

O-301-09

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 82928  
BY THE BEAUTY WORKS LIMITED  
FOR REVOCATION OF TRADE MARK No. 2282282  
STANDING IN THE NAME OF  
THE DEZAC GROUP LIMITED**

## **BACKGROUND**

1) The following trade mark is registered in the name of The Dezac Group Limited.

Mark	Number	Registered Date	Class	Specification
AB BELT	2282282	08.03.02	25	Clothing, footwear, headgear.

2) By an application dated 3 July 2007, subsequently amended, The Beauty Works Limited applied for the revocation of the registration under the provisions of Section 46(1)(a) & 46(1)(b) claiming there has been no use of the trade mark on the goods for which it is registered in the five years following registration or in the alternative in the five years prior to the filing of the application for revocation. Revocation dates of 9 March 2007 & 3 July 2007 were sought.

3) On 25 October 2007 the registered proprietor filed a counterstatement denying the applicant's claims.

4) Both sides filed evidence. The matter came to be heard on 24 September 2009 when the registered proprietor was represented by Mr Caddy of Messrs Wynne-Jones Laine & James LLP and the applicant was represented by Mr Ramage of Alexander Ramage Associates.

## **REGISTERED PROPRIETOR'S EVIDENCE**

5) The registered proprietor filed a witness statement, dated 25 October 2007 by Kevin John Herbert a Project Engineer employed by the proprietor company. He states that the proprietor has used the mark on "a range of waste [sic] bands with body toning pads incorporated into them". He states that they are used as fashion items in the gym, by joggers or simply worn around the home. He states they were designed as items of fashion. Mr Herbert states that the items were sold via outlets such as Boots, Argos, QVC, Empire, Eezee TV and Cyber TV. During the relevant periods the items were made in various prints such as zebra, leopard, camouflage and denim. He also filed the following exhibits:

- Exhibit KJH-1: samples of advertising material, undated. This shows the use of different fabrics for the product. These refer to ways to work out and comment on the absence of external wires and the ease of use.
- Exhibit KJH-2: These are said to be photographs of a catwalk with models wearing the item at the "Stuff" fashion show held during 3-6 October 2002 at Earls Court, London. However, they are undated, but do show models wearing the belt, complete with control device, in different fabrics.
- Exhibit KJH-3: A selection of invoices to third party retailers. These are dated between 13 June 2002 and 11 November 2005. There are eleven invoices to the large organisations identified as selling the product in paragraph 5. The invoices total over £100,000, all of which appear to relate to toning belts.

## **APPLICANT'S EVIDENCE**

6) The applicant filed two witness statements. The first, dated 28 January 2008, is by Nicolette Pearson a Director of the applicant company. She states that the "Stuff" show referred to by the proprietor as a fashion show is in fact a show for "gadgets and technology". At exhibit NP1 she provides pages from the internet which shows no "hits" against a search under "Stuff Fashion Show" linked to "Earls Court", dated January 2008. Subsequent pages show clear links to the magazine "Stuff" and its annual show for technology and hi-fi. There are also references to the Duracell Bunny in relation to this show and which appeared in the photos filed by the proprietor. At exhibit NP2 she provides copies of e-mail correspondence between the applicant and its supplier of toning belts where the supplier confirms that the primary purpose of the item sold by the applicant is to tone abdominal muscles.

7) The second witness statement, dated 11 February 2008, is by Benjamin Alexander Ramage the applicant's Trade Mark Attorney. At exhibit BAR1 he provides a copy of a letter, dated 25 June 2007, from the proprietor's solicitors to the applicant alleging that the electronic muscle toning belt being sold by the applicant was identical to the goods covered by the proprietor's trade mark 2282282. At paragraph three of this letter the solicitor writes:

"Our client is one of the leading manufacturers of health, beauty and fitness products worldwide. It supplies and has supplied numerous top sports retailers, including Argos, with a number of goods used for fitness training, including two electronic muscle toning belts named the "AB BELT" and the "AB BELT PRO" (the goods)."

And at paragraph 5:

"The Trade Mark and the mark "AB BELT PRO" ("the Mark") have therefore been used extensively in the United Kingdom since at least 2001 in relation to fitness products. As a result of this use, our client's Trade Mark and the Mark have a reputation in the United Kingdom."

8) The response, from Mr Ramage, is provided at exhibit BAR2. Mr Ramage states that he carried out an internet search of the proprietor's website. He provides copies of pages from the website at exhibit BAR3. These show that the proprietor markets the item as a muscle toning device.

