

TRADE MARKS ACT 1994

IN THE MATTER OF Application

Nos 1577271 & 1577275 by

**5 Roho, Inc. to register two trade
marks in Class 10.**

BACKGROUND

10

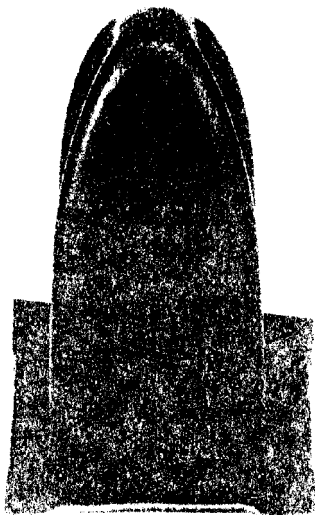
On 5 July 1994, Roho Inc., applied under the Trade Marks Act 1938 for the registration of two trade marks in Class 10 of the register. The trade mark applications were given the numbers 1577271 and 1577275. Application no. 1577275 consists of the shape of a piece of medical apparatus. Application no. 1577271 consists of the shape of a component part of the same piece of medical apparatus. The respective marks are reproduced below.

15

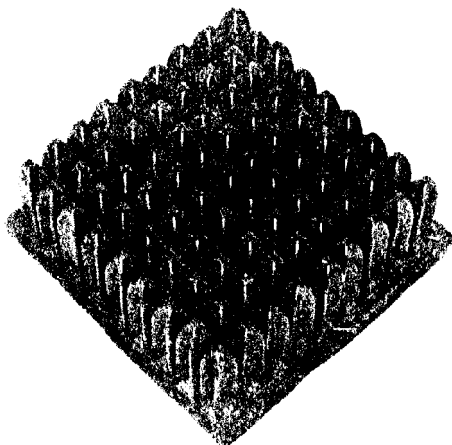
1577271

1577275

20



25



30

The specification of goods is in each case as follows:

Surgical and medical apparatus and instruments; cushions and mattresses for surgical, medical and curative purposes; childbirth mattresses.

5

As a result of objections taken by the Registrar, the applicants decided to convert the applications under the transitional provisions set out in Schedule 3 to the Trade Marks Act 1994. The result of this is that the applications now stand with a filing date of 31 October 1994 and fall to be determined under the provisions of the Trade Marks Act 1994. Thus all further references to provisions of the Act are references to the 1994 Act.

10

I record here that application number 1577271 claims priority under the Paris Convention based upon an earlier filing in Germany on 24 June 1994. Application no. 1577275 also claims priority on the basis of an earlier filing in Germany, this time with effect from 5 July 1994. However, nothing appears to turn on these priority dates.

15

Following a hearing which took place on 6 July 1998, at which the applicants were represented by Mr Guy Tritton of Counsel, instructed by J.A. Kemp & Co, I maintained that the objections that had been raised by the examiner under Sections 3(1)(a), 3(1)(b) and 3(2)(b) of the Act and the application was refused. I now state my reasons for this decision.

20

I shall first of all deal with application number 1577275. The sign applied for has been the subject of other proceedings. Mr Tritton advised me at the hearing that the design of the applicants' goods has previously been the subject of other statutory intellectual property rights. I understand that it has previously been the protected under a patent and design right. In this connection I understand that there are licence of right proceedings underway at the moment. Additionally, the applicants' United Kingdom distributors sued another party who proposed to sell a product of similar appearance in the United Kingdom for passing off. This action before Jacob J. was unsuccessful - see FSR [1995] pages 169 - 183.

25

30

I find it convenient to deal with the objection under Section 3(2)(b) first. Section 3(2)(b) of the

Act is in the following terms:

A sign shall not be registered as a trade mark if it consists exclusively of -

5 (b) the shape of goods which is necessary to obtain a technical result

SECTION 3(2)

10 The applicants filed a Statutory Declaration dated 27 September 1995 by Raymond Hodgkinson, who is the Chief Executive of Raymar, who act as the applicants' exclusive distributor in the United Kingdom. Mr Hodgkinson states that the sign applied for has been in use in the United Kingdom since 1978. The evidence confirms what one might expect from the appearance of the goods, which is that the shape is functional. The following extracts are from a promotional
15 booklet contained within exhibit RH/2 to Mr Hodgkinson's declaration.

"The ROHO dry floatation system of air inflatable wheelchair cushions and mattresses has been researched and developed with the objective of providing a fully flexible and adjustable device for effective prevention and treatment of pressure sores.

