

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 2012542

BY S.M. JALEEL & COMPANY LIMITED

TO REGISTER A TRADE MARK IN CLASS 32

DECISION

On 10th November 1998 Mr. R.A. Jones acting as Hearing Officer for the Registrar of Trade Marks issued a decision rejecting an application by S.M. Jaleel & Company Limited (“the Applicant”) to register the shape of a bottle with a “*six fingered petaloid base*” for use as a trade mark in relation to “non-alcoholic beverages and preparations for making such beverages; fruit flavoured carbonated drinks; all included in Class 32; fruit juices for use as beverages”.

The shape was represented graphically in the application for registration in the following manner:



No evidence of distinctiveness acquired through use was filed on behalf the Applicant. The application was, however, supported by evidence in the form of a Statutory Declaration of Gerald Mitchell. He is a director of a company called PCI (PET Packaging, Resin and Recycling) Limited which he described as the world's leading consultancy for PET (polyethylene terephthalate) resin and packaging products. His evidence was directed to the proposition that "the combination of the feet into a near spherical overall bottle body shape and the extremely low ratio of bottle height-to-circumference" rendered the shape in issue unique and distinctive.

The hearing officer concluded that the sign put forward for registration was "devoid of any distinctive character" and therefore excluded from registration by the provisions of Section 3(1)(b) of the Trade Marks Act 1994. He regarded the bottle shape as unexceptional:

The mark consists entirely of the shape of the bottle which, it seems to me, is typical of soft drink containers made of PET (polyethylene 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.

He was reinforced in these views by Exhibit KM5 to Mr. Mitchell's Statutory Declaration. This consists of a photograph (reproduced as an annex to this Decision) in which ten bottles are shown grouped together for comparison. With the possible exception of the third bottle from the left (Schweppes) they all appear to have "petaloid" bases. With reference to that photograph, the hearing officer observed:

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 the bottles at each end ("Pepsi" and "Deep Spring") there is not a significant difference.

His overall assessment was as follows:

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.

The Applicant gave Notice of Appeal to an Appointed Person under Section 76 of the 1994 Act. The hearing of the appeal subsequently took place before me. I indicated at the conclusion of the hearing that the appeal would be dismissed. I now give my reasons in writing for so deciding.

The Trade Marks Act 1994 implements Council Directive No. 89/104/EEC of 21st December 1988 to approximate the laws of the Member States relating to trade marks. I wish to make four points with regard to the relevant legislative provisions before relating them to the application for registration in the present case:

1. The provisions of Sections 3(2) and 1(1) of the Act (Articles 3(1)(e) and 2 of the Directive) confirm that unless the "*shape of goods or their container*" consists "*exclusively*" of "*the shape which results from the nature of the goods themselves*" or "*the shape of goods which is necessary to obtain a technical*

result” or “*the shape which gives substantial value to the goods*”, it can constitute a “*sign*” susceptible of registration as a “*trade mark*” if it is both “*capable of being represented graphically*” and “*capable of distinguishing goods or services of one undertaking from those of other undertakings*”.

2. A three-dimensional shape which satisfies these requirements must none the less possess “*a distinctive character*” in order to be registrable under Section 3(1)(b) and the proviso to Section 3(1) of the Act (Articles 3(1)(b) and 3(3) of the Directive). These provisions exclude all signs from registration unless and until they have or have acquired enough of “*a distinctive character*” to be perceived as indications of trade origin by the relevant class of persons or at least a significant proportion thereof: paragraphs 44, 46 and 52 of the Judgment of the European Court of Justice in Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee Produktions-und Vertriebs v. Boots-und Segelzubehör Walter Huber and Franz Attenberger (4th May 1999); parts C(ii) and D(ii) of the Judgment of Aldous LJ in Philips Electronics NV v. Remington Consumer Products Ltd (Simon Brown, Aldous and Mantell L.JJ) (5th May 1999).
3. Paragraphs 22 and 23 of the Judgment of the European Court of Justice in Case C-342/97 Lloyd Schuhfabrik Meyer GmbH v. Klijsen Handel BV (22nd June 1999) provide guidance as to the matters to be considered when assessing whether a sign possesses a distinctive character:

“22. In determining the distinctive character of a mark ... the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a

particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v. Huber and Attenberegger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark, how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

As emphasised in paragraph 11 of the Judgment in that case, it is for the national court to determine whether any given sign can rightly be said to possess a distinctive character in the light of these considerations.

