

**O/103/18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK REGISTRATION NO 3126466  
OWNED BY MOTHERLYLOVE LTD**

**DOWN BELOW**

**AND**

**THE APPLICATION FOR A DECLARATION OF INVALIDITY THERETO  
UNDER NO 501292 BY NATURAL BIRTHING COMPANY LTD**

## Background and pleadings

1. Motherlylove Ltd (“the proprietor”) applied for the trade mark Down Below (number 3126466) on 10 September 2015. It was registered on 18 December 2015 for the following goods and services:

Class 3: Blended oils and non-blended oils, all for the use in massage, baths and sprays.

Class 35: Advertising; business management; business administration; office functions; organisation, operation and supervision of loyalty and incentive schemes; advertising services provided via the Internet; production of television and radio advertisements; accountancy; auctioneering; trade fairs; opinion polling; data processing; provision of business information; e-commerce services provided via the Internet; product demonstration and product display services; demonstration of goods for retail purposes; demonstration of goods and services by electronic means; Toiletries, Cosmetics, Soaps, Creams, Lotions, Aromatherapy oil, Essential oils, Blended essential oils, Body care and beauty care preparations, Carrier oils (vegetable and essential oils), Derivatives of essential oils, essences, aromatics and aromas, aromatic extracts, essential oils and essential oil based compositions, body care and beauty care products, aromatherapy products and preparations, perfumery; skin care products and preparations; information, advisory and consultancy services relating to all the aforesaid.

2. On 12 August 2016, Natural Birthing Company Ltd (“the applicant”) applied to have the registration declared invalid under section 47(1) of the Trade Marks Act 1994 (“the Act”), claiming that the registration offends sections 3(1)(b), (c), (d) and 3(6) of the Act. These sections state:

“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 of services, or other characteristics of goods or services,
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practice of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

“3.— (6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

3. In summary, the section 3(1) claims are as follows:

- Under 3(1)(b): the applicant had previously tried to register the same mark for massage oils and had been refused registration by the IPO because Down Below would be seen as instructive as to the area of the body in relation to which the goods would be used.
- Under 3(1)(c): Down Below is used to describe the perineum/vulva area of the female body, in which case the mark describes the intended purpose of the massage oils.
- Under 3(1)(d): As above, Down Below is in customary use as a common name for this area of the female body, used by women and health

professionals. The product is aimed at pregnant women; midwives use 'down below' to refer to the perineal area.

4. The section 3(6) claim is framed as follows:

"Motherly Love have been selling their Down Below product since October 2012 and made no attempt to trademark the name until they realised that we were selling the same product using the same name. They wrote to us in September 2015 to claim that we were "passing off" their unregistered Trademark, as soon as we denied their claims they immediately applied for this Trademark.

They applied for this Trademark with the knowledge that there was already a product of the same nature on the market with the same name, just in order to add strength to their common law case.

They already had the product on the market so they knew exactly what type of product they wanted the trademark for, and yet they were vague on their application by describing a perineal massage oil as "blended oils and non-blended oils, all for use in massage, baths and sprays" in order to get the trademark application through. Their product is not for use in a bath and it is not a spray so this should not have been quoted in their application. They did this with the knowledge that if they described the product as a perineal oil it would not be allowed.

To be clear I am not asking the IPO to decide a Common Law case of who started using the Down Below name first on their product. I accept the decision that I was given from the IPO that Down Below is not distinctive enough to be trademarked. However if that is the case then I request that Motherly Love's trademark of Down Below be invalidated for the same reason as in reality their use of it is exactly as ours."

5. The applicant has stated in its pleadings that it seeks the invalidation of the registration for all the goods and services for which it is registered.

