

TRADE MARKS ORDINANCE (CAP. 559)

APPLICATION NO. : **300748099**
MARK : **COTTON ON BODY**
APPLICANT : **Cotton On Body Pty Ltd**
CLASSES : **3, 25, 35**

STATEMENT OF REASONS FOR DECISION

Background

1. This is an application of Cotton On Body Pty Ltd of Victoria, Australia (“the Applicant”). On 26 October 2006, the Applicant applied to register the mark shown below (“the subject mark”) under the Trade Marks Ordinance (Cap. 559) (“the Ordinance”).

COTTON ON BODY

2. The registration of the subject mark is sought in respect of various goods and services in Classes 3, 25 and 35, the specifications of which are reproduced at *Annex A* of this statement of reasons for decision.
3. At the examination stage, objections were raised under sections 11(1)(b) and (c) of the Ordinance in relation to the goods in Class 25 and the “wholesaling and retailing of clothing, clothing accessories, fashion accessories, footwear, headgear” in Class 35 (collectively, “the objectionable goods and services”). The objections were raised on the basis that the subject mark was devoid of any distinctive character and consisted exclusively of a sign which might serve, in trade or business, to designate the characteristics of the objectionable goods and services.
4. By a letter of 28 December 2007, the Applicant requested a hearing on the registrability of the subject mark. The hearing was set down to take place before me on 9 April 2008, at which Ms. Milla Cheung of Messrs. Robin Bridge & John Liu appeared for the Applicant. I reserved my decision at the end of the hearing.

5. No evidence of use of the subject mark has been filed in this application. I have, therefore, only the *prima facie* case to consider.

The Ordinance

6. The absolute grounds for refusal of an application for registration are set out in section 11 of the Ordinance. The relevant provisions under section 11 read as follows:-

- “(1) Subject to subsection (2), 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 which may serve, in trade or business, to designate the kind, quality, quantity, intended purpose, value, geographical origin, time of production of goods or rendering of goods or rendering of services, or other characteristics of goods or services; and
 - (d) ...”

Decision

7. Having considered all the relevant facts, I am of the view that the subject mark is not objectionable under the Ordinance in respect of the goods in Class 3 and the services in Class 35, with the exception of “wholesaling and retailing of clothing, clothing accessories, fashion accessories, footwear, headgear” in the class (collectively, “the unobjectionable goods and services”). Subject to meeting the requirements stipulated in paragraph 32 below, the subject application insofar as it is in respect of the unobjectionable goods and services may proceed to registration.
8. For the rest of this statement of reasons, therefore, I shall consider the subject application insofar as it is in respect of the following goods and services applied for:
 - (a) “clothing; footwear; headgear” in Class 25 (“the objectionable goods”) and
 - (b) “wholesaling and retailing of clothing, clothing accessories, fashion accessories, footwear, headgear” in Class 35 (“the objectionable services”).

Section 11(1)(c) of the Ordinance

9. Section 11(1)(c) precludes from registration marks consisting exclusively of signs which may serve to designate the characteristics of the goods and services in respect of which registration is sought. In *Wm. Wrigley Jr. Company v OHIM* [2004] 1

W.L.R. 1728 (“the *DOUBLEMINT* case”), the European Court of Justice (“ECJ”) held that, at paragraph 32:

“In order for OHIM to refuse to register a trade mark under Article 7(1)(c) of Regulation No 40/94 [*broadly similar in terms to section 11(1)(c) of the Ordinance*], 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 provisions 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.”

