

TRADE MARKS ACT 1994
IN THE MATTER OF Two Applications
to register the shape of a bottle as a
Trade Mark in Classes 29 and 32

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DECISION

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On 21 January 1994 Kabushiki Kaisha Yakult Honsha (Yakult) applied under the Trade Marks Act 1938 for the registration of the trade mark shown below in Classes 29 and 32. The applications were numbered 1560017 and 1560018.

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25 The mark consists of the three dimensional shape of the bottle depicted above.

The specification of Application No 1560017 is as follows:

30 “Jellies, jams; eggs, milk and other dairy products, including yoghurt and yoghurt preparations; edible oils and fats; preserves, pickles; and meat, fish, poultry and game preparations and extracts.”

The specification of Application No 1560018 in Class 32 is as follows:

“Non alcoholic drinks; syrups and other preparations for making beverages.”

5 On 28 April 1995 the applicant gave notice under Paragraph 11 of Schedule 3 of the Trade Marks Act 1994, in respect of both applications, claiming to have the registrability of the mark determined in accordance with the provisions of the new Act. The consequences of this are that the registrability of the trade mark must be determined under the provisions of the Trade Marks Act 1994 and (in accordance with Paragraph 11(3) of Schedule 3 to the Act) the application date
10 is deemed to be 31 October 1994.

The Registrar subsequently examined the applications under the provisions of the 1994 Act and, as a result, raised objection under Section 3(1)(a)(b) and (c) of the Act on the grounds that the mark consisted of the device of a non-distinctive bottle which was a sign that other traders may
15 legitimately wish to use in trade in relation to drinks. These objections were subsequently the subject of a hearing before the Registrar on 23 December 1996. The objections were maintained at that hearing.

The applicant subsequently filed evidence in an attempt to overcome the objections. The evidence
20 takes the form of a declaration by Yoshinori Kuroda, who is the Chief Executive of Yakult Europe B.V., a wholly owned subsidiary of Yakult. Mr Kuroda states that the mark which is the subject of the applications in suit was first used in the United Kingdom on 28 March 1994 when goods within containers of the shape depicted in the applications were shipped to a United Kingdom distributor. The goods in question consist of a non-alcoholic fermented milk drink
25 containing a beneficial lactic acid bacteria. Although these drinks are relatively new to the United Kingdom they have apparently been enjoyed by large numbers of people in other parts of the world for sometime.

Mr Kuroda provides approximate turnover figures in relation to the products mentioned above.
30 The figures provided indicate that approximately 600,000 bottles of the product were provided under the trade mark in the period April to October 1994. This equates to around £270,000

worth of goods. The evidence also indicates that in the period from November 1994 to the end of 1996, sales of products under the trade mark increased to over £3 million.

5 Mr Kuroda further states that prior to 31 October 1994 the applicant promoted its products by way of samplings and demonstrations in the London area. Promotional expenditure figures are provided which show that up until December 1994 the applicant had spent £146,000 in promoting its products in the United Kingdom. A similar figure was spent during the first 10 months of 1995. From November 1995 to December 1996 advertising expenditure increased substantially to nearly £2.5 million. Fermented milk drinks in bottles of the shape the subject of the trade mark applications have subsequently been sold throughout the United Kingdom. It is not clear whether 10 sales were made on a nationwide basis prior to the date of application (31 October 1994). The exhibits to Mr Kuroda's Declaration show that, in practice, the word mark YAKULT always appears prominently on the container shape in question.

15 The applicant subsequently commissioned a public survey to demonstrate the distinctiveness acquired by their trade mark. The survey is described in a Statutory Declaration dated 5 November 1997 by Sara Jane Leno, who is a Trade Mark Attorney employed by Forrester Ketley & Co. Ms Leno explains that a market survey was conducted between 25 and 29 June 1997. It was based on a representative sample of over 2,000 adults who were interviewed at 20 130 sampling points. The objective of the survey was to determine recognition of the bottle shape applied for partly by way of comparison between the level of recognition of that shape and that of a well known unbranded bottle shape. To that end Ms Leno explains that respondents were shown a Coca Cola bottle with the trade mark COCA COLA removed. The respondents were then shown the mark applied for and asked the following question:

25 "This is a product which you may or may not have seen before. It comes in a pack this shape and size, but of course it would have a name and description on it. Do you recognise this as a product that you have seen before?"