6. The proprietor denies all the claims against it. In summary, it claims that:

- The application has been brought as ‘tit-for-tat’ as the applicant refuses to acknowledge ML’s earlier rights in the mark;
- Down Below is not descriptive of the goods and services, and is not customary in the current language or bona fide practices of the trade. It is allusive and therefore inherently distinctive.
- In any case, the use made of the mark would entitle it to rely upon the proviso to section 3(1) of the Act<sup>1</sup> as the proprietor first used the mark in 2011, four years prior to filing its application to register the trade mark and before the applicant starting using the sign Down Below.
- It already had unregistered rights in the mark when it applied for the trade mark registration; the filing of the application was made in accordance with this use and to safeguard the trade mark from unauthorised third party use.
- The scope of protection is not vague or deceptive. The wording is readily understood and provides protection for present and future offerings under the mark.

## **Representation**

7. The applicant represented itself at pleadings stage, but later appointed OCL Solicitors as a representative. The proprietor has been professionally represented by ip21 Limited throughout. Both parties filed evidence and written submissions during the evidence rounds. Both elected for a decision to be made from the evidence and submissions filed.

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<sup>1</sup> The proviso to section 47(1) of the Act, as these are invalidation proceedings.

## Relevant dates

8. The relevant date for assessing whether the grounds under section 3(1) and 3(6) of the Act are made out is the date on which the application to register the contested mark was filed, 10 September 2015. However, in accordance with the proviso to section 47(1), the registration shall be saved from invalidation on grounds of non-distinctiveness if it has been shown that the mark had acquired a distinctive character by the date of the application for invalidation, i.e. 12 August 2016.<sup>2</sup>

## Evidence

### The applicant's evidence-in-chief

9. Jane Mason is the applicant's majority shareholder and is a registered and practising midwife of 12 years' experience. Ms Mason has provided two witness statements in these proceedings.

10. Ms Mason states that the applicant was founded by her and another midwife to develop products which, in their experience, would be of benefit to new and expectant mothers. Ms Mason does not state when the applicant was founded. However, she states that (at the date of her statement in 2017) the applicant sold products through retailers such as Boots, Superdrug, Holland and Barrett and online retailers, such as The Hut Group, Amazon and Not on the High Street.com. The applicant also sells directly from its own website.

11. The applicant applied for the trade mark Down Below for perineal massage oil, but the application was refused by the IPO on 25 November 2013, for the reasons given in the pleadings.

12. Ms Mason states that she, as a midwife, would often refer to a woman's genitalia as 'down below', one reason being that some women may not know the word perineum. She explains that midwives commonly use the words 'down below'

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<sup>2</sup> See, by analogy, *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52 (Ch), paragraph 179.

for a second reason; namely, that it helps to avoid the embarrassment and upset that some women feel when more specific language is used. 'Down below' was originally adopted as a "catchy" trading name, but in the light of the IPO's reasons for rejecting the application Ms Mason says that she realised that it was non-distinctive and therefore accepted the IPO's decision to reject the application.

13. In support of the applicant's claim that DOWN BELOW is non-distinctive, Ms Mason provides:<sup>3</sup>

- A copy of an article obtained from the internet in November 2013 entitled 'vocabulary used by patients to describe their symptoms and Parts of the body' which includes the entry '*Genitals: down below, private parts*';<sup>4</sup>
- A copy of an entry from the Online Slang Dictionary, which states that '*down below*' is slang for female genitals;
- A copy of an article dated April 2017 from the Daily Mail online about the practice of waxing, shaving or clipping public hair with the title 'More women are grooming down below...';
- An entry from the blog site 'netmums', apparently left in 2010, under the heading 'lump down below', which goes on to describe the writer having found a lump in her pubic area.

14. As regards the proprietor's use of the mark DOWN BELOW, Ms Mason provides copies of pages from the proprietor's website showing that its products are marketed like this:



<sup>3</sup> See exhibit JM1

<sup>4</sup> This article was sent to the applicant in 2013 by the Examiner of its own trade mark application in order to illustrate the reason for the IPO's objection to it in class 3.