20

ROHO cushions and mattresses provide optimum pressure distribution. They conform to the body's natural contours creating a uniform distribution of pressure over the body contact area.

25

The ROHO System helps prevent tissue deformation because even pressures reduce distortion of the skin and allow blood to maintain its flow through the tiny capillaries that are located under the skin. Blood brings with it the nutritional products that the cells need to maintain tissue health and permit healing of a pressure sore. The ROHO System is constructed of flexible, interconnecting cells."

30

“Increased Sitting Times

5 *With even pressure distribution ROHO cushions allow people to sit for longer periods of time. Research in the UK has shown that ROHO cushion users sit for an average of nearly 12 hours each day and many sit for up to 18 hours without skin problems. (L. Cheshire 1987)”*

In the passing-off proceedings mentioned above, Jacob J. described the applicants’ goods in the following terms:

10

“It is an odd looking device - a number of witnesses called it ugly. It is clearly striking to the eye and memorable. It has a more or less square black rubber base, upon which sit a rectangular array of inflatable rubber cells. The cells are all identical and are each square in cross-section at their base. Each square is closely adjacent to the others. 15 When inflated the cells are close enough to provide each other with some sideways support when the weight of the user is applied. The cells have four ‘fins’, i.e. portions where the four sides meet. The fins rise from the corners and meet in a cruciform at the top of the cell. Between the fins the cell walls bow inwards when the cell is uninflated.”

20

“Functionally the cushion works thus: the base contains pipework through which the cells can be inflated. The cells are connected to each other through the base (which is a sandwich of rubber). Thus when a posterior exerts pressure on the cushion the cells adjust to accommodate the shape. In practice the user is placed on the cushion when it 25 is fully inflated and a skilled and trained health-care professional then releases pressure through a valve. The posterior is accommodated by some of the cells sinking more than others. The carer endeavours to set the cushion so that there is even pressure over all of it. Moreover there is maximum surface contact so that pressure on the posterior is as low as it can be. The effect is said to be “air floatation” - the user is, as far as possible, 30 sitting on compressed air.”

30

I do not think that the applicants really dispute that the shape applied for is functional. However,

they contend that the sign does not consist “exclusively of a shape which is necessary to obtain a technical result.” The applicants point out that a number of other shapes could achieve the same result.

5 The current state of the law as regards Section 3(2) of the Act is set out in the decision of Jacob J. in Philips Electronic NV v Remington Consumer Products [1998] RPC page 283. Following the implementation of EC Directive 104/89 the trade mark law throughout the EU is the same. Jacob J. endorsed the approach taken by Judge Goran Nilsson, who expressed a minority view when the Swedish Court of Appeal considered a similar matter in a Swedish case relating to the
10 shape of the same three headed razor. Philips was also a party to those proceedings. The relevant part of Judge Nilsson’s opinion is as follows:

15 *“If the shape of a product is not exclusively motivated by its function and thus the existing non-functional design elements do have distinctiveness, Section 13(2) of the Trade Marks Act, according to its wording, would not be a hindrance for registration. According to one model of interpretation, this provision relates only to such technical result which is expected to be reached with the shape to the extent that there is no obstacle for registration when an equal result can be obtained with another shape. Such an interpretation will mean that an exclusively functional shape would be covered by the
20 hindrance when the shape cannot be varied in order to obtain a certain technical result. Another conceivable way to interpret the provision would be to make a total analysis of the elements of the shape of the product and consider whether these are caused by purely technical reasons in relation to the result which is desired. Only if that is the case would there be a hindrance against registration. Where there are several possibilities to obtain a technical result of equal value, but the right to manufacture a product which is advantageous from a manufacturing point of view, is exclusively granted to one manufacturer by way of a trade mark right, the first model of interpretation would grant an exclusive right under the protection of trade mark law for technical solutions which could not be obtained by other means. Moreover, that model would lead to arbitrary and
25 complicated assessments in the registration procedure. For these reasons the provision should be interpreted to be a hindrance to registration of trade marks, the shape of which are solely motivated by the technical result. Then a product which has a shape, which
30*

is solely motivated by function will - even if there are alternative means to reach the same technical result - be excluded from protection as a trade mark. This interpretation does not open the possibility for obtaining trade mark protection for products which have a shape which is solely dictated by function.”

