

## **TRADE MARKS ACT 1994**

### **IN THE MATTER OF APPLICATION NO.2153230 BY THE DRAMBUIE LIQUEUR COMPANY LIMITED TO REGISTER A TRADE MARK IN CLASSES 25 AND 33**

#### **DECISION AND GROUNDS OF DECISION**

On 10 December 1998, The Drambuie Liqueur Company Limited of 12 York Place, Edinburgh, EH1 3EU applied under the Trade Marks Act 1994 to register the trade marks shown at Annex A as a series of two marks in Classes 25 and 33.

The form of application included the following statement:

“The marks comprise the appearance of the three dimensional articles as portrayed in the attached graphical representations.”

The only difference between the marks is that the first mark in the series is limited to the colours shown on the form of application. The applicant has not defined these colours. They appear to be a dark brown or black bottle with a red cap.

The goods for which registration was sought were as follows:

Class 25        Articles of outerclothing, T-shirts, hats and headgear.

Class 33        Spirits and liqueurs.

Objection was taken to the application under Sections 3(1)(a) and (b) of the Act. The objection under Section 3(1)(a) was taken only in respect of goods in Class 25 on the grounds that the marks do not function as trade marks for those goods. The objection taken under Section 3(1)(b) of the Act was taken against Classes 25 and 33 because the marks are considered to be devoid of distinctive character.

At the hearing, at which the applicants were represented by Mr Hillier of Reginald W Barker & Co, their trade mark agents, I held that the shape of the bottle is non-distinctive and maintained the objection. Mr Hillier directed my attention to the word “Drambuie” which appears on the top of the bottle cap in both marks. I informed Mr Hillier that I would give further consideration to this point and that I would write to him with my decision. On 13 October 1998 I wrote to Mr Hillier maintaining the objection under Section 3(1)(b) on the grounds that although the word “Drambuie” is distinctive and appears on the top of the bottle cap, I considered it to be de minimis within the totality of the marks. The application was therefore refused in accordance with Section 37(4) of the Act.

Having considered these objections further I have now concluded that the objections under Sections 3(1)(a) of the Act may be waived. The only remaining objection is that the marks applied for fail to meet the requirements of Section 3(1)(b) of the Act. As it is possible for the marks to be used in relation to the goods contained within the class 25 specification I am satisfied that this objection may be waived in respect of Class 25. However, the objection under Section 3(1)(b) is maintained in Class 33.

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 Marks Rules 1994 to state in writing the grounds of my decision and the materials used in arriving at it.

No evidence of use has been put before me. I have, therefore, only the prima facie case to consider.

Sections 3(1)(b) of the Act is set out below:

3-(1) The following shall not be registered:

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

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

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

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:

“What does *devoid of 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?”.

The Registrar’s practice in relation to shape marks is set out in Chapter 6 of the Registry’s Work Manual at Page 58. The appropriate section is reproduced below:

“The appropriate test for prima facie acceptance will be whether because:

1.The shape in question immediately strikes the eye as different and therefore memorable;

2.and the differences between the applicants’ shape and those used by other traders are arbitrary and not dictated by function or some other non-trade mark purpose;

the public are likely to assume that the goods or services with reference to which the shape is to be used recurrently are those of one and the same undertaking.

Shapes, or elements of shapes, which are likely to be taken by the public as serving:

- a) a functional purpose (such as improving the performance of the goods);
- b) as a convenience feature (such as convenient storage);
- c) a purely decorative or aesthetic purpose (such as novelty shape for goods aimed at children or the attractive shape of an ornament);

- are unlikely to be regarded by the public as identifying the *origin* of the goods, at least until they have been educated to that perception.

Such signs are therefore likely to be open to objection, *prima facie*, on distinctiveness grounds, whether or not there are additional grounds of refusal under Section 3(2) of the Act.”

At the hearing Mr Hillier referred to the fact that the bottle contains a raised ridge shape which extends to the front and both sides of the bottle. There is no such feature on the rear of the bottle. In correspondence prior to the hearing Mr Hillier referred to this feature as:

“a distinctive moulded in shape on the front surface, resembling the drip of fluid down the front face of the bottle”.

Whilst I disagree that this feature resembles “the drip of fluid down the bottle” it is nevertheless a fact that the ridge itself exists as a feature of the bottle. Mr Hillier argued that this provided the bottle with a distinctive distinguishing feature which would enable it to function as trade mark and concluded that it was, therefore, not devoid of distinctive character. I do not agree with that conclusion. Bottles for goods such as liqueurs and spirits are available in a wide variety of shapes and sizes and many of them incorporate raised patterns on their surfaces. I do not accept that this particular feature brings any distinctiveness to the marks.

