

1 THE PATENT OFFICE

2 Tribunal Room 2,
3 Harmsworth House,
4 13-15 Bouverie Street,
5 London EC4Y 8DP.

6 Thursday, 24th February 2005

7 Before:

8 MR. GEOFFREY HOBBS QC
9 (Sitting as the Appointed Person)

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11 In the Matter of the Trade Marks Act 1994

12 -and-

13 In the Matter of Application No: 2283400
14 in the name of
15 KAO KABUSHIKI KAISHA
16 also t/a
17 KAO CORPORATION

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19 Appeal of the Applicant from the decision of
20 Mr. Ian Peggie dated 9th June 2004 on behalf of
21 the Registrar.

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23 (Transcript of the Shorthand Notes of Marten Walsh Cherer Ltd.,
24 Midway House, 27/29 Cursitor Street, London EC4A 1LT.
25 Telephone No: 020 7405 5010. Fax No: 020 7405 5026.)

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27 MR. RICHARD MEADE (instructed by Messrs R.G.C. Jenkins & Co.)
28 appeared as Counsel for the Applicant/Appellant.

29 MR. ALLAN JAMES (Principal Hearing Officer) appeared on behalf of
30 the Registrar of Trade Marks.

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32 APPROVED DECISION

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1 THE APPOINTED PERSON: On 9th June 2004 Mr. Ian Peggie issued a
2 decision on behalf of the Registrar of Trade Marks rejecting
3 an application by Kao Kabushiki Kaisha to register the
4 designation NATURALLY SMOOTH as a trade mark for use in
5 relation to "moisturisers; shave minimising moisturisers for
6 women" in class 3.

7 The application was rejected under Section 3(1)(b) of
8 the Trade Marks Act 1994 which provides for refusal of
9 registration in cases where the trade mark is "devoid of any
10 distinctive character". It is clear from the proviso to
11 Section 3(1) that the word "devoid" means, in substance,
12 "unpossessed".

13 The designation NATURALLY SMOOTH was not said to have
14 acquired a distinctive character through use in the United
15 Kingdom in relation to goods of the kind specified by the
16 applicant for registration.

17 Having directed himself as to the law with regard to
18 the requirement for "distinctive character", as laid down by
19 the ECJ in Joined Cases C-53/01 to C-55/01
20 Linde AG & Ors at paragraphs 37, 39 to 41 and 47 and also by
21 reference to case C-104/00P DKV v. OHIM (Companyline) at
22 paragraphs 20 to 24 and 31 to 36, the hearing officer
23 assessed the designation NATURALLY SMOOTH with reference to
24 the goods of interest to the applicant in the following
25 terms:

1 "12. I must assess the mark's distinctiveness in
2 relation to the goods for which the applicant seeks
3 registration, which are moisturisers. I must also
4 have regard to the perception of the relevant
5 consumers of these goods, which in my view are the
6 general public.

7 13. I am of the view that the phrase "NATURALLY
8 SMOOTH" is not an unusual way of describing the
9 applicants' goods and therefore the public would not
10 distinguish them by reference to those words from
11 those products provided by other undertakings. I
12 consider that the mark would serve to designate one of
13 the essential characteristics of the goods. For
14 example, "NATURALLY SMOOTH" sends out an unequivocal
15 message about the intended purpose of the goods. It
16 clearly conveys to customers that these moisturisers
17 will have the effect of leaving the skin feeling
18 "naturally smooth".

19 14. Assuming notional and fair use of the mark,
20 which includes use on the packaging of the goods as
21 well as in advertising, it seems unlikely to me that
22 the relevant consumer would consider this mark to
23 denote trade origin because "NATURALLY SMOOTH" would
24 be regarded as denoting a moisturiser which had the
25 effect of leaving the skin feeling smooth.

