

O-166-04

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 2283400  
TO REGISTER A TRADEMARK  
IN CLASS 3**

**BY KAO KABUSHIKI KAISHA ALSO t/a KAO CORPORATION**

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**DECISION AND GROUNDS OF DECISION**

**Background**

1. On 17 October 2001, Kao Kabushiki Kaisha also t/a Kao Corporation of 14-10 Nihonbashi Kayabacho, 1-chome Chuo-ku, Tokyo 103-8210, Japan applied to register the trade mark NATURALLY SMOOTH in class 3 in respect of the following goods:

Shaving lotions; cosmetics; toiletries; moisturizing lotions; preparations for the care and treatment of the body and skin; deodorants and anti-perspirants for personal use.

2. Objection was taken against the application under Section 3(1)(b) of the Act because the mark consists of the words “Naturally Smooth” being devoid of any distinctive character for e.g. smooth products.

3. A Hearing was held on 29 October 2002 at which the applicants were represented by Dr S R James of RGC Jenkins & Co, Trade Mark Attorneys. The objection under Section 3(1)(b) was maintained and the application subsequently refused 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 Marks 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,”

## **The case for registration**

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

- In use “NATURALLY SMOOTH” would be perceived as a trade mark. An example of the mark in use was provided by the agent and this is at ANNEX A.
- The term “NATURALLY SMOOTH” is a meaningless phrase in relation to the goods claimed.
- The phrase is both ambiguous and subjective and at most allusory to a purpose of some of the goods claimed.

8. Following the Hearing by letter of 29 January 2003 the agent limited the specification of goods to:

Moisturizers; shave minimising moisturizers for women.

He further submitted that in relation to shave minimising moisturisers for women, in particular, the products purpose is to reduce the number of times women feel the necessity to shave. These women are not, therefore, “naturally smooth” but wish to become artificially smooth for a short period between shaves. The mark therefore puts the unusual idea of a perfect, yet in fact unobtainable, situation before a woman and means that the phrase is not only unusual but extremely memorable. The relevant consumers know that the phrase is therefore essentially meaningless and will see it as an unusual mark signifying the origin of a product.

## **Decision**

9. The approach to be adopted when considering the issue of distinctiveness under Section 3(1)(b) of the Act has recently been summarised by the European Court of Justice in paragraphs 37, 39 to 41 and 47 of its Judgment in Joined Cases C-53/01 to C-55/01 *Linde AG, Windward Industries Inc and Rado Uhren AG* (8<sup>th</sup> April 2003) in the following terms:

“37. It must first of all be observed that Article 2 of the Directive provides that any sign may constitute a trade mark provided that it is, first, capable of being represented graphically and, second, capable of distinguishing the goods and services of one undertaking from those of other undertakings.

.....

39. Next, pursuant to Article 3(1)(b) of the Directive, trade marks which are devoid of distinctive character are not to be registered or if registered are liable to be declared invalid.

40. For a mark to possess distinctive character within the meaning of that provision it must serve to identify the product in respect of which registration

is applied for as originating from a particular undertaking, and thus to distinguish that product from products of other undertakings (see Philips [2002] ECR I-5475, paragraph 35).

41. In addition, a trade mark's distinctiveness must be assessed by reference to, first, the goods or services in respect of which registration is sought and, second, the perception of the relevant persons, namely the consumers of the goods or services. According to the Court's case-law, that means the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and circumspect (see Case C-210/96 Gut Springenheide and Tusky [1998] ECR I-4657, paragraph 31, and Philips, paragraph 63).

.....

47. As paragraph 40 of this judgment makes clear, distinctive character means, for all trade marks, that the mark must be capable of identifying the product as originating from a particular undertaking, and thus distinguishing it from those of other undertakings.”

10. In paragraph 20 of the Judgement in the “Companyline” Decision (Case C-104/00) 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.”

11. 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).

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

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

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

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

16. I am not persuaded that the mark “NATURALLY SMOOTH” in totality is distinctive in that it would serve in trade to distinguish the applicants’ goods from those of other traders. In my view the mark applied for will not be identified as a trade mark without first educating the public that it is one. I therefore conclude that the mark applied for is devoid of any distinctive character and is thus excluded from prima facie acceptance under Section 3(1)(b) of the Act.

## **Conclusion**

17. In this decision I have considered all documents filed by the agent and all the arguments submitted 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 Section 3(1)(b) of the Act.

Dated this 9th day of June 2004

Ian Peggie  
For the Registrar  
the Comptroller-General