

**TRADE MARKS ACT 1994**

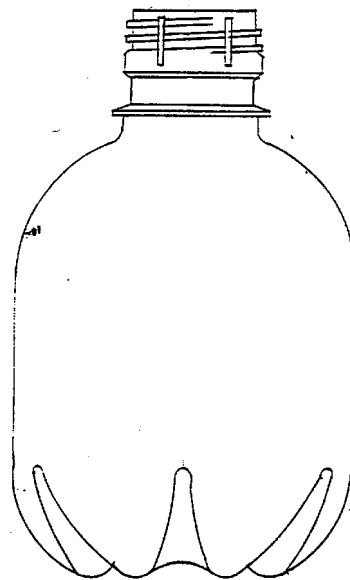
**IN THE MATTER OF  
APPLICATION NO. 2012542 BY  
SM JALEEL & COMPANY LIMITED  
TO REGISTER A TRADE MARK IN CLASS 32**

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**DECISION AND GROUNDS OF DECISION**

10 On 27 February 1995, SM Jaleel and Company Limited of Otaheite Industrial Estate, South  
Oropouche, San Fernando, Trinidad, West Indies, applied under the Trade Marks Act 1994 to  
register the following as a trade mark in Class 32 for “non-alcoholic beverages and preparations  
15 for making such beverages; fruit flavoured carbonated drinks; all included in Class 32; fruit juices  
for use as beverages”.



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40 The mark was further described at Box 3 of the application form (TM3) as - “ ”Six Fingered  
Petaloid base” 3-dimensional mark “ and is, therefore, an application for the shape of a bottle as  
shown above.

45 Objection was taken under Section 3(1)(b) of the Act on the grounds that the mark was devoid  
of any distinctive character and under Section 3(1)(c) on the grounds that it consists exclusively  
of a sign which might serve, in trade, to designate the kind of goods to be sold under it.

The matter came before me at a hearing at which the applicants were represented by

Mr D B Lutkin of Mathys & Squire, their trade mark agents. I maintained the objections and following refusal of the application under Section 37(4) of the Act I am now asked under Section 76 of the Act and Rule 56(2) of the Trade Mark Rules 1994 to state in writing the grounds of decision and the materials used in arriving at it.

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A period of time was allowed after the hearing for the applicants to file any evidence of use in support of their application. However, none was received. I have, therefore, only the prima facie case to consider.

10 Upon further reflection I consider that the objection under Section 3(1)(c) should be waived. Therefore, I will make no further reference to it in this decision.

Section 3(1)(b) of the Act bars registration of “trade marks which are devoid of any distinctive character”.

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The test of distinctiveness was laid down by Mr Justice Jacob in the TREAT case [1996] RPC 281 page 306 lines 2-5 when he said:

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

25 The mark consists entirely of the shape of the bottle which, it seems to me, is typical of soft drink containers made of PET (polyethelene terephthalate), having no markings or embellishments to help distinguish it in the market place. It was argued by the agent that the “Six Fingered Petaloid base” was novel. From my own knowledge and experience of such every day products I do not see anything novel in this element of the mark. At best it may be a slight variant on other such bottles but to my mind there is nothing memorable or distinctive about it. However, the agent  
30 argued, in particular, that the overall appearance was of a short “dumpy” or “chubby” bottle which gave it sufficient novelty so as to make it distinctive in the market place.

I am aware that such bottles come in many shapes and sizes, including “short” bottles. In support of their argument the agent filed a sworn statement from Mr Mitchell of PCI (PET Packaging, Resin & Recycling) Limited. In this statement they describe themselves as “the world’s leading consultancy for PET resin and packaging, not least PET bottles, in the United Kingdom.” The statement included various examples of such bottles, in particular their exhibit KM5 which I attach as Annex A of this decision. It can be seen that the applicant’s bottle is significantly shorter than the two bottles it is placed between. However, I consider that if placed alongside  
40 the bottles at each end (“Pepsi” and “Deep Spring”) there is not a significant difference. Furthermore, the application makes no claim as to size, only indicating the proportions of the bottle. Mr Mitchell, in his statement establishes his credentials as an authority on the subject and gives interesting background of a technical nature about PET bottles, in particular regarding the height/circumference ratio of such bottles, much of which is not of direct relevance to the matters  
45 under consideration. However, he goes on to say:-

“More recently the use of PET bottles for CSD has moved into the small bottle (500ml or less) sector.

