

O-229-05

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION No. 2199395
STANDING IN THE NAME OF DANIELE RYMAN
AROMACOLOGY LIMITED**

AND

**IN THE MATTER OF A REQUEST FOR A DECLARATION OF
INVALIDITY THERETO UNDER No. 81767
BY CHANTECAILLE BEAUTE, INC**

TRADE MARKS ACT 1994

IN THE MATTER OF Application No. 81767 for a Declaration of Invalidity by Chantecaille Beaute, Inc in respect of Trade Mark registration No. 2199395 in the name of Danièle Ryman Aromacology Limited

BACKGROUND

1. The trade mark AROMACOLOGY was applied for on 7 June 1999; the registration procedure was completed on 19 October 2001. The mark stands registered for a specification of goods reading:

Soaps; perfumery; essential oils; skin care products, cleansers, toners, moisturisers; cosmetics; preparations for the hair.

2. I note that at the examination stage, the application proceeded to publication on the basis of honest concurrent use with registration No. 1376374, which is for the mark AROMAOLGY owned by Aveda Corporation.

3. On 18 June 2004, Chantecaille Beaute, Inc applied for a declaration of invalidity against the above registration. They did so on the basis that the mark was registered in breach of Sections 3(1)(b) and (c) of the Act, adding, that the mark had not acquired a distinctive character following registration. The Applicant frames its attack in the following terms:

“2. The Applicant asserts that to the trade in, and average consumer of the goods for which the trade mark is registered, the term Aromacology is a designation of the study of the psychological effects of odours especially plant oils, or, more simply, the science of aromas. The term is spelled in a number of different ways in the field including “Aromacologie”, “Aromaology”, “Aromachology” and “Aromathology”. The term Aromacology is used herein as a reference to any of these spellings.

3. As a result of use of the term Aromacology in the relevant trade since at least 1989 it is devoid of any distinctive character for goods in class 3.

4. The term Aromacology is a sign or indication which may serve in trade to designate a kind of goods in class 3, namely those developed in accordance with the principles of the science of aromas.

5. On 4 June 2004 Solicitors acting on behalf of Danièle Ryman Aromacology Limited (the “Proprietor”) wrote to a retailer of the Applicant’s goods, which use the term “Aromacologie” in accordance with honest practices in industrial or commercial matters, alleging trade mark infringement.”

4. The Registered Proprietor filed a counterstatement denying the above grounds and putting the Applicant to proof of these claims. I note the following comments appearing in the counterstatement:

“1...It is denied that the trade mark was registered in breach of Section 3(1)(b) and (c) of the Act at the application date, 7 June 1999 and it is further denied that it has not after registration acquired a distinctive character. It is the Proprietor’s case that the trade mark had acquired distinctive character at the date of application and/or has acquired distinctive character after registration as a result of the Proprietor’s use of it.

2. ...It is the Proprietors case that the trade mark is a coined term, coined by the Proprietor, and that it is a valid trade mark.

3...It is the Proprietor’s case that the trade mark is valid and is not a term that is in common usage in the trade. Further, the Proprietor has taken steps in the past to stop infringing use of the trade mark by third parties. The Proprietor contends that the Applicant cannot rely on infringing use of the trade mark by third parties to support its allegation that the trade mark was registered in breach of Section 3(1)(b) and (c) of the Act....

5...it is denied that the Applicant uses the term “Aromacologie” in accordance with honest practices in industrial or commercial matters.

6. It is the Proprietors case that the trade mark is valid. The trade mark had acquired distinctiveness through the use made of it prior to the application date. In the alternative, the trade mark has acquired distinctiveness after registration as a result of the use made of it by the Proprietor. Further, the trade mark is not a common term used in trade to designate goods in Class 3 or at all.”

5. Both sides filed evidence and both ask for an award of costs in their favour. The matter came to be heard on 25 July 2005, when the Registered Proprietor was represented by Ms A Mastrovito instructed by Manches; the Applicant for Invalidity was represented by Ms B Cookson of Nabarro Nathanson. I should add that it was the original intention of the parties that each would present one of their witnesses for cross-examination at the hearing. In the event, and by mutual agreement, the parties decided not to proceed with this proposal.

EVIDENCE

Applicant’s evidence

6. This consists of three affidavits and three witness statements. The first affidavit, dated 16 November 2004, is from Sylvie Chantecaille. Ms Chantecaille explains that she is the founder and Managing Director of Chantecaille Beaute Inc, the Applicant for Invalidation, a position she has held since 1997; prior to that, Ms Chantecaille spent twenty years at Estèe Lauder. Ms Chantecaille explains that the principal activity of the Applicant is the design and distribution of cosmetics and skincare products. She confirms that she is both authorised to speak on behalf of the Applicant

and that the information in her affidavit comes, unless otherwise specified, from her own personal knowledge.

7. The main points emerging from Ms Chantecaille's affidavit are:

- that some time around 1998, the Applicant decided to create a range of skincare products which incorporated essential oils. These products were described as aromacologie products, because Ms Chantecaille had seen the word used and understood it to mean the physiological and psychological effects of smell;
- that the Applicant's aromacologie range combined natural flower and plant extracts with essential oils to produce products which effect the brain as well as the body;
- that aromacologie is a generic name which the Applicant used on their products to describe the range and to conceptualise the holistic properties of the products. Its use on the Applicant's products conveys to consumers the way in which the products work;
- that at the time the use of the word aromacologie was contemplated, Ms Chantecaille was fully aware of its use in the cosmetic and skincare industry. She was, she explains, particularly aware of the use of aromaology by Aveda and aromathology by Crabtree and Evelyn which she understood to be references to the same science;
- that trade mark searches were conducted, and Ms Chantecaille was informed that aromacologie was likely to be treated as a descriptive term. As a result, she concluded that descriptive use by the Applicant would be both accurate and legally acceptable;
- that the Applicant has used aromacologie in a descriptive manner on their products. They do not, and never have, says Ms Chantecaille, used aromacologie as a brand name;
- that the products were launched in 2001. Exhibit SC1 consists of sample packaging, from which Ms Chantecaille notes that the word aromacologie appears at the bottom of the products. Ms Chantecaille adds that the brand name on the products is clearly Chantecaille which appears at the top of the products in capital letters. Consistent with the use of aromacologie as a descriptive term, Ms Chantecaille explains that the Applicant has launched a separate range of aromatherapy products with the word armootherapie appearing in place of the word aromacologie.

8. The second affidavit, dated 15 November 2004, is from Annette Green. Ms Green explains that she is Chairman of the Sense of Smell Institute of 145 East 32 Street, New York. She confirms that she is authorised to speak on behalf of the Institute, adding that unless otherwise stated, the information provided is known to her personally or has been taken from the books and records of the Institute or has been provided by Officers of the Institute. Ms Green explains that she served as the Executive Director of the Fragrance Foundation from 1961 until 1991, and from 1992

until 2002, she served as President of that organisation. She currently holds the title of President Emeritus of the Fragrance Foundation and is the co-author of the book *Secrets of Aromatic Jewelry*. She is also a founding member of the Sense of Smell Institute.

9. The main points emerging from Ms Green's affidavit are:

- that the Sense of Smell Institute is a tax-exempt, charitable organisation with the goal of being a leading global resource relating to the sense of smell and its importance to human psychology, behaviour and quality of life;
- that the Institute was founded in 1981 under the name Fragrance Foundation Philanthropic Fund, and was originally dedicated to funding scientific studies on the sense of smell and the beneficial effects of fragrance;
- that the organisation underwent several name changes. In 1984 the name was changed to Fragrance Research Fund Limited, in 1992 to the Olfactory Research Fund Limited, and again in 2001 to its current name the Sense of Smell Institute;
- that in 1987 the Institute began publishing a newsletter called "Focus on Fragrance." In 1992, the name of the newsletter was changed to "Aroma-Chology Review". The newsletter contained articles written primarily by Institute grant recipients which focused on new developments in the olfactory field. In general, the newsletter was mailed to Institute grant recipients, corporate sponsors, the media, and a limited number of subscribers. Publication of the newsletter by the Institute ceased in 2002;
- that since 1985 the Institute has awarded more than fifty research grants and fellowships totalling over \$1.4 million to research scientists in the fields of developmental, perceptual, social and cognitive psychology, anthropology, biology, neuroscience and related disciplines in institutions in 14 states and 7 countries, including the US, Canada, UK, Germany, Australia, Russia and Israel;
- that the Institute has promoted the collection of scientific data under controlled conditions to study the interrelationship of psychology and fragrance technology to transmit a variety of specific feelings and enhance behaviour through the olfactory experience;
- that in an attempt to describe this new field of scientific study involving smells and the effects they have on human well being, Ms Green coined the term "Aroma-Chology" in about 1986;
- exhibit AG-1 consists of a print-out from the Institute's web site which defines "Aroma-Chology". It does so in the following terms:

"A concept developed under the leadership of the Sense of Smell Institute in the 1980s. It refers to collection of scientific data under controlled conditions to study the interrelationship of psychology and fragrance technology to transmit a variety of specific feelings and enhance behaviour through the olfactory experience. Aroma-Chology seeks to establish the positive effects of

aromas on human behaviour that are verifiable through reproducible scientific experiments. Aroma-Chology deals only with the psychological effects achieved through the use of ambient odors that stimulate the olfactory pathways to the brain”;

- that in 1987, the Institute filed a trade mark application in the United States for the mark Aroma-Chology in relation to seminars and conferences dealing with the sense of smell, and that the mark achieved registration in 1989;
- that Ms Green is acquainted with Danièle Ryman and is familiar with her work in the field of aromatherapy and with Ms Ryman’s products;
- that in the early 1990s, the Institute sponsored a symposium on Aroma-Chology, entitled “Aroma-chology: The Impact of Science on the Future of Fragrance” which was held in New York in November 1991. The symposium was targeted at individuals involved in the fragrance industry. Ms Green explains that she: “...personally contacted Ms Ryman for sample products involving an aromatherapy kit marketed at that time by Ms Ryman that Virgin Airlines distributed to passengers to combat jet lag. Ms Ryman was aware of the nature of the symposium when I made the request to her. Ms Ryman complied with the request and donated the kits which were then given to symposium participants.”

Exhibit AG-2 consists of photographs of one of the remaining kits the Institute retained.

10. The first witness statement, dated 18 November 2004, is by Nicola Kinnaird. Ms Kinnaird is the President and Creative Director of Space NK Limited, having previously been the company’s Managing Director since its creation. She adds that she is also responsible for the company’s public relations, its communications and for the researching and selection of new products. She explains that she was contacted by the Applicant to provide her statement in support of the application, and confirms that she is authorised to make her statement on the company’s behalf having access to the company’s books and records.

