

O-280-04

TRADE MARKS ACT 1994

**IN THE MATTER OF
APPLICATION NO. 2202567
TO REGISTER A TRADE MARK
IN CLASS 25
BY WARNACO U.S., INC**

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DECISION AND GROUNDS OF DECISION

Background

1. On 9th July 1999, Warnaco U.S., Inc. of 470 Wheelers Farms Road, Milford, Connecticut 06460, U.S.A. applied to register the trade mark BODYSLIMMERS in respect of “clothing, footwear and headgear” in Class 25.
2. Objection was taken against the application under Sections 3(1)(b) and (c) of the Act because the mark is devoid of any distinctive character, for example, “goods which make the body look slimmer”. Objection was also raised under Section 5 of the Act because of the presence of earlier rights on the register. This objection was subsequently waived and I do not need to refer to it again in this decision.
3. A hearing was held on 4th November 2003 at which the applicant was represented by Mr J.E. Robey of Wilson Gunn Gee, Trade Mark Attorneys. The objection was maintained and the application was subsequently refused on 3rd August 2004 in accordance with Section 37(4) of the Act.
4. Following refusal of the application I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Mark Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.
5. No evidence of use has been put before me. I have, therefore, only the prima facie case to consider.

The law

6. The relevant part of Section 3 of the Act is as follows:

“Section 3(1):

The following shall not be registered-

- (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,”

The case for registration

7. In support of the application, submissions were made in correspondence and at the hearing by Mr Robey, whose principle arguments may be summarised as follows:

- BODYSLIMMERS is an invented word which, when viewed as a whole, has a fanciful nature and is not directly descriptive and therefore has sufficient distinctiveness to render it capable of distinguishing the applicant’s goods;
- although the component “body” and the word “slimmer” are arguably independently descriptive, the combination of the two words into an invented word and the addition of the letter “s” to show that the word is in the plural, are sufficient to remove the word from the category of words that might legitimately be required by other traders for use in describing their goods;
- the mark is registered at the Office for Harmonization in the Internal Market in respect of clothing, footwear and headgear (Registration 121509).

8. Mr Robey submitted examples of promotional materials showing the mark in use. A selection of these is shown at Annex A. Referring to the examples, Mr Robey submitted that it is apparent that BODYSLIMMERS is a term which the public will perceive as a trade mark, and associate with a wide range of goods from a single source. Mr Robey argued that whilst NANCY GANZ is also shown as a trade mark alongside BODYSLIMMERS, this does not detract from the inherent distinctiveness of the mark applied for. The two terms appear separately such that, if anything, the public is likely to regard the use as dual branding. Mr Robey pointed out that BODYSLIMMERS appears in larger type, before NANCY GANZ, thus emphasising that it is a trade mark in its own right. Mr Robey concludes that were the term descriptive or being used in a descriptive way, the normal arrangement of words would be to follow the trade mark with the descriptive term.

Decision

9. I was not persuaded by these arguments to accept the application and the objection under Section 3(1)(b) and (c) of the Act was maintained.

Section 3(1)(c)

10. There are now a number of judgments from the ECJ which deal with the scope of Article 3(1)(c) of First Council Directive 89/104 and Article 7(1)(c) of Council Regulation 40/94 (the Community Trade Mark Regulation), whose provisions correspond to Section 3(1)(c) of the UK Act. I derive the following main guiding principles from the cases noted below:

- subject to any claim in relation to acquired distinctive character (not relevant in

this case) 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* – Case 191/01P (Doublemint) paragraph 30;

- thus Articles 7(1)(c) (Section 3(1)(c)) pursues an aim which is in the public interest that descriptive signs or indications may be freely used by all – *Wm Wrigley Jr v OHIM*, paragraph 31;

- 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.

11. Two other cases are relevant in considering the application of these principles. In *Campina Melkunie BV and Benelux-Merkenbureau* – Case C-265/00 (BIOMILD) the ECJ indicated that a mark consisting of a neologism composed of elements descriptive of characteristics of the goods was itself descriptive of those characteristics within the meaning of Article 3(1)(c), unless there was a perceptible difference between the neologism and the mere sum of its parts.

12. With these guiding principles in mind I turn to the circumstances of this case. I am of the view that the phrase BODYSLIMMERS is not an unusual way of describing the applicant’s goods and therefore the public could not distinguish them from those provided by other undertakings. Although the word BODYSLIMMERS does not appear to be defined in any

dictionary, in the context of the goods sold under the mark, it sends out an unequivocal message about the intended purpose of the goods. It clearly conveys to customers that the undergarments sold under the mark will have the effect of giving the wearer the appearance of a slimmer body. Shown under Annex A are examples of the mark in use which includes the following claims for the goods' effects:

“Trims and smoothes the tummy”

and

“Firm control with a light touch, that is what to wear when all you want is a flatter tummy”.