5 Here for various reasons, the height to circumference ratio has tended to be on average 0.9:1, still making the bottles look relatively tall and thin. A search of our extensive library of past and current bottles suggests a range of bottle height to circumference ratios for small bottles exists from 1.0:1 to 0.75:1 as the total bottle size (including the height associated with common thread finish at the top of the bottle) but with the ratio reducing to 0.66:1 to 0.91:1 when only the body of the bottle is considered (as all bottles need the common thread finish/closure system). However, they still appear to be long and tall. 10 The so called Chubby bottle produced by Jaleel does have a distinctive shape insofar that it appears to be almost spherical and has a body (below the thread finish) height to circumference ratio of 0.52:1 - a considerably lower ratio than any other bottle in our library, or any other design for soft drink bottle known to us. Apart from this ratio, the main contributor to this impression of a round shape is the near hemispherical design of the bottle shoulder and the fact that the shoulder immediately goes into the neck ring/thread area. In all other bottles examined, there tends to be a discernable sloping shoulder and the so called “long neck” type design being used. 15

20 In the light of the above, I am asked to give my opinion as to the distinctiveness of the two bottle shapes under reference. Both have dome shaped shoulders and short necks which are common and non-distinctive features in themselves. Both have petaloid type feet. Although feet themselves are common and functional and are used by many other bottles, both sets in these cases seem to have been designed beyond mere functionality and with aesthetics in mind, such that they have been rounded at the edges and this adds to the visual hemispherical impression of the base area and the near spherical shape of the bottles overall. The combination of the two shoulder and base features when put together to produce a very distinctive near spherical visual impression for the bottle overall. The final feature of the two shapes is the height to circumference ratio of 30 0.52:1 for the bottle body only, which, I believe, is unique in this particular field. In fact, I can recall only having seen one similarly configured bottle - a 35 litre beer container made for the US market.

35 In my opinion the use of the combination of the feet into a near spherical overall bottle body shape and the extremely low ratio of bottle height-to-circumference renders both shapes unique and distinctive. Accordingly, it is my belief that the applicants should be permitted registration of both shapes as trade marks.”

40 (I should mention that the evidence refers to two bottle shapes as it was filed in support of both this and a similar application.)

While I must acknowledge Mr Mitchell’s apparent expertise in the field of PET bottles I do not consider that he can speak for how customers may perceive the mark applied for, nor does he

attempt to do so. There is no evidence before me as to whether the public would perceive the mark applied for as a badge of trade origin, nor is there any evidence that, even if the height to width ration is lower than other bottles, it is so different as to be memorable and therefore distinctive.

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The evidence filed in this case establishes that a trade expert considers the shape to be “unique and distinctive”. It does not, in my view, establish that he recognises the shape of the bottle as a trade mark for the goods nor can it establish that the relevant purchasing public would recognise the shape of the bottle, as a trade mark. As Jacob J stated in the previously mentioned British Sugar Plc v. James Robertson & Sons Ltd (TREAT trade mark), at page 304, lines 41 - 43.

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“Overall there is this further point, namely that recognition is not the same thing as perception as a trade mark - as not only recognising the word but as regarding it, in itself, as denoting the goods of one particular trader.”

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In my view, Jacob J’s comments apply equally to shape marks.

The mark at issue seems to me to be a plain bottle shape with no obvious characteristics to distinguish it in the market place from bottles of a similar, although not necessarily identical, shape. I do not say that the mark is unregistrable but in the absence of any evidence of recognition as a trade mark by the public or evidence of distinctiveness acquired through the use made of it I consider it would be inappropriate to grant a monopoly in this particular bottle shape.

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I conclude that the mark is debarred from registration under Section 3(1)(b) of the Act because it is devoid of any distinctive character.

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In this decision I have considered all the documents filed by the applicant and all the arguments submitted to me in relation to this application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it is debarred under the terms of Section 3(1)(b) of the Act.

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Dated this 10 day of November 1998

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**R A JONES**  
**For the Registrar**  
**the Comptroller General**