11. The main points emerging from Ms Kinnaird’s witness statement are:

- that her company was formed in 1992, and began trading in April 1993 under the name Space. NK as a “lifestyle” store in Covent Garden, London, selling items such as clothing, accessories, beauty products and jewellery. That the company now has 36 stores throughout the UK, including a number of other stores in London, together with stores in Birmingham, Manchester, Leeds, Edinburgh, Glasgow and Belfast. The company, which also has mail order and Internet sales operations, operates a day spa in the Notting Hill area of London, and sells their own private label range of beauty products, are said to specialise in the retailing of high quality beauty products including skincare, make up, fragrances, toiletries and accessories. Exhibit NK1 consists of print-outs from the company’s web site indicating its range of activities;
- that she is asked by the press to comment on matters concerning beauty and cosmetics on “*an almost weekly basis*” and that she has given interviews and

commentary to, for example, national newspapers and international monthly magazines, such as The Daily Telegraph, The Times, Vogue, Elle, Marie Claire and others;

- that she also writes on beauty related issues and that her book “Awaken Your Senses – Change Your Life” was published in 2002. In addition, in 2003, she was asked to write a column for the Japanese edition of Vogue magazine on developments in the cosmetics and beauty products industry, and, also in 2003, she received the Cosmetic Executive Woman “Achiever” award;
- that her company began selling aromatherapy products when it began trading in 1993. That by aromatherapy products, she means those products specifically based on the therapeutic use of essential oils. That the company began by selling products from the Espa and Elemis ranges of products and now sells products from the Aromatherapy Associates range. Exhibit NK2 consists of print-outs from these companies’ websites;
- that in 1999, her company launched its private label range of products based on the principles of aromatherapy, and that since 1999, the company’s day spa and beauty treatment centre has also provided aromatherapy products and treatment as part of the service to their customers;
- that her company began selling the Applicant’s range of fragrances about 5 years ago, and in about January 2001 they began stocking the Applicant’s skin care products. Having checked her company’s records, she confirms that the word aromacologie appeared on the skin care products from the outset. Exhibit NK3 consists of a copy of her company’s Winter 01/02 brochure illustrating the products;
- that in June 2004, her company received a letter of demand from solicitors acting for the Registered Proprietor in respect of their sale of the Applicant’s skin care products. A copy of that letter, dated 4 June 2004, is provided as exhibit NK4. Ms Kinnaird explains that the letter required her company to immediately cease selling these products on the grounds that they infringed the Registered Proprietor’s AROMACOLOGY trade mark. She explains that the matter was then dealt with by the respective parties’ solicitors, with the Registered Proprietor’s solicitors withdrawing their threat of infringement action against her company in a letter dated 9 July 2004 and which is provided as exhibit NK5;
- that she was surprised to have received the original letter, as she would not have expected that anyone could properly claim exclusive rights to the word Aromacology or obtain a trade mark registration for the word;
- that although she cannot say precisely when she first became aware of the term Aromacology (or Aromachology as she says it is sometimes spelt), it was well before June 1999. She explains that she has always used and understood the term to mean the study of the physiological and psychological effects of smells and scents. Her view is, she says, supported by the explanation of the term appearing in “The New Perfume Handbook” by Nigel Groom published in 1997. Exhibit NK6 consists of a copy of an extract from this book together with a copy of the

front cover and title pages. She notes that under the term Aromachology there appears a definition which reads, inter alia: “A branch of aromatherapy concerned with the physiological effects of scents including their use to influence moods.”

- that in her experience, the term Aromachology occurs regularly in conversation and in written material concerning the effect of smells. She explains that she was invited to speak at a symposium in Paris in October 2002 run in conjunction with The Fragrance Foundation entitled “Well-Being, Aroma-Chology and the Future of Fragrance”. Exhibit NK7 consists of a copy of a paper delivered to the symposium by Dr Annick Le Guerer entitled “Smell – A sense for the Future” with Ms Kinnaird noting that aromachology is mentioned on page 4 of the document;
- that although she has been aware for many years that Ms Ryman is a well known and respected practitioner in Aromatherapy, she does not: “..recall ever having seen, read or heard anything, either in the press, during conversation or otherwise, which would suggest that Aromachology is or might be a brand name for the products of Danièle Ryman or anyone else.”

12. The second witness statement, dated 18 November 2004, is by George Henry Dodd. Mr Dodd states that, in his view, he is in: “..a privileged position to give an opinion on the word “Aromachology””. He explains that he is (i) an aroma scientist, who has worked for Unilever and founded and directed the only smell research group in the UK – The Olfaction Research Group at the University of Warwick (1971-1994), (ii) a professional aromatherapist who has taught for several years in the leading UK schools, (iii) a working perfumer, currently Director of Amora Perfumes Limited, (iv) a professional biochemist, having been a University lecturer at Warwick in Biochemistry (1971-1994), (v) a founding director of the world’s first aroma biotechnology company, Kiotech plc (listed on OFEX), (vi) a senior research fellow in the Highlands Psychiatric Research Group, Inverness and (vii) a recognised international expert and consultant on all aspects of the sense of smell. A copy of Mr Dodd’s most recent CV is provided as exhibit GD-1. Mr Dodd comments:

“My extensive background experience over many years, as outlined above, allows me to have an informed opinion on the genesis and evolution of aromachology and related terms.”

13. The main points emerging from Mr Dodd’s witness statement are:

- that many professionals in perfumery feel that the word aromachology is subsumed in the term perfumery;
- that Aromatherapy is the anglicised form of the French word aromatherapie and that strictly speaking, the word should be interpreted as a therapy using aromas; this word is in the public domain;
- that POP is an acronym for the term Psychology-of-Perfumery which was invented by him and his colleague to describe the work on aroma science which they initiated at the University of Warwick in the early 1970s. In 1986 the term

was formalised when they organised the world's first conference on this key emerging topic in contemporary perfumery and contemporary aromascience;

- that there are variations of the spelling of aromachology but all refer to essentially the same kind of thing i.e. the scientific study of odours, in particular the effects of scents of all kinds on human physiology and psychology;
- that the Warwick Olfaction Group which he founded in 1971 at the University of Warwick, pioneered modern scientific studies in many areas of olfaction and, in his view, the success of this group encouraged the Fragrance Foundation in New York to recognise that the US needed to develop an interest in the scientific aspects of fragrance;
- that the Foundation decided to seek funding for fragrance research and invented a word to describe fragrance research. The Foundation could have chosen scentology or fragrantology or aromaology or perfumology but chose aromachology – the term referring to the scientific study of the effects of aromas on humans;
- the first (or one of the first) public displays of the new word aromachology was in the proceedings of the 1st International Conference on the Psychology of Perfumery in 1986;
- that the term aromachology is formally defined in Chapter 13 of the first POP volume published in 1988 (provided as exhibit GD-3). At that time it was said to be a service mark of the Fragrance Foundation. Exhibit GD-4 is a copy from the United States Patent and Trade Mark Office's website, which confirms that in 1989, AROMA-CHOLOGY was registered by the Fragrance Foundation for a range of services in Class 41. Of this registration, he comments: "I recall that when the word AROMA-CHOLOGY was discussed as a trade mark during Annette Green's talk at the conference, the audience were distressed. This was because it was inappropriate at an academic meeting to pre-empt public usage of a new scientific term by registering it as a trade mark";
- that in his view the term since then has lost any proprietary significance and is now the name of a scientific field. He says:

“Specifically, the term gradually became part of the scene of smell research, and was regarded as a useful generic term, and which, crucially, was not owned by anyone or any organization. In scientific circles, where the term was conceived and first used, this remains the usage of the term today. That is, it describes a body of scientific enquiry and is not owned by any body, company, or person. In this regard, the new word –aromachology- is used less amongst professionals in perfumery and more amongst aromatherapists and similar persons (most of whom are untrained in the aroma sciences and generally lack technical expertise in perfumery and the perfume sciences), and amongst consumers. This word is generic and is in the public domain.”

- that once the term started to be used in the general scientific community it began to attract the attention of various companies who wished to employ aspects of the

term for their own commercial purposes. Whilst for consumer cosmetics in 1999, perhaps only a few shoppers would have been aware of the meaning of Aromacology, in his view, it was obvious that cosmetic houses would also want to use it;

- an example of this is use by The Aromachology Patch Company which was registered (as a company) in the UK in 1999 and which aspires to have products which have been developed through aromachological research. This company, like others which incorporates some form of aromachology (often with a different spelling) into their name or description of their activity does not, he says, presume to have rights over the word aromachology and regard this term as being in the public domain;
- that in his opinion an association between Aromacology and fragranced products has now been created in the minds of consumers due to the commercial uses that have been made, and that in view of the history of the word aromachology it is legitimate for a company to incorporate this word into their company name or trademark but this does not give them any rights over the general field of aromachology. He concludes his statement in the following terms: “..I believe that the company is mistaken in the belief that it has some special right over the now well-established and general field of scientific enquiry which goes by the name of aromachology.”

14. The third affidavit, dated 17 November 2004, is by Mary Fontenot. Ms Fontenot explains that she is an attorney at law in the firm of Ostrolenk Faber Gerb & Soffen, LLP, who are instructed by the Applicant.

15. The main points emerging from Ms Fontenot’s affidavit are:

- that on 30 September 2004, she performed a search in the LexisNexis “News-All” database (which contains over 12,000 sources, including sources from the UK), for various spellings of AROMACOLOGY. The search resulted in 819 references (provided as exhibit MF-1) ranging from September 1987 to September 2004 that use some form of AROMACOLOGY. Discounting items that emanate from the same press release and references to Ms Ryman, there are, she says, over 700 items that use the term independently of the Registered Proprietor;
- the results by year are provided in tabular form indicating, for example, 3 results in 1987, rising to a peak of 158 in 2002 and dropping to 34 in 2004. She notes that many of these references were to articles that were circulated in the UK;
- that she retrieved the full text of articles from UK newspapers and journals or publications with significant UK circulation written before 1 June 1999 (a number of which are provided at exhibit MF-2). She notes that there are 49 such records, many of which refer to Crabtree & Evelyn’s Aromathology line of products. She highlights a number of excerpts which, she says, describe events or products having an association with the term aromacology and indicate that the term aromacology was being used by commercial organisations in their sales activities and by scientists as an exclusively descriptive term long before June 1999 i.e. the application date of the registration in suit.

16. The third witness statement, dated 19 November 2004, is by Barbara Cookson. Ms Cookson is a solicitor and partner in the firm of Nabarro Nathanson, the Applicant's professional representatives in these proceedings. She explains that in addition to her professional role in this matter, she is also a member of the relevant public for the goods at issue. She estimates that she spends at least £1,000 annually on such goods adding that she would also expect to receive the goods at issue as gifts. She states that she has a personal collection of essential oils and has been interested in aromatherapy and the use of such essential oils for at least thirty years.

