

O/457/11

**TRADE MARKS ACT 1994**

**IN THE MATTER OF REGISTRATION NOS 2002829 and 2184362  
IN THE NAME OF BRAWN, LLC FOR THE TRADE MARK**

**UNDERGEAR**

**IN CLASSES 25, AND 14, 25, 35, 38 AND 39 RESPECTIVELY**

**AND IN THE MATTER OF APPLICATIONS FOR DECLARATIONS OF  
INVALIDITY THERETO UNDER NOS 83949 AND 23948  
BY X-TECHNOLOGY SWISS GMBH**

## **TRADE MARKS ACT 1994**

**IN THE MATTER OF Registration Nos. 2002829 and 2184362  
In the name of Brawn LLC for the trade mark**

## **UNDERGEAR**

and

**IN THE MATTER OF applications for declarations of invalidity thereto under  
Nos. 83948 and 83949 by X-Technology GmbH**

### **BACKGROUND AND PLEADINGS**

1. There are two registered trade marks involved in these proceedings. The first is 2002829 which stands in the name of Brawn LLC ('Brawn'). The mark was applied for on 26<sup>th</sup> November 1994 and completed its registration procedure on 20<sup>th</sup> September 1996. The mark comprises the word 'UNDERGEAR' and the goods and services for which it is registered are as below:

#### **Class 25**

T-shirts, vests, underwear, nightwear; hosiery.

2. The second is 2184362, also in the name of Brawn. This mark was applied for on 14<sup>th</sup> December 1998 and completed its registration procedure on 30<sup>th</sup> May 2003. The mark also comprises the word 'UNDERGEAR' and the goods and services for which it is registered include clothing, footwear and headgear in class 25, along with other goods and services in other classes.
3. On 24<sup>th</sup> December 2010, X-Technology Swiss GmbH ('Tech') applied for declarations of invalidity under section 47 of The Trade Marks Act 1994 ('the Act') in respect of both registrations, but only insofar as the specifications covered the term 'underwear'.
4. The statement of grounds is the same in both cases. The specific grounds of invalidity are stated as follows:-
  - under section 3(1)(a), in that the mark is not capable of distinguishing underwear goods of one undertaking from that of another and that other traders would, as a consequence, be prejudiced as they would not be free to use a word that should be available to describe goods naturally. In addition there is a risk that the public would be confused and the specific subject matter of the mark would be damaged as the meaning of 'undergear' makes it impossible to guarantee origin;

- under section 3(1)(b), in that the mark consists exclusively of the word 'undergear' which is an English word for underwear and is synonymous with all types of underclothing and undergarments. It is thus devoid of distinctive character. In support of this, copies of various definitions from traditional and online dictionaries are supplied:-
  - Collins Concise Dictionary (Third Edition) ('Collins') shows that the definition of the word 'under' includes, "directly below; on, to, or beneath the underside or base of" and the definition of the word 'gear' includes " *Inf* up-to-date clothes and accessories";
  - Webster's Third New International Dictionary of the English Language (Unabridged) ('Websters') defines 'undergear' as "gear placed below or under something else; running gear and chassis of a vehicle";
  - The Longman Dictionary of Contemporary English defines 'gear' as, amongst other things, "a set of clothes that you wear for a particular occasion or activity";
  - [www.thefreedictionary.com](http://www.thefreedictionary.com) , defines gear as "*inf* up-to-date clothes and accessories and the meaning of underwear is given as "clothes worn under the outer garments, usually next to the skin";
  - a similar definition of 'underwear' is provided by [www.audioenglish.net](http://www.audioenglish.net) as "undergarment worn next to the skin and under outer garments".
- under section 3(1)(c), in that the mark consists exclusively of a sign or indication used to designate the kind or intended purpose of the relevant goods in class 25, that is to say, underwear. As well as the various dictionary definitions already referred to, the applicant says the average consumer of the relevant goods would be familiar with various other 'gear' words (including colloquial use) in relation to clothing, such as, "swimgear", "sportsgear", "skigear";
- under section 3(1)(d) in that the mark consists exclusively of a sign or indication which has become customary in the current language or in the bona fide and established practices of the trade since 'undergear' is synonymous with 'underwear'.

In sum, Tech says there is a public interest in preserving the rights of other traders to use the term, over which no-one should have a monopoly given its synonymous meaning.