5

Jacob J. generally agreed with this approach, but stated that:

“I have some minor qualification of Judge Nilsson’s interpretation - “Shape which is solely motivated by the technical result”. The difficulty is the word “motivated”. That suggests the question is subjective, thus involving an enquiry to the designer’s purpose. That cannot be right, and I do not think Judge Nilsson meant the test to be subjective. So I would pose the enquiry thus: in substance does the shape solely achieve a technical result? I have added the qualification “in substance” because I do not believe that shapes with trivial embellishments or variants are outside exclusion for registrability.”

10

15

I think it is clear from this that the applicants cannot avoid refusal of their application purely on the basis that there are other shapes available from which the same technical result could be obtained.

20

The applicants also filed expert evidence in support of their application. This takes the form of a Statutory Declaration dated 25 October 1996 by Christopher Bar, who is a senior examiner for the National Institute of Physical Sciences in Medicine. Mr Bar says that he is also the Director of an MSC course called “Rehabilitation Technology” based in the Welsh National School of Medicine and has been a tutor for individual students studying for MSc and PhD through the Welsh National School of Medicine. Mr Bar further states that he has a BEng(Hons) in physics and electronics, and MSc in Management and Technology and a PhD in the field of tissue biomechanics. Mr Bar states that he is familiar with the applicants’ products and that, until recently, there was nothing else like this commercially available. He states that the appearance of the applicants’ products is distinctive of ROHO cushions which incorporate the Dry Flotation technology of ROHO, Inc.

25

30

Mr Bar further says:

5 *“Flotation cushions use membranes or containers which are filled with either air or liquid. The ROHO cushion is an air filled floatation cushion comprising vertical cells. Each of these cells is in effect a vertical air column and the individual cells are interconnected to the surroundings cells through narrow passageways which allow the air to move between the cells in a controlled manner. As a result, air is contained within the cushion but is able to circulate freely between the cells so that a natural process of pressure equalisation occurs between the columns of air, or cells, when they are under*
10 *load. The aggregate effect of these interconnected cells enables the cushion to act as a fluid and to synthesize floatation allowing the individual to be “immersed” into the cushion. The ability of the cells to move air between cells also enables the cushion to adjust over time to accommodate changes in posture or shape of the user. The ROHO cushion can be adjusted, if necessary, to allow the surface to be customised to each*
15 *individual user’s body weight and shape by an increase of air volume within, or release of air from, the cells through a valve positioned at a conventional point on one of the sides of the cushion.*

20 *In particular, the shape and design of the four finned cushion is clearly not designed for aesthetic reasons and is not necessary to achieve the desired clinical effect. The use of finned air chambers is a design feature that relates to the mechanical mechanism whereby the cells or deform somewhat on being loaded, but the four finned cells are not necessary for this action. Deformation of the cells under load could be achieved through a number of other constructions such as piston or bellow type designs and even if finned*
25 *cells are the selected method, there is no reason, mechanically why a different number of fins would not function as well. The ROHO cushion previously used seven finned chambers. Empirically, no change in function was detected as a result of this change in terms of pressure sore prevention in clinical practice.*

30 *In my opinion, any number of fins from three or more could provide the appropriate level of mechanical function. Similarly, as stated above an alternative design approach could*

be the use of air bellows instead of finned air chambers. These will provide the same function of a deforming air pillar. Thus, Talley uses a bellows design with success.”

5 In support of the contention that the shape of the applicants’ goods does not “in substance solely achieve a technical result”, Mr Tritton referred me to a registered design case - Cow (PB) & Coy. Ltd v Cannon Rubber Manufacturers Ltd (1959 RPC 347). In that case the Court of Appeal decided that the defendant had not shown that the diagonal ribbing on the Plaintiff’s hot water bottles was dictated solely by function. On my reading of the case this was because 1) the direction of the ribbing was found to be arbitrary 2) the Court found that the design had eye
10 appeal, and 3) the defendants had not discharged the onus that was upon them to show that the design was invalid. Mr Tritton argued that this case supported the applicants’ position, and he referred me to the evidence of Mr Bar which indicated that, inter alia, this type of cellular cushion did not have to have four fins per cell to obtain the desired technical result.

15 In the Philips v Remington case referred to above, Jacob J. also referred to a registered design case, Amp v Utilux (a later case before the House of Lords - 1972 RPC page 109) when considering the meaning of Section 3(2). However, it appears to me that Jacob J. mentioned this case merely to illustrate that his point - provisions of an Act (or Directive) must have been intended to have a reasonable degree of application - had arisen before. He clearly did not intend
20 to directly import case law under the Registered Design Act as a suitable means of deciding the meaning of provisions in the Trade Marks Act 1994 which (coming from a European Directive) has a completely different origin and purpose.

