

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NUMBERS  
2000661 AND 2000662 BY UNILEVER PLC TO  
REGISTER TRADE MARKS IN CLASS 30**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NUMBERS 45851 AND 46305 BY  
SOCIETE DE PRODUITS NESTLE SA**

## TRADE MARKS ACT 1994

**IN THE MATTER OF Application Numbers  
2000661 and 2000662 by Unilever Plc to  
Register Trade Marks in Class 30**

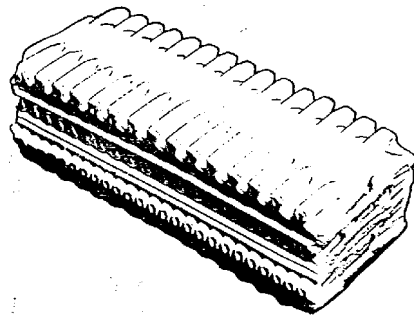
**and**

**IN THE MATTER OF Opposition Thereto Under  
Numbers 45851 and 46305 by Societe De Produits  
Nestle SA**

### BACKGROUND

1. On 31 October 1994, Unilever Plc applied to register the following trade marks in Class 30:

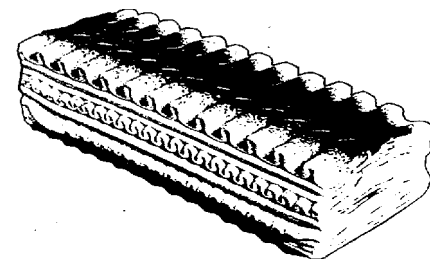
(i) No 2000661



3-Dimensional

Specification of Goods - "Ice cream products".

(ii) No 2000662



The mark consists of a 3 dimensional shape.

Specification of Goods - "Ice cream dessert products".

2. The applications were subsequently accepted by the Registrar "because of distinctiveness acquired through use" and published in the Trade Marks Journal. On 7 November 1996 Societe des Produits Nestle SA filed Notice of Opposition against the applications and the oppositions were subsequently consolidated. In summary, the grounds of opposition were:-

- (i) Under Section 3(2)(a) of the Act because the marks consist exclusively of the shape which results from the nature of the goods themselves.
- (ii) Under Section 1(1) and Section 3 of the Act because the marks are not capable of distinguishing the applicant's goods from those of other undertakings as sales of the applicant's product do not necessarily establish the shape as a badge of origin.
- (iii) Under Section 3(6) of the Act as the applications were made in bad faith to the extent that the products in the shape now sought to be registered are protected by UK Patent No 2108363 which will expire on 26 August 2001 and the application amounts to an attempt to prolong indefinitely and even to extend the protection provided by the patent.

3. The applicants have filed counterstatements denying the grounds of opposition and both sides have filed evidence. The matter came to be heard on 25 May 2001 when the applicant for registration was represented by Mr Miller of Counsel, instructed by Castle International and the opponent by Ms Himsworth of Counsel instructed by Nestle UK Ltd.

### **Opponent's Evidence**

4. This consists of a statutory declaration by Sarah Dixon dated 16 June 1997. Ms Dixon is a legal adviser in the Group Legal and Secretarial Department of Nestle UK Ltd, a position she has held since 1992.

5. Ms Dixon asserts that the marks in suit do not function as signs capable of distinguishing the goods of the applicant but consist merely of a characteristic of the products sold by reference to the applicant's trade mark Vienetta, namely the appearance of the products. She refers to Exhibits SD1 and SD2 to her declaration as examples of the packaging in which the Vienetta product is sold and a videotape of television advertisements for the product and goes on to state that from this material it can be seen that although the shape of the product appears on the pack it is always used with other trade marks ie Vienetta and Walls, and the illustration of the product is merely for customer information.

6. Ms Dixon states that ice cream desserts of a similar external shape and configuration have been sold in the UK prior to the date of the applications and continue to be produced and sold. In support she refers to the following products:-

- (i) “Fiorella”, manufactured by Motta Eiskrem GmbH (Motta) and sold in the United Kingdom during the period 1991 to 1993 (perhaps 1994 in view of the products long shelf life) exclusively by J Sainsbury Plc. A copy of the packaging of this product is at Exhibit SD 3 to the declaration. According to the records of Motta, which became part of the Nestle SA group of companies in 1995, the following estimated quantities of “Fiorella” ice cream desserts were produced:

| 1991    | 1992    | 1993    |
|---------|---------|---------|
| 650,000 | 956,000 | 918,000 |

- (ii) “Hispanola” - manufactured by The Premium Ice Cream Company (formerly Thayer’s Dairy Ice Creamery, which was launched in 1993 and continues to be sold. An example of the packaging is at Exhibit SD 4.
- (iii) “Recital” - an ice lolly manufactured in Greece and sold in the UK. An example of the packaging is at Exhibit SD 5. This product was purchased by an employee of Nestle in 1997, some three years after the relevant date for these proceedings.
- (iv) “Bossanova” - an ice cream dessert manufactured by Motta for Fragifrance for distribution to Tesco Stores in the United Kingdom in 1995, which is, once again, after the relevant date. An example of the packaging is at Exhibit SD 6.
- (v) “Cascade” - an ice cream dessert sold by an affiliate and licensee of the opponent. An example of the packaging is at Exhibit SD 7. There is no suggestion that this product was in the UK market place prior to the relevant date.

7. Next, Ms Dixon refers to Exhibit SD 8 to her declaration, which is a copy of UK Patents Nos 2108363 and 2143718. She states that according to the applicant’s packaging they believe the Vienetta product is protected by these patents. Ms Dixon adds that the applicant has threatened and/or commenced proceedings for infringement of these patents against various defendants including Nestle UK Ltd and that the patents are due to expire on 26 August 2001.

