold nearly 600,000 units in

1995 rising to over 2 ½ million units in 1999. He says that sales take place at supermarkets, department stores, to chemists and hairdressers, who then sell these products on to the public. He provides examples of the products themselves at Exhibit JM2 to his declaration. At Exhibit JM3 he exhibits copies of invoices showing sales of the goods to various distributors. He further provides figures showing the annual cost of advertising and marketing products. These indicate that, in 1995, the opponent spent £130,000 promoting its products. By 1999, this had risen to just under £½ million. Mr Monteiro claims that the products have been advertised through television and magazine marketing together with billboards, leaflets and counter promotions. At Exhibit JM4 he provides an example of some recent promotional material, although this seems likely to post date the application under opposition.

31. In assessing the effect of this use upon the distinctive character of the earlier trade mark I note that:

- the opponent has provided no details to support its assertion of TV advertising;
- the material put forward to show how the mark has been used indicates that it has appeared as part of a composite trade mark and is used alongside other marks such as L'OREAL, STUDIO LINE and INVISI SPRAY;
- there is no independent evidence that the goods in question are known as FX products, or that even if they were, the mark was well known in the United Kingdom at the date of the applicants trade mark application.

32. In this connection, I note that in **Duonebs Trade Mark**, 2 January 2001. BL/048/01, Mr Simon Thorley QC as Appointed Person said that:

“In my judgement, I believe what the ECJ had in mind was the sort of mark which by reason of extensive trade had become something of a household name so that the propensity of the public to associate other less similar marks with that mark would be enhanced. I do not believe that the ECJ was seeking to introduce into every comparison required by Section 5(2), a consideration of the reputation of a particular existing trade mark.”

33. I do not believe that the rather sketchy details of the use made of the earlier mark is sufficient to elevate it into the sort of mark that might be entitled to an exceptional scope of protection.

Comparison of marks

34. I consider the letters FX to be a dominant element within the earlier trade mark. That does not mean that the figurative components of the mark should be discounted when it comes to a comparison with the applicants' mark because, as the ECJ has noted, the average consumer normally considers marks as wholes. I have not overlooked the fact that the word EFFECTS appears within the opponent's earlier trade mark. However, it is in such small letters within the upright of the letter 'F' that I do not believe that it can be considered to be an essential feature of the earlier trade mark. I did not understand Mr Castle to contend otherwise.

35. In fact it was common ground before me that there is no visual similarity between the opponent's earlier trade mark and the mark of the applicants. Mr Castle submitted that there was considerable aural similarity between the respective trade marks because of the phonetic resemblance between the letters FX and the word EFFECTS, which appears as the second word in the applicants' trade mark. I do not think that it can be denied that there is an element of phonetic similarity between FX and EFFECTS, but as Mr Clegg pointed out, the applicants' mark is a two word mark, and I would not therefore regard the degree of similarity to be particularly high.

36. The parties differed most on the question of whether there is, or is not, a conceptual similarity between the respective marks. Mr Castle, relying upon the entry in Collins Dictionary which indicates that FX is an informal abbreviation for the term 'Special Effects' as used in films etc., submitted that the applicants' mark shared the same concept as that of the opponent. Mr Clegg submitted that the average consumer would not equate the earlier trade mark with the words SPECIAL EFFECTS. He pointed out that the appearance of the letters FX in one dictionary as short for 'Special Effects' does not establish that the meaning is well known to the average consumer of cosmetics and cosmetic services. He further pointed out that, in other fields, the letters FX can have alternative meanings, for example in the financial market it means Foreign Exchange. I believe there is force in Mr Clegg's submissions. I am not persuaded that the average consumer would see the letters FX as meaning 'Special Effects' when used in relation to a trade in cosmetics and cosmetic services.