15. I note that the names used for these products are a mixture of more or less descriptive terms, 'Tums and Boobs' being the most obviously descriptive whilst 'Footloose' is, at most, allusive.

#### The proprietor's evidence

16. The proprietor's evidence consists of two witness statements by Ms Jan Bastard, the founder of MotherlyLove Limited. I note the following points from Ms Bastard's first statement:

- The proprietor was incorporated in December 2011 *"to provide a variety of products for Mums to be and beyond."*
- Ms Bastard has 40 years' experience as a nurse and midwife.
- The proprietor's products, including the product sold under the contested mark, *"had a soft launch in 2011 - 2012 with family and friends being the initial consumers along with their network of friends."*
- The proprietor's products were formally launched in March 2013.
- Initially the products were marketed *"through personal contacts, midwives and complementary therapists before attending a number of trade events relating to Pregnancy, Mother and Baby, and the like in order to showcase [the] range and to get interest and orders."*
- *"Nowadays [the statement is dated November 2016] orders are generated through trade fair attendance, our website, a variety of social media tools and accounts, repeat users and referrals from past users, my links with various pregnancy bloggers and as a direct result of the awards we are winning. Our products and gift sets are also available via Amazon and NotOnTheHighstreet.com to name but a few popular websites that stock our products."*
- The proprietor has attended 56 trade shows in the UK between 2013 and the date of the application for invalidation, many of which were local events in Norfolk and the South East of England (particularly in 2013 and 2014).



- The proprietor received 9 awards for its products (6 in 2016), none of which appear to relate specifically to the Motherlylove Down Under product.<sup>5</sup>
- She received an email from Jane Mason of the applicant in September 2013 saying that the proprietor’s products “*look very interesting*” and asking “*are they doing well?*”
- She subsequently found out that the applicant had applied to register DOWN UNDER as a trade mark and contacted Ms Mason to draw her attention to the proprietor’s earlier rights in the mark.
- When the applicant’s application was withdrawn she assumed that was the end of the matter until a customer approached her at a trade show in June 2015 about seeing another product with the same name. This turned out to be one of the applicant’s products.
- She confirms that within the medical/midwifery profession, “DOWN BELOW” refers to “*down there*” meaning a woman’s “*nether regions*” or “*intimate areas.*” However, she disputes that “DOWN BELOW” is a specific reference to the perineum.

17. I further note that in her second statement Ms Bastard:

- Provides a copy of an email from Mrs Sally Bastard dated 6<sup>th</sup> February 2016 confirming the use and existence of the proprietor’s DOWN BELOW product in August 2012.<sup>6</sup>
- Provides a copy of an email to her representative in June 2015 which she says shows that confusion occurred when both parties exhibited their DOWN BELOW products at the same trade show.<sup>7</sup>
- Confirms that the parties’ products are sold through the same channels.
- Provides four pages of images returned from Google search results for ‘perineal oil photos’ and ‘Down Under perineal oil’, which show only the parties to these proceedings using ‘Down Under’ in relation to such goods.<sup>8</sup>

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<sup>5</sup> See exhibits JB4 and 5

<sup>6</sup> See JB1 to Bastard 2

<sup>7</sup> See JB2 to Bastard 2. In fact the email records that mums-to-be were asking if the parties’ products were the same (as opposed to being from the same trade source).

<sup>8</sup> See JB5 to Bastard 2

- Provides a copy of an email sent to the proprietor’s representative relating to the words revealed by the Google searches, and accompanying screen shots for the relevant hits, which she points out do not show use of ‘down below’ to describe private parts.<sup>9</sup>

### Applicant’s evidence in reply

18. The applicant’s evidence in reply consists of a second statement from Jane Mason. In her second statement Ms Mason:

- Provides five emails she received from other midwives confirming that they use, and/or have heard ‘down below’ used, to describe the female genital area/perineum;
- Information about the proprietor’s Motherlylove Down Below product showing that it is a perineum massage oil;
- Points out that the term ‘down below’ is used descriptively in a blog and in a case study on the proprietor’s own website: *“It is important to have confidence and trust in the massage oil that you will use to massage this sensitive area Down Below”* and *“Do not use perineal massage, if you have an infection “down below”.”*