10. Therefore, for the purpose of section 11(1)(c) of the Ordinance, the relevant consideration is whether the mark carries a meaning which can be used for the purpose of describing the characteristics of the goods in question. That is to say, if at least one of the mark’s possible meanings designates a characteristic of the goods and services in question, the mark is precluded from registration under section 11(1)(c) of the Ordinance. In this connection, whether the mark carries other non-descriptive meanings is of little relevance.
11. The subject mark is the combination of three generic English words “COTTON ON BODY”. According to *Collins English Dictionary* (Millennium edition), “body” is a versatile word which carries numerous meanings including “the entire physical structure of an animal or human being”, “the flesh, as opposed to the spirit”, “the largest or main part of anything” and “the part of a dress covering the body from the shoulders to the waist”.
12. Contrary to Ms. Cheung’s written submission that the subject mark is a creative combination of words and does not describe any characteristics of the objectionable goods and services, “cotton on body” is in fact a description commonly used to indicate that in respect of a clothing item, the part covering the area from the shoulders to the waist and as opposed to other parts such as the sleeves, is made of cotton. As shown in the Internet references provided to the Applicant during the examination stage on 3 January 2007, “cotton on body” is a phrase often used in trade to describe that the body of the piece of clothing is made of cotton. Excerpts of these Internet references are provided at *Annex B* of this statement of reasons for decision. There is nothing creative, unnatural or unique about the combination of the English words which form the subject mark.
13. Furthermore, when used in respect of the objectionable goods, namely clothing, footwear and headgear, the subject mark describes that the goods are made of cotton and to be worn on the body. In this context, “body” carries the more liberal meaning

which is not limited to the trunk or the torso but the entire physical structure of a human being, thus including the head and the feet.

14. Additionally, as “body” also carries the meaning of “the largest or main part of anything”, when used in relation to the objectionable goods, including footwear and headgear, the subject mark directly describes that the largest or main part of the piece of clothing, footwear and headgear is made of cotton.
15. In relation to the objectionable services, “cotton on body” simply describes that the largest or main part of the merchandise such as “clothing, clothing accessories, fashion accessories, footwear, headgear” wholesaled or retailed through the service is made of cotton. The subject mark also designates that the merchandise wholesaled or retailed is made of cotton and can be worn on the body.
16. With regard to the Internet examples provided to the Applicant during the examination stage, showing how other traders were using the phrase “cotton on body” to describe articles of clothing, Ms. Cheung observed that the websites were related to clothing only, but not footwear or headgear. Ms. Cheung also submitted that the Internet search conducted by the Applicant, yielding nothing which showed common descriptive use of the phrase “cotton on body”, should be taken into account for the purpose of assessing descriptiveness and distinctiveness of the subject mark.
17. As I have explained in paragraph 10 above, the relevant consideration for the purpose of section 11(1)(c) is whether at least one of the mark’s possible meanings designates the characteristics of the goods and services in question. It is of little relevance that the mark carries other meanings. Also, while current use of a mark to describe certain characteristics of the goods and services in question would be a clear indication that the mark can be so used, the lack of actual use of the mark as a description does not mean that the mark cannot serve such purpose. Indeed, as stated in the *DOUBLEMINT* case, *supra*, to be precluded from registration under section 11(1)(c), it is not necessary for the mark to be in actual use at the time of the application for registration in a way that is descriptive of the goods and services in question. In other words, even if “cotton on body” is not currently used in trade to designate the characteristics of footwear and headgear, it does not mean that the subject mark does not consist exclusively of a sign that is descriptive of the characteristics of footwear, headgear and the related wholesaling or retailing services. Also, I do not find the Internet searches of the Applicant, which do not show the phrase “cotton on body” being used as a descriptive phrase, to be of any assistance.

18. I am not persuaded by Ms. Cheung that the subject mark is merely suggestive or allusive of the objectionable goods and services in an indirect way. In relation to the objectionable goods and services, the descriptive meanings conveyed by the phrase “cotton on body” are obvious and direct. The subject mark is capable of designating the characteristics of the objectionable goods by stating that the goods sold are to be worn on the body and made of cotton, or the largest part of the goods is made of cotton. It is also capable of describing the characteristics of the objectionable services, namely, the goods provided through the wholesaling or retailing services are made of cotton and to be worn on the body, or are made of cotton in the major parts. The subject mark consists exclusively of signs which may serve to designate that the objectionable goods are made of cotton and the objectionable services are in relation to the sale of goods which are made of cotton. Accordingly, the subject mark is precluded from registration under section 11(1)(c) of the Ordinance.

Section 11(1)(b) of the Ordinance

19. Section 11(1)(b) of the Ordinance, operating as a ground of objection separate and independent from that under section 11(1)(c), precludes from registration signs which are devoid of any distinctive character. In *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281 at 306, Mr. Justice Jacob said:

“What does *devoid of any distinctive character* mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark?”