1 15. The assertion that because the term may be
2 interpreted ambiguously and therefore have more than
3 one meaning is not a relevant consideration when one
4 of those meanings is descriptive. In the DOUBLEMINT
5 decision of the European Court of Justice C191-01 (see
6 Office for Harmonisation in the Internal Market (Trade
7 Marks and Designs)(OHIM) v Wm Wrigley Jr 2003 WL
8 101985) the ECJ confirmed the validity of the OHIM's
9 approach that a word such as DOUBLEMINT does not cease
10 to be descriptive simply because it can have several
11 meanings and is therefore ambiguous. In the mind of
12 the average consumer, DOUBLEMINT is spontaneously
13 associated with certain potential characteristics of
14 the goods in question, namely their mint-based
15 composition and their mint flavour, so that the word
16 is necessarily descriptive and cannot therefore be
17 registered as a Community trade mark."

18 16. I am not persuaded that the mark "NATURALLY
19 SMOOTH" in totality is distinctive in that it would
20 serve in trade to distinguish the applicants' goods
21 from those of other traders. In my view the mark
22 applied for will not be identified as a trade mark
23 without first educating the public that it is one. I
24 therefore conclude that the mark applied for is devoid
25 of any distinctive character and is thus excluded from

1 prima facie acceptance under Section 3(1)(b) of the
2 Act."

3 On 7th July 2004 the applicant gave notice of appeal to
4 an Appointed Person under Section 76 of the Act contending,
5 in substance, that the Hearing Officer had erred by not
6 regarding the words "naturally" and "smooth" as sufficiently
7 idiosyncratic in combination to satisfy the test for
8 possession of a distinctive character, hence registrability
9 under the Act. This contention was developed in argument at
10 the hearing before me.

11 With regard to the test for possession of a distinctive
12 character, I believe it is unnecessary and unhelpful to try
13 to specify in abstract terms the level or degree of
14 distinctiveness that might be sufficient to enable a sign to
15 be regarded as free of objection under Section 3(1)(b).
16 Moreover, in paragraph 20 of its judgment in the Companyline
17 case, the ECJ specifically pointed out that the tribunal
18 considering an objection to registration under
19 Section 3(1)(b) is under no obligation to rule on the
20 possible dividing line between the concept of lack of
21 distinctiveness and that of minimum distinctiveness.

22 Each sign must be assessed for registrability on its
23 own merits. The relevant perspective is that of the average
24 consumer of the goods concerned and the average consumer is,
25 for this purpose, deemed to be reasonably well-informed and

1 reasonably observant and circumspect. However, that does not
2 mean that he or she should be regarded as likely to spend
3 time construing or interpreting the marks and signs that he
4 or she may come across in the course of a normal shopping
5 trip.

6 What matters for present purposes is whether normal and
7 fair use of the designation NATURALLY SMOOTH would be likely
8 to trigger perceptions and recollections in the mind of the
9 average consumer that were origin specific rather than origin
10 neutral. To put it another way: would the perceptions and
11 recollections likely to be triggered by the designation serve
12 to individualise the goods concerned to a single undertaking?
13 This is a matter of impression.

14 It was submitted on behalf of the applicant that the
15 words in question involve a conundrum. There is no such
16 thing, except for babies, as naturally smooth skin. Buyers
17 and users of the relevant products would be aware of that and
18 the idiosyncrasy of the terminology would, for that reason,
19 be sufficiently arresting to enable the designation to serve
20 as an indication of trade origin.

21 I think this involves an over-analytical approach to
22 the meaning and use of words as written and spoken in
23 everyday English. It seems to me that the words "naturally"
24 and "smooth" are meaningful separately and in combination.
25 In combination I think they would be taken to be promoting

1 the benefits and advantages to the user of using moisturisers
2 of the kind to which they referred.

3 I think the connotation of "naturally smooth looking
4 skin" in the context of moisturisers is strong and clear; so
5 much so that the designation, in my view, lacks the degree of
6 singularity and specificity of significance that it would
7 need to possess in order to be registrable in the absence of
8 a claim to distinctiveness acquired through use.

9 I consider that the Hearing Officer's decision was in
10 substance correct. The appeal will therefore be dismissed.
11 In keeping with the usual practice, there will be no order
12 for costs in connection with this appeal.

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