8. Ms Dixon explains that, broadly speaking, the patents protect a composite product comprising several thin superimposed layers of an extrudable material such as ice cream, separated by very thin layers of a different material such as chocolate. In a preferred embodiment of the product one or more layers of the ice cream is/are extruded such that they are not flat and she adds that, this feature is incorporated in the applicants Vienetta product in the form of the convoluted layers whose edges can be seen in the marks. Ms Dixon is advised that extrusion is a technique widely used in the manufacture of ice cream and indeed, that there would be no other way to manufacture a product like the Vienetta. Accordingly, Ms Dixon submits that registration of the marks in suit could effectively prevent other

manufacturers from producing products according to this preferred embodiment which they would otherwise be entitled to do after the expiry of the patents.

### **Applicant's Evidence**

9. The first statutory declaration filed on behalf of the applicants is by Michael Hebel and is dated 10 July 1998. Mr Hebel is the Ice Cream Marketing Director of Birds Eye Walls Limited a subsidiary of Unilever Plc, a position he has held since 1993 having joined Unilever in 1981.

10. Mr Hebel describes the marks in suit as follows:-

“The marks when viewed as a whole, consists of an intricate combination of layers or tiers of ice cream in the form of a rectangular brick-shaped block. The overall visual impression of the product is characterised by the unique layered wave or ruffle which runs throughout the product and results from extruded ice cream layers being laid down like waves. Attention should be paid to the total impression or global appreciation of the mark, as the product is viewed longitudinally and laterally at the cut edge. What is striking is the definition, regularity and uniformity of the wave pattern interspersed with the flat layers. Each layer is separated from the next without any intermingling by the coverture layer which results in an overall appearance of regularity of layers and a sharply defined wave-shaped pattern. The hallmark of the product is the 3-dimensional structure as can be seen from the side or longitudinal view which is characterised by one or more layers showing a wave-shaped pattern.”

In Mr Hebel's view the unique layered wave-shaped pattern of the product has enabled it to develop a distinct personality from other ice cream products which can come in all varieties of shapes. He says, that this has been highlighted in advertising and promotion by using product shots or wave imagery such as waves on a beach, ruffles or by adopting slogans such as “Great Moments come in Waves”.

11. Next, Mr Hebel states that the products' market share of the UK pre-prepared ice cream dessert market (by value) in 1993 and 1994 were approximately 65% and 60% respectively and that approximately 17.65 million Vienetta were sold in this country in 1994.

12. Mr Hebel goes on to draw attention to recent court decisions concerning infringing products in Germany and Holland (copies of which are at Exhibit MH 4 to his declaration) in which it was held that the shape of the product was distinctive and served to identify the origin of the goods.

13. Mr Hebel explains that when his company launched the product nationwide in the UK in April 1982, it was supported by a £1.26m (in the first 18 months of launch) advertising campaign which included television and press advertising. He adds that Vienetta's market share of the UK pre-preformed ice cream dessert market in terms of value was as follows:-

|             |             |             |             |             |             |
|-------------|-------------|-------------|-------------|-------------|-------------|
| <b>1985</b> | <b>1986</b> | <b>1987</b> | <b>1988</b> | <b>1989</b> | <b>1990</b> |
| 86%         | 74%         | 76%         | 81.2%       | 81.2%       | 78.3%       |
| <b>1991</b> | <b>1992</b> | <b>1993</b> | <b>1994</b> | <b>1995</b> | <b>1996</b> |
| 78.3%       | 66.1%       | 65.2%       | 60%         | 65.5%       | 67.5%       |

14. On the promotion of the product, Mr Hebel provides at Exhibit MH 7 to his declaration a selection of press advertisements for the years 1993 through to 1994, consisting of the following:-

| <b>Page</b>         | <b>Date of Advertisement</b> | <b>Publication</b>                              |
|---------------------|------------------------------|---|
| 1                   | 1983                         | Not known                                       |
| 2a, b, c & d        | 1988/89                      | Trade Presenter                                 |
| 3                   | 1990                         | Not known                                       |
| 4                   | June 1991                    | Daily Mirror                                    |
| 5                   | 1991                         | Trade Presenter                                 |
| 6                   | 1991 (Not confirmed)         | Trade Presenter                                 |
| 7a & b              | 1991/92                      | Trade Presenter                                 |
| 8                   | 1992                         | Women's magazine and TV Times                   |
| 9                   | Feb 1993                     | Daily Record                                    |
| 10a, b, c, d, e & f | Feb 1993                     | Daily Mirror                                    |
| 11                  | 1993                         | Consumer Magazine                               |
| 12                  | 1994                         | Trade Presenter                                 |
| 13                  | 1994                         | Kentucky Fried Chicken restaurant chain leaflet |
| 14                  | 1994                         | Not known                                       |
| 15a, b, & c         | 1996                         | Women's Magazine                                |

15. Mr Hebel states that Exhibit MH 7 shows that advertising focusses on the distinctive wave-shaped pattern which can be seen from side or longitudinal views of the Vienetta to the extent that in some instances the brand name (Vienetta) has not been included eg "The Biggest Slice" advertisement (page 6).

16. In addition to the press advertisements, Mr Hebel points out that the product has been promoted through national television commercials, each containing the mark applied for.

Exhibit MH 8 is a video containing various commercials shown in the UK between 1986 and 1994 together with TV stills dated 1989 and 1992. He adds that other advertising eg through point of sale material and leaflets, had also taken place and examples are at Exhibit MH 9.

