

O-146-08

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2426657  
BY BALLETT INTERNATIONAL LTD  
TO REGISTER THE TRADE MARK:**

**SLIMWEAR**

**IN CLASS 25**

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**By Ballet International Ltd**

**To register the trade mark SLIMWEAR**

**In class 25**

### **BACKGROUND**

1. On 8 July 2006 Ballet International Ltd applied to register the trade mark SLIMWEAR for the following goods:

Class 25: Articles of clothing, footwear and headgear.

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 kind of goods e.g. clothing designed to give the wearer a slim appearance.

3. Following a hearing<sup>2</sup>, at which the applicant was represented by Mr Dyson of Bailey Walsh & Co, I maintained the objections based on sections 3(1)(b) and (c) of the Act. No further correspondence or evidence was received from the applicant and the application was then refused on these grounds. I should add that following issue of the formal notice of refusal, I wrote to the applicant to clarify that whilst the refusal related to the terms “articles of clothing; footwear”, it did not relate to the term “headgear”; the reasons for this will become clearer later in this decision.

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.

#### **The applicant’s submissions**

5. At the hearing, the attorney focused on his argument that, considered as a whole, the mark was not a natural description as it had an unusual construction which rendered the mark immune from any allegation that it could be used legitimately as a description by other traders. Further submissions were made (at the hearing and in previous correspondence) to the extent that although the word “wear” was commonly used in trade in combination with descriptive words (e.g. footwear), the use of a word descriptive of the appearance or the effect of losing weight (slim) would be unusual as the word SLIM is not a word which relates to either a part of a body or to an article of clothing.

6. It should also be noted that some evidence of use of the term being used on the Internet had been provided to the attorney prior to the hearing. The attorney argued that

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<sup>1</sup> The examination report raising these objections was sent to the applicant on 17 August 2006.

<sup>2</sup> The hearing itself took place on 20 April 2007.

these references were not compelling as they by no means indicated that the term was a known one. I will address all of the attorney's arguments in more detail later in this decision.

## **DECISION**

### **The law**

7. The relevant legislation 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 services, or other characteristics of goods or services,”

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

#### **The legal test and the relevant case-law**

8. 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>3</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.

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<sup>3</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).

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. 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.”

9. I also take account of the decision of the ECJ in *Postkantoor* (Case C-363/99) which considered the registrability of combinations of descriptive words. Paragraphs 96 – 100 of the judgement are reproduced below:

“96. If a mark, such as that at issue in the main proceedings, which consists of a word produced by a combination of elements, is to be regarded as descriptive for the purpose of Article 3(1)(c) of the Directive, it is not sufficient that each of its components may be found to be descriptive. The word itself must be found to be so.

97. It is not necessary that the signs and indications composing the mark that are referred to in Article 3(1)(c) of the Directive 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 those signs and indications could be used for such purposes. A word 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 (see to that effect, in relation to the identical provisions of Article 7(1)(c) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), Case C-191/01 P *OHIM v Wrigley* [2003] ECR I-0000, paragraph 32).

98. As a general rule, a mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics for the purposes of Article 3(1)(c) of the Directive. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned.

99. However, such a combination may not be descriptive within the meaning of Article 3(1)(c) of the Directive, provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements. In the case of a word mark, which is intended to be heard as much as to be read, that condition must be satisfied as regards both the aural and the visual impression produced by the mark.

100. Thus, a mark consisting of a word composed of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, is itself descriptive of those characteristics for the purposes of Article 3(1)(c) of the Directive, unless there is a perceptible difference between the word and the mere sum of its parts: that assumes either that, because of the unusual nature of the combination in relation to the goods or services, the word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts, or that the word has become part of everyday language and has acquired its own meaning, with the result that it is now independent of its components. In the second case, it is necessary to ascertain whether a word which has acquired its own meaning is not itself descriptive for the purpose of the same provision.”

10. 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? 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. Furthermore, in relation to words that are combinations of other words that individually have a descriptive meaning, then to qualify for registration the whole must be considered to be of an unusual nature with the result that the combination is more than the sum of its parts.

### **The mark itself & the possible relationship with the goods**

11. The mark itself consists of two common English words, namely “slim” and “wear” combined as SLIMWEAR. The fact that the words are conjoined, together with the nature of the words themselves, means that the mark will be considered as a self standing phrase

and not merely two words with no relationship to each other. Looking at these words, particularly in light of the type of goods sought, the word “wear” relates to items designed to be worn as clothing. It is also proper for use in combined form (the dictionary gives the example of “nightwear”). The word “slim” relates to being small in width relative to height or length, and, to make or to become slim<sup>4</sup>. In the context of clothing this would be taken as a reference to the body of the wearer. The whole therefore creates a phrase that, at the very least, alludes to a type or category of clothing that in some way makes the wearer look slim; my assessment on whether the word SLIMWEAR could be used as a legitimate description will come later.