5. Brawn filed a defence and counterstatement in which it denied all the grounds of invalidity. Specifically, it says the term is capable of being a sign which function as a trade mark and is capable of distinguishing the goods of one trader over another. It denies the word 'UNDERGEAR' is synonymous with underwear and that the word 'UNDERGEAR' is totally descriptive of underwear in class 25. The word 'UNDERGEAR', it says, is a term coined by the registered proprietor and is readily recognised as a distinctive trade mark. It denies that the various dictionary definitions demonstrate that the term is descriptive, or has become customary in the current language or in the bona fide or established practices of the trade; rather, the two words, underwear and 'UNDERGEAR' are etymologically distinctive.
6. Evidence was filed by the registered proprietor which I shall summarise below. Neither party requested to be heard and so the following decision is arrived at from a careful reading of the papers on file. Both parties request costs.

#### **Evidence of the registered proprietor**

7. This takes the form of a witness statement dated 5<sup>th</sup> August 2011 by Graham Farrington, a Trade Mark Attorney with Ladas & Parry LLP, acting for the proprietor. He says the applicant for invalidity filed a Community Trade Mark under number 4211454 for the trade mark X-UNDERGEAR. This was successfully opposed by Brawn, the appeal by Tech was unsuccessful and the case is now before the General Court. Mr Farrington says it is apparent Tech considered the term 'undergear' to be distinctive when accompanied by the term 'X-'. When its own mark was refused because of the prior rights of Brawn it made the claim that undergear lacks distinctiveness.
8. Exhibit GF1 comprises a copy of Websters showing the definition of 'undergear' as provided by Tech. Exhibit GF2 comprises copies of other dictionaries and their various definitions (or rather, lack of definitions) of 'undergear'. The word is not recognised by the Free Online Dictionary; likewise at Dictionary.com. At the thesaurus [www.merriam-webster.com](http://www.merriam-webster.com) the word is also not recognised; likewise at the Cambridge and Oxford Dictionaries online. Further non-recognition is exhibited at Your Dictionary.com, thesaurus.com and synonym.com.
9. Mr Farrington submits that unabridged dictionaries, such as Websters, contain entries for almost any term in the lexicon, including coined terms composed of two dictionary terms. Unabridged dictionaries include terms which are most of the time simply unknown or uncommon for the average consumer in daily use. Regular dictionaries, none of which recognise the term, contain terms of common use. Even in the Webster's dictionary, Mr Farrington notes the definition given bears no relation to clothing at large, specifically underwear.

10. The absence of dictionary references suggests, says Mr Farrington, that 'UNDERGEAR' is a word coined by Brawn and that English speaking consumers will perceive the term as a badge of origin. In contrast, Exhibit GF3 comprises copies of search results made using the ONE LOOK Dictionary search facility which shows that 46 dictionaries recognise the term 'underwear'. The contrast in search results for the term 'undergear' and 'underwear' show, says Mr Farrington, that the word is not in common use as a synonym for underwear.
11. Exhibit GF5 comprises the results of a GOOGLE search on the word 'UNDERGEAR' which reveals, says Mr Farrington, that all or substantially all the links to UNDERGEAR re-direct to Brawn's UNDERGEAR branded products, offered by online retailers and different forums discussing Brawn's products. Examples of such trade mark usage are as follows:
- at [www.undergear.com](http://www.undergear.com), the registered proprietor's own website;
  - UnderGear Facebook at [www.facebook.com/undergear](http://www.facebook.com/undergear) Company Overview. For over 25 years UnderGear® has been a leading retailer...Through an attractive catalog and exciting online site, UnderGear® provides ....
  - UNDERGEAR STYLE at [undergearstyle.blogspot.com](http://undergearstyle.blogspot.com) 16<sup>th</sup> April 2010 – To get you in the party mood, check out these pictures from UnderGear's underwear event at Club 57 in NYC last weekend....
  - JAMES GUARDINO for Undergear – YouTube Take a peek at this behind the scenes video from the Undergear SS09 catalog photo shoot....
  - 1 UnderGear Men- tribe net at [tribes.tribe.net/undergearmen](http://tribes.tribe.net/undergearmen) 18<sup>th</sup> May 2007 – You know you look and read the catalog cover to cover. Here is a place to share pictures and comments.
  - Undergear.com on Myspace
  - Happy Holidays from UnderGear – YouTube video Behind the scenes from our Holiday Catalog photo shoot
  - UnderGear: No boxers, No briefs....Form the people who brought you.....As previously noted, the International Male catalog is being phased out. The new company is UnderGear.com and thankfully they've sent out their summer 2008....
  - International Male – Wikipedia, the free encyclopedia The catalog originally carried a wide variety of men's underwear, but this was spun

off into a separate catalog, Undergear, which focuses exclusively on.....

