

O-073-08

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2434915  
BY ARCADIA GROUP BRANDS LIMITED  
TO REGISTER THE TRADE MARK:**

**SMOOTH CURVES**

**IN CLASS 25**

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In class 25**

### **BACKGROUND**

1. On 9 October 2006 Arcadia Group Brands Limited applied to register the trade mark SMOOTH CURVES for the following goods:

Class 25: Articles of clothing; footwear; boots; shoes; slippers; sandals; hosiery; socks; stockings; tights; headgear; caps; hats; berets; belts; gloves; mittens; scarves; shawls.

2. An objection was raised by the UK Intellectual Property Office under sections 3(1)(b) and (c) of the Trade Marks Act 1994 (“the Act”)<sup>1</sup>. The grounds for the objection were that the mark was a sign which may serve in trade to designate the intended purpose of the goods, e.g. underwear which helps to smooth curves when worn. Objection was also raised under section 5(2) of the Act on the basis of a number of earlier trade marks<sup>2</sup>; the section 5 objections are not in issue for the reason that will be seen in the next paragraph.

3. Following a hearing<sup>3</sup>, at which the applicant was represented by Mr Michael Lynd of Marks & Clerk, I maintained the objections based on sections 3(1)(b) and (c) of the Act; the objections based on section 5(2) were, however, waived. Evidence for the purpose of establishing acquired distinctiveness was then filed on 7 September 2007. I did not consider this evidence to overcome the objections and the applicant was notified accordingly. No hearing was sought in order to provide submissions on the adequacy of the evidence. The application was then formally refused in relation to the goods of the application other than “boots; shoes; slippers; sandals; headgear; caps; hats; berets; belts; gloves; mittens; scarves; shawls”. This means that the application was refused in relation to:

“Articles of clothing; footwear; socks; stockings; tights.”

4. I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Marks Rules 2000, to state in writing the grounds of my decision and the materials used in arriving at it.

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<sup>1</sup> The examination report raising these objections was sent to the applicant on 21 November 2006.

<sup>2</sup> The application was examined prior to the changes in *ex officio* examination practice detailed in the Trade Marks (Relative Grounds) Order 2007 (SI 1976/2007)

<sup>3</sup> The hearing itself took place on 3 April 2007.

### **The applicant's submissions**

5. At the hearing, Mr Lynd put forward two primary arguments. Firstly, it was argued that the mark was not an apt description because it was in the “*Baby-Dry*” mould<sup>4</sup>. It was argued that you would not refer to an article of clothing as being “smooth curves clothing”. The second argument was based upon the existence of three earlier registrations which Mr Lynd considered to be on a par with the present application yet they had been accepted for registration. I will deal with these submissions in more detail later.

6. It should also be noted that although some evidence of use of the term being used on the Internet had been provided to the attorney (with the examination report) this was not discussed in any great detail at the hearing as such use was not significant or compelling. The discussion focused on the descriptiveness or otherwise of the words themselves.

### **The applicant's evidence**

7. This consists of a witness statement of Mr Frances Russell, the brand director of EVANS (who are a trading division of the applicant company). He states that the trade mark was first used in September 2006 in relation to:

Control knickers, control thongs, control bodies, two pair pack control knickers, control corsets.

8. Use in the period 2006-2007 is stated as:

Control knickers	£100,000
Control thongs	£100,000
Control bodies	£150,000
Two pair pack control knickers	£700,000
Control corsets	£35,000
<b>TOTAL</b>	<b>£1,085,000</b>

9. Mr Russell completes his evidence by stating that the goods have been sold throughout the UK in 304 of the Evans stores and as a consequence of this use the mark is well known to the general public and to buyers of underwear.

## **DECISION**

### **The law**

10. The relevant legislation contained in the Act reads as follows:

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

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<sup>4</sup> A reference to the judgment of the European Court of Justice in *Baby-Dry* [2001] ETMR 75

(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 services, or other characteristics of goods or services,

.....

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

### **The section 3(1)(c) objection**

#### **The legal test**

11. The European Court of Justice (“ECJ”) has dealt with the purpose and scope of section 3(1)(c) many times. A helpful summary of the position was given in *Wm. Wrigley Jr. Company v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case - 191/01 P, where it was stated<sup>5</sup>:

“29. Article 7(1)(c) of Regulation No 40/94 provides that trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographic origin, time of production of the goods or rendering of the service, or other characteristics of the goods or service are not to be registered.