30 If respondents answered "yes", the interviewer went on to say:

“What brand or product is it?”

Once the unprompted questions had been completed, two prompted questions were asked, ie

5 “Have you seen or heard of this product before?”

and,

“Have you bought or tried YAKULT yourself?”.

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One of the initial conclusions of the survey report is that the Yakult product (and by extension the container shape applied for) is virtually unknown in the Midlands and North of England. Awareness was highest in the South East (which is where the applicant has made greatest efforts to promote the product and the mark). Thirty-eight per cent of those interviewed in the South
15 East were able to name the Yakult product by reference only to the shape of the container shown to them. Fifty-five per cent of those interviewed were aware of the Yakult product. By way of comparison, eighty seven per cent of respondents in the South East identified the unbranded Coca Cola bottle correctly.

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The applicant also points out that eighty one per cent of those surveyed in the South East indicated that they were not aware of any (or any other) other products on sale in the United Kingdom in a pack of this shape. Thirteen per cent indicated that they were aware of other products on sale in containers of this shape. Six per cent did not know. It is also claimed that eighty eight per cent of those surveyed (again in the South East) said they would recognise
25 the pack again if they saw it. It is not clear, however, exactly what questions were put to the respondents in order to ascertain their answers to the last two questions. Ms Leno concludes that the evidence shows that the shape applied for is 100 per cent distinctive in fact and she points out that since the launch in 1994, over 18.75 million bottles have been sold in the United Kingdom.

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The Registrar maintained the objections to the applications in the face of this additional evidence and the applicant asked to be heard again. A further hearing took place on 2 October 1998 when

the applicant was represented Ms D MacFarland of Counsel, instructed by Forrester Ketley & Co.

At that hearing I waived the objections taken under Section 3(1)(a) & 3(1)(c) of the Act, but the objection under Section 3(1)(b) was maintained and the application refused. I gave my reasons
5 for that decision at the hearing, which I now amplify.

Sections 1(1) and 3(1)(a) & (b) are as follows:-

10 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, consists of words (including personal names), designs, letters, numerals of the shape of goods or their packaging.

15 Section 3(1)(a) are as follows:

The following shall not be registered-

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

(b) trade marks which are devoid of any distinctive character.

25 Section 1(1) of the Act makes it clear that signs consisting of the shape of packaging for goods are capable of being registered as trade marks. It is now established that a sign may qualify as a trade mark under Section 1(1) of the Act yet be debarred from *prima facie* registration by Sections 3(1)(b)-(d) of the Act. In the AD2000 trade mark case (1997 RPC 168 @ 174 lines 4-8), Geoffrey Hobbs QC, sitting as the Lord Chancellor's Appointed Person, described the relationship between the sections in the following terms:-

30 "The proviso to section 3(1) indicates that the essence of the objection to registration

under Section 3(1)(b) is immaturity: the sign in question is not incapable of distinguishing the goods or services of one undertaking from those of other undertakings, but it is not distinctive by nature and has not become distinctive by nurture.”

5 Jacob J. adopted a similar view in the case of Philips Electronics N.V. v Remington Consumer Products (1998 RPC P283 @ 301, lines 41-53 and 302, lines 1-7). In contrast to the Philips case, I see nothing about the nature of the applicant’s sign that would make it impossible for it to acquire a distinctive trade mark character through use. Indeed the evidence indicates that it has, to some extent, started to function as an indication of origin, at least in parts of the UK. That does
10 not mean that the shape of the applicant’s bottle is distinctive by nature. It may simply be that the sign has been able to acquire a degree of distinctive character through nurture.

Before me, Ms MacFarland contended that the shape of the applicant’s packaging was *prima facie* distinctive. The distinctive feature was said to be the presence and positioning of the
15 indentation running around the circumference of the bottle about half way down its length. In Ms MacFarland’s submission this feature, and the resulting “shoulders” of the bottle, provided an unusual distinctive shape somewhat resembling a decapitated dumpy human figure.