17. Mr Hebel goes on to divide the average promotional expenditure between 1990 and 1994 between the various forms of advertising media:-

|       |   |       |
|-------|---|-------|
| (i)   | Press, including magazines, point of sale | 12.4% |
| (ii)  | TV  | 76%   |
| (iii) | Radio                                     | 0.2%  |
| (iv)  | Hoardings and posters                     | 0.5%  |
| (v)   | Other                                     | 10.9% |

18. He then provides the following details of the estimated value of expenditure on advertising activities in support in support of the mark in the UK since launch:-

| <b>Year</b>  | <b>Value</b>      |
|--------------|-------------------|
| 1982         | 165,300           |
| 1983         | 1,102,700         |
| 1984         | 616,900           |
| 1985         | 910,200           |
| 1986         | 1,525,000         |
| 1987         | 1,888,000         |
| 1988         | 2,231,300         |
| 1989         | 3,130,400         |
| 1990         | 3,188,400         |
| 1991         | 2,178,100         |
| 1992         | 2,055,525         |
| 1993         | 1,502,079         |
| 1994         | 2,203,887         |
| <b>Total</b> | <b>22,988,791</b> |

19. Mr Hebel states that the product has been sold extensively since launch throughout the UK in major retail outlets such as Iceland, Waitrose, Tesco, Asda, Safeway, Sainsburys, Somerfield, Kwiksave as well as numerous smaller retail shops and cash and carries. He provides the following estimated volumes and sales figures of the product since 1985 based upon the historical recommended retail price:-

#### **TOTAL SALES**

| <b>YEAR</b> | <b>PACKS<br/>(Million)</b> | <b>VOLUME<br/>(Litons)</b> | <b>VALUE<br/>(£Million)</b> |
|-------------|----------------------------|----------------------------|-----------------------------|
| 1985        | 13.44                      | 8065                       | 15.99                       |
| 1986        | 14.02                      | 8414                       | 17.53                       |

|              |               |               |               |
|--------------|---------------|---------------|---------------|
| 1987         | 15.66         | 9404          | 19.59         |
| 1988         | 18.78         | 1276          | 24.15         |
| 1989         | 20.36         | 12219         | 26.76         |
| 1990         | 19.76         | 11859         | 27.47         |
| 1991         | 17.44         | 10472         | 25.55         |
| 1992         | 15.72         | 9438          | 23.42         |
| 1993         | 15.67         | 9410          | 24.30         |
| 1994         | 17.51         | 10510         | 27.82         |
| <b>TOTAL</b> | <b>168.36</b> | <b>101067</b> | <b>232.58</b> |

20. Mr Hebel explains that as a result of the products high profile and success, it receives unprompted publicity in the trade and marketing press as well as in national publication eg newspapers. At Exhibit MH 10 to his declaration are examples of articles referring to the product.

21. In relation to competitors products, Mr Hebel states that where such products have infringed or threatened to infringe, his company has taken appropriate steps, including legal action. However, other products with spray or piped on decoration may not infringe and Mr Hebel says this explains that they may co-exist in the UK market. Turning to the specific products mentioned in Ms Dixon’s statutory declaration, Mr Hebel states that some are considered quite different to the marks in suit but others eg “Recital” have been subject to “action” by the applicant.

22. The second statutory declaration filed on behalf of the applicant is by Alain Hugot and is dated 12 August 1998. Mr Hugot is the Category Patent Coordinator for the Ice Cream Group and Unit Manager of Unilever Patent Department.

23. Mr Hugot does not agree with the opponent’s view that registration of the marks in suit could effectively prevent other manufacturers from producing the product according to a preferred embodiment as they would otherwise be entitled to do after the expiry of the patents. He adds that patent and trade mark rights are quite different and in this case the patents serve to protect a process and structure which can manifest themselves in a variety of forms. In Mr Hugot’s view it is possible to create a product which outwardly resembles the appearance of the Vienetta product but which does not fall within the scope of the claims of the relevant patents and conversely, he believes it possible to manufacture a product which infringes the patents but which has an appearance quite different from the marks in suit.

24. Mr Hugot explains that, in very simplified terms, the relevant patents refer to an internal structure and how such structure is produced. If the vertical sides of a product made according to the relevant patents are exposed, these sides will reflect the way in which the product has been made and its internal structure. However, a product may have an internal structure derived from the process protected by the patents, but as a result of the application of a complete chocolate coating, this structure is hidden and the appearance of the product is radically different from that of the applications in suit.



25. Mr Hugot goes on to state it is also possible to achieve a similar external appearance to that of the applications in suit without infringing the relevant patents. For example, the vertical sides of a cake can be covered with an ice cream layer by way of a series of extrusion nozzles in a wave fashion. This process will not infringe the relevant patents but the resultant product may still resemble the applications such that there is a likelihood of association and/or confusion. He adds that there are two other instances where products may exhibit the characteristic wave-shape layered pattern of the product or mark, leading consumers to believe there was some trade connection between the two, but do not infringe the relevant patents. First, one of the essential elements of GB 2108363 is the existence of very thin layers of fat based couverture confection material between the ice cream layers. Their absence would affect the issue of patent infringement decisively, but have little impact on consumers' perception of the overall shape of the product or mark. Therefore, a product without these very thin layers could still closely resemble the product such that consumers believed that the two came from the same source but would not infringe GB 2108363. Secondly, another essential element of the relevant patents is the product's dimensions and more specifically the thickness of the ice cream layers (less than 5mm in GB 2143718 and 'thin' in GB 2108363). If a product is identical in appearance to the product, bar its dimensions, then the relevant patents will not be infringed, although consumers would be likely to believe the product was in some way connected with the product or its manufacturer.