20. Further to the above principle, in assessing the distinctive character of a sign, Sir Andrew Morritt in *Nestle SA’s Trade Mark Application (“Have a Break”)* [2004] F.S.R. 2, at 26 stated that:

“The distinctiveness to be considered is that which identifies a product as originating from a particular undertaking. Such distinctiveness is to be considered by reference to goods of the class for which registration is sought and consumers of those goods. In relation to the consumers of those goods the court is required to consider the presumed expectations of reasonably well informed, and circumspect consumers.”

21. It follows that the distinctive character under section 11(1)(b) of the Ordinance means that the mark, assuming no use of it, must be capable of identifying the product or service as originating from a particular undertaking, and thus distinguishing it from those of other undertakings. The distinctiveness of the mark must be assessed by reference to the goods or services for which registration is sought and the perception of the relevant consumers.

22. By nature of the objectionable goods and services, which essentially are related to the sale of clothing, footwear and headgear, the relevant consumers are the members of the general public in Hong Kong who purchase or are looking for articles of clothing, clothing accessories, headgear and footwear.
23. When assessing the distinctiveness of the subject mark, I must consider the context in which the mark is used in respect of the objectionable goods and services. The fair use of a mark in respect of the relevant goods and services includes applying it on the goods or their packaging as well as using it in the course of advertising or promotion of the goods and services.
24. Ms. Cheung submitted that the phrase “cotton on body” was not commonly used in connection with the objectionable goods and services, but was a unique and creative combination of words. According to Ms. Cheung, a reasonably well-informed, observant and circumspect consumer of average intelligence would know that the phrase “cotton on body” was being used by the Applicant as a trade mark to denote origin but not a descriptive term.
25. On seeing the subject mark on the packaging or promotional leaflets of clothing, clothing accessories, footwear and headgear, the relevant consumers would perceive the subject mark as an indication that the products are largely made of cotton or are made of cotton and to be worn on the body. As the subject mark is the direct descriptions (a) of the materials the objectionable goods made of, (b) that the objectionable goods are to be worn on the body and (c) of the characteristics of the goods provided through the objectionable services, I am not satisfied that without first being educated, the relevant consumers would regard the subject mark as a guarantee of a particular trade origin.
26. In *Deutsche SiSi-Werke GmbH & Co. Betriebs KG v. OHIM* [2006] E.T.M.R. 41 (Case C-173/04P) at paragraph 60, the essential function of a trade mark is described by the ECJ as:

“to guarantee the identity of the origin of the marked product or service to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin”
27. Having considered the subject application carefully, I am not persuaded that the relevant consumers would rely on the subject mark alone, without any possibility of confusion, to identify a particular undertaking from which the objectionable goods and services originate. The subject mark is devoid of any distinctive character and is precluded from registration under section 11(1)(b) of the Ordinance.

Other registered trade marks

28. In support of the subject application, Ms. Cheung pointed out that other registered trade marks of the Applicant, "COTTON ON" and "COTTON ON KIDS", had been registered on a *prima facie* basis in respect of goods and services similar to the objectionable goods and services. According to Ms. Cheung, if the two registered trade marks were found to possess the requisite inherent distinctiveness as a badge of trade origin, the subject mark must be similarly accepted as registrable.
29. The registrability of a mark must be assessed by reference to the mark in its entirety. I have considered the registered trade marks. I do not find that the impression conveyed or the connotation carried by the two registered trade marks of the Applicant to be the same as that of the subject mark. I do not find them to be comparable to the subject mark. In any event, it is well established that each case must be considered on its own merits. The state of the register is of little relevance when there are valid grounds for refusal against the subject application.

Foreign registrations of the subject mark

30. Ms. Cheung also drew my attention to the registrations of the subject mark in Australia and New Zealand. It should be noted that national trade mark rights are territorially limited and granted independently of each other. The bare fact of registration in other countries is not sufficient to establish that a sign is eligible for registration here (*Automotive Network Exchange Trade Mark* [1998] R.P.C. 885). As I have found that the subject mark is precluded from registration under the Ordinance, the registrations of the subject mark in overseas jurisdictions do not serve to overcome the objections raised under sections 11(1)(b) and (c) as stated above.