### **The section 3(6) ground – bad faith**

19. The law in relation to section 3(6) of the Act (“bad faith”) was summarised by Arnold J. in *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* as follows:<sup>10</sup>

“131. First, the relevant date for assessing whether an application to register a trade mark was made in bad faith is the application date: see Case C- 529/07 *Chocoladenfabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* [2009] ECR I-4893 at [35].

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<sup>9</sup> See JB7 to Bastard 2

<sup>10</sup> [2012] EWHC 1929 (Ch)

132. Secondly, although the relevant date is the application date, later evidence is relevant if it casts light backwards on the position as at the application date: see *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2008] EWHC 3032 (Ch), [2009] RPC 9 at [167] and cf. Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 at [31] and Case C-192/03 *Alcon Inc v OHIM* [2004] ECR I-8993 at [41].

133. Thirdly, a person is presumed to have acted in good faith unless the contrary is proved. An allegation of bad faith is a serious allegation which must be distinctly proved. The standard of proof is on the balance of probabilities but cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith: see *BRUTT Trade Marks* [2007] RPC 19 at [29], *von Rossum v Heinrich Mack Nachf. GmbH & Co KG* (Case R 336/207-2, OHIM Second Board of Appeal, 13 November 2007) at [22] and *Funke Kunststoffe GmbH v Astral Property Pty Ltd* (Case R 1621/2006-4, OHIM Fourth Board of Appeal, 21 December 2009) at [22].

134. Fourthly, bad faith includes not only dishonesty, but also "some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined": see *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at 379 and *DAAWAT Trade Mark* (Case C000659037/1, OHIM Cancellation Division, 28 June 2004) at [8].

135. Fifthly, section 3(6) of the 1994 Act, Article 3(2)(d) of the Directive and Article 52(1)(b) of the Regulation are intended to prevent abuse of the trade mark system: see *Melly's Trade Mark Application* [2008] RPC 20 at [51] and *CHOOSI Trade Mark* (Case R 633/2007-2, OHIM Second Board of Appeal, 29 February 2008) at [21]. As the case law makes clear, there are two main classes of abuse. The first concerns abuse vis-à-vis the relevant office, for example where the applicant knowingly supplies untrue or misleading information in support of his application; and the second concerns abuse vis-à-vis third parties: see *Cipriani* at [185].

136. Sixthly, in order to determine whether the applicant acted in bad faith, the tribunal must make an overall assessment, taking into account all the factors relevant to the particular case: see *Lindt v Hauswirth* at [37].

137. Seventhly, the tribunal must first ascertain what the defendant knew about the matters in question and then decide whether, in the light of that knowledge, the defendant's conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary standards of honest people. The applicant's own standards of honesty (or acceptable commercial behaviour) are irrelevant to the enquiry: see *AJIT WEEKLY Trade Mark* [2006] RPC 25 at [35]-[41], *GERSON Trade Mark* (Case R 916/2004-1, OHIM First Board of Appeal, 4 June 2009) at [53] and *Campbell v Hughes* [2011] RPC 21 at [36].

138. Eighthly, consideration must be given to the applicant's intention. As the CJEU stated in *Lindt v Hauswirth*:

"41. ... in order to determine whether there was bad faith, consideration must also be given to the applicant's intention at the time when he files the application for registration.

42. It must be observed in that regard that, as the Advocate General states in point 58 of her Opinion, the applicant's intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case.

43. Accordingly, the intention to prevent a third party from marketing a product may, in certain circumstances, be an element of bad faith on the part of the applicant.