30. Accordingly, signs and indications which may serve in trade to designate the characteristics of the goods or service in respect of which registration is sought are, by virtue of Regulation No 40/94, deemed incapable, by their very nature, of fulfilling the indication-of-origin function of the trade mark, without prejudice to the possibility of their acquiring distinctive character through use under article 7(3) of Regulation No 40/94.

31. By prohibiting the registration as Community trade marks of such signs and indications, Article 7(1)(c) of Regulation No 40/94 pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all. That provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (see, inter alia, in relation to the identical provisions of Article 3(1)(c) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of Member States relating to trade marks (OJ 1989 L 40, p.

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<sup>5</sup> The judgment was in relation to the analogous provision of Article 7(1)(c) of Council Regulation 40/94 (the Community Trade Mark Regulation).

1), *Windsurfing Chiemsee*, paragraph 25, and Joined Cases C-53/01 to C-55/01 *Linde and Others* [2003] ECR I-3161, paragraph 73).

32. In order for OHIM to refuse to register a trade mark under Article 7(1)(c) of Regulation No 40/94, it is not necessary that the signs and indications composing the mark that are referred to in that article actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that such signs and indications could be used for such purposes. A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned.”

12. The question to answer is, therefore, whether the sign put forward for registration could be used for the purpose of describing a characteristic of the goods sought? Furthermore, there is no requirement to support the objection with a finding that the sign is already in use in a descriptive manner. The reference to “at least one of its possible meanings” indicates that if it could be argued that the sign has more than one possible meaning, it is sufficient to maintain the objection so long as one of its possible meanings is descriptive.

### **The mark itself**

13. The mark itself consists of two common English words, namely “smooth” and “curves”. There is no real separation of these elements - they would not be seen as self standing words simply presented in close proximity to each other – they would, instead, be read together to create the phrase “smooth curves”. In this phrase the word “smooth” is an adjective qualifying the noun “curves”. The whole therefore creates a phrase that relates to curves that are smooth in nature.

14. But what does this mean in relation to the goods at issue? The word curve relates to a continuous bending line (it therefore has no straight elements). The word could therefore relate to the profile of many goods. However, I am conscious that the word curves is a word that is used in relation to the outline of the feminine form. Indeed, dictionary definitions<sup>6</sup> describe the word curve as “something that curves or is curved, such as a bend in the road or the contour of a women’s body”. In relation to the word “smooth”, the same dictionary provides a number of related definitions – they all come back to the point that it relates to the concept of having no irregularities, roughness, ruffles or being uniform etc. The mark as a whole could therefore be seen as relating to the curves of the feminine body with such curves being free from roughness and irregularities. The phrase could also relate to the profile of the goods themselves, however, this is a less likely meaning in relation to clothing given the flexible nature of these goods.

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<sup>6</sup> Collins English Dictionary 5<sup>th</sup> Edition – definition 2.

### **The characteristic being described**

15. When assessing matters under this ground it is important to consider what characteristic of the goods the sign is alleged to describe and then whether the sign is in fact apt for that descriptive purpose. I have already stated that the sign is unlikely to be utilised as a description of the nature or the kind of the goods themselves. What is more likely is that the sign will be taken as a reference to the smooth curves of the wearer of the goods. As I have already said, the word curve(s) is a word often associated with the feminine form. But what do the goods have to do with this?

16. I am aware from my own general knowledge that certain articles of clothing are designed to have a controlling effect on the figure of the wearer. This knowledge is not peculiar to me (I am by no means an expert in this area) and will be known by the relevant consumer of the goods (likely to be the general public). By use of the word “controlling” in this description, I mean to describe that the item of clothing manipulates the body so that the wearer has one or more of what may be regarded as positive effects on the shape of the body – for example, the clothing may make the body look slimmer, it may give a flatter stomach, it may give the body a more defined curvature, or it may “lift” certain parts of the body. Taking this into account, it therefore seems to me that the characteristic of the goods that the sign could be said to describe is this sort of intended effect or purpose.

17. I should say that clothing which is able to give this element of control or manipulation would normally be in the nature of undergarments such as tights, briefs etc. However, I cannot rule out the possibility that other items of clothing could also give this intended effect if specifically designed to do so.

### **Could the sign be used for this descriptive purpose?**

18. I have described what meaning could be taken from the mark in relation to the goods, and also what characteristic the sign could be describing - but does this equate to the sign being one that could be used in trade for this descriptive purpose? As detailed above, being curvy or curvaceous is, amongst many people, a desirable quality. Having curves without ripples or other imperfections will no doubt also be desirable. Given that some forms of clothing exist to perform certain manipulative actions, it takes little imagination to envisage that clothing could exist to produce the intended effect of giving the wearer a smooth and curvaceous figure. Smooth curves being acquired could therefore be the intended purpose of the goods in question.