Mr Tritton was constrained to accept that there was little likelihood that anyone would place any
25 importance on the direction of the ribbing on a hot water bottle for the purposes of determining trade origin. Likewise, as Mr Tritton was also constrained to accept that, it is unlikely that the average purchaser would discriminate between the number of fins on this type of vertical cellular cushion for the purposes of identifying trade origin. It appears to me that the number of fins in the cell structure of the type of goods produced by the applicants are the sort of “trivial variation”
30 which Jacob J. indicated would make no difference to the exclusion from registrability under Section 3(2) of the Act. Moreover, I do not believe that because a different number of fins per

cell could obtain the same technical result it can be said that a four finned cellular structure cannot be regarded as solely obtaining a technical result. Mr Bar states in his evidence that, to be effective, this type of cellular product needs to contain three or more fins per cell. If there is no advantage in having more than three fins per cell, it seems very likely that the larger the number of fins in excess of three, the more the design would depart from the usual manufacturing preference of keeping designs as simple as possible consistent with efficient performance. I conclude that the four finned cells of the applicants' goods solely obtain a technical result.

For the reasons I have already given, the fact that there are at least two alternative designs which could achieve the same technical result does not assist the applicants. I cannot see anything else in Mr Bar's evidence which could assist the applicants' case under Section 3(2)(b). At the hearing, I understood Mr Tritton to suggest that the overall appearance of the goods was not necessary to obtain a technical result because there was an arbitrary element about the manner in which the individual vertical air cells were arranged. I cannot see any substance in this submission. Mr Tritton had to accept that joining the vertical air cells together in a way reminiscent of conventional "tiling" was likely to be the most convenient method of assembly where the desired overall shape is either square or rectangular - as most cushions and mattresses are. I conclude that all the individual elements of the shape and their arrangement are solely to obtain a technical result. The sign is therefore excluded from registration by Section 3(2)(b).

A sign which is excluded from registration by Section 3(2)(b) of the Act cannot escape refusal on the grounds that it has nevertheless acquired a distinctive character in fact. Strictly speaking therefore, the other grounds of refusal are not relevant. However, in case I am found to be wrong in my primary finding, and for the sake of completeness, I will go on and give my reasons for refusal under Section 3(1) of the Act.

SECTION 3(1)

I find it convenient to consider next the objection under Section 3(1)(b). This is as follows:

The following shall not be registered -

trade marks which are devoid of any distinctive character

Jacob J. has also provided some guidance on the meaning of Section 3(1)(b). In *British Sugar Plc v James Robertson and Sons Limited* (TREAT) 1996 RPC.281, he asked rhetorically -

5

“What does devoid of any distinctive character mean?”

To which his answer was -

10

“I think the phrase required consideration of the mark on its own assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark?”

In *Philips v Remington*, Jacob J. added to this in the following terms:

15

“What I have said about word marks is true also of picture marks. They may be more or less descriptive. A picture of an article is equivalent to a description of it - both can convey information. If the picture is simply of an artifact which traders might legitimately wish to manufacture then to my mind it is just like the common word for it and, like the word for it, incapable of distinguishing.

20

Mr Pumfrey also argued that it was not right to import the sort of considerations contained in article 3.1(e) i.e. shape “resulting from nature”, “necessary to obtain a technical result” or giving “substantial value”, into the requirement of capability of distinguishing and not being devoid of distinctive character. They are separate objections he said. I do not think necessarily so. I can see nothing in the Directive which suggests that the various grounds of objection to validity may not overlap.”

25

It appears to me that precisely the same considerations apply where the trade mark in question is the shape of the goods rather than merely a picture of them. I have already found that the shape in question consists exclusively of functional features. Where a shape consists exclusively

30

offunctional features it seems to me to follow that other traders will (leaving aside other intellectual property rights which have no bearing on the matter) have a legitimate reason to wish to make their own goods in a like shape. A purely functional shape is not going to be seen by the public as an indication of origin without a considerable amount of education. I conclude that, *prima facie*, the applicants' mark is excluded from registration by Section 3(1)(b) of the Act.

10

However, that is not the end of the matter because the applicants claim that the mark has acquired a distinctive character as a result of the use made of it. They contend that the application should succeed under the proviso to Section 3(1) of the Act. The proviso is in the following terms:

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.