26. The applicants next statutory declaration is dated 14 July 1998 and is by Elizabeth Mary Cratchley who was head of the Corporate Trade Marks Department of the applicant company until her retirement on 31 December 1996.

27. Ms Cratchley states that since 31 October 1994 it has been possible to register three dimensional product shapes as trade marks in the UK and that it was the applicant's belief that the marks in suit were and are capable of distinguishing and that the marks do not consist of shapes which result from the nature of the goods themselves as ice cream desserts can come in any form or shape.

28. Mr Cratchley denies any accusation of bad faith or any intention to use the applications as prolonging existing patent or other legal protection.

29. The applicant has submitted sixty one statutory declarations relating to a customer survey on whether the shape of the ice cream dessert sold by reference to the trade mark Vienetta and produced by Birds Eye Walls Limited is sufficiently distinctive to operate as a trade mark. So that customers recognise the shape of Vienetta, per se, as a badge of origin.

30. In a statutory declaration dated 5 March 1999 Emily Mary Walton, a solicitor practising in the firm Dibb Lupton Alsop explained that following instructions from Unilever Plc to organise the above mentioned customer survey, she contacted a market research company called Surveyplan to help in the recruitment of interviewees to conduct a survey in a busy shopping location. Sutton, Surrey was chosen as a location for the survey.

31. Ms Walton explains that she organised a team of four trainee solicitors and a junior solicitor employed by her firm to carry out the surveys with her and that, in addition, two

members of the Unilever Corporate Trade Marks Department and a manager from Unilever UK Legal Department assisted. The outline plan was as follows:-

- (i) Surveyplan recruit interviewees and bring them to Trinity Church hall;
- (ii) The interviewee is asked a series of questions by reference to a presentation board showing 4 photographs which are frozen dessert products, one of which is the “VIENNETTA” product
- (iii) If the interviewee’s answers confirmed Unilever’s belief that consumers recognise the shape of the “VIENNETTA” product on its own without any packaging or reference to the trade marks “WALL’S” or “VIENNETTA” and the interviewee was willing to participate further in the survey, a Statutory Declaration is drafted (in manuscript) by a member of her team in conjunction with the interviewee as necessary; and
- (iv) The finalised Statutory Declaration was then signed and sworn before an independent solicitor on stand-by in the church hall.

32. Ms Walton adds that the identical shot of each product was used without any other additional material in the photograph. She was unable to use real products because of the problems of keeping the ice cream desserts frozen and in good condition during the survey day; and the difficulties in sourcing the three non-Wall’s products.

33. Prior to the survey, on the evening of 28 September 1998, Ms Walton briefed the “VIENNETTA” shape survey team outlining how the surveys would be conducted. In particular she pointed out the importance of not prompting the interviewee or suggesting answers to the interviewee. The survey team were instructed to note the responses verbatim from the interviewees on the questionnaire form. She goes on to state that on the day of the survey, 29 September 1998, Surveyplan provided a team of four interviewers and one supervisor for the day. The four interviewers or field workers, stood in the High Street in Sutton, stopping members of the public at random and asking the questions as laid out in the questionnaire shown at Exhibit EMW 1 to Ms Walton’s declaration. This preliminary exercise was to recruit interviewees who had bought or consumed ice cream or frozen dessert in the last three to six months or had considered buying or consuming a frozen dessert in the last three to six months. If the person interviewed did not buy or consume ice creams, the interviewer terminated the interview. If the interviewee was prepared to give up his time, the Surveyplan interviewer asked if he/she or anyone in his or her family worked in any of the following organisations:-

- (i) Sainsbury
- (ii) Marks & Spencer
- (iii) Asda

- (iv) Trust House Forte
- (v) Unilever
- (vi) Safeway
- (vii) Iceland
- (viii) Tesco

The aim of this question was to remove any Unilever employees or their families from the survey.

34. Ms Walton goes on to state that if the interviewee had agreed to further questions, the Surveyplan interviewer took the interviewee to Trinity Church Hall which is 500 yards off the High Street to a room ready prepared for the “VIENNETTA” shape survey where the survey team were present. In the room, the Surveyplan interviewer would introduce the candidate to one of the “VIENNETTA” shape interviewer team, handing over the completed Surveyplan questionnaire. An example of this questionnaire is at Exhibit EMW 2 to Ms Walton’s declaration and at Annex 1 to this decision. The photographs referred to in Exhibit EMW 2 (Annex 1) were displayed on a rectangular board labelled 1, 2, 3 and 4 as shown in the series of photographs at Exhibit EMW 3 to Ms Walton’s declaration.

35. The photographs were of the following products:-

- |              |  |
|--------------|--|
| Photograph 1 | The CASCADE product produced by Nestlè.                          |
| Photograph 2 | The Chocolate and Vanilla ice cream gateau sold by Iceland.      |
| Photograph 3 | The VIENNETTA product.   |
| Photograph 4 | The RHAPSODY product produced by Allied Foods and sold in Tesco. |

36. Ms Walton explains that the three alternatives to the VIENNETTA product were chosen as they were viewed by the applicants as being the most similar products to VIENNETTA available in the UK market.

37. Next, Ms Walton states that the survey questions were explained to the interviewee on the basis that the research was for a client who identity was to remain anonymous, and the questions would be asked with reference to a presentation board, displaying products labelled 1 through to 4. The interviewee was asked to refer to the products according to their number. The answers to the questions asked were noted by the interviewer word for word in the spaces provided on the questionnaire form.