## **PROPRIETOR'S EVIDENCE IN REPLY**

9) The applicant filed three witness statements. The first, dated 27 June 2008, is by Brian Kenneth Charles Dunlop the applicant's Trade Mark Attorney. He states that the relevant periods for the revocation actions are 9 March 2002 – 8 March 2007 for Section 46(1)(a) and 3 July 2002- 2 July 2007 for the Section 46(1)(b) ground. He therefore comments that all of the applicant's evidence is outside the relevant periods. At exhibit BKCD-1 he provides an extract from the on-line version of Chambers English Dictionary (1988 edition) and The New International Webster's Comprehensive Dictionary (1996 edition) which provide the following definitions of

a belt: “a strip of flexible material worn especially around the waist as an item of clothing or a means of carrying something” and “a similar article worn as a corset or for the protection or safety or as a symbol of distinction”, “ a girdle, zone or band; a band of leather or other material worn around the waist” and “a band worn around the waist”. At exhibit BKCD-2 he provides a copy of the class 25 List of Goods from the Seventh Edition of the International Classification of Goods and Services, which he states was in force at the time of the application for the mark in suit being filed.

10) The second witness statement, dated 6 August 2008, is by Malcolm Bradley Mills a Director of the proprietor company. He states:

“2. Dezac coined the name AB BELT for its range of toning belts in about 2001. A toning belt comprises a waist band or belt and one or more toning pads and a control unit. The control unit is battery powered. The toning pads tone muscle around which they are situated. Toning pads (or pad-based EMS toners, as they are more correctly known) do not need to be used in conjunction with belts. ....

3. The AB BELT product comprises a textile band or belt that fits around the waist onto which toning pads can be fitted. Contrary to what Mr Ramage says, it is most definitely a piece of clothing, and it is most definitely marketed as a piece of fashion wear for the body conscious.

4. This sort of product was new at the time and the name AB BELT was chosen as a fanciful allusion to a conventional fashion “belt”. It is a piece of flexible material intended to be worn around the waist which serves the dual purpose of carrying toning apparatus (whilst aesthetically hiding it) and acting as a fashion accessory, helping the wearer to look good.

5. The product is typically worn in the gym or whilst out jogging or undertaking some other form of exercise, so as to increase the effectiveness of the work out. Many people prefer to wear their AB BELT waist bands under their sports shirts (or, indeed under their clothing) but, since the late 1980’s, much modern sports kit is designed to leave the midriff bare, so we were encouraged to market the AB BELT range of products for external, visible use. In other words, we marketed it as a stand alone piece of gym wear, or sports wear.”

11) Mr Mills states that STUFF magazine does contain features on fashion, and he demonstrates this with copies of extracts from the magazine at exhibits MBM-2 & 3. He states that the “STUFF” show is on at the same time as the “What Hi-Fi Sound and Vision Show” and at the same venue so that customers get two shows for the price of one. This is backed up by exhibit MBM-4.

12) The third witness statement, dated 4 December 2008, is by Mr Herbert who has filed evidence previously in this case. He states:

“The evidence submitted with this witness statement under Attachment 1 comprises various true copies of product literature from the Slendertone Company which demonstrate that the market leader in the distribution of innervation [sic] (C.S.I.) technology products markets its products in the form of garments and fashion accessories and refers to them as such. The evidence is

directly relevant to the above proceedings, as it corroborates the registered proprietor's view that the sale of such garments constitutes use in respect of goods in trade mark class 25."

13) The attachment shows that Slendertone are marketing a mini skirt which houses an EMS system.

#### **APPLICANT'S EVIDENCE IN REPLY**

14) The applicant filed two witness statements. The first, dated 11 November 2008, is by Mr Ramage who has previously provided evidence in this case. He points out that the Classification guide has belts in various class headings. He contends that the correct class for apparatus for the therapeutic toning muscles is in Class 10, whereas apparatus for toning muscles, other than for medical rehabilitation, is proper to Class 28. He also points out that the only evidence of use provided by the proprietor has been on belts or bands incorporating toning pads. Mr Ramage states that the proprietor's website, which he copies at exhibit BAR5 refers to the product as a toning belt. He states that he carried out a Google search for "AB BELT" and "toning belt" and achieved very similar results, which he provides copies of at exhibit BAR6 & 7. At exhibit BAR9 Mr Ramage provides copies of a search he did of the US Food and Drug Administration (FDA) which has to approve all pharmaceuticals and medical devices for use in the USA. It shows that the proprietor applied for FDA approval of the "ab belt pro" and "ab belt" devices and described them as muscle stimulators being specifically designed to exercise the abdominal muscles for the purposes of improving abdominal muscle tone.