15

It is apparent from this that the matter must be judged as at the date of application - 31 October 1994. I propose to consider the application of the proviso together with the provisions of Section 3(1)(a) of the Act, which is as follows:

The following shall not be registered -

20

Signs which do not satisfy the requirements of Section 1(1).

Section 1(1) of the Act is as follows:

25

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

30

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

It appears to me that if the applicants' contention is right - their mark has in fact acquired a

distinctive character as a trade mark - then it cannot, by definition, be incapable of distinguishing. With this observation in mind I now turn to the applicants' evidence.

As I indicated earlier, the applicants filed a Statutory Declaration dated 27 September 1995 by
5 Raymond Hodgkinson which states that the mark has been in use in the United Kingdom since
1978. Mr Hodgkinson states that the mark has been used continuously since that time in respect
of "Cushions and mattresses for surgical, medical and curative purposes". The number of units
sold has risen steadily from 30 in 1978 to 6,500 in 1992. Unit sales for 1993 and 1994 are not
provided, but it is clear from the annual turnover figures, which are provided, that the number of
10 units sold in those years must also have been in excess of 6,000. Mr Hodgkinson also provides
details of the applicants promotion of goods under the mark. From the information he provides
it appears that between 1988 and 1994 the applicants spent, on average, around £30,000 per
annum promoting goods under the mark. In the year ending March 1995 (half of which is, of
course, after the date of this application) advertising expenditure increased to around £63,000.
15 Mr Hodgkinson provides details of the various publications in which the mark is promoted. Not
surprisingly these are all aimed at health care professionals of one sort or another. Exhibits RH-2,
RH-4 and RH-5 to Mr Hodgkinson's declaration consist of copies of various promotional leaflets
and advertisements featuring the applicants' goods. It is clear from this material, and from Exhibit
RH-5A to a further declaration from Mr Hodgkinson dated 7 August 1996, that the applicants
20 do not rely upon the shape of their goods alone to distinguish their products: they always use the
word mark ROHO. Although the word ROHO is not obviously visible on the goods themselves,
the mark does appear very prominently on the packaging of the goods and also on the
promotional material and advertisements.

25 At the hearing, Mr Tritton sought to distinguish the applicants' use from the use of the Phillips
3-headed razor, which Jacob J. characterised as "at best a limping trade mark", because it had
always needed the "crutch" of the word mark Philishave in use in order to be able to do the job of
distinguishing. Mr Tritton emphasised that, in this case, the applicants' word mark ROHO does
not appear prominently on the goods themselves. There is in fact some evidence, which I will
30 come to later, that the applicants' mark appears in small script on the underside of the goods.
However, I accept that the applicants' word mark does not appear prominently on the goods in

the way that Philips did on the plaintiff's goods in the Philips v Remington case. However, given that the evidence shows that the goods are always sold in cardboard boxes, and that the applicants' word mark appears very prominently on those boxes and in promotional material and advertisements for the goods in question, I do not think that too much can be made of this point.

5 In the passing off action referred to above Jacob J. dealt with the proposition that the shape of the applicant's goods had become a badge of origin as a result of use in the following terms:

10 *“Mr Morcom pressed me with a proposition based on length of use. He suggested that where a particular trader had been the sole source of the product recognised by its appearance by users for a sufficient time, that recognition somehow turned into a relevant reputation: that it should be assumed that consumers had come to want the product not only for its functional or visual qualities but because they wanted the product from that particular trade origin and none other. Length (and extent) of use is obviously relevant to establishing recognition by the product. But it can never be enough on its own to establish what might be called “brand loyalty” for the shape of the product itself.”*

15

Before me, Mr Tritton conceded that the applicants' case could not succeed based upon the length and extent of use alone. He relied also on the evidence of seven trade witnesses to establish what Jacob J. termed “brand loyalty”; which I take to mean recognition as a trade mark. This evidence takes the form of seven Statutory Declarations by Anthony David Harman, Katharine Anna Fox, Elizabeth C Rogers, Lone Rose, Susan Hilsdon, June Sutherland and Norma Haynes. The first five declarations are dated in August of 1996. The last two are dated August and September 1997, respectively.

20

25 Mr Harman says he is a Special Seating Consultant and has worked in that capacity within the National Health Service and various other companies for many years. He states that he has known of the ROHO cushion for 15 - 18 years. He believes that the ‘nodules’ are characteristic of this cushion and very distinctive. Until recently, he says, there was nothing at all similar on the market.