38. The interviewers then asked the following questions:-

- (i) “Do you eat ice cream?” If the answer was no, the interview was finished;
- (ii) When shown the presentation board, the interviewee was asked. “Do you recognise any, and if so, can you identify them?”
- (iii) If the interviewee gave the name “VIENNETTA” for the product labelled 3, he or she was asked; “you have correctly identified 3 as VIENNETTA, why did you say that?” The answer was noted by the interviewer verbatim.
- (iv) “How would you describe the appearance of VIENNETTA (perhaps to a blind person)?”
- (v) “Do you know who makes “VIENNETTA”?”
- (vi) “Who do you think makes or sells the others?”
- (vii) “Can we contact you again about this Survey?”
- (viii) “Can we use this completed questionnaire in Court proceedings?”
- (ix) “Is this your correct name, address and home/daytime telephone number?” (showing the Surveyplan questionnaire)

39. Ms Walton adds that if time permitted and the interviewee gave appropriate answers to the questionnaire, the interviewee was asked if he or she would mind giving a statutory declaration confirming his or her answers to the survey. The interviewer explained that this declaration would be used in legal proceedings in which Unilever aimed at obtaining trade mark protection for the shape of the “VIENNETTA” product. In several instances, interviewees did not wish their questionnaires to be used in court proceedings or did not have the time to stay to give a statutory declaration. At Exhibit EMW 4 is a list of declarants who provided statutory declarations.

40. Ms Walton explains that a total of 89 people were interviewed by the “VIENNETTA” survey team. However 7 individuals specifically stated, when asked, that their questionnaires were not to be used in court proceedings. She therefore calculated the figures referred to below on the basis of 82 people interviewed. The data contained in the seven excluded questionnaires is summarised in Exhibit EMW 5. These 7 VIENNETTA questionnaires and their corresponding Surveyplan questionnaires are available for inspection at the offices of her firm.

41. Ms Walton draws attention to a problem in relation to the survey in that while the original shape questionnaires and the corresponding Surveyplan questionnaires were being copied in the Reprographics Unit at Unilever House, a photocopying error occurred and 5 VIENNETTA shape questionnaires became detached from their corresponding Surveyplan questionnaires. These 5 surveys together with 5 uncorrelated Surveyplan questionnaires are at Exhibit EMW 7. Ms Walton continues, due to the photocopying error, it was not possible

with certainty to tie up the Surveyplan questionnaires within this batch with the correct shape questionnaires and the data contained in these questionnaires has been deemed not to constitute recognition of Product 3 as “VIENNETTA” or a similar name nor “WALL’S” as the manufacturer . She states that in a further five instances when the “VIENNETTA” questionnaires were completed by one member of the survey team, the “no” was circled in response to the question “Can we use this completed questionnaire in court proceedings”. This was a clerical error. In all these instances, statutory declarations were taken from interviewees who then signed their declaration in front of the independent solicitor.

42. Ms Walton provides a breakdown of the survey results as follows:-

- (i) Out of the 82 people interviewed, 55 named the product shown in photograph 3 as “VIENNETTA”, equating to 61.1% of the total number of interviewees. Statutory Declarations have been filed in evidence from 53 of these 55 people who named the “VIENNETTA” product.
- (ii) In 8 further instances interviewees named one or more of the other products shown in photographs as being the “VIENNETTA” product as well as naming Product 3 as “VIENNETTA”. If these 8 individuals (Kathleen Filding, Jackie Kavanagh, Bernadette Stokes, Frances Steinte, Mr Dale, Mr C Collins, Olive Heisler and Christine Matusevics) are included, a total of 63 interviewees recognised Product 3 as “VIENNETTA”. Out of a total 82 questioned, the 63 positive responses gives a percentage of 76.8% who named Product 3 as “VIENNETTA”.
- (iii) A further 2 people recognised Product 3 but gave similar names, “Vienna” and “Vetti”. When the total of all those people referred to in this paragraph and paragraphs 23, 24 and 25 are calculated, 65 out of the 82 people recognised Product 3 as “VIENNETTA” or gave a similar name or also named one of the other three products as “VIENNETTA”. This gives a percentage of 79.3% who named Product 3 as “VIENNETTA” or some other name similar to “VIENNETTA”.
- (iv) Out of 55 people who named Product 3 only as “VIENNETTA”, 53 named the manufacturer as “Walls”, making a percentage of 96.4%. Out of the total number of people interviewed (82) 58 gave the name “Wall’s as the manufacturer of Product 3 which is a percentage of 70.7%.

### **Opponent’s Evidence in Reply**

43. This consists of a statutory declaration by Gavin Emsden, dated 9 December 1999. Mr Emsden is a Market Intelligence Manager in the Marketing Intelligence Department of Nestle UK Limited. He has 10 years experience in the field of market research. He comments on the market survey evidence filed on behalf of the applicants in these proceedings.

44. Firstly, Mr Emsden is critical of the sample size, stating that a total of 82 people is insufficient to give accurate or reliable results. He concludes that according to accepted market research calculations the results given by Ms Walton in her declaration could be 6-10% greater than the true proportion of customers who would recognise the product by the shape alone. In Mr Emsden's view, an absolute minimum for reliable results in this type of survey would be at least 150.

45. Mr Emsden goes on to state that, in view of his comments above, the results provided by Ms Walton are unwarranted. He adds that as eight of the respondents named an additional one or more of the products as VIENETTA, it is possible they may have been guessing. Mr Emsden expresses concern about question 3 and also queries the relevance of question 4 of the survey. With regard to question 3, Mr Emsden states that where a respondent identifies VIENETTA in Question 2 as the name of Product 3 in the photographs, the interviewer informs the respondent that the answer VIENETTA is correct. Mr Emsden explains that there is no need to inform the respondents of the "correct" answer and to do so removes any possibility of distinguishing between those respondents who genuinely associated the picture with the VIENETTA brand name and those who might have been guessing. He summarises that this could have a serious effect on the responses to Question 3 "Why did you say that?".