19. The attorney argued that the sign was in the “*Baby-Dry*” mould. *Baby-Dry* is a judgment of the ECJ, the relevant parts of the judgment read:

“40. As regards trade marks composed of words, such as the mark at issue here, descriptiveness must be determined not only in relation to each word taken separately but also in relation to the whole which they form. Any perceptible difference between the combination of words submitted for registration and the

terms used in the common parlance of the relevant class of consumers to designate the goods or services or their essential characteristics is apt to confer distinctive character on the word combination enabling it to be registered as a trade mark.

41. It is true that Article 7(2) of Regulation No 40/94 states that Article 7(1) is to apply notwithstanding that the grounds of non-registrability obtain in only part of the Community. That provision, which was rightly cited at paragraph 24 of the contested judgment, implies that, if a combination of words is purely descriptive in one of the languages used in trade within the Community, that is sufficient to render it ineligible for registration as a Community trade mark.

42. In order to assess whether a word combination such as 'BABY-DRY is capable of distinctiveness, it is therefore necessary to put oneself in the shoes of an English-speaking consumer. From that point of view, and given that the goods concerned in this case are babies' nappies, the determination to be made depends on whether the word combination in question may be viewed as a normal way of referring to the goods or of representing their essential characteristics in common parlance.

43. As it is, that word combination, whilst it does unquestionably allude to the function which the goods are supposed to fulfil, still does not satisfy the disqualifying criteria set forth in paragraphs 39 to 42 of this judgment. Whilst each of the two words in the combination may form part of expressions used in everyday speech to designate the function of babies' nappies, their syntactically unusual juxtaposition is not a familiar expression in the English language, either for designating babies' nappies or for describing their essential characteristics.

44. Word combinations like 'BABY-DRY cannot therefore be regarded as exhibiting, as a whole, descriptive character; they are lexical inventions bestowing distinctive power on the mark so formed and may not be refused registration under Article 7(1)(c) of Regulation No 40/94."

20. I have considered the above judgment, but do not feel that the applicant's position is improved. Every case must be determined on its own merits and facts, whilst, of course, taking into account the guidance given in binding jurisprudence. In the *Baby-Dry* judgment it was conceded that whilst the words at issue could be used in combination as part of everyday speech, they nevertheless had in themselves a syntactically unusual juxtaposition which was not a familiar expression in the English language<sup>7</sup>. The words "smooth curves" can also be used in combination as part of everyday speech, e.g. "these items of clothing will give you smooth curves", but this is where the similarity ends because, in contrast to *Baby-Dry*, I consider the expression to lack the syntactically unusual juxtaposition required to convince me that the objection was ill founded. The words are direct and clear, namely that the intended effect of the goods is to give the

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<sup>7</sup> Paragraph 43 of the judgment.

wearer smooth curves and that this message will be clear even when viewing the words as a self standing expression.

21. The attorney also argued that the expression “smooth curves clothing” would not likely exist. I do not doubt that, but, I do not consider this to alter the aptness of the sign as presented from acting as a description of the intended purpose of the goods. There are many expressions that would never qualify for trade mark protection which, similarly, if preceding the name of the goods, would create slightly clumsy language. However, this does not equate to those signs being anything other than descriptive when one considers the range of possible uses that must be taken into account.

### **Precedents**

22. The attorney also provided me with three earlier acceptances to support the acceptance of the present case. Whilst I agreed to have sight of them, I am conscious of the comments of Jacob J in *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281:

“In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led to the Registrar to put the marks concerned on the Register. It has long been held that under the old Act that comparison with other marks on the Register is in principle irrelevant when considering a particular mark tendered for registration, see *e.g. MADAME Trade Mark* (1966 RPC 541) and the same must be true of the 1994 Act. I disregard the state of the register evidence.”

23. I responded to the precedents in my hearing report by stating that I did not consider them to be on all fours with the application in suit and that, in any event, they were irrelevant for the reasons given above. I must make a decision on the merits of the case before me and the reasoning and explanations already given stands as such. In the circumstances, I do not intend to say any more about the precedents quoted.