30

Ms Fox states that she is a Chartered Physiotherapist and has, for the past 22 years, worked with people with physical disability. She states that she has known of the ROHO cushion for the past six years and has used it on numerous occasions for patients with profound disabilities. She further states that she regards the appearance of the applicants' cushion as being distinctive of their goods.

Ms Rogers states that from 1971 until her retirement in 1990 she was a Senior Nurse Manager at the National Spinal Injury Centre at Stoke Mandeville Hospital. She states that she has been aware of the applicants' cushions since they were put on the market in 1978 or 1979 by Raymar. Ms Rogers describes the appearance of the applicants' cushions as "an inflatable egg box". She further states that over the last 2 or 3 years some other cushions have appeared on the market which look similar to the ROHO cushion, but nevertheless she regards the appearance of the ROHO cushion as distinctive.

Ms Rose describes herself as a Danish Chartered Physiotherapist and a member of the Chartered Society of Physiotherapist and a State Registered Physiotherapist. Since 1977 she has worked in the physiotherapy department of Stoke Mandeville Hospital. She states that she has been aware of a cushion having the appearance of the applicants' goods since the early 1980's. She further states that until quite recently when a substantially identical cushion came on the market the applicants' cushion was the only cushion having an appearance entirely different from other cushions on the market. She says this was due to its individual "cell" appearance.

Ms Hilsdon states that she has been a Senior Occupational Therapist with the Milton Keynes Wheelchair Service for the past 4 years. Before that she held a similar position in Maidenhead. She states that in 1987, she carried out some work on behalf of the Department of Health in evaluating wheelchair cushions. Ms Hilsdon further states that she has been familiar with the appearance of the applicants' cushions for the past 13 or 14 years. In her opinion it has a very distinctive profile. Ms Hilsdon further states that she is aware that a competitor has recently entered the market. However she says, if she were to be shown a black and white photograph of such a cushion she would have no doubt in saying that it was a ROHO cushion, or likely to beso.

Ms Sutherland is the Head Occupational Therapist at the Chelsea and Westminster Hospital in London. She states that she is familiar with all the different types of pressure sore cushions on the market, including the ROHO cushion. She explains that she has been asked how she identifies a ROHO cushion. She says that she identifies it because it has a unique design, although she is aware that very similar cushions have recently appeared on the market. She further states that she knows the trade mark ROHO appears on the underside of the cushion but she adds that this is not visible when the cushion is in use in hospitals, when they are normally stacked up on cupboards and on shelves. She notes that the packaging in which the cushions come is frequently discarded to save space.

10

Ms Haynes is a Registered Mental Nurse and a Registered General Nurse who is currently employed by a private company managing a Nursing Home. Ms Haynes states that she knows of the ROHO cushion by its appearance. She describes it as a black, rubber, 'bobbly' looking cushion. She makes a similar observation to that made by Ms Sutherland as regards the appearance of the trade mark ROHO on the underside of the applicants' goods and its significance. She further states that during her period as a Nurse Manager she was responsible for ordering cushions for ward use. She states that she always ordered them as ROHO cushions, defining the size of the cushion that was needed.

15

At the hearing, Mr Tritton confirmed that the evidence referred to above was not collected as part of a survey. The persons giving evidence were sought out to support the applicants' case. But even making allowance for this, it appears to me that the evidence establishes that there is a significant degree of recognition of the shape of the applicants' goods on the market, and there was a wide degree of "association" between cushions of this shape and the applicants at the relevant date. The evidence also appears to confirm that the applicants' goods are recognised by their cellular or 'bobbly' appearance. There is no suggestion that the number of fins per cell plays any part in the recognition of the shape. The evidence also suggests that by August 1996 there was a degree of realisation amongst the relevant public that a competing product had entered the market with a very similar appearance to that of the applicants' goods. Indeed, Ms Rogers states that she had been aware of such a competing product for the past 2 or 3 years. This ties in with the information given to me at the hearing, which is that the competing FLOTAIR product

25

30

entered the market shortly after the unsuccessful passing off proceedings in July 1994, and would therefore almost certainly have been commercially available before the relevant date in these proceedings (31 October 1994). This is no doubt why Ms Hilsden states that the representation of the applicants' goods which was shown to her was a ROHO cushion *or likely to be so*.