46. Mr Emsden turns to the statutory declaration of David Pratt who was one of the respondents interviewed on behalf of the applicant. He points out that at paragraph 4 of his declaration Mr Pratt states that "When shown the photographs in Exhibit DP 1 I recognised number 3 due to the adverts I have seen for the product. I was not able to name the product straight away only when prompted with the name". In order to obtain the most accurate results in a survey such as this, the respondents must make a spontaneous association between the shape of the goods and the product name or manufacturer. Where a respondent is prompted there is no opportunity for him or her to be confused, thus presenting what appears to be more conclusive evidence, but may in fact be distorted. Mr Emsden states that it is well known in the industry that prompting can and often does lead to unreliable results. He would therefore always insist that interviewers do not prompt respondent or, if they do, that the results are separated. Mr Emsden adds that the questionnaire contains no instructions to the interviewer about prompting and that other respondents may have been prompted.

47. Finally, on the overall purpose of the survey, Mr Emsden notes that in paragraph 2 of her declaration that the purpose of the survey was according to Ms Walton, "to confirm Unilever's firmly held belief that the shape of the ice cream dessert sold by reference to the trade mark "VIENNETTA" produced by Birds Eye Wall's Limited is so distinctive as to operate as a trade mark, and that consumers recognise the shape of "VIENNETTA" as a badge of origin". Mr Emsden has looked through the 82 questionnaires and he notes that only 23 of the respondents referred to the shape of the product or analogous concepts in their responses to Question 3. In his opinion, if the purpose of the survey was to determine the extent to which consumers focussed on shape as an aid to recognition of the product, at best the desired association was made by 28% of the respondents.

## **Applicant's Further Evidence**

48. This consists of statutory declarations by Emily Mary Walton, Alexander Griffith and Ruth Daniels which are filed in response to Mr Emsden's comments about the prompting of respondents, in particular David Pratt.

49. Emily Mary Walton, in her second statutory declaration, states that Mr Pratt was the only interviewee to be prompted and hence it is recorded in his declaration. She refers to paragraph 6 of her earlier statutory declaration where it is stated that the importance of not prompting the interviewee or suggesting answers, was pointed out to the survey team. Ms Walton adds that in view of the pre-survey day briefing, the substance of which she repeated during the survey day, it was not considered necessary to insert formal instructions in to the questionnaire forms used by the interviewers.

50. Alexander Griffith's statutory declaration is dated 12 May 2000. He is a solicitor at Dibb Lupton Alsop and was the individual who interviewed David Pratt for the survey. Mr Griffith confirms that Mr Pratt asked to be prompted during the interview and made a large amount of fuss as he knew the product but could not remember the name which was 'on the tip of his tongue'. Mr Griffith states that he cannot recall the exact words he used when he prompted Mr Pratt but that it was in the form of a clue and that he did not mention the word VIENETTA. Mr Pratt provided that name on his own.

51. Ruth Daniels' statutory declaration is dated 15 May 2000. Ms Daniels is a solicitor with Dibb Lupton Alsop. She helped draft Mr Pratt's statutory declaration at the time of the survey. Ms Daniels states that she was aware that individuals should not be prompted but as Mr Pratt had made a fuss about having the name of the product 'on the tip of his tongue' an exception had been made and that this was recorded on the survey result form. Ms Daniels confirms that all survey team members were given strict instructions not to prompt the interviewees.

52. This concludes my summary of the evidence filed in this case. I now turn to the decision.

## **DECISION**

53. Before turning to the grounds of opposition, I wish to consider the nature of the applications in suit. Application number 2000661 is defined as "3-Dimensional", while application number 2000662 (although originally applied for as "3-Dimensional") is deemed to consist of "a 3-dimensional shape". It seems to me that both applications comprise the combination of shape and appearance which characterise the goods and are not merely limited to features of shape as such. In other words the marks consist of all the features shown in the representations as filed. Therefore, the applicant's original definition of both marks as "3-Dimensional" is correct and the subsequent adjustment of 2000662 to "The marks consist of a 3-dimensional shape" wrongly characterises the mark and taken literally, has the effect of excluding from the subject matter of the mark those features of appearance which are not features of shape. That would be contrary to Section 39 of the Act. Accordingly, I will

consider the application in suit on the basis that they consist of “3-Dimensional” marks ie they comprise a combination of shape and appearance.

54. Firstly, I wish to consider the grounds of opposition raised under Section 3(1) of the Act, which reads:-

“3.-(1) The following shall not be registered -

- (a) signs which do not satisfy the requirements of section 1(1),
- (b) trade marks which are devoid of any distinctive character,
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade:

Provided that, 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.”

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

- (a) the shape which results from the nature of the goods themselves,
- (b) the shape of goods which is necessary to obtain a technical result, or
- (c) the shape which gives substantial value to the goods.

(3) A trade mark shall not be registered if it is -

- (a) contrary to public policy or to accepted principles of morality, or
- (b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).

(4) A trade mark shall not be registered if or to the extent that its use is prohibited in the United Kingdom by any enactment or rule of law or by any provision of Community law.

(5) A trade mark shall not be registered in the cases specified, or referred to, in section 4 (specially protected emblems).



(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.

55. The requirements of Section 1(1) of the Act are as follows:-

1.-(1) 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, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.

56. In considering the application of the above law, especially in the light of current uncertainties stemming from the references to the European Court of Justice, I am content to take on the approach helpfully set down by Ms Hinsworth in her skeleton arguments.