17. The main points arising from Ms Cookson's witness statement are:

- that essential oils and products containing them are sold in the UK through a variety of outlets with, in Ms Cookson's opinion, the lower end of the market being represented by retail chains such as Holland & Barrett, Boots and Marks and Spencer. She comments that products range in price over a substantial range and that a significant sector of the market is for more exclusive products sold in the cosmetic departments of department stores and specialist retailers such as Space NK, Sephora and others;
- that there is also a significant market amongst professional aromatherapists that use these goods in the course of their business, this is the professional as opposed to the consumer market of which she is a member;
- that the consumer market is almost exclusively female since purchases made by men will almost always be for the women in their lives and/or bought on instructions;
- that as the goods are luxury products purchased to indulge the consumer, the relevant consumer will be more than usually well informed, observant and circumspect and will be someone who takes great care in the selection of the goods and enjoys and shows interest in the process;
- that in this market, product, labels, literature and packaging are all lovingly studied and the goods browsed;
- that in the higher end of the market, assistance will be available to describe and promote the benefits and use of the individual products;
- that the sign in issue AROMACOLOGY is a neologism of the prefix aroma and the suffix ology, both of which are well known in the English language and would require no definition for members of the consumer or professional market;
- that whilst the term does not appear in the current version of the Oxford English dictionary (as of 14 June 2004), it does appear in the glossary of the second edition of "The Complete Guide to Aromatherapy" published in 2003. Exhibit BEC 1 consists of a copy of the cover page, bibliographic details together with the page on which the definition appears. It reads as follows: "Aromacology – The study of the psychological effects of odours, particularly those of essential oils used in aromatherapy";

- that she carried out Internet research and pages from the Internet are provided as exhibit BEC 2. She comments that although these were all pages that were available on the Internet in June 2004, it is, in her view, clear that some of them have been available for a considerable period and would represent the understanding of the sign at the relevant date. Having identified a range of Internet pages which feature the words aromachology and aromacology, she concludes that this exhibit demonstrates that aromacology is being used as a reference to a science related to aroma in some sense and although the spelling is not consistent the implication is that this is a strictly origin neutral sign;
- that when a term is not to be found in a dictionary, there is a risk that it will be registered as a trade mark as the relevant absolute grounds issues will not be appreciated at the time of examination; in addition, the sign may also appear on the register in a descriptive sense as part of a mark which is as a whole distinctive. Exhibit BEC 3 is a print-out of all the marks protected or applied for in the UK or on the International Register in Class 3 which have the prefix Arom and the suffix Ology. She notes that prior to the relevant date, two substantial companies in the relevant market, Aveda Corporation and Crabtree & Evelyn had used and sought to monopolise a conceptually identical sign, i.e. Aromaology by Aveda and Aromathology by Crabtree. She says that she would regard all three signs as being identical and simply spelling variations of a word that has not yet had its spelling crystallised by a dictionary definition;
- that the application to register the sign Aromacology by the Registered Proprietor, proceeded on the basis of honest concurrent use with the AROMAOLOGY trade mark of Aveda Corporation. She comments that despite the obvious inferences from the evidence submitted by the Registered Proprietor, no absolute grounds objection was raised;
- that exhibit BEC 5 consists of extracts from an abandoned United States trade mark application made by the Registered Proprietor for the same mark on 21 January 2000. She notes that this application was objected to by the United States Patent & Trade Mark Office and provides copies of the official action issued together with the evidence the Examiner provided in support of her objection based on, inter alia, the descriptive nature of the sign. She notes that the application was ultimately abandoned as a result of non-response to the Examiner's objections;
- that exhibit BEC 6 consists of a copy of a brochure produced by Fenwick of Bond Street, who are a re-seller of the Applicant's products and which illustrates several of these goods and the way in which the sign Aromacologie is shown on the product. This brochure demonstrates, in her view, that the sign would be perceived by the relevant public in an origin neutral manner in much the same way as the terms, with subtly different spellings, are used by others in the field.

Registered Proprietor's Evidence

18. This consists of ten witness statements. The first, dated 2 March 2005, is by Danièle Ryman. Ms Ryman explains that she is the founder and President of Danièle Ryman Aromacology Limited. She confirms that she is authorised to speak on behalf of her company adding that unless otherwise indicated the information in her statement comes from her own personal knowledge or is taken from the records of her company to which she has access.

19. The main points emerging from Ms Ryman's witness statement are:

- that she has been practicing in the field of aromatherapy in the United Kingdom since the late 1960s;
- that aromatherapy is a specialised form of therapy with top practitioners being recognised as such. She adds that she studied the subject under Marguerite Maury, the pioneer of aromatherapy until her death in 1968 and has since become recognised as one of, if not the best known practitioner of the therapy both amongst other practitioners and the public. Exhibit DR1 consists of references to Ms Ryman which have appeared in newspapers or magazines, together with copies of a selection of articles from newspapers and magazines and details of books she has written;
- exhibit DR2 consists of copies of articles from newspapers and magazines indicating some of the famous people who have used her products and services. These include, for example, Lady Thatcher, the late Diana Princess of Wales, the Duchess of York, Princess Margaret, Richard Branson, Lady Elizabeth Anson, Joan Collins and Roger Moore. Exhibit DR3 consists of a transcript of a recording of a television programme on QVC UK, first shown on 28 April 2000, in which Ms Ryman is introduced by the host as a leading authority, author, speaker and practitioner in the aromatherapy industry in the UK with her own well known brand of products called Aromacology;
- that she coined the word Aromacology in the UK in the early 1980s and has used the term in connection with her business in aromatherapy products in the UK;
- that in 1991 her company underwent a corporate re-branding exercise and the use of the mark Aromacology on products, advertising and business materials became more prominent. In her view the word has been used as a trade mark, with a capital first letter together with the TM symbol to the upper right hand corner. Since achieving registration, her company has used the ® symbol on their website and on business papers, stationery and invoices. Examples are provided as exhibit DR4;
- exhibit DR5 consists of a list of the products in relation to which the trade mark has been used in the UK and consists of: facial washes, night treatment, facial and body sorbets, anti-ageing serum, anti-ageing body and anti-ageing hand crème, moisturising crème, soothing eye gel, hydrating and clarifying exfoliator, body

wash, hand mask, rejuvenating mask, clarifying mask, rescue balm and blemish vanishing gel;

- exhibit DR6 consists of a selection of leaflets, photographs of products and of display stands showing the use of the Aromacology trade mark;
- exhibit DR7 consists of a selection of invoices showing use of the Aromacology trade mark in connection with aromatherapy products;
- that at the end of 2001, her company entered into an exclusive arrangement with Marks & Spencer in the UK to promote and sell her company's Aromacology brand of products throughout the UK and in their seven franchise stores in Hong Kong;
- that it has been difficult to obtain details of turnover figures for the period prior to July 1999 due to a fire at her company's previous premises. However, turnover of products sold between July 1999 to December 2001 amounted to some £2.1m, on the following basis: July 1999 to December 1999 - £740,154; January 2000 to December 2000 - £1,187,154 and January 2001 to December 2001 - £192,280;
- that turnover in the UK in 1999 and 2000 was in excess of £1m. Ms Ryman believes that the number of units sold in each of the five years prior to the date of application to have been similar to those sold in 1999 and 2000 such that turnover figures for those years would have been broadly similar. She observes that turnover in 2001 was lower as a result of the preparations for the launch by Marks & Spencer of an exclusive range of her company's products under the Aromacology trade mark;
- that all products sold by Marks & Spencer included the Aromacology trade mark and that the mark was the most dominant element of the packaging. Samples of the packaging, advertising, in-store displays, leaflets, product lists, employee brand guides is provided as exhibit DR8. She adds that under the exclusive arrangement with Marks & Spencer, sales of £2.6m were achieved between October 2001 and June 2003;
- that all products sold from 1991 have borne the Aromacology trade mark as do all invoices for bulk sales of such products; that her company's website is accessible nationwide and sells her company's products; that the sale and distribution of the Aromacology brand by Marks & Spencer throughout their 300 stores nationwide, establishes, in her view, that use of the mark has been made throughout the UK and that the mark is associated with her company;
- that a substantial amount of the Aromacology marked products have been sold to various airlines flying to and from the United Kingdom;
- she concludes her statement in the following terms: "Sales of my Company's Aromacology brand of products in the UK have been substantial forming a major percentage of the sales of aromatherapy products in the United Kingdom. Accordingly I believe that the trade mark Aromacology enjoys a distinctive character indicating goods of my Company and distinguishing them from

aromatherapy products of other companies. The mark was not at the date of application or the date of registration generic and the substantial use of it since the date of registration establishes that the mark is not generic or descriptive in the UK marketplace for the goods concerned today.”

20. The second witness statement, dated 3 March 2005, is by James Nicholls. Mr Nicholls explains that he is the Managing Director of Danièle Ryman Limited a position he has held since 2001. Prior to that, Mr Nicholls was Chief Executive of Nicholls & Price, Television & Marketing, of whom he notes that the Registered Proprietor was a client and he a consultant. His previous positions include Executive Producer of the “Holiday Show” television series (Australia, New Zealand, SE Asia, and cable in the UK), and three years as Marketing Director of Air New Zealand where, he says, he first became aware of Danièle Ryman and her aromatherapy products. He confirms that he is authorised to speak on his company’s behalf and that his statement is based on his own personal experience and knowledge unless otherwise stated.

21. The main points arising from Mr Nicholls’ witness statement are:

- that during his time at Air New Zealand he was responsible for the re-branding launch and company image across the airline. In December 1989, the Danièle Ryman range of products for passengers was recommended to him;
- that following meetings with Ms Ryman’s Marketing Director, Farrol Kahn and Chris Moss of Virgin Atlantic (who has been the first to use Ms Ryman’s products), the programme was approved as part of the airline re-launch and that in 1990 he came to London for a final presentation and to commission the product range;
- that all Air New Zealand flights featured in-flight video and audio programming with Ms Ryman illustrating the products, and her books and products were featured on duty free. He refers to exhibit JN1 (but should be exhibit JN2) which, he says, consists of articles, letters and an airline brochure relating to the success of Ms Ryman’s products on international airlines including, Aer Lingus, British Airways and Air New Zealand. He adds that the products were on board all flights into and from the UK for 11 years;
- that in September 1993, he was a speaker together with a representative of British Airways, at the WAEA international airline conference in London, his presentation including a reference to Ms Ryman and her products. At this conference he met representatives of Jetlag International Manufacturing group who produced and supplied amenities for British Airways. They were introduced to Ms Ryman, and began manufacturing for her. In 1993, British Airways introduced Ms Ryman’s products and the products were onboard for four years;
- that 15 international airlines with an estimated 52 million passengers have featured Ms Ryman’s aromatherapy products all of which flew in and out of the UK, and that the Aromacology trade mark was introduced on all Ms Ryman’s products on all her international client airlines from 1995;

- that in 1991, he negotiated a contract for Danièle Ryman Aromacology products to be featured and sold on Television Shopping Network (TVSN) based in Sydney, Australia, and with satellite footprints throughout SE Asia, China and New Zealand. He refers to exhibit JN2 (but should be exhibit JN1) which consists of a letter dated 17 December 1999 from the General Manager of Network Production at TVSN in which he states that it was the most successful product launch to date. He adds that the company sold £60,000 of Aromacology products within a month, that Ms Ryman appeared on a number of TVSN shows and that there was extensive Australian and New Zealand media coverage;
- that in April 2000, Danièle Ryman Aromacology products were offered for sale on QVC, the largest cable-shopping network in the UK;
- that in December 2000, Ms Ryman made a presentation on her Aromacology brand of products to Marks & Spencer; they were introduced into Marks & Spencer stores in October 2001;
- that Marks & Spencer invested significantly in the range over the next 3 years. This included: design and development, packaging, manufacturing, a range of 27 products and further gifts, for, for example, Christmas, Mother's Day (all products were, he says, called Aromacology), store space and stands in 300 stores, staff training on a national basis, staff catalogues, a launch programme, ongoing media events, point of sale items and brochures, national and regional public relations coverage, features in the Marks & Spencer magazine. He adds that Danièle Ryman Aromacology products were sold in 7 stores in Hong Kong. For 3 years, Danièle Ryman Aromacology products were featured at the annual management conference. For 2 years, Ms Ryman was a speaker for Marks & Spencer at the UK Vitality Show, where, he says, they had a display devoted to the Danièle Ryman Aromacology brand, and that during the 3 year agreement period, Ms Ryman visited numerous UK stores and gave customer presentations and media interviews;
- that a representative of Marks & Spencer confirmed that at that time, 10 million customers visited their stores in the UK each week. A photograph of one of Marks & Spencer's typical Aromacology display stands is provided as exhibit JN3;
- that Ms Ryman has appeared on GMTV and the Gloria Hunniford shows;
- that in January 2003 an approach was made to Danièle Ryman Aromacology Ltd by Boots plc, for a licensing agreement to feature Danièle Ryman skincare products in the UK and Eire.