Conclusion

31. In this decision, I have carefully considered all of the submissions, both written and oral, made by and on behalf of the Applicant. For the reasons given above, I consider that the subject mark is precluded from registration by sections 11(1)(b) and 11(1)(c) of the Ordinance. The subject application is accordingly refused under section 42(4)(b) of the Ordinance.
32. As I have indicated in paragraph 7 above, the subject application in respect of the unobjectionable goods and services may proceed to publication, provided that the Applicant files, on or before **20 October 2008**, an amendment on Form T5A to amend the specification by restricting the application to the unobjectionable goods

and services only. If the Applicant fails to do so on or before 20 October 2008, the subject application in respect of these goods and services is deemed to be abandoned.

Margaret K.W. YU
for Registrar of Trade Marks
18 September 2008

Class 3

Cosmetics; body and beauty care cosmetics; face creams for cosmetic use; cosmetic creams; skin moisturizers; face and body lotions; hand lotions; skin lotions; baby lotion; facial cleansers; skin cleansers; beauty creams for body care; beauty masks; facial masks; facial scrubs; lipsticks; make-up; make-up remover; eye make-up; mascara; pencils for cosmetic purposes; nail care preparations; nail polish; sun care lotions; sunscreen creams; cosmetic suntan lotions; after-sun lotions; perfumes; essential oils; massage oils; aromatherapy oils; cosmetic oils; potpourri; perfuming sachets; bath oils for cosmetic purposes; bath salts (non-medicated); bath lotions; non-medicated toiletries; deodorants and antiperspirants; body spray used as a personal deodorant and as fragrance; talcum powder; perfumed powder; hair care preparations; shampoos; hair conditioners; hair styling preparations; hair gels; hair mousse; hair spray; hair colouring preparations; hair dyes; soaps for personal use; hand soaps; liquid soaps; perfumed soaps; cosmetic soaps; deodorant soaps; shaving preparations; shaving creams; shaving lotions; shaving soap; after-shave preparations; after-shave balms; after-shave lotions; toothpaste; breath freshener; cosmetic preparations for the care of mouth and teeth; non-medicated mouth wash and rinse; pumice stones for personal use.

Class 25

Clothing; footwear; headgear.

Class 35

Wholesaling and retailing of clothing, clothing accessories, fashion accessories, footwear, headgear, cosmetics, body and beauty care cosmetics, face creams for cosmetic use, cosmetic creams, skin moisturizers, face and body lotions, hand lotions, skin lotions, baby lotion, facial cleansers, skin cleansers, beauty creams for body care, beauty masks, facial masks, facial scrubs, lipsticks, make-up, make-up remover, eye make-up, mascara, pencils for cosmetic purposes, nail care preparations, nail polish, sun care lotions, sunscreen creams, cosmetic suntan lotions, after-sun lotions, perfumes, essential oils, massage oils, aromatherapy oils, cosmetic oils, potpourri, perfuming sachets, bath oils for cosmetic purposes, bath salts (non-medicated), bath lotions, non-medicated toiletries, deodorants and antiperspirants, body spray used as a personal deodorant and as fragrance, talcum powder, perfumed powder, hair care preparations, shampoos, hair conditioners, hair styling preparations, hair gels, hair mousse, hair spray, hair colouring preparations, hair dyes, soaps for personal use, hand soaps, liquid soaps, perfumed soaps, cosmetic soaps, deodorant soaps, shaving preparations, shaving creams, shaving lotions, shaving soap, after-shave preparations, after-shave balms, after-shave lotions, toothpaste, breath freshener, cosmetic preparations for the care of mouth and teeth, non-medicated mouth wash and rinse, pumice stones for personal use; including such services provided through stores, by means of catalogues and direct mail, or on-line from a global computer network or the Internet.

1. <http://www.knickers247.com/item.asp?i=211>
Armani : 1/4 Zip Jumper
Two Tone Navy and Grey 1/4 Zip Jumper from Armani, with front large single pocket. Armani Jeans logo on back of Jumper.
Made with: 100% **Cotton on Body**. Trim 97% Cotton, 3% Elastane.

2. http://www.cheapstingybargains.com/10020/leather_bomber/
Timberland leather bomber jacket
 - 100% leather
 - Lining: 100% **cotton on body**; 50% nylon/50% acetate on sleeve
 - Filler: 100% polyester