In the Proctor & Gamble case in the Court of Appeal (as yet unreported) Walker LJ said:

“Despite the fairly strong language of s. 3(1)(b), “devoid of any distinctive character” - and Mr Morcom emphasised the word “any” - that provision must in my judgment be directed to a visible sign or combination of signs which can by itself readily distinguish one trader’s product - in this case an ordinary, inexpensive household product - from that of another competing trader. Product A and Product B may be different in their outward appearance and packaging, but if the differences become apparent only on close examination and comparison, neither can be said to be distinctive”

Mr Hillier also referred me to the word “DRAMBUIE” which, together with a device, appears on the top of the red cap. Mr Hillier argued that as DRAMBUIE is a distinctive word then the marks as a totality cannot be devoid of distinctiveness.

The registry has a established practice which covers both of these points and is published in

Manual Chapter 6 at Page 59. The relevant section is reproduced below:

**“Where the shape is devoid of any distinctive character, the sign may still be accepted if it contains additional matter such as get up, words and devices. However, where the added matter is de minimis or unclear, or is itself devoid of any distinctive character, the application should be refused.”**

The word DRAMBUIE does appear on the bottle cap. However in the colour version of the marks it is not clearly seen, nor is it in a prominent position. In the black and white version it is seen even less clearly and, although it appears in the same position, the lack of clarity renders it far less prominent. In both marks there is a device element which appears with the word DRAMBUIE but I consider this to be no more than a non-distinctive border. The actual cap does not appear to be particularly large and, as a consequence, the device and the letters forming the word DRAMBUIE are themselves small. In my view the word DRAMBUIE is both unclear and de minimis within the marks applied for. I do not consider that the colour version of the mark is any more distinctive than the black and white version. Dark coloured glass and brightly coloured plastic caps are not unusual for alcoholic drinks.

I have already stated that no evidence of acquired distinctiveness has been submitted in support of this application and I do not consider that the public would, without education, regard this sign to be an indication of origin of the goods. I therefore conclude that the sign is debarred from registration by virtue of Section 3(1)(b) of the Act in relation to spirits and liqueurs.

In the light of my reconsideration of the Section 3(1)(a) and 3(1)(b) objections in respect of the goods in Class 25, the Registrar would consent to an Order remitting the application for re-examination insofar as these goods are concerned.

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 fails to qualify under Section 3(1)(b) of the Act.

Dated this 14 day of May 1999.