22. Having reviewed the evidence provided by the Applicant, he then makes the following comments:

- that he does not understand how Ms Kinnaird can deny any knowledge of Ms Ryman's use of Aromacology, given that in 1999 he personally wrote to Ms Kinnaird and sent a Danièle Ryman Aromacology pack with a view to her company, Space NK, selling the Aromacology branded packs as Christmas gifts.

The pack was, he says, returned to him, together with a signed letter from Ms Kinnaird declining the offer;

- that given that QVC, the key Marks & Spencer and Boots health and beauty commercial experts have confirmed that they had not heard of Aromacology until it was used by Ms Ryman as her trade mark, he does not understand how a number of the witnesses can claim not to have heard of Ms Ryman and her association with the Aromacology trade mark;
- that Ms Ryman has known Ms Green for a number of years and that they have met on a number of occasions including at the Aroma-Chology Conference in Paris in 2002. He says that Ms Green has never mentioned the Aromacology trade mark to Ms Ryman or shared any concerns with her;
- that together with their Trade Mark Attorneys Hallmark IP Limited, a number of companies have been contacted in defence of their trade mark.

23. The third witness statement, dated, 3 March 2005, is from Jonathan Wyness of Manches, the Registered Proprietor's professional representatives in this matter. Mr Wyness confirms that the facts in his statement come from his own personal knowledge and experience and from reading the evidence filed by the parties to the proceedings. His detailed (14 page) statement consists of a mixture of comments and observations on the evidence filed, together with submissions on how the matters to be determined in these proceedings should be approached. Whilst I do not propose to offer a summary of the statement here, I have of course read it, and will keep its contents in mind when reaching my decision.

24. The fourth witness statement, dated 3 March 2005, comes from Nicholas Francis Preedy. Mr Preedy is a Trade Mark Attorney and Executive Manger of HallMark IP Limited where he has worked for 8 years. He explains that he has acted for both Danièle Ryman Limited and Danièle Ryman Aromacology Limited in many trade mark matters in both the UK and overseas.

25. Having provided information on how the application was prosecuted at the ex-parte examination stage, he explains that subsequent to the mark becoming registered, examples of the same or similar marks were discovered and various companies approached, with a request that they note the existence of the Aromacology trade mark and cease use of the mark of concern; examples provided are The Body Shop and Coty Inc. In so far as The Body Shop was concerned, Mr Preedy explains that following a telephone call received from The Body Shop, he was advised that the franchisee concerned would be told to withdraw any offending products. A subsequent check revealed that this action had been taken. In relation to the approach to Coty Inc, he explains that although no written confirmation was received, no further action was taken by them as Mr James Nicholls had contacted the company in New York and was advised that the product would be withdrawn in the near future.

26. The fifth witness statement, dated 2 March 2005, is by Helen Tarver. Ms Tarver is a Brand Development Manager for Boots, a position she has held since April 2004. Prior to this, she was Head of Brands for skincare at Boots, a position she held for 18

months. She confirms that she has access to her company's records and is authorised to speak on their behalf.

27. The main points emerging from Ms Tarver's witness statement are:

- that Boots is one of the best known retail names in the UK, providing health and beauty products and advice to enhance well being. The Boots Group employs around 75,000 people and their products are sold in over 130 countries. In the UK there are 1450 Boots stores nationwide;
- that prior to joining Boots she was Global Category Head for Cosmetics at The Body Shop another well known company in the field of health, beauty and personal care products in the UK, and around the world;
- that by virtue of her in depth knowledge and experience in the field of health and beauty products in the UK she is competent to speak from her own knowledge and expertise;
- that she has been familiar with Ms Ryman and her Aromacology brand of products for approximately 3 years;
- that she has always believed that the name Aromacology was a brand name for Ms Ryman's products, and that she has not seen any other use of the word Aromacology on products in the UK;
- that when she noticed the use by the Applicant of the word aromacologie she brought it to the attention of Ms Ryman;
- that in October 2004, Boots launched an exclusive range of Danièle Ryman skincare products in its stores in the UK and Ireland and that she was personally involved in this arrangement from the start;
- that having been aware that Marks & Spencer sold Ms Ryman's products using the Aromacology brand name, Boots wanted to differentiate their products from the Marks & Spencer range. Because they believed that the name Aromacology was better known to the public than the Danièle Ryman name, they removed the name Aromacology from the range sold by Boots;
- that in her view the majority of the UK public will not have heard of the word Aromacology and so would consider it a distinctive brand name with no particular meaning when used either alone or as part of a composite mark, and that a minority would be familiar with the word Aromacology only because of the Danièle Ryman Aromacology brand sold by Marks & Spencer.

28. The sixth witness statement, dated 15 February 2005, is by Barbara Brittingham Powers. Ms Brittingham Powers explains that she specialises in homeopathic medicines and owns laboratories in Mexico and California which manufactures products for distribution and sale in approximately 4 countries. In addition, she owns and supervises a health centre in Mexico that specialises in multifunctional and integrative medicine. She adds that together with her team of doctors she attends

conferences and seminars. She says: “*I have personally used Aromacology products since the early 70’s*” and that by virtue of her in depth knowledge of, and experience in the field of health which includes the use of aromatherapy products, she is competent to provide her statement from her own experience and expertise.

29. The main points emerging from Ms Brittingham Powers’ witness statement are:

- that in 1972 she lived in London and attended a conference on natural beauty and health in London at which Ms Ryman spoke and that as a result she made her first appointment at Ms Ryman’s clinic;
- that she has used Ms Ryman’s products ever since and that Ms Ryman also prepares custom made orders for her;
- that at first Ms Ryman’s products were only branded with her name and that since the late 70s she was looking to arrive at her own name;
- that Ms Ryman has marketed her products under the Aromacology name since the early 1980s;
- that she is not aware of other products in the UK or elsewhere which have been marketed under the Aromacology name and that in her opinion the name Aromacology is exclusive to Ms Ryman’s products.

30. The seventh witness statement, dated 15 February 2005, is by Jacqueline Paterson. Ms Paterson explains that from September 1999 until April 2004 she was employed by Marks & Spencer as a Business Unit Director Beauty which became Business Unit Director Beauty and Lingerie.

31. The main points emerging from Ms Paterson’s witness statement are:

- that Marks & Spencer is one of the UK’s leading retailers and that according to their website 10 million people shop with them each week in over 375 stores throughout the UK;
- that prior to joining Marks & Spencer she was Buying and Marketing Controller at Boots Limited, a position she held between 1995 and 1998;
- that by virtue of her in depth knowledge and experience in the field of health and beauty products in the UK she is competent to speak from her own knowledge and expertise;
- that in 1996/97 whilst at Boots they looked to introduce a range of aroma therapeutic products into stores and their research led them to Ms Ryman who they knew to be a leader in this field with well documented credentials and an established product line. However, it was not possible to conclude a deal at that time;

- that in her subsequent capacity at Marks & Spencer she was involved in the launch of Ms Ryman's products throughout her company's stores nationwide in 2000/2001;
- that in her opinion the term Aromacology has been synonymous with Ms Ryman's products serving to distinguish them from the Aromatherapy products of other companies and that she has not seen any other use of the word Aromacology, in any spelling on products in the UK;
- that in her view the majority of the UK public will not have heard of the word Aromacology, and that a minority would be familiar with the word Aromacology only because of the Danièle Ryman Aromacology brand sold by Marks & Spencer.

32. The eighth witness statement, dated 22 February 2005, is by Pauline Owen. Ms Owen explains that she is currently employed as a Technical Sales Executive at her company CPL Aromas Limited a UK company which manufactures fragrance oils for cosmetic and fragrance companies. She adds that she has held the position of Technical Director at her company for eight years and confirms that she has access to her company's records and is authorised to speak on its behalf.

33. The main points emerging from Ms Owen's witness statement are:

- that by virtue of her in depth knowledge and experience in the field of fragrances, cosmetics and chemical formulation in these areas, she is familiar with the UK cosmetics market and is competent to provide her statement from her own knowledge and expertise;
- that she has been familiar with Ms Ryman and her aromatherapy products since 1995;
- that in 1997 her company started producing the Danièle Ryman aromatherapy products sold by Marks & Spencer;
- that Ms Ryman's products include the Aromacology name on the packaging;
- that she is not aware of any other product in the UK market place which used the name Aromacology at that time and that she believes that the term Aromacology is meaningless except as a mark used on Ms Ryman's products.

34. The ninth witness statement, dated 16 February 2005, is by David Munden. Mr Munden explains that he is a Chartered Chemist, and a Member of the Royal Society of Chemists and the Society of Cosmetic Scientists. He was a Past President of the Society of Cosmetic Scientists in the UK and is currently the Honorary Secretary. He is also the joint owner of Smallburgh Laboratories Ltd, a company which develops scented formulations for cosmetic companies in the UK and overseas. He confirms that he has access to his company's records and is authorised to speak on its behalf.

35. The main points emerging from Mr Munden's witness statement are:

- that he has participated in seminars and conferences on the subject of fragrances and cosmetics including various lectures, and that during the 70s and 80s he travelled worldwide lecturing on perfumes to cosmetic and toiletries manufacturers;
- that by virtue of his in depth knowledge and experience in the field of fragrances, cosmetics and chemical formulation in these areas, he is familiar with the UK cosmetics market and is competent to provide his statement from his own knowledge and expertise;
- that he has known Ms Ryman since the early 1980s and that his company and its predecessors have made formulations for Ms Ryman's Aromacology range of products;
- that his first recollection of the Aromacology name was at a lecture given by Ms Ryman in the early 1980s;
- that he does not recall anyone using the term before Ms Ryman and that he is not aware that any company uses the name on its aromatherapy products;
- that he believes that the term Aromacology is used occasionally within the scientific community during debates on the subject of aromatherapy;
- that he believes that the term Aromacology is meaningless in the market except as a mark used on Ms Ryman's products.