13. Regarding these examples, whilst I acknowledge that BODYSLIMMERS is shown prominently and has a visual impact at least equal to that of NANCY GANZ, I remain of the view that the public would merely interpret the word as a type of product in the NANCY GANZ range of undergarments. For instance, advertisements for the goods also include prominent references to “Body Makeover”, “Shape Maker”, “Tummy Trimmer” and “Body Shaper”. In my view, BODYSLIMMERS along with these other combined elements would not be perceived as trade marks but merely convey the intended effect of the goods when worn on the body.

14. Mr Robey contended that in combining the two words “body” and “slimmers” this creates an invented word and furthermore, with the addition of the letter “s” to show that the word is in the plural, this is sufficient to remove it from the category of words that might legitimately be required by other traders for use in describing their goods. I reject these arguments. It seems to me that BODYSLIMMERS (whether plural or singular) does not consist of a neologism which has a perceptible difference from the individual elements which make up the mark. Furthermore, this is the type of combination which other traders may wish to use in the course of trade. In order to demonstrate this point, I sent to Mr Robey extracts from web sites on the internet which show how other traders use the words “body slimmer” descriptively. These are shown at Annex B. For example, on the JCPenney website, the following goods are promoted:

“NEW! Delicates® Body Slimmer

- Reinforced tummy panel for control
- Satin side panels shape and smooth hip line bulge
- Derriere shaper smoothes and rounds

15. A reference such as this underlines the importance that BODYSLIMMERS is a term which should be kept free for use by others. In the Opinion of Advocate General Jacobs in the trade mark *DOUBLEMINT*, he said (on 10 April 2003):

“Availability for general use

91. That last consideration leads me to the question of the extent to which Article 7(1)(c) of the Trade Mark Regulation must be interpreted in the light of the aim referred to in the

Windsurfing Chiemsee judgment, namely that descriptive signs and indications should be freely available to be used by all traders in relation to the relevant goods.

92. In my Opinion in *Baby-Dry*, (39) I took the approach that in the scheme of the Community Trade Mark Regulation a trade mark could include signs or indications designating product characteristics but could not consist exclusively of them. By virtue of Article 12(b), the trade mark cannot prevent other traders from using such signs for descriptive purposes. The aim of Article 7(1)(c) is to avoid the registration of descriptive brand names for which no protection could be available rather than to prevent any monopolising of ordinary descriptive terms. A very similar view was taken by the Court at paragraph 37 of its judgment.

93. In the present case, both the Office and the United Kingdom Government have expressed reservations about that approach, which has also been criticised in the literature. (40) It appears, they have pointed out, to represent a departure from the Courts statement in *Windsurfing Chiemsee* that Article 7(1)(c) of the Trade Marks Directive 'pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the categories of goods or services in respect of which registration is applied for may be freely used by all and that Article 6(1)(b) (which corresponds to Article 12(b) of the Regulation) does not have a decisive bearing on that interpretation.'

94. It may be feared that the approach in question is liable to shift the balance of power in favour of a trade mark owner with monopolistic ambitions who may assert, or threaten to assert, his rights against an alleged 'infringer who merely seeks to use descriptive terms descriptively and honestly'. In the real world, a defence under Article 12(b) might be worth rather less than its ostensible value in law.

95. That danger cannot be ignored. A trade mark owner wishing to monopolise not only his trade mark but the area around it may threaten unmeritorious proceedings against a competitor, who may capitulate rather than incur the costs of litigation as well as risk an adverse outcome.

96. However, for the reasons already given, I do not think that the *Baby-Dry* case, properly understood, does shift the balance in the way that has been suggested. And the danger mentioned will be obviated if the criterion of 'perceptible difference' in paragraph 40 of the *Baby-Dry* judgment is applied as I have suggested above, so that a mark is accepted for registration only when it is apparent to both traders and consumers that as a whole it is not suitable, in the ordinary language of trade, as a designation of characteristics of the product in question.

97. In any event, it seems clear that there was no intention, in the *Baby-Dry* judgment, to depart from the view in *Windsurfing Chiemsee* that it is in the public interest that descriptive signs may be freely used by all. Very recently, in *Linde*, (42) the Court has expressly reaffirmed that position."

16. The fact that in some instances the trade refers to "body slimmer" in the singular in preference to "body slimmers" does not affect the question of distinctiveness. In the context of assessing the mark when used to promote, for example, tummy flattening undergarments, I take

the view the public would likely perceive BODYSLIMMERS as a mere pluralized form of “body slimmer”.

17. I therefore reach the conclusion that the mark designates the goods’ characteristics and is therefore debarred from registration under Section 3(1)(c) of the Act.