12. There are also however a number of, what may be termed 'ambivalent' results exhibited, meaning those which do not *plainly* show 'trade mark' use, such as:

- MEN IN UNDERGEAR – YouTube video dated 1<sup>st</sup> August 2010 described as "men in underwear, boxer briefs, speedos, sports gear and jockstraps;
- Performance Under Gear at [www.performanceundergear.com](http://www.performanceundergear.com)
- Westport Under Gear – Online Athletic apparel site at [www.westportundergear.com](http://www.westportundergear.com) .
- Under Gear – Badminton Proshop Shuttlehouse View Under Gear from other makers. Other categories, Badminton Racket, Shoes, Bag, Game shirt, Game pants, Warm-up pants, Warm-up shirt....
- Key Undergear at [www.aboystore.com](http://www.aboystore.com) – Men's underwear, men's accessories, Men's loungewear gymwear, resortwear and swimwear
- Cityboyz Sweat Under Gear at [www.cityboyzfashions.com](http://www.cityboyzfashions.com) "SWEAT UNDER GEAR provides today's man with an underwear line that reflects his athletic fashionable lifestyle."
- Renato Ferreira for Undergear – [www.allhotmen.com](http://www.allhotmen.com) "More Undergear summer styles !"
- Undergear Products – PacificJock [www.pacificjock.com](http://www.pacificjock.com) "Offering mens' designer underwear etc
- Undergear Swimwear 2011 [www.homorazzi.com](http://www.homorazzi.com)

13. Further, the search on 'UNDERGEAR' has also revealed a number of images showing men in vests and underpants. I also note that the search on 'undegear' also pulled out the site Men's underwear at [www.abcunderwear.com](http://www.abcunderwear.com).

14. There is no evidence, says Mr Farrington, that consumers would use the word 'UNDERGEAR' to refer to underwear, either in the form of surveys, declarations by Consumer Associations or otherwise. He concludes by saying it is not sufficient to merely assert that a term comprising the known words 'under' and 'gear' must be devoid of distinctive character simply by

virtue of its composition of two known words. There are a number of UK trade mark registrations formed by the combination of the word 'under' followed by another English term or the word gear preceded by another English term. Exhibit 6 comprises a print out of relevant third party UK registrations such as, UNDERBELLY, BODY GEAR and TOPGEAR. Such marks have the same grammatical 'structure and composition' and are nevertheless capable of registration. In the same way, so, says Mr Farrington, is 'UNDERGEAR'.

## **DECISION**

### **The law**

15. Section 3(1)(a)(b) (c) and (d) of the Act are relevant in invalidation proceedings in view of the provisions of Section 47(1) of the Act, the relevant parts of which read:

“**47.** - (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration). Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

...

(5) Where the grounds of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.”

Section 3(1) (a) (b) (c) and (d) of the Act reads:

“**3.** - (1) The following shall not be registered –

(a) signs which do not satisfy the requirements of section 1(1),

(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 bona fide and established practices 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.

Section 1(1) of the Act reads:

1. - (1) In this Act a “trade mark” means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.

16. The relevant date at which the assessment as to whether any, or all, the grounds of objection is, or are, made out is the dates of application for the registrations under attack, being 26<sup>th</sup> November 1994 in relation to 2002829 and 14<sup>th</sup> December 1998 in relation to 2184362. If the objection is made out at those dates, it would also necessary to consider whether the mark had acquired a distinctive character after it was registered. The relevant date for this purpose would be the dates of the applications for invalidation, being 24<sup>th</sup> December 2010.

### **Section 3(1)(a)**

17. In *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* Case C-299/99 the CJEU stated:

“36. It is true that Article 3(1)(a) of the Directive provides that signs which cannot constitute a trade mark are to be refused registration or if registered are liable to be declared invalid.

37. However, it is clear from the wording of Article 3(1)(a) and the structure of the Directive that that provision is intended essentially to exclude from registration signs which are not generally capable of being a trade mark and thus cannot be represented graphically and/or are not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

38. Accordingly, Article 3(1)(a) of the Directive, like the rule laid down by Article 3(1)(b), (c) and (d), precludes the registration of signs or indications which do not meet one of the two conditions imposed by Article 2 of the Directive, that is to say, the condition requiring such signs to be capable of distinguishing the goods or services of one undertaking from those of other undertakings.