5

I also note that although Ms Sutherland and Ms Haynes appear to go out of their way to say that they do not rely upon the word mark ROHO appearing on the underside of the applicants' cushions in determining the origin of such cushions, Ms Haynes also states that when she was responsible for ordering such cushions, she always ordered them as "ROHO cushions".

10

All of this suggests to me that:

1. There is a wide degree of "association" between the shape of the applicants' goods and the applicants:

15

2. This "association" was likely to have been somewhat weakened by the relevant date in these proceedings because of the launch of a substantially identical looking product by FLOTAIR:

20

3. The applicants' goods are ordered by reference to the word mark ROHO.

Given that a rival product of substantially identical appearance legitimately entered the market before 31 October 1994, there must be some doubt about whether the shape of the applicants' goods can be said to have been truly distinctive of them at that date. However, leaving such considerations aside, I am not persuaded that the "association" between the shape of the goods in question and the applicants as the makers of those goods can truly be said to amount to recognition as a trade mark.

25

As Hoffman J. said in Unilever Limited's (striped toothpaste No. 2) trade marks 1987 RPC page 19:

30

5 “There are many cases which speak of the extreme difficulty which faces a trader who produces a new article to which he attaches a descriptive name. In proving that the name has acquired a secondary meaning denoting an article made by him. As Lord Davey said in *Cellular Clothing Co Limited v Maxton & Murray* 1899 AC 326 at page 344:

10 “..... the evidence of persons who come forward and say that the name in question suggest to their minds and is associated by them with the Plaintiff’s goods alone is of a very slender character, for the simple reason that the Plaintiff was the only maker of the goods during the time that his monopoly lasted, and therefore there was nothing to compare it with.”

15 *There is in my view a similar obstacle in the path of a trader who has enjoyed a de facto monopoly of a product with a relatively simple feature chosen not as a badge of origin but on the grounds that it was likely to appeal to the public. The fact that members of the public now associate that feature with his product tells one nothing about what they would think if a product with a similar feature came upon the market.”*

20 I do not consider that the “association” which exists between the shape of the goods and the applicants goes beyond the degree of association which is inevitable when for many years there has only been one manufacturer of a particular type of product. In my view the shape of the applicants’ goods serves primarily to distinguish one *type* of medical cushion and mattresses from other types of medical cushions and mattresses.

25 At the hearing, Mr Tritton argued that the evidence contained in a third Statutory Declaration by Raymond Hodgkinson dated the 29 October 1996, contradicted the view expressed above and showed that the shape of the applicants’ goods was indeed acting as a badge of origin. The evidence in question consists of copies of three notes sent to Raymar, the applicants’ UK distributors, by persons asking for the repair of FLOTAIR cushions. Mr Tritton contended that
30 this was evidence of origin confusion which could only have come about if the shape of the applicants’ goods was regarded by those concerned as a badge of origin. The first note is from

the Matron of St Wilfred's Hospice in Eastbourne. It is really no more than a compliment slip upon which is written:

"To Roho

5

For repair and return please.

Matron."

10 Mr Hodgkinson exhibits a letter of response dated 23 February 1996 which states that the cushion sent to Raymar was not a ROHO but a FLOTAIR cushion. Similar evidence was given in the passing off proceedings referred to earlier. Jacob J. dealt with this evidence as follows:

15 *"I was invited to assume that whoever sent the products for repair thought that Orto's were made by ROHO, this I declined to do. There is simply not enough evidence to go on. I think it most unlikely that the person actually sending the cushion was anything other than a clerk or the like. I have no reason to suppose that any serious consideration of the maker of the cushion arose. It may well be that the senders thought ROHO could repair the cushion even though it was of a different make even though it was of a*
20 *different make. Indeed, in one of the cases ORTO have gone off the market and Raymar were probably the only people who might be able to effect repair."*

The second note attached to Mr Hodgkinson's declaration appears to be in this category. It is from the Community Health Services NHS Trust South Derbyshire. It is also in the nature of a
25 compliment slip. It is addressed to Raymar and refers to "four ROHOs and one FLOTAIR." The note is in the following terms:

"Leaking etc. Please examine and info how many can be repaired."

30 However, the third note cannot be said to be a request to Raymar to repair another suppliers equivalent cushions. It is from the Wheelchair User Services of Greenwich District Hospital.

This note is also addressed to Raymar. It is in the following terms:

“Please advise if this ROHO can be repaired.