A J PIKE  
For the Registrar  
The Comptroller General

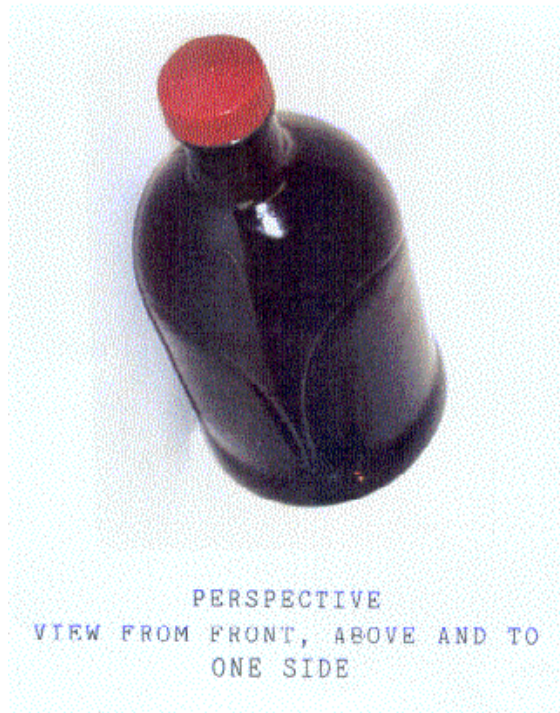


VIEW FROM FRONT

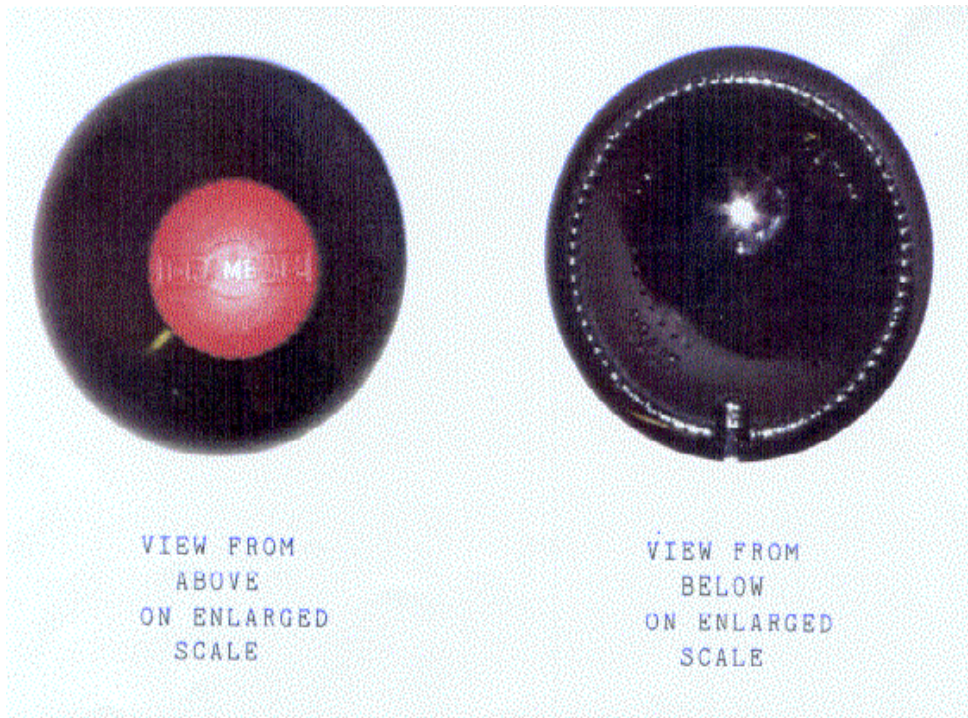


VIEW FROM  
REAR AND SLIGHTLY  
TO ONE SIDE

VIEW FROM ONE SIDE  
(OPPOSITE SIDE CORRESPONDS)



PERSPECTIVE  
VIEW FROM FRONT, ABOVE AND TO  
ONE SIDE

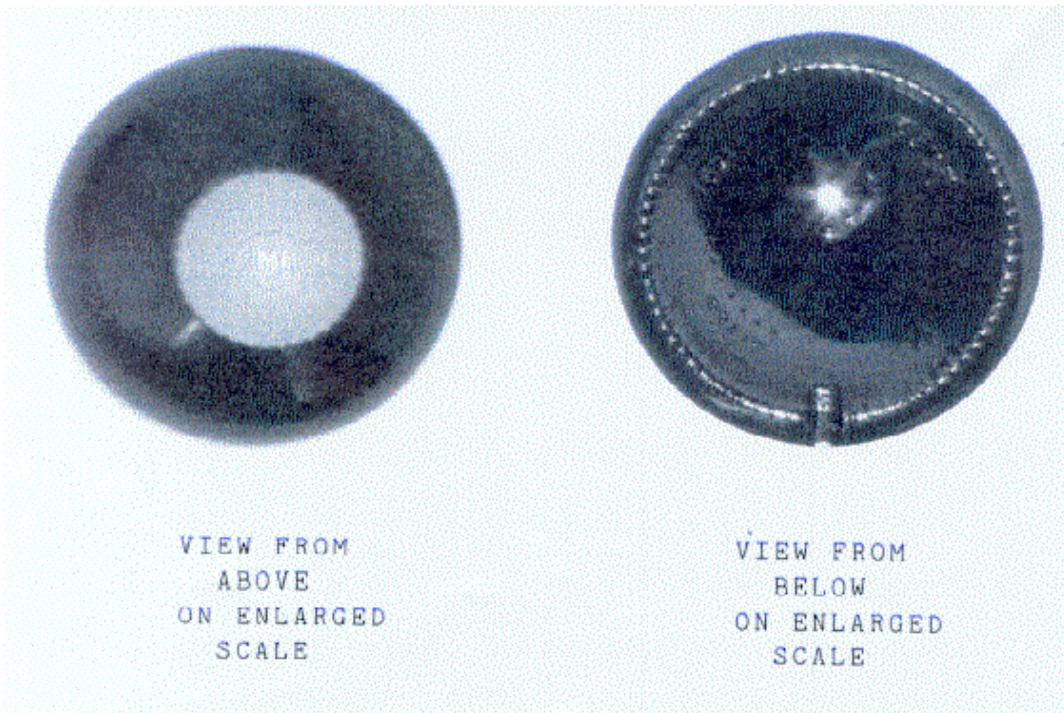


VIEW FROM  
ABOVE  
ON ENLARGED  
SCALE

VIEW FROM  
BELOW  
ON ENLARGED  
SCALE



PERSPECTIVE  
VIEW FROM FRONT, ABOVE AND TO  
ONE SIDE



VIEW FROM  
ABOVE  
ON ENLARGED  
SCALE

VIEW FROM  
BELOW  
ON ENLARGED  
SCALE



VIEW FROM FRONT



VIEW FROM  
REAR AND SLIGHTLY  
TO ONE SIDE.



VIEW FROM ONE SIDE  
(OPPOSITE SIDE CORRESPONDS)