39. It follows that there is no class of marks having a distinctive character by their nature or by the use made of them which is not capable of distinguishing goods or services within the meaning of Article 2 of the Directive.

40. In the light of those considerations, the answer to the first question must be that there is no category of marks which is not excluded from registration by Article 3(1)(b), (c) and (d) and Article 3(3) of the Directive which is none the less excluded from registration by Article 3(1)(a) thereof on the ground that such marks are incapable of distinguishing the goods of the proprietor of the mark from those of other undertakings.”

18. Consequently, in order for a sign to fall foul of section 3(1)(a) of the Act, the mark concerned will not be capable of registration, as it will fall foul of sections 3(1)(b), (c) and/or (d) of the Act, and it cannot acquire distinctive character through the use made of it. There is nothing inherent in the trade mark concerned that makes it incapable of registration whatever the use made of it. It is to be noted that the Act envisages even signs which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade can be registered, if they have acquired a distinctive character. Consequently, the opposition under section 3(1)(a) of the Act is dismissed. As the trade mark will also have to fall foul of sections 3(1)(b), (c) and/or (d) of the Act, for it to be excluded under section 3(1)(a) of the Act, this ground of opposition is otiose.

### **Section 3(1) (c)**

19. There are now a number of judgments from the Court of Justice of the European Union (CJEU) which deal with the scope of Article 3(1) (c) of First Council Directive 89/104 (recoded and replaced by Directive 2008/95/EC on 22 October 2008) and Article 7(1) (c) of the Community Trade Mark Regulation (“the CTMR”), whose provisions correspond to Section 3(1) (c) of the UK Act. The following main guiding principles, relevant to this case, are noted below:

- subject to any claim in relation to acquired distinctive character, 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, Article 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;

- Section 3(1) (c) of the Act excludes signs which may serve, in trade, to designate the kind of goods or other characteristics of goods. It follows that in order to decide this issue it must first be determined whether the mark designates a characteristic of the goods in question;

- to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say in trade and or amongst average consumers of the said goods or services, reasonably well-informed and reasonably observant and circumspect, in the territory in respect of which registration is applied for - *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04 at paragraph 24;

- a sign's descriptiveness may only be assessed, first, in relation to the goods or services concerned and, secondly, in relation to the perception of the target public, which is composed of the consumers of those goods or services – *Ford Motor Co v OHIM (as above)*.

20. I must decide whether, in 1994 or 1998, it was likely that the average consumer (by which I include the trade as well as the average consumers in the UK for underwear (meaning the vast majority of the population)) would have perceived the word 'undergear' as designating a characteristic of underwear; that is to say, the word 'undergear' was, at the material dates, synonymous with underwear.

21. In order to establish this, Tech refers me to dictionaries. These provide separate meanings of the words 'under' and 'gear'. The meaning of the word 'gear' in particular, is shown to refer to informal use in relation to clothing and accessories, but not underwear specifically.

22. That said, establishing the definitions separately of the words 'under' and 'gear' is not decisive. The Appointed Person, in the PutterScope (BL O/96/11) case said:

"8.....Although I agree that it necessary for the purpose of explanation to break down the mark into its component parts, one must be aware of the danger that such an iterative approach may be unfair to the applicant. Each individual part of a mark may be non-distinctive, but the sum of the parts may have distinctive character – see Satelliten Fernsehen GmbH v OHIM [2005] ETMR 20 [SAT 1], at paragraph 28. Ultimately the decision making tribunal must stand back from the detailed breakdown of the mark and envisage how the entire trade mark would be understood by the public when applied to the goods of the specification. Would the average consumer consider that it was a trade mark indicating goods from a

particular source or would they consider that it simply indicated the function of the goods?"