15) The second witness statement, dated 2 July 2009, is by Dr Patricia Smith, the Chief Executive Officer of Bio-Medical Research Ltd (BMR) a company registered in Ireland. She states that her company has also sought to have the proprietor's mark revoked. BMR's application is currently suspended pending the outcome of this case. She states that Slendertone, referred to by the proprietor in its evidence is a division of her company. She states that the products of Slendertone have been developed over many years and consist of garments with electrodes and wiring integrated into the garment. The primary function is to deliver electrical signals to the skin. She states that the functional intent is quite different from clothing. She states:

"There are countless examples of devices which are attached to body-like garments but whose function and primary purpose is fundamentally different from clothing and which are not offered for sale as clothing. A medical lumbar support belt has a primary function of supporting the lumbar spine but may also have the appearance of an abdominal belt. A life jacket may technically be an item of clothing in that it is worn on the body but its primary function is to keep a person afloat in water. The descriptions in our literature of our product as garments have to be taken in the context of their primary function as electrical muscle stimulation delivery systems. Whilst the AB Belt's have a fabric component and are intended to be wrapped around the body, their primary purpose is, nonetheless, to act as a vehicle for devices for delivering electrical signals to the skin. Indeed the presence of conductive wires that transmit electric currents into the body, coupled with the fact that our AB Belts have no clothing function per se, endorses that the devices are not items of clothing. The only

function of the garment aspect is to support the wires, electrodes and electronic modules of an abdominal stimulation kit of which it is part.”

16) Dr Smith states that the garments in the Slendertone range are not intended to be worn without the pads and are purely for modesty purposes. At exhibit PS9 she attaches a copy of an earlier witness statement, dated 8 August 2008 which also has exhibits attached. This witness statement was originally filed with regard to revocation number 83039. Most of the comments in her statement have been made in her latest statement or by others in the instant case.

17) That concludes my review of the evidence. I now turn to the decision.

## **DECISION**

18) The revocation action is based upon Section 46(1)(a) & (b) of the Trade marks Act 1994, the relevant parts of which read as follows:

“46.-(1) The registration of a trade mark may be revoked on any of the following grounds -

- (a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;
- (b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;
- (c) .....
- (d) ....

(2) For the purposes of subsection (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made.

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.”

19) The applicant alleges that the mark has not been used in the five years subsequent to registration or in the five years prior to the date of the application for revocation.

The periods in question are, therefore, 9 March 2002 – 8 March 2007 for Section 46(1)(a) and 3 July 2002- 2 July 2007 for the Section 46(1)(b) ground.

20) Where the registered proprietor claims that there has been use of the trade mark, the provisions of Section 100 of the Act make it clear that the onus of showing use rests with him. It reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

21) At the hearing the registered proprietor agreed that no use of the mark had been made with regard to footwear and headgear and that these items should be revoked as of 9 March 2007. The registered proprietor also accepted that they had used the mark only on the single product. The applicant conceded that the registered proprietor had made genuine use of the mark in suit, but only on electronic muscle toning belts, which it contended are in Class 10 or 28, not Class 25.

22) The registered proprietor contends that the item is a belt as well as a muscle toning device. Mr Caddy contended that had his company been advising at the registration stage they would have sought registration in a number of classes, class 25 amongst them. I do not regard this as being relevant. I note that the registered proprietor refers to the item as a muscle toning belt on its website, in its advertising and on its invoices. The companies that it supplies these items to such as Argos, Empire Stores etc all place the item in the gym equipment/electrical sections of their catalogues not in the clothing sections. Mr Caddy confirmed that there is no evidence of the item being sold without the electric toning pads, wires or control device ie as a strip of fabric. Nor is there any evidence of the item being sold in clothing boutiques or other retail outlets as an item of clothing. Whilst I accept that the item that the proprietor has used its mark on is made of cloth and goes round one's waist I do not believe that it can be described as a belt in the clothing sense despite the contention that it meets the dictionary definition. The item is clearly marketed and sold as a muscle toning device complete with electric pads and a control device to send electric impulses to stimulate muscles. It is never sold without the electronic apparatus. The proprietor sought to rely upon the fact that they use different fabrics such as zebra or leopard prints, and contended that this made it a fashion item. Almost without exception items sold to the general public will be stylised to one degree or another. I doubt whether any manufacturer sets out to make a deliberately ugly item. Even mundane items such as fridges, mixers and kettles are designed to appeal to the eye. Whether the proprietor's goods are aesthetically pleasing or fashionable is a moot point, these things being in the eye of the beholder. But even if some were inclined to regard them as such it does not alter the fact that they are fundamentally muscle toning devices, which for ease of use and convenience are placed inside a fabric belt.

23) The registered proprietor has, in my opinion, failed to provide any evidence that the mark in suit, AB BELT, has been used on clothing in either the Section 46(1)(a) or (b) period. The mark will therefore be revoked in full as of 9 March 2007.

24) As the applicant has been successful it is entitled to a contribution towards costs. Mr Ramage sought costs at the top end of the registry scale due to the additional

evidence filed by the registered proprietor which required evidence in reply. To my mind such matters are part and parcel of any action before the Registry. I order the registered proprietor to pay the applicant proprietor the sum of £1,600. This sum to 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 29<sup>th</sup> day of September 2009**

**George W Salthouse  
For the Registrar,  
the Comptroller-General**