36. The tenth witness statement, dated 2 March 2005, is by Derek Wheeler. Mr Wheeler explains that after obtaining degrees in Chemistry and Physiology at London University he joined British Drug Houses in 1964. He subsequently moved to Smith & Nephew in 1967 and then to Yardley in 1970 where he was involved in analytical chemistry, product formulation, process engineering and marketing. In 1977 he was appointed Chief Chemist at Dixor Strand later becoming Managing Director. He was a co-founder of Elite Assembly Ltd, a cosmetic manufacturing company which was sold to Peter Black Cosmetics in 1983, where he remained as Technical Director until 1986. He was also a co-founder and major shareholder in Disperse Technologies and is currently Technical Director of the Disperse Group plc which formulates cosmetic and allied products. He states that he enjoys an international reputation as a leading cosmetic scientist and has made significant contributions to the teaching, advancement and dissemination of cosmetic science through many lectures and publications.

37. The main points emerging from Mr Wheeler's witness statement are:

- that by virtue of his in depth knowledge and experience in the field of fragrances, cosmetics and chemical formulation in these areas, he is familiar with the UK cosmetics market and is competent to provide his statement from his own knowledge and expertise;

- that he has known Ms Ryman since the early 1980s;
- that since the 1980s he has worked with Ms Ryman helping to produce stable formulations of her blends and scented products and solutions;
- that in those days the term aromatherapy had a questionable reputation amongst the public and he recalls talking to Ms Ryman about making her products distinguishable from other aromatherapy products on the market. He also recalls the conversation during which the term Aromacology was first mentioned, commenting that he may have been the one who to his mind invented it;
- that he believes that the term Aromacology is meaningless in the market except as a mark used on Ms Ryman's products, adding that he is not aware that it is a term used in the marketplace on any products other than those of Ms Ryman.

That concludes my review of the evidence filed.

THE LAW

38. Section 47(1) reads:

“47.-(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.”

The applicant relies here on Section 3(1)(b) and (c) which reads:

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

- (a)
- (b) trade marks which are devoid of any distinctive character,
- (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,”

39. The applicant asserts that the word ‘aromacology’ designates the study of the physiological or psychological effects of odours and, therefore, designates a characteristic of goods developed in accordance with the principles of the science of aromas. The principal objection is under sub-paragraph (c) but, as a consequence, it is also said that the word is devoid of distinctive character within the meaning of (b).

Principal authorities

40. I was referred at the hearing to a large number of authorities on particular aspects of the case. I propose at this point to set out what I consider to be the main guiding principles in relation to the operation of Section 3(1)(c) (or its equivalent in the First Council Directive 89/104 and Article 7(1)(c) of Council Regulation 40/94 on the Community Trade Mark). Other authorities will be referred to as necessary during the course of my decision. The guiding principles are:

- Section 3(1)(c) pursues an aim which is in the public interest, namely that descriptive signs or indications may be freely used by all and thus prevents such signs or indications being reserved to one undertaking alone because they have been registered as trade marks – *Windsurfing Chiemsee Produktions v Huber* 1999 ETMR 585 paragraph 25 and *Wm Wrigley Jr & Company v OHIM* – Case 191/01P (Doublemint) paragraph 30;
- signs and indications which may serve in trade to designate the characteristics of goods or services are deemed incapable of fulfilling the indication of origin function of a trade mark – *Wm Wrigley Jr & Company v OHIM* – paragraph 30;
- it is not necessary that such a sign be in use at the time of application in a way that is descriptive of the goods or services in question. It is sufficient that it could be used for such purposes – *Wm Wrigley Jr v OHIM*, paragraph 32;
- it is irrelevant whether there are other, more usual signs or indications designating the same characteristics of the goods or services. The word ‘exclusively’ in paragraph (c) is not to be interpreted as meaning that the sign or indication should be the only way of designating the characteristic(s) in question – *Koninklijke KPN Nederland NV and Benelux Merkenbureau*, Case C-363/99 (Postkantoor), paragraph 57;
- if a mark which consists of a word produced by a combination of elements is to be regarded as descriptive for the purposes of Article 3(1)(c) it is not sufficient that each of its components may be found to be descriptive, the word itself must be found to be so – *Koninklijke KPN Nederland NV and Benelux Merkenbureau*, paragraph 96;
- merely bringing together descriptive elements without any unusual variations as to, for instance, syntax or meaning, cannot result in a mark consisting exclusively of such elements escaping objection – *Koninklijke Nederland NV and Benelux Merkenbureau*, paragraph 98;
- however such a combination may not be descriptive if it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements – *Koninklijke Nederland NV and Benelux Markenbureau*, paragraph 99;

- a mark consisting of a neologism composed of elements descriptive of characteristics of the goods is itself descriptive of those characteristics within the meaning of the Section/Article unless there is a perceptible difference between the neologism and the mere sum of its parts – *Campina Melkunie BV and Benelux-Merkenbureau* – Case C-265/00 (Biomild).

Relevant dates and onus

41. It is common ground that there are, potentially, two relevant points in time at which the issue must be tested. The first is the filing date of the registration under attack – in this case that is 7 June 1999. If the registered proprietor succeeds in defending the registration based on my findings at that point in time, that is an end to the matter (there being no additional grounds under Section 46(1)(c) or (d)). If, on the other hand, I find that the mark was in breach of Section 3(1)(c) at that point in time then the proprietor is still entitled to have its position assessed on the basis of the second paragraph of Section 47(1) by virtue of use since registration. This possible defence would need to be considered as at the filing date of the application for invalidity, that is to say 18 June 2004.

42. It is also common ground that these separate considerations affect the matter of onus. It is for the applicant for invalidity to displace the prima facie presumption of invalidity that was created by the mark being placed on the register with effect from the filing date of 7 June 1999. But, if the proprietor needs to rely on distinctiveness acquired after registration, then it bears the legal burden of satisfying me that such acquired distinctiveness has been established (see – *Premier Luggage and Bags Ltd v Premier Co (U.K.) Ltd & Another* [2002] ETMR 69 at paragraph 53).

DECISION

The position at 7 June 1999

43. In considering usage of AROMACOLOGY I bear in mind the following passage from the Court of Appeal’s judgment in *Bach and Bach Flower Remedies* [2000] RPC 513:

“35. The usage in question must be by those engaged in the relevant trade or activity. Normally that will be the usage of the average consumer of the goods in question as described in *Lloyd Schuhfabrik*. Obviously the evidence on that question is not limited to those who are consumers or end-users but may extend to others concerned in the trade such as manufacturers, wholesalers and retailers.”

44. The matter was also considered in the *Premier Luggage* case. The Court of Appeal noted that:

“21 The judge was concerned as to whether “the relevant class of persons”, for the purposes of the test posed by the Court of Justice in paragraph 52 of its judgment in the *Windsurfing Chiemsee* case, was confined, in a case like the present (where the supplier does not sell direct to the

public), to wholesalers and retailers, or included the ultimate consumer. He resolved that question at paragraph 47 of his judgment:

“It seems to me that I am bound to follow the decision and reasoning of the Court of Appeal in the *Bach Flower* case. I do not consider that in the present case, which concerns the situation in which retailers and wholesalers are themselves purchasers or intermediate purchasers of the claimant’s goods, this requires me to ignore wholesalers and retailers completely. It does, however, require me, for the purposes of the proviso to section 3(1) of the 1994 Act, to treat ultimate consumers as part of the relevant class of persons who, or a substantial proportion of whom, because of the PREMIER mark, must identify the claimant’s goods as originating from the claimant.”

At paragraph 48, he directed himself that he must be satisfied that:

“... the class comprising retailers, wholesalers and ultimate consumers, or at least a significant proportion of them, identify luggage as originating from the claimant in consequence of the PREMIER mark.””

45. The Court held that:

“55 the judge applied the correct test when he directed himself that he must consider whether the evidence established that the average consumer (including both trade purchasers and members of the public) would appreciate that the PREMIER mark displayed on the products of Premier Luggage was not used in a laudatory sense but as a distinctive branding of the products.”

46. Accordingly, my consideration must extend to both end-users of the Class 3 goods concerned in this case and others concerned in the trade such as manufacturers, wholesalers and retailers. There is no direct evidence from members of the public in this case though it seems from *Bach and Bach Flower Remedies* (see paragraph 21 of the Court of Appeal judgment) that, without cross examination, any such evidence would need to be treated with some caution. I do have evidence from the trade and other knowledgeable sources though there is some difficulty in establishing what their understanding and beliefs were at 7 June 1999 and why they held the views they did.

47. Ms Mastrovito’s submission on behalf of the registered proprietor was to the effect that the word AROMACOLOGY was a coined word and that in June 1999 it was only the name of a science and then primarily in the United States. Such usage could be distinguished from trade mark usage in relation to Class 3 goods.

48. The evidence contains contradictory indications as to who coined the word and when. Danièle Ryman’s own evidence is a measure of the difficulty of reconstructing the history of the word. Her evidence in chief in these proceedings claims that “I coined the word Aromacology in the UK in the early 1980’s”, whereas her evidence at the examination stage (filed to support an honest concurrent use claim), exhibited at

BEC4 to Ms Cookson's evidence, says that "In 1991 I invented the word AROMACOLOGY ...".

49. There are other competing claims. Thus, Annette Green's evidence (paragraph 11) refers to Aroma-Chology as "a concept developed under the leadership of the Sense of Smell Institute in the 1980s". Mr Dodd says that he traces "the first (or one of the first) public displays of the new word "aromachology"" to use at a UK conference held at the University of Warwick in 1987. The fact that Ms Green claimed it as a (US) service mark in connection with seminars and conferences at the time further clouds the issue and is somewhat difficult to reconcile with her separate claim that it is a 'concept'.

50. In support of the registered proprietor's position Mr Wheeler has suggested that he may have been the person who invented it and, confusingly, Barbara Brittingham Powers claims to "have personally used Aromacology products since the early 70's". It is impossible to reconcile that claim with her subsequently stated belief that "Since the late 70's she [Danièle Ryman] was looking at arriving at her own name, which she did and trademarked as Aromacology".

51. It is not, in my view, profitable to try and reconcile the divergent claims that exist in the evidence. In any case the more important question is not who invented the word but as what – the name of an emerging science or a trade mark? More important still, how has the word been used and what impact would it have had on the relevant body of consumers in June 1999.

52. It is not disputed that the word had some currency from mid 1980s onwards (it is neither possible nor necessary to pin a more exact date on it). Mr Dodd is, so far as I can tell, an independent witness in this matter. He has a background as a scientist but latterly has moved into the area of the commercialisation of the science in which his expertise lies. Referring to his work in the University of Warwick Olfaction Group he says:

“8 In my opinion, the success of the Warwick Olfaction Group during the 1970s-80s, encouraged the Fragrance Foundation in New York to recognize that the US too needed to develop an interest in the scientific aspects of fragrance. The Foundation decided to seek funding for fragrance research and ultimately invented a word to describe fragrance research.

9 So, the search was 'on' for an "-ology", and it could have been "scentology" or "fragrantology" or "aromaology" or "perfumology" – but actually became "aromachology". The term refers to the (scientific) study of the effects of aromas on humans.”