“Turning to consider the law in relation to the registrability of a trade mark it is clear that in order for a mark to be free of objection under Sections 3(1)(a) to (d) of the Act a sign must possess enough of a distinctive character to be perceived as an indication of trade origin by the relevant class of persons or at least a significant proportion thereof (see paragraphs 44, 46 and 52 of *Windsurfing Chiemsee Produktions-und Vertriebs v. Boots-und Segelzubehor Walter Huber and Franz Attenberger* [1999] ETMR 585 (ECJ)).

A sign possesses a distinctive character if goods identified by it would be thought by the average consumer to have come (directly or indirectly) from one and the same undertaking as envisaged by in paragraphs 27 and 28 of *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] ETMR 1 (ECJ)

A sign which cannot be expected to perform that essential function to the required extent is liable to be excluded from registration by one or more of the provisions of Section 3(1)(a) to (d) of the Act. The four paragraphs of Section 3(1) of the Act are not mutually exclusive in this respect (see paragraph 33 of the judgment of Morritt LJ in *Bach Flower Remedies Trade Marks* [1999] IP & T 146).

In order to be registrable as a trade mark, a shape must not only be distinctive in the sense of being different and eye-catching, but also must be distinctive as a badge of origin. It is insufficient to show that the subject matter is new and visually distinctive; it must be distinctive in a trade mark sense.

This point was most recently reiterated in the High Court by Laddie J in *Re Kabushiki Kaisha Yakult Honsha's Application* 8<sup>th</sup> March 2001 (unreported), an appeal relating to the application to register the shape of a container, where the judge stated the law to be as follows:

“The fact that a particular design is eye-catching because it is unusual or

decorative is not enough by itself. At all times the Registry has to ask whether the design is distinctive as a badge or origin. The exercise to be undertaken was described by the European Court of Justice in *Lloyd Schuhfabrik & Co GmbH v Klijsen Handel BV* [2000] FSR 77:

“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 is registered as coming from a particular undertaking, and thus to distinguish those goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those 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 .....” (Para 22).

In my view the same point was made even more succinctly by Lloyd J in *Dualit Limited's (Toaster Shape) Trade Mark Application* [1999] RPC 890, a case concerning an application to register the shape the shape of an electric toaster as a trade mark;

‘..... Does (the mark) have a meaning denoting the origin of the goods?’ (P.897).

Where inherent distinctiveness is concerned, the Registry has to find that the mark performs the function of identifying the origin even before the public is educated that it is to be used for that purpose. Where invented, non-descriptive word marks are used, it may be easy to come to such a finding, but where a container is in issue it may well be more difficult. As (Counsel for the Appellants) rightly conceded, the fact that a container is unusual or attractive does not, per se, mean that it will be taken by the public as an indication of origin. The relevant question is not whether the container would be recognised on being seen a second time, that is to say, whether it is of a memorable appearance, but whether by itself its appearance would convey trade mark significance to the average consumer. For the purpose of this appeal, I am prepared to accept that the bottle shape, which is the subject of these application, is both new and visually distinctive, meaning that it would be recognised as different to other bottles on the market. That does not mean that it is inherently distinctive in a trade marks sense”.

Further “In Bach Flower Remedies Trade Marks [2000] RPC 513, the Court of Appeal confirmed that the meaning and significance of a sign may depend on the manner in which it has been used; that it is “**permissible and necessary**” to determine the meaning and significance a sign would possess when used at the date upon which it is put forward for registration; that use of a sign does not of itself prove that the sign is distinctive; that increased use does not of itself do so either; and that use and increased use must be in a distinctive sense in order to have any materiality:

see, in particular, paragraphs 31-35 of the judgment of Morritt L.J...”

In addition in Philips Electronics v Remington [1999] RPC 809 (CA) Aldous LJ considering the position under Section 3(1) stated at page 817:

“I do not believe that the fact that a trade mark has by use become such as to denote goods of a particular trader necessarily means that it is capable of distinguishing as required by Section 1 (Article 2) ..... Thus a person who has had a monopoly use of a trade mark for many years may be able to establish that it does in fact denote his goods exclusively, but that does not mean that it has a feature which will distinguish his goods from those of a rival who comes into the market. The more the trade mark describes the goods, whether it consists of a word or shape, the less likely it will be capable of distinguishing those goods from similar goods of another trader.”

And at page 81 line 25:

“Shapes such as shown in the trade mark are pictorial description of products. The test for registrability is the same for shapes as that for word marks ..... But that [submission] avoids the question of whether a picture of a three-dimensional article which is purely descriptive of the article is registrable. In my view the definition in the Act and the Directive prevents that happening. No doubt an application to register a picture of a reel of cotton or a flag for coffee would succeed as they are not descriptive of the goods for which registration is sought; but that does not mean that a shape of an article is registrable in respect of the article shown in the application. To so hold would enable a few traders to obtain registrations of all the best designs of an article and thereby monopolise those designs. In my view a shape of an article cannot be registered in respect of the goods of that shape unless it contains some addition to the shape of the article which has trade mark significance. It is that addition which makes it capable of distinguishing the trade mark owner’s goods from the same sort of goods sold by another trader.”

Previously Jacob J had indicated in *British Sugar v James Robertson* [1999] RPC 281 that it was illogical to assume that use equalled distinctiveness. The judge also indicated that it would be wrong to accept evidence of use, by itself, as evidence of distinctiveness, particularly where the mark applied for had in practice always been used together with another distinctive mark.”