23. In other words, establishing a descriptive meaning for the words 'under' and 'gear' separately does not mean that Tech succeeds under section 3(1) (c). It is well established that the combination of two potentially descriptive words may well equate to *more* than a descriptive sum of the individual parts.
24. In my view this is the case here. The average consumer in the UK will inevitably be used to, and familiar with, the word 'underwear'; that is the word used by traders and consumers alike and in everyday language and has been so for many years. There is no reason to suppose (for example, if 'undergear' were a shortened version of 'underwear', or that it was used in the USA in relation to a new product) that 'undergear' is used synonymously in the UK. In fact, with the exception of Websters dictionary, the word 'undergear' is not even recognised in any of the dictionaries relied upon by Tech.
25. I would just add that, even if there been any recognition in dictionaries of the word 'undergear', Tech would have had to make good the claim to invalidity going back to the material dates in 1994 and 1998.
26. As to the sole recognition of the word in Websters, as Brawn points out, this is an unabridged dictionary which, by definition, contains many more terms which are not in everyday usage. Furthermore, the definition given in Websters (relating to cars and aeroplanes) is far removed from clothing and underwear in particular.
27. I have no hesitation then, in finding that the evidence of the dictionaries relied upon by Tech does not make good its claim that the word 'undergear' is synonymous with 'underwear', and would be understood as such by the average consumer in the UK.
28. It may be argued that better evidence of potential descriptiveness may have been provided by Brawn itself in its GOOGLE search evidence, some of the hits of which may, as I have said, be classed as 'ambivalent'. That said, the best that can be said of this evidence is that it is 'ambivalent'; in other words, in terms of the weight to be accorded this evidence, it raises no more than a small question mark as to whether the relevant word is used descriptively, in certain circumstances, by others. This falls far short, then, of making a compelling case. Not only is not compelling in terms of the context in which the word is used, other criticisms of this ambivalent evidence can be made in that it is not plainly of UK sourced material and nor can it necessarily be said to reflect on the position at the material dates.

29. Taking the hits as a whole, the GOOGLE search evidence points to significant 'trade mark' use by the proprietor and this reinforces its contention that the word is capable of functioning as a trade mark.
30. Finally, I should consider the argument that even without the dictionaries, the average consumer in the UK is so familiar with usage of the word 'gear' (including colloquial usage) in relation to clothing, such as 'swimming gear', 'sports gear' and so forth, that absolutely no mental effort on the part of that consumer would be involved in arriving at a definition of 'undergear', as being a synonym for 'underwear'. The difficulty with this submission is that 'underwear' is, as I have said in para 24 above, such an established and understood term that the evidence of linguistic displacement or supplementary usage (in a trading context) would have to be compelling and of course, must reflect backwards to the material dates. Such 'evidence' as there is (for example, the fact that the GOOGLE search on 'undergear' also revealed an underwear site at [www.abcunderwear.com](http://www.abcunderwear.com) and images of men in their underwear) is insufficient to make good the claim and falls far short of what is required.
31. In all the circumstances I have no hesitation in dismissing the claim under section 3(1)(c).

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

32. As is recognised, section 3(1)(b) can be broader in scope and application than both sections 3(1)(c) and (d). It is plain, however, from the pleadings in this case that my determination under section 3(1)(c), in effect, determines the matter under section 3(1)(b) also. In other words, Tech says the mark is non-distinctive by virtue only, of it being synonymous with the word 'underwear'.
33. I have said that Tech has not made out that primary claim under section 3(1)(c) and the ground under section 3(1)(b) is also dismissed.

### **Section 3(1)(d)**

34. Section 3(1) (d) of the Act requires consideration of the nature of use in the market place and a finding that the sign has 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 the mark is applied for or registered (see, *Merz & Krell GmbH & Co.* [2001] ECR I-6959, para 41).
35. The ground under section 3(1)(d) must be established by persuasive evidence going to actual use of the word, 'undergear', in the context of clothing, specifically, underwear. My criticisms of Tech's evidence under section 3(1)(c) apply with even more force under section 3(1)(d). There is

simply nothing from which I can say that the word *'undergear'* was actually in use in the current language and bona fide and established practices of the trade to designate underwear at the material dates, or ever, for that matter.

36. I conclude then that the ground under section 3(1)(d) of the Act also fails and the registration is not invalid on that ground either.

### **Overall conclusion**

37. The declarations of invalidity have failed under section 47, relying upon section 3(1) (a) (b), (c) and (d).

### **Costs**

38. Brawn LLC has been totally successful in defending against these applications to declare the registrations invalid and it is entitled to a contribution towards its costs. I take into account this decision has been reached without a hearing and neither party sought costs off the normal scale. In the circumstances I award Brawn LLC the sum of £1000 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

1. Preparing counterstatements and considering statements of case - £400
2. Filing evidence - £300
3. Filing submissions - £300

Total £1000

39. I order X-Technology Swiss GmbH to pay Brawn LLC the sum of £1000. The sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 15<sup>th</sup> day of December 2011**

**Edward Smith  
For the Registrar  
The Comptroller-General**