Likelihood of confusion

37. The likelihood of confusion must be assessed through a global comparison of all relevant factors. As I have already noted, it is common ground that there is no visual similarity between the trade marks. There is a limited degree of aural resemblance between the marks, but there is no evidence that aural similarity is exceptionally significant in this market. In these circumstances, my conclusion that any conceptual similarity between the trade marks would not be immediately apparent to the average consumer of cosmetics must inevitably lead to the conclusion that there is no likelihood of confusion between the respective trade marks, even when they are used for identical goods.

38. In that event, it must follow that there is no likelihood of confusion if the applicants' mark is used in respect of the services listed in Class 42.

39. It must also follow from what I said earlier, that if the opposition based upon earlier trade mark 2015288 fails, so too must the opposition based upon earlier marks 2148612 and 2148615, which are less similar marks. The objection under Section 5(2)(b) is therefore rejected.

Section 5(4)(a)

40. Section 5(4)(a) of the Act is as follows:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

- (a) *by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade”*

41. Mr Clegg suggested in his skeleton argument that the approach to be taken under Section 5(4)(a) of the Act is as follows:

- “18 *In a ground of opposition based on Section 5(4)(a), the onus is on the opponent to make out a case by filing appropriate evidence. [See Audi-Med (1998) RPC 859].*
- 19 *Following Geoffrey Hobbs QC’s comments in WILD CHILD Trade Mark (1998) RPC 455 at 460, endorsed by Pumfrey J. in REEF Trade Mark (2002) RPC 19 at paragraph 29, itself upheld in relation to section 5(4)(a) in the Court of Appeal (2002) WL 820084 at paragraph 41, the question raised by this ground of opposition is as follows: was normal and fair use of the designation SPECIAL EFFECTS liable to be prevented at the date of application by enforcement of rights which the opponent could then have asserted against the applicants in accordance with the law of passing off?*
- 20 *Following on in accordance with the authorities quoted above, the opponent must therefore establish the three necessary elements of the action for passing off:*
- 20.1 *that the opponent’s goods have acquired a goodwill or reputation in the market and are known by some distinguishing feature;*
- 20.2 *that normal and fair use of SPECIAL EFFECTS by the applicants would constitute a misrepresentation (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the applicants are goods or services of the opponent; and*
- 20.3 *that the opponent has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the applicants’ misrepresentation.”*

42. I did not understand Mr Castle to suggest that there was anything wrong with Mr Clegg’s submissions in this respect, and I gratefully adopt them. The opponent plainly had a significant trade in hair care products prior to the relevant date. As I have already noted, the evidence shows that the opponent has made use of the letters FX alongside other distinguishing signs, including the figurative markings which are included within its earlier registered trade marks.

43. I have already considered whether the sign which constitutes registered trade mark No. 2015288 is likely to be confused with the applicants’ mark if they were used concurrently in respect of identical goods in Class 3. My answer was that no likelihood of confusion exists. If that is so, it must follow that use of the applicants’ mark cannot amount to a misrepresentation.

44. Consequently, the only way in which the opponent can advance its claim under Section 5(4)(a) over and above the case it has already presented under Section 5(2)(b), is to show that its goodwill was known by the trade mark SPECIAL FX prior to the date of the application under opposition. The opponent claims to have used this mark from 1 June 2000, one month prior to the date of the application. The use claimed is again in respect of hair care products. Mr Monteiro puts the position like this:

“... my company has launched the trade mark SPECIAL FX. This, in my opinion, is phonetically and conceptually identical to the trade mark SPECIAL EFFECTS, the mark the subject of this opposition and would be taken by consumers to be the same product. As my company launched SPECIAL FX with a great deal of publicity in the month before this application was filed, there seems to me to be a great chance of confusion by the public as to the origin of the SPECIAL EFFECTS product.”

45. There is plainly a strong phonetic resemblance between the words SPECIAL EFFECTS and the word and letters SPECIAL FX. Further, the meaning of the letters FX in the phrase SPECIAL FX would be more likely to be apparent to members of the public, and would in any event bring the phonetic resemblance between the marks close to identity. I must therefore look carefully at the opponent’s claim to have used this trade mark a month before the date of the application.