53. It is clear from Mr Dodd's evidence that at least in academic circles a word was required to give a more scientific feel to the work being done on the psychological and physiological effects of aromas and to distinguish it from aromatherapy. As indicated above, Ms Mastrovito accepted that the word was in use as the name of a new science at least in the US. Mr Dodd's evidence supports the view that the term was also being used in the UK. Moreover Ms Green's attendance at the Warwick

University Conference on the Psychology of Perfumery referred to above (in her capacity as Director of the Fragrance Foundation) suggests that the leading players on both sides of the Atlantic were aware of one another's interest in this area.

54. Ms Mastrovito, sought to distinguish this scientific work and usage from the use of the word as a trade mark in relation to Class 3 goods. It seems to me that that argument fails on two accounts. Firstly, Mr Dodd says that "Once the term started to be used in the general scientific community it began to attract the attention of various companies who wished to employ aspects of this term for their own commercial purposes". The commercialisation of scientific research seems to me to be an entirely plausible development. Mr Dodd cites the activities of the Aromachology Patch Company as an example of such commercialisation (see also the extract from *The New Perfume Handbook* later in this decision) .

55. Secondly, the distinction that is sought to be drawn between the science and use of the word in relation to goods seems to me to be an artificial one that does not entirely withstand an examination of the proprietor's own evidence. Thus, Mr Wheeler says "Her [Danièle Ryman's] products were based on a great deal of research and were far more scientifically orientated than many of the aromatherapy products on the UK market at that time". Mr Wheeler is well placed to make such an assessment. He has degrees in chemistry and physiology, was an analytical chemist and now is Director of a company that formulates cosmetics and allied products. Mr Munden, a Chartered Chemist, also comments on the use of the term Aromacology within the scientific community during debates on the subject of aromatherapy. Mr Nicholls, who gives evidence on behalf of the proprietor, also refers at several points to the research undertaken by Danièle Ryman and her contributions to scientific books. His exhibit JN1 contains references to her being a qualified biochemist.

56. I do not, therefore, accept that use of the term aromacology was confined to the scientific community or that a clear distinction can be drawn between the science and the commercial application of that science. The evidence suggests that a new word was sought to distinguish the more scientific approach to the effects of aromas from aromatherapy. But it did not take long for the word to be used more widely including in a commercial context.

57. In addition to the statements of the parties' witnesses as to their beliefs and understandings there is other material in the evidence that must be considered in coming to a view as to how the term was being used and how the relevant public including the trade was likely to have perceived the word in June 1999.

58. I should say in passing that it will be apparent at various points in this decision that variant spellings of the basic word are employed. The registered proprietor's mark is AROMACOLOGY. The word can sometimes be found spelt as 'aromachology', that is to say with the addition of the h. Exhibit MF-1 shows a large number of each of these spellings as well as a small number of other variants. The registered proprietor contends that the word was coined from 'aroma' and 'ecology' and thus constitutes an acceptable neologism. It was submitted that the more natural construction to describe a science based on aromas would have been 'aromaology'. This seems to me to be a fine point of distinction and not necessarily one that would enter the thought processes of the trade or of consumers who are not generally

credited with analysing the construction of words/marks. But in the final analysis, if the word is descriptive of the goods at the relevant date, it does not matter whether it was a neologism when first coined.

59. Mary Fontenot's evidence contains the results of a LexisNexis database search in relation to use of AROMACOLOGY (in its variant forms) in media references. A summary of the results can be found at paragraph 15 above. Ms Mastrovito submitted that this evidence was open to criticism on a number of accounts. The main criticisms were that it is not always possible to determine whether the references are US or UK (or elsewhere); that some of the references are to third party trade marks or may be infringing use; that some of the references to aromacology could be trade mark use or misuse; and that the full text of the relevant articles is not always exhibited. There is force to some of these criticisms but a sufficiently large number of references survive to give this part of the evidence relevance. The following is a selection of excerpts from articles which pre-date the filing of the registration under attack and which are from UK sources:

- June, 1997: "... I was intrigued by the idea of these Diet Scent '**aromacology**' patches. How could the smell of an orchid put me off chocolate?" *The Independent* (London); by Caroline Sarrl, June 21, 1997; Reference 672.
- May, 1997: "The latest brainstorm to wean people off confectionery comes from Liz Paul, a food specialist and self-confessed chocolate addict. Using the new, and more or less bogus, science of **aromacology**, Liz found certain smells put her off her nibbles." *The Scotsman*, May, 1997; Reference 683.
- May, 1998: write-up on products in Boots stores: "Altro products are made by 4W, the company which created the cult Mio Essential Fragrances, and like Mio, Altro is based on the natural science of **Aromachology** – the power of fragrance on the mind." *The Herald* (Glasgow); May, 1998; Reference 625.
- April, 1998; write-up on a spa-like facility in Auldearn called Boath House; "the staff trains in body-work systems and plant **aromaology** and are able to determine each clients aroma identity ..." *Aberdeen Press and Journal*; April, 1998; Reference 631.
- May 24, 1997: Appearing in *The Guardian* (London) in *The Guardian Weekend Page*, pg. 67, entitled *Lastword: Glossary for the 90s* "**Aromocology** n. A new so-called science that claims to use odours to benefit your health. A scented patch worn on your arm, for instance, is claimed to put you off chocolate and so help your diet; but some scientists are not convinced that **aromacology** works, and, er, smell a rat." Reference 682.
- June 9, 1990: Article on Shiseido; "These days, even Shiseido's headquarters in Tokyo's Ginza district smells of roses – or of citrus or jasmine, depending on the time of day. This is the company's means

of demonstrating ‘**aromacology**’ – the Muzak of fragrance.” *Financial Times* (London); June, 1990; Reference 810.

60. Whilst it is true that the full text of the articles is not always exhibited, the references are sufficiently self-contained for the meaning to be ascertained. The last of the above extracts relating to Shiseido is one of a number relating to that company, the others being from various editions of *Cosmetics International*. I accept Ms Mastrovito’s submission that the articles do not show that Shiseido was itself using the term aromacology in relation to products offered for sale in the UK. It is, however, clear that the term was being used in publications circulating in the UK in relation to that firm and the journalistic reference is as a descriptor.

61. As Ms Fontenot acknowledges a number of the media items identified in the LexisNexis search relate to Danièle Ryman but I take the view that a significant number refer to AROMACOLOGY in terms that suggest it is the name of a science or quasi science rather than a trade mark.

62. A further category of material that is relevant to this part of the enquiry is Ms Ryman’s own evidence as to how she presented the word to consumers in the period up to the filing date of her application. Much of her evidence relating to this period goes to establishing her reputation as a leading practitioner of aromatherapy and the celebrity clients that have used her services. Little, if any, of the material exhibited to her witness statement deals with use of AROMACOLOGY prior to June 1999. Somewhat unusually, it is the applicant for invalidity who has exhibited the evidence filed by Ms Ryman at the examination stage. The material is at Exhibit BEC4 to Ms Cookson’s evidence.

63. The trading figures supplied relate only to July 1999 onwards and so are strictly beyond the relevant date. Invoice evidence forms Exhibit DR1 to the second witness statement filed in support of the then application. The invoices bear dates in the period 1996 to 1999. An example of a typical invoice is shown in the Annex to this decision for ease of reference. The words Danièle Ryman Aromacology are shown in a roundel at the centre of which is a flower device. Beneath that composite mark are the words Aromacology/Aromatherapie. Ms Mastrovito submitted that the message thus conveyed was that goods sold under the mark were Danièle Ryman’s Aromacology (brand) aromatherapy products.

64. I do not find that an altogether natural interpretation. The linkage of ‘Aromacology/Aromatherapie’ is more likely in my view to be taken as a descriptive reference to a characteristic of the goods, namely that they were products that utilised the principles of aromacology and/or aromatherapy. The mere fact that Aromacology also appears in the composite sign along with the words Danièle Ryman does not necessarily support a different view of the matter (substituting the word Aromatherapie for Aromacology in the roundel would not, for instance, turn that word into a trade mark or give it distinctive character within the totality of the mark). I note also that at this time the proprietor was not using a TM indicator to draw attention to the claimed significance of AROMACOLOGY though I accept this cannot be determinative.

65. I should also refer to the evidence filed in order to demonstrate that aromacology had passed into common usage to the point where dictionaries define the term. The first of the definitions is outlined in *The New Perfume Handbook, Second Edition* (Exhibit NK6 to Ms Kinnaird's evidence). The first edition of the publication was in 1992. It appears to be available in the UK (it is published and printed in this country and has other UK referencing). The exhibited extract is from the 1997 edition as follows:

“Aromachology A branch of aromatherapy concerned with the physiological effects of scents including their use to influence moods. Current research, mainly in Japan, is concerned with the selection of scents with calming or uplifting effects and the physical measurement of those effects. Applications being developed in Japan, principally by Shiseido, include an aromatic alarm clock, designed to emit satisfying odours at the time of awakening, and the emission of perfumes in work environments designed to refresh and to relieve stress among office and operational staff.

Some commercial fragrance houses have already sought to apply aromachology in the composition of their fragrances, e.g. Guy Laroche's 'Horizon' is claimed to promote relaxation and a sense of happiness while reducing irritation and stress, Lancaster's 'Relax' to induce a relaxed feeling, Yardley's 'Exprit Vital' range to offer various effects from 'sensory fragrances' – 'Eau Fresh' to cool and refresh, 'Eau Energie' to enliven and invigorate, 'Eau Sensuelle' to soothe and relax. 'Wings', introduced by Giorgio Beverly Hills in 1993, claims to contain a combination of ingredients which promote happiness, sensuality, relaxation and stimulation. IFF researchers can now offer a multitude of what are termed mood enhancement fragrances.”

66. I do not know whether the 1992 edition of the Dictionary also recognised the existence of the term.

67. It is not clear what the intended audience is for *The New Perfume Handbook*. Ms Cookson suggested that end consumers would use it. Perhaps some would. But it strikes me as rather more in the nature of a reference work for the trade in the broadest sense. It may also be of interest to academics but it would seem from the second paragraph of the above passage that the publication demonstrates an awareness of commercial applications for what it calls this 'branch of aromatherapy'. I also infer that, even if the origins of the term AROMACOLOGY was in scientific circles that there was at least by 1997 a more general awareness of the science and its potential in the perfumery /cosmetics field.

68. The second reference is contained in the Second Edition of *The Complete Guide to Aromatherapy* by Salvatore Battaglia (Exhibit BEC1 to Ms Cookson's witness statement). However, this is an Australian publication and I consider that I should exercise caution in determining its relevance in the UK market.

69. For the same reason I am reluctant to place weight on the definition of Aromachology on the Sense of Smell Institute web-site (Exhibit AG1 to Ms Green's affidavit). Perhaps the most that can be taken from these latter two references is the

inference that the trade is an international one and the vocabulary of the trade may also be international in scope.

70. The main conclusions I draw from this material are that:

- it is not possible at this late stage to identify who coined the word. It is possible that general interest in a more scientific approach to the effects of aromas in the mid 1980s led more than one person to look for and coin an appropriate term;
- the evidence suggests that use was initially concentrated in scientific circles but by the end to late 1990s was being used more widely in the UK (including in the press and at least one dictionary);
- there is no direct evidence as to how consumers would have reacted to use of the word at the relevant date but it appears that commercialisation of the science was taking place;
- use of the word by other traders in relation to Class 3 goods in the UK was limited;
- the registered proprietor's own use was not unambiguously to indicate the trade origin of the goods and more easily lent itself to the interpretation that it was descriptive use.