This is clearly a matter of first impression. My first impression was not the same. It appears from
20 the evidence that this type of fermented milk drink is consumed from the bottle. The bottle itself is not large; smaller than most bottles from which the contents are consumed directly. My first impression was that the indentation in the bottle was there to provide users with a convenient means of gripping the bottle between their thumb and index finger in order to assist whilst drinking the contents through the relatively small aperture. Exhibit YK9 to Mr Kuroda’s
25 declaration consists of an advertisement for the applicant’s goods.

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The advertisement is re-produced below.

5

What is Yakult ?

Yakult is a fermented milk drink for everybody interested in their health. It contains a bacteria called Lactobacillus casei Shirota.

How does it work ?

Good bacteria are beneficial to our health - a favourable balance plays an important role in our digestive system and therefore contributes to our overall well-being.

Who should you drink Yakult ?

Yakult comes in a handy seven pack, that's one for each day of the week. Daily Yakult contributes to your natural level of good bacteria by the special Lactobacillus casei Shirota - and it doesn't matter when you drink it although many people enjoy their Yakult with breakfast.

How many people drink Yakult ?

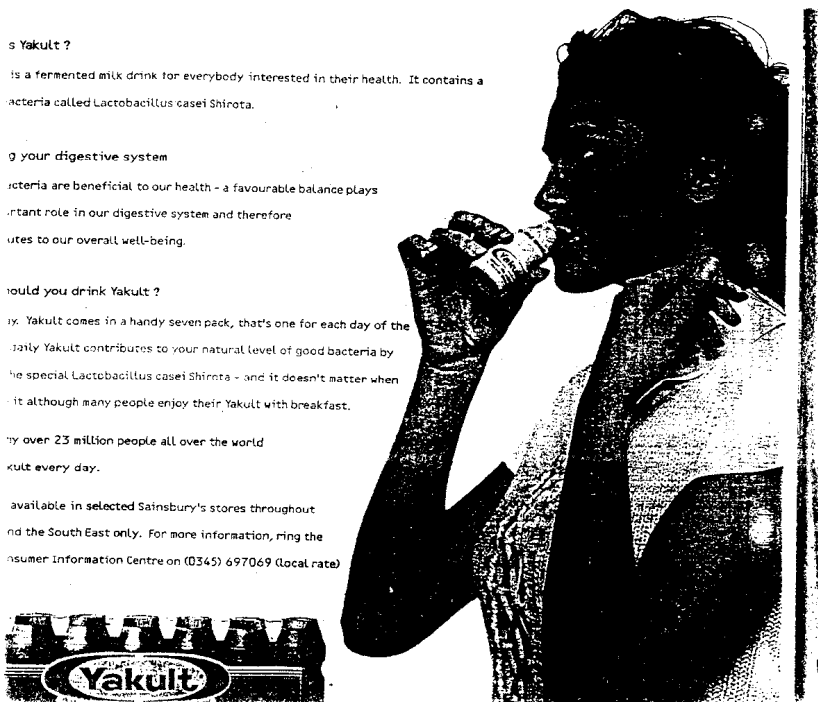
Over 23 million people all over the world drink Yakult every day.

Where can I buy Yakult ?

Yakult is available in selected Sainsbury's stores throughout the South East only. For more information, ring the Consumer Information Centre on (0345) 697069 (local rate).

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It can be seen that the advertisement shows a young woman using the finger grip in precisely the way I expected it to be. Whether the finger grip is really necessary for this purpose is another matter. And doubtless there are other ways of achieving the same result. But in my view, such considerations are irrelevant to the *prima facie* case for registration. In the TREAT trade mark case (1996 RPC 281 @ 306) Jacob J. asked rhetorically:-

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“What does devoid of any distinctive character mean?”

25

To which he suggested the answer was:-

“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?”

30

It appears to me that the average consumer's first impression of the shape of the applicant's bottle is likely to be that it is a pretty ordinary shaped bottle with an indentation for use as a finger grip. If that is right the shape of the applicant's bottle is unlikely to be regarded as denoting trade origin until the public have been educated to such a secondary meaning.