12. In relation to the mark and the presence of the word SLIM within it, it is worth recording that certain articles of clothing are designed to have a controlling or shaping 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). These types of controlling or shaping clothing are mentioned in some of the Internet references sent to the applicant. By use of the word “controlling” or “shaping” in this description, I mean to describe that the item of clothing manipulates or shapes the body in order to give a positive effect to its shape – one such positive effect could clearly be to give the body a slim appearance. Taking this into account, it therefore seems to me that the characteristic of the goods that the sign could be said to describe is the kind and intended purpose or effect of the goods e.g. a category of clothing (wear) that is intended to “slim” the wearer.

13. I should add that clothing which is able to give this element of control or shaping would normally be in the nature of items such as briefs, corsets, tights 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. Nevertheless, the refusal of the application does not relate to “headgear” as I consider that the characteristic sought to be described is not relevant here. Most of what I have said so far is unlikely to be in dispute with the applicant, what is in dispute is whether the construction of the mark is unusual and, consequently, whether it is a sign that could be used for descriptive purposes. I deal with this issue next.

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

14. There is no doubt in my mind that the mark, at the very least, is highly allusive of the goods in question. The attorney argues that it does not transcend into a mark that is descriptive in view of the unusual construction of the words. In earlier written submissions the attorney referred to the word “footwear” and argued that the mark sought to be registered is not the same as this construction. Whilst it is true that “foot” in footwear relates to the part of the body on which the clothing is worn and that this cannot be said of SLIMWEAR, I also note that the word “wear” is often used as a combining word (as the dictionary itself suggest) and extends beyond combination with a word describing the part of the body on which the clothing is worn. Examples include combining the word with words descriptive of the time of day of wear (nightwear,

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<sup>4</sup> The definitions in this paragraph come from Collins English Dictionary – 5<sup>th</sup> Edition.

daywear, eveningwear), the activity undertaken whilst the clothing is being worn (sportswear, swimwear), the formality of occasion (formalwear, casualwear) and the intended purpose of the wear (support wear, protective wear). There are no doubt many more examples. What this tells me is that in terms of the potential for descriptive use, it is common to utilise the word wear and combine it with a word that has some descriptive characteristic of the category of wear being offered and that this descriptive characteristic is a varied one.

15. I have already identified the meaning of the word slim and what the consumer is likely to take from it, notably, to make or become slim. Taking this into account, and in view of the range of descriptive uses with which the word “wear” is commonly combined (including words descriptive of the intended purpose of the goods), I see no reason why the two words in question could not be combined to describe wear intended to make the wearer become (even if just on a temporary basis whilst the goods are being worn) slim.

16. Although the Internet references provided to the applicant were discussed at the hearing, I do not intend to say much about them here. The attorney argued, and I agree, that they do not demonstrate that the term is a known one in trade. I do, however, note that a finding under section 3(1)(c) does not require the sign to be in actual use. Nor shall I detail the attorney’s precedents and the arguments relating thereto (detailed primarily in correspondence prior to the hearing). As the attorney conceded himself, the Registrar is not bound by precedent of this nature. Furthermore, precedents are effectively irrelevant given that I am not aware of the circumstances which led to them being placed on the register<sup>5</sup>. The mark put forward has to be considered on its own merits on the basis of its own properties; this is what I have attempted to do in this decision.

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

18. In relation to the goods of the application, the objection does not relate to articles of headgear as these items do not strike me as being likely to give a slim effect. The other goods: articles of clothing, footwear could all realistically do so. Although there may be some goods within these broad terms to which the objection does not apply, no amended specification has at any time been proposed so I have no option other than to refuse registration for these broad terms filed.

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

19. The test to be applied under this ground has 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

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<sup>5</sup> See to that effect the comments of Jacob J in *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281.

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.

20. I am aware that all of the grounds under section 3 of the Act have independent scope<sup>6</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 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 because the relevant consumer will see the sign as a description of the kind and intended purpose or effect of the goods and not as a badge of origin; the mark will therefore not identify to them the undertaking that is responsible for the goods.. **Therefore, although shortly stated, I conclude that the sign put forward for registration falls foul of section 3(1)(b) of the Act.**

## **CONCLUSION**

**21. I therefore conclude that:**

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

22. 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.”

**Dated this 22<sup>nd</sup> day of May 2008**

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

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<sup>6</sup> See, for example, the decision of the High Court in *Have A Break* [2002] EWHC 2533 (Ch).