5 *Thanks. Jan Dias”*

Raymar’s response is also included within Exhibit RH-6 to Mr Hodgkinson’s third Declaration. It points out that the cushion sent for repair was a FLOTAIR cushion and not a ROHO, as Ms Dias apparently thought. I do not think that this evidence is sufficient to disturb the view I have expressed above. It is clear from the evidence before me (and it is also obvious) that the persons who are responsible for ordering such products in the National Health Service are not necessarily the same people who return goods for repair. There is absolutely no evidence that the shape of the applicants’ goods is relied upon to distinguish the applicants’ goods during the process of selection and order. Bearing that in mind and also taking into account that the evidence shows that::

10

15

1. the goods are frequently stored apart from their original packaging;
2. the applicants’ word mark is not very prominent upon the product itself;
3. a rival product has only come on to the market relatively recently and it is therefore likely that some users of this type of product may still not be aware of the existence of more than one manufacturer (particularly those users who are not responsible for making the initial selection of such products);

20

25

- it appears to me that the confusion evident in Jan Dias’ note to Raymar, is likely to be no more than what one would expect in the immediate aftermath of the applicants’ long period of statutory monopoly in products bearing the shape in question.

30 I conclude that, at the relevant date, the shape of the applicants’ goods had not acquired a distinctive character *as a trade mark*. The sign applied for does not therefore qualify for

registration under the proviso of Section 3(1). That being the case, the sign applied for is excluded from registration by Section 3(1)(b).

5 Finally, I turn to the question of whether the sign applied for is excluded from registration by Section 3(1)(a) of the Act. In the Philips v Remington case referred to above, Jacob J. said:

10 *“Some matters are basic to any rational law of trade marks. I believe this case involves such a problem, involving as it does the question of the extent to which trade mark law, conferring a perpetual monopoly, can interfere with the freedom within the European Union of manufacturers to make an artefact of desirable and good engineering design.*

15 *With that sort of consideration in mind I turn to the Directive. Recital 7(b) emphasises that capability of distinguishing is a fundamental requirement of the sort of sign which can be registered. I do not think one can disregard this. It is, in my opinion, important that a capacity to distinguish is put forward as a limitation, at this very early stage. I further think it is significant to note that Recital 10(a) places particular importance on the purpose of the trade mark - to guarantee trade origin. If that is what trade marks are for, then a sign which can never fully do that is not, in my judgement, to be regarded as capable of distinguishing.*

20 *I think that is the case here. Philips can never get away from the fact that the sign primarily denotes function. More use could not make any difference. The sign can never only denote shavers made by Philips and no-one else because it primarily says “Here is a three headed rotary shaver”. It is not capable of denoting only Philips goods.”*

25 In my view, similar considerations apply here. The shape of the applicants’ goods primarily says “Here is a cushion (or mattress) composed of vertical air cells.” Without the benefit of another statutory monopoly protecting the design of the product, it is not capable of denoting only the goods of ROHO, Inc. I conclude that the sign applied for is also excluded from registration by
30 Section 3(1)(a) of the Act.

Application no. 1577275 is therefore refused under Section 37(4) of the Act because it is excluded from registration by Sections 3(1)(a), 3(1)(b) and 3(2)(b) of the Act.

I now turn to consider application no. 1577271, which is the shape of a single vertical air cell.

5 It could be argued that the case for refusal under Section 3(2)(b) is somewhat less strong in relation to this mark because the number of fins per cell is more noticeable when one considers the shape of a single vertical air cell and may therefore be said to be less of a “trivial variation.” However, for the reasons I gave earlier, I do not consider that the use of four fins per vertical air cell can be regarded as being for any purpose other than “solely obtaining a technical result.” I
10 therefore find that this mark is also excluded from registration by Section 3(2)(b). The case for registration under Section 3(1) of the Act appears to be even weaker than the case for application no. 1577275. There is no evidence of any use of the shape of a single vertical air cell which could even arguably be said to have given a single cell of the applicants’ goods a trade mark character. Moreover, on the evidence it appears extremely unlikely that a single vertical air cell could ever
15 be used alone and there is, if anything, an even stronger case for saying that the shape of such a cell is incapable of acquiring a trade mark character. I conclude that application no. 1577271 is also excluded from registration by Sections 3(1)(a), 3(1)(b) and 3(2)(b) of the Act. This application is therefore also refused under Section 37(4) of the Act.

20 **Dated this 18 Day of August 1998**

Allan James

25 **For the Registrar**

The Comptroller General