71. In reaching a conclusion on this aspect of the case I have also considered a number of other cases that were referred to by the parties, in particular *Merck & Co Inc v Smithkline Beecham Plc (Jeryl Lynn)*[2000] ETMR 75, *Universal Products (Lytham) Manufacturing Limited* and *Bioglan Laboratories Limited (Cosmeceutical)*, O-349-99, and *The Sensory Company International Limited and Rompa Limited*, O-031-05. It goes without saying that each of those cases was decided on its own facts and beyond certain general principles (which can in the main be derived from the ECJ cases) do not directly assist in coming to a view on this case.

72. Ms Mastrovito may be right to say that it does not automatically follow that because a word is the name of a science it cannot also function as a trade mark. That may even be true in relation to goods related to that science but there are obvious difficulties in the path of an applicant where the science feeds into, and is, or has the potential to become, the basis for, the development of related goods. Nor in my view does it assist the registered proprietor that there may be, or have been, other possible names for the science in question (*Postkantoor*, paragraph 57).

73. The key issue is whether in June 1999 AROMACOLOGY served in trade to designate a characteristic of the goods or whether it was a word that should be kept free for other traders to use even if it was not actually in use in trade at that point in time. It is clear in this respect that it is not necessary for the applicant for invalidity to show that the sign was in use in trade at the critical date. It is sufficient if Chantecaille is able to show that it could have been so used (*Doublemint*, paragraph 32 and *Windsurfing*, paragraph 31).

74. The weight of evidence seems to me to be in the applicant's favour. There was sufficient use/knowledge/awareness of the term by the time the application was filed that registration should have been precluded by Section 3(1)(c) of the Act because other traders would have had good reason at that point in time to think that this was a word that they should be free to use in relation to their own competing products to indicate a characteristic of those products. Even if it qualified as a neologism at the time it was first used, it had by the relevant date fallen into use as the name of a new science and would be required in relation to the commercial exploitation of that science.

75. In the light of my finding in relation to Section 3(1)(c) I do not propose to give separate consideration to the objection under Section 3(1)(b). It was held in *Postkantoor* that:

“86. In particular, a word mark which is descriptive of characteristics of goods or services for the purposes of Article 3(1)(c) of the Directive is, on that account, necessarily devoid of any distinctive character with regard to the same goods or services within the meaning of Article 3(1)(b) of the Directive. A mark may none the less be devoid of any distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive.”

76. On that basis the objection under Section 3(1)(b) will also have been made out without my needing to consider whether there is also an independent objection under this head.

The position on acquired distinctiveness

77. The registered proprietor has explained that due to a fire at the previous premises of the company, certain trading information in the period prior to the filing of the application is not available. So far as I can tell from the limited material that has been provided in relation to this earlier period the trade was substantially based on the supply of products to airlines to combat jet lag etc. along with sales of goods in connection with Ms Ryman's aromatherapy practice. There is no information on what other outlets there were for the goods during that time.

78. There are two main categories of evidence covering the period from the June 1999 filing date to June 2004. Firstly, there are the sales, amounting in total to just over £2 million, from July 1999 to December 2001. Secondly, there are the sales under the licensing agreement with Marks & Spencer.

79. There is very little information in relation to the July 1999 to December 2001 period explaining how these sales came about and how the goods were sold. I infer that these sales were a mixture of continuation of sales to airlines (not all of which necessarily relates to the UK) and sales of products at or through Danièle Ryman's aromatherapy practice including her web-site. There will also have been sales resulting from exposure on the QVC cable shopping network in or after April 2000 but the information on this is scant being of uncertain duration and introduced primarily to establish Danièle Ryman's reputation in the field. I am uncertain of the precise dates of some of the material advanced in support of the claim that AROMACOLOGY has been used continuously during this period. Exhibit DR4 to

Ms Ryman's witness statement, for instance, contains a variety of material some of which clearly post dates the filing of the application for invalidity (much of the press reporting referred to at the end of the exhibit) or can be so dated by reference to e.g. an 'offer' end date.

80. The material in DR6 is similarly difficult to date but I note the use of the TM which is likely to mean that the usage in question is at least before 19 October 2001, the date on which the registration process was completed.

81. Most of the promotional material contained in DR6 gives primary prominence to the name Danièle Ryman and the initials DR in stylised form. AROMACOLOGY appears in smaller type but with the TM symbol. The final page of this exhibit is one of the few instances of prominent use of AROMACOLOGY on its own (but the use of the ® symbol on this item probably places it some time after October 2001).

82. DR6 also contains a number of product packaging/product literature items that send out distinctly conflicting messages about the word AROMACOLOGY. There are several examples of product packaging showing "AROMACOLOGY" followed by the words "THE SCIENCE OF AROMAS". Supporting explanatory text refers to "Danièle began research into mood fragrances and therapeutic perfumes and has coined a new term, Aromacology, meaning "Science of Aromas"." The natural inference to be drawn is that the word was coined to describe a new science and not as a trade mark. It is an explanation of what aromacology is for the benefit of anyone who is not already familiar with the term.

83. The invoice evidence at DR7 includes 4 items from this period – 3 to Glorient Trading (a Hong Kong company that appears to be handling airline business) and one to QVC. Prominence is given to Danièle Ryman's name and stylised letters DR. There is nothing to indicate that AROMACOLOGY is being accorded trade mark significance.

84. That brings me to the licensing agreement with Marks and Spencer which commenced in October 2001 and continued until June 2003. If I am right that the 1999 to 2001 trade was primarily business with various airlines (largely conducted through intermediaries) along with sales of products from Danièle Ryman's clinic, then that trade was in part directed to customers outside the UK and those attending her clinic and would have resulted in limited exposure to a wider customer base in this country. Coupled with that, airline passengers and those attending private clinics are unlikely to be in a position to exercise choice in terms of branded goods (being largely captive customers) and may not even have cause to consider any branding.

85. The same cannot be said of the Marks & Spencer (M & S) business. This was both a wider public trade and one where high street shoppers have a range of choices available to them. The Danièle Ryman products were given store space in some 300 M & S stores and generated some £2.5 million of sales. This is, therefore, important evidence as to how AROMACOLOGY was used and how both consumers and other traders would have perceived the sign. The key supporting exhibits in considering this use are exhibits DR7 and 8. DR7 contains 6 invoices issued to M & S. I note that they use the ® symbol. DR8 contains some 454 pages and shows samples of

packaging, advertising, in-store displays, leaflets, product lists, employee brand guides and a large volume of press material.

86. As might be expected the Marks & Spencer and Danièle Ryman names feature prominently in the literature. It is not entirely clear how much of the first 68 pages is internal guidance to M & S staff and how much would be directed at customers. Some at least appears to fall into the first of these categories. Thus, the first page is designated as being for “Section Manager, Visual Merchandiser and Sales Advisors”. I note too that some of the material is from a concurrent promotion with M & S in 7 stores in Hong Kong. (Although the turnover figures are not broken down it is reasonable to assume that the bulk of sales would have occurred through the 300 or so UK stores).

87. The word AROMACOLOGY is used in a mixture of upper and lower case, sometimes with a TM or ® symbol but sometimes without either but usually in close association with the words Danièle Ryman.

88. This material suggests that there was a clear attempt to educate M & S staff to the claimed trade mark significance of AROMACOLOGY and that the careful consumer would have received a similar message. Against that, Danièle Ryman’s reputation and presence (she features heavily in the promotional literature) were clearly key to the venture and it is questionable as to how far consumers’ search for branding would have extended beyond the Marks & Spencer and Danièle Ryman names.

89. The bulk of exhibit DR8 consists of local and national media coverage linked to the Marks & Spencer promotion. There is some duplication of material particularly from the local press coverage (one article from the Dorset Evening Echo, for instance, appears at least three times). Nevertheless it is a significant body of evidence and has merited careful consideration. I consider that it gives a mixed picture as to the significance attaching to the word AROMACOLOGY for reasons which I will go on to explain by way of examples (the page numbers in what follows are taken from a paginated version of DR8 which was kindly supplied for the purpose of the hearing).

90. The first category is what would arguably be taken as trade mark use. Examples are:

“Marks & Spencer has launched a new perfume, bath and body range called Aromacology” (page 84)

“Called Aromacology, this new holistic range from Danièle Ryman

(page 156)

“Danièle Ryman from Aromacology at Marks & Spencer says that

(page 267)

This category might also include those advertisements which feature a picture of products bearing the mark where a TM or ® symbol is evident (though with the proviso that this level of detail is rarely visible in the photocopied examples supplied and is unlikely to make an independent impact on consumers).

91. A more numerous second category includes multiple branding where it must be uncertain as to what significance would be attached to AROMACOLOGY. Examples are:

“Aromacology can help heal some of the damage we do to ourselves.”
(page 82)

“Marks & Spencer Danièle Ryman Aromacology Asleep Bath Essence”
(page 188)

“..... Marks & Spencer is the only place where high quality Aromacology products can be bought at an affordable price.....” (page 382)
(this quotation is from Jacqueline Paterson who gives evidence for the registered proprietor).

92. A third category (again there are numerous examples) uses the word in circumstances which would be taken as entirely descriptive in nature. Examples are:

“She [Danièle Ryman] has....written four books...on the subject of aromacology.” (page 66)

“To combat the stress and strain of living lives Marks & Spencer has launched its own range of holistic aromacology products” (page 83)

“....in the world of essential oils and aromacology.” (page 87)

“Marks & Spencer’s Aromacology range has been developed by the most celebrated expert in the world of essential oils and aromacology, Danièle Ryman” (page 144)

93. There is also a fourth category where the advertisements/advertorials appear to make no mention of AROMACOLOGY at all in the text (a close inspection of any supporting photographs would therefore be needed to spot the word). Examples can be found on pages 75, 78, 107, 111 and 126.

94. In addition to the above a number of the press articles/advertorials referring to or promoting the products include explanations along the following lines:

“...Aromacology, meaning the science of aromas...” (page 3)

“Aromacology is a term owned by Danièle Ryman to describe ‘the science of aromas’.” (page 7)

“Aromatherapy has become a total beauty buzzword over the past few years, but aromacology is something quite new. As opposed to aromatherapy, it’s concerned with the study or sense of smell and the relationship between psychology and aromas from essential oils, and the latest in fragrance technology.” (page 74)

“Aromacology, as opposed to aromatherapy, is a new science. It is dedicated to the study of the sense of smell, ‘osmology’ and the inter-relationship between psychology and aromas from essential oils, and the latest in fragrance technology.” (page 90)

95. Also contained in DR8 (pages 214 to 217) is a copy of a lengthy article from Aromatherapy Magazine (January/February 2002 edition) for which Danièle Ryman was interviewed. The article opens with two experts in the field offering their definitions of aromachology and goes on to draw a distinction between aromachology and ‘its better known cousin’ aromatherapy. Danièle Ryman is quoted as saying that she coined the term aromacology in 1986/87. The article goes on:

“ ‘Other brands have since picked up on it, and use variations of the spelling and so forth, but it is something that is trademarked to my product range.’