44. That is in particular the case when it becomes apparent, subsequently, that the applicant applied for registration of a sign as a

Community trade mark without intending to use it, his sole objective being to prevent a third party from entering the market.

45. In such a case, the mark does not fulfil its essential function, namely that of ensuring that the consumer or end-user can identify the origin of the product or service concerned by allowing him to distinguish that product or service from those of different origin, without any confusion (see, inter alia, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 48).

46.....the fact that a third party has long used a sign for an identical or similar product capable of being confused with the mark applied for and that that sign enjoys some degree of legal protection is of the factors relevant to the determination of whether the applicant was acting in bad faith”.

47. In such a case, the applicant’s sole aim in taking advantage of the rights conferred by a Community trade mark might be to compete unfairly with a competitor who is using the sign which, because of characteristics of its own, has by that time obtained some degree of legal protection.

48. That said, it cannot be excluded that even in such circumstances, and in particular when several producers were using, on the market, identical or similar signs for identical or similar products capable of being confused with the sign for which registration is sought, the applicant’s registration of the sign may be in pursuit of a legitimate objective.”

20. There appears to be two parts to the applicant’s case. Firstly, that the proprietor’s application to register DOWN BELOW was made in the knowledge of the applicant’s use of the same mark for the same goods and with the intention of improving upon its legal position under the common law to prevent third party use of a later conflicting trade mark. Secondly, that the goods/services listed in the application are

described in broad terms and are therefore not a fair reflection of the specific product sold under the mark; namely, perineal massage oils.

21. I find that the first part of the s.3(6) ground is misconceived and must be rejected. This is because it is clear from the case law that it is not bad faith to apply to register a trade mark that (a) is in use, (b) may have acquired a certain degree of legal protection, and (c) with the intention of preventing a third party from taking unfair advantage of the trade mark. On the contrary, the trade mark registration system exists precisely to help businesses to prevent abuses of this kind.

22. The second part of the s.3(6) ground is also misconceived and must also be rejected. This is because there is no requirement for the trade mark to be in use in respect of all the goods/services listed in the application for registration. It is sufficient that the applicant has a *bona fide* intention to use the mark in relation those goods/services. Consequently, the mere fact that the proprietor has so far used the mark in relation to only one product is not sufficient to present a *prima facie* case that the application for registration was filed in bad faith. In this regard, it is important to bear in mind that an allegation of bad faith is a serious allegation. Cogent evidence is required to support it. In my view, the applicant's evidence is equally consistent with good faith (i.e. that the proprietor had not ruled out expanding the range of products it sells under the mark) as bad faith (that the proprietor did not intend to use the mark in relation to anything other than a perineal massage oil).

23. The s.3(6) ground for invalidation therefore fails.

### **The s.3(1) grounds – non-distinctiveness**

24. It is convenient to start with the s.3(1)(d) ground. In *Telefon & Buch Verlagsgesellschaft GmbH v OHIM*,<sup>11</sup> the General Court summarised the case law of the CJEU under the equivalent of s.3(1)(d) of the Act as follows:

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<sup>11</sup> Case T-322/03

“49. Article 7(1)(d) of [EU Trade Mark] Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma* (BSS) [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public’s perception of the mark (*BSS*, paragraph 37).

50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (*BSS*, paragraph 38).

51. Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and *BSS*, paragraph 39).”

25. I find that there is enough evidence to conclude that ‘down below’ is a term which has become customary to designate the female genital area (at least) amongst healthcare professionals dealing with pregnancies. However, there is no evidence that it has become “customary” as a designation of perineal massage oils, or any other goods. Indeed the only evidence of any use of the term in relation to goods is the evidence of use of the name by the parties to these proceedings. And both of

these parties regard, or have in the past regarded, the name as their trade mark. Consequently, the s.3(1)(d) ground is rejected.