46. Mr Monteiro provides a list of magazines in which he claims the trade mark has appeared. The applicants’ evidence consists of the results of an investigation which they jointly carried out to establish whether or not the trade mark SPECIAL FX had in fact appeared in any of the magazines listed in the opponent’s evidence. The applicants say that they looked at all of the magazines titles listed and tried to find the publications for each of the months of May, June and July of 2000. Out of a potential of 42 magazines to be examined only one was not accounted for, although another magazine was apparently not published before October 2000. The applicants provide details of the research they undertook at the British Library and via a magazine archive facility. The applicants say that despite having looked at the magazines in question, they could find no advertisements for any products under the trade mark SPECIAL FX during the period in question.

47. Mr Monteiro’s second declaration was filed in response to this evidence. He exhibits (as JM 1) copies of various magazines from the years 2000 and 2001 which include examples of products advertised under trade marks which incorporate the word and letters SPECIAL FX. However, all of these magazines were published after the relevant date in these proceedings and cannot therefore support the opponent’s claim to have established any reputation or goodwill under the SPECIAL FX trade mark prior to the relevant date. Mr Monteiro exhibits (as JM 2) a schedule from a company known as Universal McCann, which is L’Oreal’s media buyer. This provides a breakdown of where and when advertising for the opponent’s products appeared in the year 2000.

48. I have been through this document carefully. The first entry I could find relating to the marketing of a product under the name SPECIAL FX specifies a date of July 2000, which is after the relevant date.

49. Mr Monteiro also claims that postcards were distributed in cinema's throughout the UK advertising the SPECIAL FX hair product, including a 50 pence off voucher. He says that these postcards were distributed "*throughout 2000 after the date of first use of the mark and into 2001*". A copy of the postcard in question is exhibited at JM 3. However, the schedule exhibited as JM 2 indicates that these postcards were first distributed on 20 July 2000, again after the relevant date.

50. In his first declaration, Mr Monteiro's provides figures for the opponent's turnover in goods bearing the trade mark SPECIAL FX. The figures indicate that turnover in such goods amounted to over £1 million at the date of the declaration. He provides further figures which indicate that almost as much had been spent promoting goods bearing this mark. However, these figures cover the period between the launch and the date of the declaration in July of 2001. No attempt has been made to provide figures for the period prior to the relevant date in these proceedings. In this connection, I note that although the opponent has provided examples of invoices (at JM 3 to Mr Monteiro's first declaration), which include entries for a product described as "STU FX" (which I take to be a reference to Studio Line FX hair product), no corresponding invoices have been provided for any goods described by reference to the words SPECIAL FX.

51. Mr Castle accepted that there was no supporting evidence for Mr Monteiro's claim that L'Oreal launched the product under the name SPECIAL FX on 1 June 2000. In the absence of any request to cross examine Mr Monteiro, he invited me to accept the claim at face value. It is for the opponent to make good its claim to have established a goodwill and reputation under the mark SPECIAL FX by the relevant date in these proceedings. In order to do so the opponent was required to provide sufficient material from which such a finding could properly be drawn. Unsupported general assertions, even provided under oath, cannot provide sufficient support for the claim that has been made. This is all the more so when some of the material put forward to support the claim, actually contradicts it.

52. I conclude that there is no established use of the trade mark SPECIAL FX prior to the relevant date. It follows that the ground of opposition under Section 5(4)(a) must fail for the reasons already given.

Costs

53. This brings me to the question of costs. Both parties were content for costs to be awarded off the Registrar's usual scale. The opposition was filed after the Registrar's revised scale of costs came into effect. Consequently, I ordered the opponent to pay the applicants the sum of £1,700 as a contribution towards their costs. This to be paid within 7 days of the end of the period allowed for appeal or, in the event of an unsuccessful appeal, within 7 days of the final determination of the matter.

Dated this 22ND day of August 2002

**ALLAN JAMES
For the Registrar**

Annex in paper copy