This product range is now available through Marks & Spencer, and includes perfumes, body and bath products, and fragranced candles, available in a variety of mood-enhancing aromas, including anti-stress, confidence and sensuality.

‘The range is all about helping people to benefit from aromacology in an accessible form,’ says Danièle.”

and

“Danièle wants aromacology to become a regular household term. There is obviously a place for these products in the market, and what we want to do is get this stuff out there; she says, her prettily-accented words tumbling over each other in her enthusiasm for the subject. ‘People are more cash-rich, but time-poor. This way they get all the benefits of aromacology without having to give up precious leisure time’.”

96. The article goes on to quote a spokesperson for bath products firm Radox as saying that “We turned to the science of aromachology

97. It seems to me that, whilst Danièle Ryman has referred in the article to her trade mark claim this is likely to be swamped by the other use of aromacology/aromachology as the name of a science.

98. I might just add that there are also references in DR8 to aromacologist/aromachologist e.g. pages 81, 214 and 249. An aromacologist would be understood to mean someone who practices, or is skilled in, aromacology and would in my view be seen as purely descriptive use. Such references do not sit easily with AROMACOLOGY being a trade mark in relation to goods that exploit the commercial potential of the science.

99. I have referred above to the evidence of the witnesses on each side who have indicated what AROMACOLOGY means to them. They might all be termed *parti pris* to use the judge’s words in the *Bach* case in so far as they have, or had, business

links with the parties (Mr Dodd excepted). The evidence of such witnesses was found to be of limited assistance in that case. I am mindful, however, in this case that I have statements from individuals in responsible positions in large high street chains, namely Ms Tarver of Boots and Ms Paterson of Marks & Spencer. It was Ms Tarver who first brought Chantecaille's use of the word 'aromacologie' to Danièle Ryman's attention. At the time their witness statements were given, I understand Marks & Spencer had ceased their association with Danièle Ryman and Boots had elected not to use the word AROMACOLOGY in order, as they saw it, to differentiate their product offerings from Marks & Spencer. Although it can still be said that they are interested parties I consider that their views merit weight both because of the size and repute of the organisations they represent and their presumed familiarity with the position in the marketplace.

100. Both these witnesses say that they associate the name AROMACOLOGY with Danièle Ryman and that they have not seen other use of the word on products in the UK.

101. As well as giving their views as people engaged in the trade, they address the issue from the point of view of the consumer and say, in quite similar terms, that they believe the majority of the UK public will not have heard of the word and that a minority would be familiar with the word only because of the Danièle Ryman brand sold by Marks & Spencer.

102. Whilst I accept these statements at face value as far as they go, in the absence of cross-examination I am not entirely clear on what basis they are able to express views as to consumer perception of the words. In principle such witnesses can give admissible evidence as to consumer perception (see *Nad Electronics Inc v. Nad Computer Systems Ltd* [1997] FSR 380 at 390, following the observations of Kerr LJ in *Sodastream Ltd v. Thorn Cascade Co Ltd* [1982] RPC 459 at 468 and Peter Gibson LJ in *Taittinger SA v. Allbev Ltd* [1993] FSR 641 at 663) but this will usually be after the benefit of cross-examination. I am not clear whether Ms Tarver's and Ms Paterson's positions placed them sufficiently close to consumers to enable them to form reliable impressions as to the latter's reaction to the word.

103. Secondly, the effect of the Marks and Spencer usage must be judged in the round including the material (particularly DR8) considered above. The perception of consumers and other traders will after all be influenced in part by the effect of material appearing in the press.

104. Thirdly, the claim not to have seen other trade usage on products does not seem to me to address the issue of what the trade understands by the term and whether it is a word that should be free for others to use. In this respect I bear in mind, inter alia, the dictionary evidence at NK6 which lists certain fragrance houses as applying aromachology in the composition of their fragrances; the reference by the Radox representative in the Aromatherapy magazine article referred to above; Mr Dodd's reference to The Aromachology Patch Company; and the UK internet advertisement by Bath Spa Natural Spring Products Ltd shown at pages 38/39 of BEC5.

105. The registered proprietor has also referred to action taken to stop use by The Body Shop and Coty Inc. These are put forward as examples of the proprietor

successfully protecting its rights. In the absence of rather more information as to the surrounding circumstances I do not regard this as being of assistance to the registered proprietor. It seems that The Body Shop example was the result of a franchisee acting outwith that company's normal rule that franchisees were not entitled to sell products bearing third party marks. Coty had apparently been using AROMACOLOGY but claimed that it was not a major product line and that it was to be withdrawn. That does not seem to me to be an acknowledgment or acceptance of Danièle Ryman's trade mark rights but rather a decision based on Coty's perception of their own commercial imperatives at that particular point in time.

106. The conclusions I draw from all this is that the registered proprietor has shown some use of AROMACOLOGY in circumstances consistent with it being promoted as, and perceived as being, a trade mark. That is true primarily of the Marks & Spencer's use though even here, on the evidence of Ms Tarver's and Ms Paterson's statements, only a minority of the public would be familiar with such usage. I do not rule out some of the earlier use as falling into this category but the position prior to October 2001 is not so well documented. I have no doubt that there would be some consumers who, because of their unfamiliarity with the word, would perceive it as being used to designate the commercial source of goods sold under the mark notwithstanding that other origin indicators, such as Danièle Ryman and/or Marks & Spencer were also present.

107. However, on my appraisal of the evidence, there would be an arguably greater number for whom the inherent characteristics of the word and/or the way it has been used would lead them to see it as no more than the descriptive name of a science even though they may not have met the term before. The many explanations of the term as being 'the science of aromas' etc or distinguishing it from aromatherapy along with the other descriptive usages illustrated above can only have reinforced how the word would be perceived by consumers.

108. There may be a further category for whom the term would simply be origin neutral to adopt the Appointed Person's phrase from "*Cycling IS...*" *Trade Mark Applications*, [2002] RPC 37 either because the presence of other more obviously trade mark matter distracted attention from the word in question and/or, because the word looked and sounded like the name of a science and merited no further enquiry.

109. The tribunal is inevitably faced with a difficulty where there is apparently mixed usage of a word.

110. The position arose in *Bach and Bach Flower Remedies*. I find the following passage from Morritt L.J.'s judgement on appeal to be of particular assistance:

"It is contended that there may co-exist in a mark both a distinctive and descriptive meaning. Reliance is also placed on the statement in paragraph 52 of the judgment of the European Court of Justice in *Windsurfing Chiemsee* to the effect that it suffices that the mark is distinctive to "at least a significant proportion" of the relevant class. The converse of that proposition, it is suggested, is that the mark is descriptive to the rest of the relevant class. The suggested conclusion, having coalesced the two points, appeared to be that for the purposes of the proviso to section 3(1) and section 47(1) a mark might

acquire a distinctive character from use if a significant proportion of the relevant class recognised it to bear both a distinctive character and descriptive connotations.

45. I do not accept those submissions either separately or as coalesced. First, it has never been the law, and counsel of HHL did not suggest that it had been, that the mark must be universally recognised as distinctive. If it were otherwise the rights of traders would be dependent on the views of the ignorant and illiterate. The observations of Viscount Maugham and Jacob J. to which the judge referred were not directed to the meaning of a word or mark to the totality of mankind. What is necessary, in the words of the Act and the Directive, is that the word or mark should “distinguish the goods or services of one undertaking from those of other undertakings” (section 1(1)) so as “to guarantee the trade mark as an indication of origin” (10th Recital to the Directive). If to a real or hypothetical individual a word or mark is ambiguous in the sense that it may be distinctive or descriptive then it cannot comply with the requirements of the Act for it will not provide the necessary distinction or guarantee. It is in that sense that a common or descriptive meaning must be displaced. It is also in that sense that I accept the second submission made by counsel for HHL before Neuberger J.

46. In my view the provisions of section 11(2) do not suggest otherwise. Use of an identical sign on identical goods constitutes infringement by virtue of section 10(1) without more. In any other case it is necessary to show a likelihood of confusion (section 10(2)), or, the taking of unfair advantage of or detriment to the distinctive character or repute of the mark, (section 10(3)) section 11(2) concerns use in accordance with honest practices of indications of the designated type. It says nothing about what is required by way of a distinctive character so as to justify the registration of the mark in the first place. It certainly does not indicate that the mark can be both distinctive and descriptive so that if used on identical goods it would not constitute infringement under section 10(1).

47. In my view it is clear that the test laid down by the Act and the principles established or confirmed by the European Court of Justice in *Windsurfing Chiemsee* and *Lloyds Schuhfabrik* require BFR to establish that in consequence of their use between 1979 and 1997 the expression BACH FLOWER REMEDIES and the word BACH have to a significant proportion of the relevant class of persons, *i.e.* the average consumer of such goods, acquired a distinctive character in the sense of distinguishing such goods manufactured by BFR from the same or similar goods manufactured by other undertakings.”

111. I also note the following from Chadwick LJ’s judgment in the same case as to how a word can through use acquire a descriptive character just as it can acquire a distinctive one:

“If a word – such as a contrived or personal name – which, absent use, is devoid of any distinctive (or descriptive) character can acquire a distinctive character through use, there can be no reason in principle why the same word should not, instead, acquire a descriptive character through use. If it does so, there can be no reason in principle why it should not, then, cease to be capable

of having the distinctive character which is the essential quality of a trade mark.”

112. The test is, therefore, whether a significant proportion of the relevant class of persons had been educated through use of the mark to see it as distinguishing the registered proprietor’s goods as at June 2004 though that does not mean that the previous descriptive nature of the word had to have been completely displaced.

113. It seems to me that whether one approaches the matter primarily from the need to protect the interests of other traders in the field (the main thrust of Section 3(1)(c)) or the perception of the average consumer (the main thrust of Section 3(1)(b)) the result is the same. I cannot with any confidence say that the word has acquired a distinctive character as indicating the registered proprietor’s goods for a significant proportion of the relevant class of consumers including the trade. At best the usage shown is ambiguous as to the significance that was intended to be given to the word. In these circumstances the application for a declaration of invalidity succeeds under Sections 47(1)/3(1)(b) and (c).

114. In accordance with Section 47(6) the registration will be deemed never to have been made.

COSTS

115. The applicant is entitled to a contribution towards its costs. I order the registered proprietor to pay the applicant the sum of £3200. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 16th day of August 2005

**M REYNOLDS
For the Registrar
the Comptroller-General**

COPY

ANNEX

FAX 323 2340



Aromacology/Aromatherapie
V.A.T. Registration Number: 240 4706 90

invoice

To: LANGHAM HILTON
1, Portland Place
Regent Street
LONDON W1 4TA

Invoice No: 2054
Order No: 19121
Date: 28/8/96

Quantity	Description	Price	Value
7 Boxes	Sex Lap Awake / Asleep	€1.25	700.00
	Transport		45.00
	with Compliments		
		Subtotal	745.00
		V.A.T. @ 17.5%	130.38
		TOTAL	875.38
	Less 25% Deposit Received See Invoice No. _____		
		TOTAL NOW DUE	875.38