26. I turn next to the s.3(1)(c) ground. The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was summarised by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc.*<sup>12</sup> The judge said:

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks ( OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94 . Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia, *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P)

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<sup>12</sup> [2012] EWHC 3074 (Ch)



[2004] E.C.R. I-5089; [2005] E.T.M.R. 44, paragraph 45, and *Lego Juris v OHIM* (C-48/09 P), paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley*, paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94, it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie*, paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94 , the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all

be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56)."

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97]."

27. The applicant's case is, in essence, that 'down below' is a sign that may be used, in trade, to describe, i.e. "designate", skin treatments suitable for use in the female genital area. Having regard to the case law, this raises the following three issues:

- (1) Would traders and consumers of skin care products recognise 'down below' as a description of the female genital area?
- (2) Is 'down below' a sign that may be used to designate skin care products which are suitable for use in this area of the body?
- (3) If the answer to (1) and (2) is 'yes', is the intended area of the body a characteristic of such goods?

28. The answer to the first question does not appear to be in serious dispute. Although the evidence provided in her later statement appears to be intended to encourage me to arrive at a contrary conclusion, Ms Bastard accepted in her first statement that “*within the medical/midwifery profession, “DOWN BELOW” refers to “down there” meaning a woman’s “nether regions” or “intimate areas.”*” In any event, and despite the informal nature of the applicant’s evidence and the lack of evidential weight of some parts of it (such as the Online Dictionary of Slang, which anyone can update), the evidence as a whole shows that ‘down below’ has the meaning suggested by the applicant, at least to midwives. It is true that midwives are not necessarily the main consumers of the goods at issue, but the utility of term as a less embarrassing way of describing the female genital area would be lost if pregnant women (who appear to be the main consumers) would not understand what the term means. This accords with my own understanding of the term. In my experience, when used in a relevant context, it is widely understood as a reference to the female genital area.

29. As to the second question, there seems no doubt on the evidence that skin care products are marketed as being suitable for particular areas of the body. It is obvious, e.g. *face* cream, *hand* cream etc. Of course, these are straightforward anatomical terms rather than informal or slang, like ‘down below’. It might therefore be questioned whether the latter kind of term would be used in the trade in medical goods, when the language of this trade is usually quite formal and serious. However, the applicant’s evidence illustrates why such informal names are likely to be used in trade, i.e. so that consumers can identify their specific skin care requirements without the embarrassment of using more specific and formal descriptions of the body. The proprietor’s use of ‘Tums and boobs’ for another skin care product suitable for use on the stomach area and the breasts is a clear example of use that is both informal and descriptive.

30. The answer to the third question is also straightforward. The area of the body for which a skin care product is most suitable will influence the constituents used in the product, the specific uses of the product, as well as the kind of consumer interested in it. Names such as *face* or *hand* therefore designate the intended purpose of such products. And even if I am wrong about that, they clearly designate other

characteristics of such products. As a matter of logic, the same must apply to DOWN BELOW when used in relation to skin care or skin treatment products suitable for use in the female genital area.

31. I therefore find that DOWN BELOW is a sign that may serve, in trade, to designate a characteristic of skin care or skin treatment products suitable for use in the female genital area. It follows that the mark was registered contrary to s.3(1)(c) of the Act in relation to such products.

32. It is necessary to identify the goods/services covered by the registration of the contested mark to which the objection applies. All the descriptions of goods in class 3 cover skin care or skin treatment products intended for use in the female genital area. The objection therefore applies to all the goods in class 3.

33. The registered services in class 35 include:

“Advertising; business management; business administration; office functions; organisation, operation and supervision of loyalty and incentive schemes; advertising services provided via the Internet; production of television and radio advertisements; accountancy; auctioneering; trade fairs; opinion polling; data processing; provision of business information.”

34. The services protected by the trade mark are those provided to others. Consequently, *advertising* means advertising the goods/services *of others* (i.e. not those of the trade mark proprietor). With this observation in mind it is clear that the descriptiveness objection does not apply to any of the above services. There is no other reason to believe that the mark lacks distinctive character in relation these services.