Section 3(1)(b)

18. Having found that the mark fails to qualify under Section 3(1)(c) of the Act, I now go on to consider whether it is eligible for Registration under Section 3(1)(b). I approach this ground of objection on the basis of the following principles derived from the ECJ cases referred to below:

- an objection under Section 3(1)(b) operates independently of objections under Section 3(1)(c) – (*Linde AG (and others) v Deutsches Patent-und Markenamt*, Journal Cases C-53/01 to C-55/01, paragraphs 67 to 68);
- for a mark to possess a distinctive character it must identify the product (or service) in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product (or service) from the products (or services) of other undertakings (*Linde* paragraphs 40-41 and 47);
- a mark may be devoid of distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive (*Koninklijke KPN Nederland v Benelux Merkenbureau*, paragraph 86);
- a trade mark’s distinctiveness is not to be considered in the abstract but rather by reference to the goods or services in respect of which registration is sought and by reference to the relevant public’s perception of that mark (*Libertel Group BV v Benelux Merkenbureau*, Case C-104/01 paragraphs 72-77);
- the relevant public must be deemed to be composed of the average consumer who is reasonably well-informed and reasonably observant and circumspect (*Libertel* paragraph 46 referring to Case C-342/97 *Lloyd Schuhfabrik Meyer*).

19. In addition to these cases, I take account of the comments under paragraph 20 of the Judgement in the COMPANYLINE decision (Case C-104/00) in which the ECJ held that there is no obligation to rule on the possible dividing line between the concept of lack of distinctiveness and that of minimum distinctiveness when considering whether a mark is “devoid of any distinctive character” within the meaning of Section 3(1)(b) (Article 7(1)(b) CTMR). It found (paragraphs 21 to 24) no error in the reasoning of the Court of First Instance to the effect that “Coupling the words “company” and “line” – both of which are customary in English speaking countries – together, without any graphic or semantic modification, does not imbue them with any additional characteristic such as to render the sign, taken as a whole, capable of distinguishing DKV’s services from those of other undertakings.” In paragraphs 31 to 36 of its Judgement the Court specifically rejected the appellant’s contention that the mark at issue should not have been refused registration under Section 3(1)(b) (Article 7(1)(b) CTMR) without

consideration of the question whether it was free of objection under Section 3(1)(c) (Article 7(1)(c) CTMR).

20. I must assess the mark's distinctiveness in relation to the goods for which the applicant seeks registration, which include articles of underclothing. I must also have regard to the perception of the relevant consumers of these goods, which in my view are the general public. For the reasons already stated, I am of the view that BODYSLIMMERS is not an unusual way of describing the applicant's goods and therefore the public would not distinguish them by reference to those words from those products provided by other undertakings. The coupling together of the words "body" and "slimmers" does not create a word which is more than the sum of its parts. I therefore find that the mark is devoid of any distinctive character under Section 3(1)(b).

21. Mr Robey made reference to the mark being accepted and registered at OHIM. The fact that an identical trade mark has been registered for identical goods at the Community office or by a member state may be taken into account by the competent authority but is not determinative of the outcome of the consideration. In considering this issue I take into account the comments of Geoffrey Hobbs QC in *Telewest Communication Plc's Trade Mark Application* [2003] RPC 26:

"21. I am not persuaded otherwise by the fact that the Applicant has applied successfully under number 001432780 for registration of SURFUNLIMITED as a Community trade mark in respect of a wide range of services in Classes 38, 41 and 42 (including services of the kind specified in the Application that is now before me).

22. The Community Office may or may not have been aware that the Applicant was seeking to register SURFUNLIMITED and SURF UNLIMITED in series in the United Kingdom on the basis that the two marks "differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark" (Section 41(2) of the Act). It is in any event clear that each national authority is entitled to assess distinctiveness in the light of circumstances prevailing in its own territory, it being recognised and accepted that assessments are liable to vary as a result of linguistic, cultural and social differences between Member States: see the cases referred to in paragraph 61 of the CYCLING IS decision.

23. In paragraph 39 of its Judgment in the COMPANYLINE case (above) the ECJ held that nothing in the Community Trade Mark Regulation required the Community Trade Marks Office to come to the same conclusions as those arrived at by national authorities in similar circumstances. Directive 89/104/EEC of 21st December 1988 similarly appears to permit the national authorities in the Member States to conclude that the outcome of an application for registration in the Community Trade Marks Office is not necessarily determinative of a parallel application for registration under the harmonised law of trade marks at the national level: see paragraph 58 of the Judgment of Lloyd J. in *Dualit Ltd's Trade Mark Application* [1999] RPC 890.

24. I do not doubt that there is a need for consistency of approach to the registration of trade marks under the applicable provisions of Community law. However, differences

of approach may result from the fact that the correct approach continues to be the subject of analysis in the case law of the supervising courts in Luxembourg. And tribunals adopting the correct approach may nevertheless arrive at different conclusions as to the registrability of a particular trade mark on an overall assessment of the circumstances prevailing in the territory to which their jurisdiction extends.”

I therefore take the view that the mark’s registration by OHIM is not persuasive in this case and for the reasons stated, the objection under Section 3(1)(b) and (c) is upheld.

Conclusion

22. In this decision I have considered all the arguments and documents presented by the applicant’s representative, and for the reasons given the application is refused under the terms of Section 37(4) of the Act because the mark fails to qualify under Sections 3(1)(b) and (c) of the Act.

Dated this 17th day of September 2004.

Charles Hamilton
For the Registrar
the Comptroller-General