5

Two aspects of the survey described above which might be said to be contrary to my conclusions on the *prima facie* case. Ms Leno states that when asked whether there were any, or any other, products on sale in the UK in bottles of the shape shown to them, 81% of respondents in the South East of England said no. And when asked whether they would recognise the shape of the applicant's bottle if they saw it again, 88% of respondents in the same area agreed that they would.

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I attach little weight to this evidence for the following reasons:-

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1. The fact that 81% of those asked were not aware of other products (or in the majority of cases and without prompting *any* products) sold in bottles of the shape at issue is not necessarily inconsistent with my finding that it is insufficiently memorable as to be distinctive.

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2. Nevertheless 13% of those involved stated that they were aware of other products offered for sale in bottles of the shape applied for.

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3. Asking someone whether they will recognise the shape they have in front of them again after they have been specifically questioned about it is artificial and highly unlikely to reflect the respondent's actual response to a casual encounter with bottles of the shape in question in the ordinary course of their shopping.

I conclude that the shape in question is devoid of any distinctive character and excluded from registration by Section 3(1)(b) of the Act.

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Section 3(1) of the Act contains a proviso 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.”

5 It is clear from the wording of the proviso that in order to qualify under this provision the trade mark in question must have acquired a distinctive character as a result of use prior to the date of application. In this case that is prior to 31 October 1994.

10 The applicant’s evidence indicates that the mark was first used in the UK in April 1994; some six months before the relevant date. Turnover before the relevant date is said to have equated to around 600k bottles. The evidence indicates that (free) samplings were the main method used by the applicant to promote the product in bottles of the shape at issue during this period. The evidence also shows that, in use, the word mark YAKULT appeared prominently on the bottles.

15 In the TREAT case, Jacob J. noted that use does not necessarily equal distinctiveness, and that use of a descriptive word together with another distinctive word reduces the likelihood that the non-distinctive word will come to acquire a trade mark character. It is clear from the subsequent PHILIPS case (see page 290, lines 29-36) that the same considerations can apply to non-distinctive shape marks. There is nothing in the evidence before me which suggests that the
20 applicant’s have gone out of their way to identify the shape of their bottles as a sign which distinguishes their goods. If I am right so far, I do not think that the Registrar could have inferred from the evidence of use filed that the shape in question had acquired a distinctive character.

25 Prompted by the Registrar’s refusal to accept that the mark had acquired a distinctive character, the applicant commissioned the survey described above. The results of the survey indicate that the shape had started to denote a trade connection with the applicant, at least in the South East of England, by the time that it was conducted in May 1997. However, this was two and half years after the date of application. The evidence indicates that by that date the applicant had sold 18.75 million bottles of products under the mark applied for, whereas a much smaller number of bottles
30 (600k) had been offered for sale before the relevant date. The evidence also shows that the promotion of the goods in bottles of the shape applied for from the end of 1995 onwards was on

a different scale to that which occurred prior to the date of application. In all the circumstances, I do not consider that the survey evidence shows that the mark acquired a distinctive character through the use made of it *before the relevant date*.

5 There is one further point that deserves comment. All the evidence indicates that the applicant has used the mark in relation to a fermented milk drink. My conclusions about the *prima facie* registrability of the mark would equally apply to all the other goods covered by application number 1560018 in Class 32. The same would apply to milk, dairy products, including yoghurt and yoghurt preparations, and edible oils and fats, which are included within the specification of
10 1560017. The objection taken would not apply to the remaining goods covered by application number 1560017. However, it is very difficult to see how the shape of a bottle could be used as a trade mark for jellies or meat etc. On the evidence it appears highly unlikely that the applicant has any intention of using the mark on anything other than fermented milk drinks. In these circumstances, I think that a partial acceptance of application number 1560017 would be artificial
15 and pointless.

In reaching this decision, I have considered all the arguments, documents and evidence placed before me. The application is refused under Section 37(4) of the Act because it is debarred from registration by Section 3(1)(b) of the Act and does not qualify for registration under the proviso
20 to Section 3(1) of the Act as a result of use of the mark prior to the relevant date.

Dated this 17 Day of December 1998

25

Allan James

For the Registrar

30 **The Comptroller General**