35. The contested trade mark is also registered in class 35 in relation to:

“e-commerce services provided via the Internet; product demonstration and product display services; demonstration of goods for retail purposes; demonstration of goods and services by electronic means; Toiletries,

Cosmetics, Soaps, Creams, Lotions, Aromatherapy oil, Essential oils, Blended essential oils, Body care and beauty care preparations, Carrier oils (vegetable and essential oils), Derivatives of essential oils, essences, aromatics and aromas, aromatic extracts, essential oils and essential oil based compositions, body care and beauty care products, aromatherapy products and preparations, perfumery; skin care products and preparations; information, advisory and consultancy services relating to all the aforesaid.”

36. This is a curious specification because the ‘services’ listed from ‘Toiletries’ to ‘skin care products and preparations’ appear to be goods, not services. There are two possible answers to this. Firstly, these are descriptions of goods which should have been included in class 3, not 35. Secondly, these descriptions are intended to qualify the services which precede them so as to properly define which goods are the subject of the proprietor’s e-commerce services etc. Given that the proprietor elected to include these descriptions as services in class 35, I think that the latter is more probable and I will approach the matter on this basis.

37. Looking at the descriptions *e-commerce services provided via the Internet; product demonstration and product display services; demonstration of goods for retail purposes; demonstration of goods and services by electronic means* this way, I find that the s.3(1)(c) objection which *prima facie* applies to the trade mark in class 3 also applies to these services in class 35. This is because the descriptions of the goods marketed via the services in class 35 cover (in varying degrees of generality) skin care or skin treatment products intended for use in the female genital area.<sup>13</sup>

38. Bearing this in mind, I find that the descriptiveness of the mark for the goods in class 3 also applies to the services described in the previous paragraph, which appear to be services intended to encourage consumers to purchase the identified goods from a particular undertaking.<sup>14</sup>

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<sup>13</sup> In reaching this view, I note that skin care products can be perfumed. The same product can therefore be described as a *skin care product* or as a *perfumery product*. Similarly, if the skin care product covers blemishes it can also be described as a *cosmetic product*.

<sup>14</sup> See, by analogy, *Fourneaux De France Trade Mark*, Case BL O/240/02. Also *Murka Ltd v EUIPO*, General Court, Case T-704/16

39. Further, even if I am wrong to find that the descriptiveness of the mark in relation to the goods extends to the associated services, then I would find that the contested mark lacks a distinctive character in relation to such closely associated services. This is because consumers would regard the mark as characterising the kind of goods being marketed/demonstrated with a view to sale rather than identifying the undertaking responsible for the services in question. The mark is therefore devoid any of any distinctive character for such services and *prima facie* excluded from registration by s.3(1)(b) of the Act.

40. Alternatively, if the descriptions of goods in class 35 are actually descriptions of goods, then the descriptiveness objection under s.3(1)(c) applies directly to such goods. In that event, the objection to the (unqualified) services in class 35 set out in paragraph 37 above still applies because (absent any other indication as to the type of goods to which the services relate) those services *could* be services intended to encourage consumers to purchase *skin care or skin treatment products intended for use in the female genital area* from a particular undertaking.

41. I therefore conclude, without it being necessary to also examine the applicability of the s.3(1)(b) ground to the goods in class 3, that the contested mark was registered contrary to s.3(1)(b) and/or s.3(1)(c) of the Act in relation to:

Class 3: Blended oils and non-blended oils, all for the use in massage, baths and sprays.

Class 35: e-commerce services provided via the Internet; product demonstration and product display services; demonstration of goods for retail purposes; demonstration of goods and services by electronic means; Toiletries, Cosmetics, Soaps, Creams, Lotions, Aromatherapy oil, Essential oils, Blended essential oils, Body care and beauty care preparations, Carrier oils (vegetable and essential oils), Derivatives of essential oils, essences, aromatics and aromas, aromatic extracts, essential oils and essential oil based compositions, body care and beauty care products, aromatherapy products and preparations, perfumery; skin care products and preparations; information, advisory and consultancy services relating to all the aforesaid.