**24. Taking all the above factors into account, I conclude that the sign SMOOTH CURVES is a sign that could be used to describe the intended purpose or effect of items of clothing and therefore the sign falls foul of section 3(1)(c) of the Act.**

25. In relation to the goods of the application, the objection does not relate to: boots, shoes, slippers, sandals, headgear, caps, hats, berets, belts, gloves, mittens, scarves and shawls as these goods do not strike me as those that are likely to give the intended affect described. The other goods: articles of clothing, footwear, socks, stockings and tights could all realistically do so (clothing due to it being such a broad term). Following the hearing, the applicant was offered an opportunity to limit the goods to those that would not likely give the intended effect described; no revised specification was filed.

### **Section 3(1)(b) objection**

26. The tests to be applied under this ground have been dealt with by the ECJ in a number of its judgments, notably in Joined Cases C-53/01 to C-55/01 *Linde AG, Winward Industries Inc and Rado Uhren AG* (8 April 2003). The test equates to assessing the impact that the sign will have on the average consumer when used in relation to the goods at issue and deciding whether they (the average consumer) will regard the sign as something that is identifying to them that the goods originate from a particular undertaking.

27. I am aware that all of the grounds under section 3 of the Act have independent scope<sup>8</sup>, however, I do not intend to deal with the ground under section 3(1)(b) in great detail. This is because, and for the same reasons that I found this trade mark is to be excluded by the provisions of section 3(1)(c) of the Act, the relevant consumer of the goods will not consider the sign to denote trade origin – i.e. the relevant consumer will see the sign as a description of the intended purpose or effect of the goods and not as a badge of origin. **Therefore, although shortly stated, I conclude that the sign put forward for registration falls foul of section 3(1)(b) of the Act.**

### **Acquired distinctiveness**

28. The proviso to section 3 of the Act permits acceptance of a mark that is otherwise unacceptable under the provisions of Section 3(1)(b) or (c) if it has in fact acquired a distinctive character because of the use made of it. Guidance on the test to be applied was provided by the ECJ in *Windsurfing Chiemsee (C108&109/97) [1999] ETMR 585* where it was stated:

“If the competent authority finds that a significant proportion of the relevant class of persons identify goods as originating from a particular undertaking because of the trade mark, it must hold the requirement for registering the mark to be satisfied.”

29. The same case provides useful guidance on some of the factors to consider when deciding whether the relevant class of persons identifies the goods as originating from a particular undertaking; the court identified that: In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account:

- a) the market share held by the mark;
- b) how intensive, geographically widespread and long-standing use of the mark has been;
- c) the amount invested by the undertaking in promoting the mark;

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<sup>8</sup> See, for example, the decision of the High Court in *Have A Break* [2002] EWHC 2533 (Ch).

d) the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking;

e) statements from chambers of commerce and industry or other trade and professional associations.

30. Applying these tests to the evidence filed leaves the applicant in a difficult position. No market share information has been provided. The date of first use is said to be September 2006 which, measured against the filing date of 9 October 2006, gives a period of use of a maximum of one month and 9 days. The geographical spread is, however, wide. No information on the amount invested in promoting the mark (if any is done at all) is given. No information is given to prove the proportion of the relevant class of person who identify the mark as originating from the particular undertaking. No statements have been provided from chambers of commerce etc.

31. Another flaw is the lack of any exhibits to the evidence showing how the applicant has used the mark. I cannot therefore assess the impact that the mark would have had. Furthermore, I do not know how much of the financial turnover figures relates to the period that I can take into account under the proviso. All this leaves me with the clear view that the evidence filed does not establish that the mark was known to a significant proportion of the relevant public. **In summary, I do not consider that the mark, even taking into account the use made of it, will perform the essential distinguishing function of a trade mark.**

## CONCLUSION

32. I therefore conclude that:

a) **The mark applied for is devoid of any distinctive character and is thus excluded from *prima facie* registration on the grounds of section 3(1)(b) of the Act.**

b) **The mark applied for describes a characteristic of the goods in question and is thus excluded from *prima facie* registration on the grounds of section 3(1)(c) of the Act.**

c) **The evidence filed is not sufficient to prove that the mark has in fact acquired a distinctive character because of its use. The proviso to section 3 cannot therefore be relied upon.**

33. In this decision I have considered all the documents filed by the applicant and all the arguments submitted to me in relation to this application and, for the reasons given, it is consequently refused under the terms of section 37(4) of the Act. This refusal relates only to:

“Articles of clothing; footwear; socks; stockings; tights.”

**Dated this 13<sup>th</sup> day of March 2008**

**Oliver Morris  
For the Registrar  
The Comptroller-General**