4. If it is possible (legally and factually) to say of a particular three-dimensional shape that it possesses “*a distinctive character*” but fails to satisfy the criteria noted in point 1 above, the shape would appear to be unregistrable in accordance with the text of the legislation. It is anticipated that guidance relating to these aspects of the legislation will be provided by the answers to the questions which the Court of Appeal has recently referred to the European Court of Justice under Article 234 (ex Article 177) of the EC Treaty in connection with the appeal from the judgment of Jacob J. in Philips Electronics NV v. Remington Consumer Products Ltd. In the meantime there would seem to be no inevitable bar to considering whether objections to the registration of three-dimensional shapes are

well-founded under Section 3(1)(b) of the act (Article 3(1)(b) of the Directive) for lack of a distinctive character, intrinsic or acquired by use: Dualit Ltd's Application 5th July 1999 (Lloyd J); Procter & Gamble Plc v. Registrar of Trade Marks [1999] ETMR 375 (CA).

The shape of the bottle put forward for registration in the present case is not said to be excluded from registration for lack of compliance with the requirements identified in point 1 above. It is said to be excluded from registration for lack of a distinctive character in accordance with the requirement identified in point 2. In the absence of any evidence to suggest that bottles of that shape have acquired a distinctive character through use, the question whether they possess a distinctive character must be decided by assessing: (i) the degree of individuality imparted to them by the shape in issue; and (ii) the resulting likelihood that they will be perceived as an indication of trade origin in relation to their contents by the relevant class of persons (or at least a significant proportion thereof). There is no opportunity to consider any other matters of the kind identified in point 3 above in the circumstances of the present application.

Mr. Mitchell's Statutory Declaration contains the following observations relating to the individuality of the shape of the bottle represented graphically in the application:

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 discernible

sloping shoulder and the so called “long neck” type design being used.

These observations are made in the context of the following information concerning height to circumference ratios in the small bottle (500 ml or less) sector:

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 thin.

I take it to be the case that his Exhibit KM5 (reproduced as an annex to this Decision) is illustrative of these matters.

He confirms that “petaloid type feet” are common and functional and form part of many other bottles. He nevertheless maintains that the petaloid feet of the bottle represented in the application:

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.

It appears to me that the features identified by Mr. Mitchell impart relatively little by way of specific individuality to the bottle shape in issue. I think they combine to produce a bottle shape which departs from established norms to such a small extent and

so unadventurously that the shape remains within the realms of the visually unsurprising. Because it scores so poorly in terms of visual aberration, I would not expect the shape to function as a point of reference for people interested in seeing whether the contents of such bottles (which may, according to the application for registration, be non-alcoholic beverages, preparations for making such beverages, fruit flavoured carbonated drinks or fruit juices for use as beverages) “have originated under the control of a single undertaking which is responsible for their quality” per paragraph 28 of the Judgment of the European Court of Justice in Case C-39/97 Canon Kabushiki Kaisha v. Metro Goldwyn Mayer [1998] ECR I -5507). The features of shape which enable the bottle to be distinguished from other bottles are, in my view, features that people would not take to be an indication of trade origin in relation to its contents unless and until they had been educated (and so become accustomed) to regard them as such.

On this view of the matter, the possibility noted in point 4 above does not arise for consideration.

Since I agree with the hearing officer in thinking that the sign put forward for registration is excluded from registration by Section 3(1)(b) of the Act, the appeal will be dismissed.

In advance of the hearing before me the Registrar gave notice of intention to seek an award of costs if the appeal was unsuccessful. I was told at the hearing that this was prompted by a concern that the usual practice (of making no order for costs on appeals to the Appointed Person in ex parte proceedings) was encouraging appeals to the Appointed

Person in cases where the prospects of success would be regarded as too small to be worth pursuing at the risk of an adverse order for costs if the appeal failed. In the event, the Registrar did not press for an award of costs against the unsuccessful appellant in the present case. I will therefore confine myself to the observation that there is no reason why unreasonableness in connection with an appeal to the Appointed Person from a decision of the Registrar in ex parte proceedings should not result in the making of an order for costs against the party who has acted unreasonably.

Geoffrey Hobbs Q.C.

9th August 1999.

Mr. Richard Davis instructed by Messrs. Mathys & Squire appeared as Counsel on behalf of the Applicant.

Mr. Allan James, Principal Hearing Officer, appeared on behalf of the Registrar.

ANNEX