Had the mark acquired a distinctive character through use in relation to these goods/services by the date of the application for invalidation?

42. The CJEU provided guidance in *Windsurfing Chiemsee*<sup>15</sup> about the correct approach with regard to the assessment of the acquisition of distinctive character through use. The guidance is as follows:

“51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.

52. If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied. However, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data such as predetermined percentages.

53. As regards the method to be used to assess the distinctive character of a mark in respect of which registration is applied for, Community law does not preclude the competent authority, where it has particular difficulty in that connection, from having recourse, under the conditions laid down by its own national law, to an opinion poll as guidance for its judgment (see, to that effect, Case C-210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 37).”

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<sup>15</sup> Joined cases C-108 & C-109/97



43. The relevant public appears to be comprised of adult females or those that help select skin care products on their behalf, e.g. midwives. The question is whether the mark had become distinctive through use by the date of the application for invalidation to that section of the public, or at least to a significant proportion of it.

44. It appears that the contested mark was first used in 2012 when products bearing the mark were marketed to family and friends of Ms Bastard. Products bearing the mark were formally launched in 2013, around 3 years prior to the relevant date. The product was initially marketed through personal contacts, midwives and complementary therapists before the proprietor attended a number of trade events relating to Pregnancy, Mother and Baby, and the like in order to promote goods bearing the mark and generate interest and orders. By November 2016 orders were being generated through attendance at trade fairs, the proprietor's website, social media tools and accounts, repeat users and referrals from past users. By that time, the proprietor's products were also available via Amazon and NotOnTheHighstreet.com.

45. The proprietor has not provided sales figures, or the market share held by the mark, or any evidence of sales to customers (which might have shed light on where in the UK the proprietor's customers are based). Nor has it provided any figures to show the amount spent promoting the trade mark. Judging from the trade shows attended, my impression is that the marketing was concentrated in Norfolk and the surrounding counties in 2013 and 2014, but extended to some national shows in 2015 and 2016. Overall, the evidence points to a small albeit growing business. On the limited evidence before me, I am unable to find that the DOWN UNDER mark would have been known to a significant proportion of the relevant UK public in August 2016.

46. Additionally, if the use shown of the mark at paragraph 14 above is typical, the proprietor's task of showing that DOWN UNDER has become distinctive of its products is complicated by the fact that the principal mark used to distinguish the trade source of the products appears to be the distinctive name MOTHERLYLOVE. The function of Down Under as a secondary or product mark is (at best) ambiguous. In context, it is more likely to be taken as a description of the intended purpose of the

product as it is a secondary trade mark. Consequently, even if the proprietor had shown that the product was known to a significant proportion of relevant consumers, it would not have led automatically to the conclusion that DOWN UNDER had acquired a distinctive [trade mark] character through use.<sup>16</sup>

### **Overall outcome**

47. The trade mark registration is partly invalid and will be cancelled, except in relation to:

“Class 35: Advertising; business management; business administration; office functions; organisation, operation and supervision of loyalty and incentive schemes; advertising services provided via the Internet; production of television and radio advertisements; accountancy; auctioneering; trade fairs; opinion polling; data processing; provision of business information. Information, advisory and consultancy services relating to all the aforesaid.”

### **Costs**

48. The application has partly succeeded and partly failed. I will also take into account that there was nothing in the bad faith claim and it was inappropriate to make such an allegation on such a flimsy basis.

49. In the circumstances I order each side to bear its own costs

**Dated this 15<sup>th</sup> day of February 2018**

**Allan James  
For the Registrar**

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<sup>16</sup> See, by analogy, the judgment of the General Court in *Audi AG, Volkswagen AG v OHIM*, Case T-318/09