57. At the hearing Ms Hinsworth argued that the marks in suit did not meet the requirements of Section 3(1)(a) as they consisted of a sign which is effectively generic for cakes (similar goods); that there is no addition to the shape of the article which has trade mark significance; and in relation to ice cream products the applicant has, by virtue of its patent rights, had a virtual monopoly in the UK. Furthermore, in relation to Section 3(1)(b) it was contended that the mark applied for had not been used without the distinctive trade marks VIENETTA and WALLS and that the evidence of use and the survey evidence should not be accepted as

evidence of distinctiveness in that they do not demonstrate that the marks in suit would be considered by the customer as a badge of origin.

58. In Ms Hinsworth's submission the shape of the applicant's product is that of a Mille Feuille, a cake confection or patisserie, and this should be taken into account in connection with the potential for infringement under Section 10(2) of the Act, when considering the registrability of the mark applied for. Her arguments on this point are based upon an extract from the Financial Times dated 6 October 1987 which was submitted with Mr Hebel's statutory declaration of 10 July 1998 (at Exhibit MH 10) filed on behalf of the applicant. The article included the following description in relation to the WALLS VIENETTA product:-

“Based on traditional Mille Feuilles, made of layers and pastry and cream, Wall's substituted pastry with ice cream, cream with chocolate, but retained the overall design impact”.

59. On behalf of the applicants, Mr Miller countered that the Financial Times extract was merely the view of an unidentified journalist, not accepted by the applicant. It could not be regarded as expert evidence on the issue. I must agree with Mr Miller on this point. The onus is upon the opponent to substantiate its assertion through evidence and they have failed to do so. Beyond the statement of a journalist, whose identity and qualification are unknown, there is absolutely no evidence that the mark applied for consists of a generic shape for cakes. Further, even if it is, I do not believe that this prevents a finding that the shape has acquired a distinctive character for a different albeit similar product. In this respect I note that the proviso to Section 3(1) applies to trade marks which are prima facie excluded from registration by Section 3(1)(d). Accordingly, unless the sign is excluded by Section 3(1)(a), the fact that the shape may be customary for similar goods cannot be decisive. In this connection I note that in Dualit (referred to earlier in this decision) Lloyd J reversed the decision of the Registrar's Hearing Officer under Section 3(1)(a) observing that the styling features of a product may have trade mark significance. If the same or closely similar shape is generic for cakes the answer to any Section 10(2) infringement action can be found in Section 11(1) of the Act which safe guards the rights of other traders to continue to use signs which designate the kind of goods concerned. The generic shape of a product must designate the kind of product at issue. It cannot be correct to deny registration of a shape for goods for which it is distinctive on the basis that it is not distinctive for different, albeit similar, goods.

60. The applicants accept that other competing products exist in the ice cream dessert market but submit that their product's appearance is capable of distinguishing, in particular because its overall complexity which stems from the contrasting layer shapes and the adaptation of the “wave like” patterns which run along the side of the product. In this regard, Mr Miller drew my attention to the decisions reached in the German and Dutch Courts. However, I have no need of their assistance. In my view, the stylised features present in the marks in suit mean that the overall appearance is visually distinctive, in that it would be recognised as different to other ice cream dessert products or ice cream products on the market. However, it does not follow that it is inherently distinctive in a trade mark sense and this is a point which I must consider later in this decision.

61. The opponents have also argued that the applicant's patent rights have, in effect, given them a virtual monopoly in the UK in relation to the shape of the mark applied for. However, in my view the evidence submitted by the applicant in the statutory declaration of Mr Hugot rebuts the opponent's claim that the shape of the applicant's product is the shape that results from the application of the patent rights. Furthermore, at the hearing, Mr Miller drew attention to the contents of the Patent claims (attached to Ms Dixon's statutory declaration of 16 June 1997 at Exhibit SD8), in particular to the penultimate paragraph of page 8 of the claims, where it states:-

“That there is no need to control the process so that the product is precisely uniform : indeed an advantage of the described multilayer product and process is that the process variables can easily introduce a periodic or other non-uniformity in the product which adds to its attractiveness for the customer.”

62. It also seems to me that the patents cover the process for producing the internal structure of the product and do not determine the external appearance of the waves and horizontal lines of extruded ice cream that decorate the sides of the product. Thus although the patent may have a bearing on the appearance of the ends of the product, the remainder of the appearance is determined by “capricious features”. Accordingly, I do not believe that registration of the application in suit will prevent other traders from exploiting the patents once they expire.

63. In my view the opponent has failed to establish that the marks in suit do not meet the requirements set out in Section 3(1)(a) and Section 1(1) of the Act and I need now to go on and consider the position under Section 3(1)(b).

64. The applicant for registration has filed evidence of use and survey evidence in support of the application. This goes to the proviso to Section 3(1). In accordance with this proviso, if, notwithstanding the absence of inherent distinctiveness, it can be shown that a mark has in fact acquired a distinctive character as a result of the use made of it, it can be registered. The crucial date for this exercise is the date of application for registration, which in the present case is 31 October 1994.

65. Sales of the applicant's product are considerable and are detailed at paragraph 19 of this decision. In 1993 the applicant's VIENETTA product had a 65.2% share of the pre-prepared ice cream dessert market. Furthermore, the product has been heavily promoted through press and television advertising and through other media, details of which are at paragraphs 14 to 18 of this decision.

66. Quite rightly, Ms Hinsworth pointed out that use of a mark does not necessarily demonstrate distinctiveness. She pointed out that the application in suit were sold and promoted under the VIENETTA brand name and the WALLS house mark. In her view the mark in suit would not be recognised as a trade mark by customers. In response, Mr Miller contended that the shape and appearance of the product features strongly on the packaging and in the advertisements of the applicant and was an additional indication of origin to the brand and house name. He pointed out that, on occasion, the product was promoted without the brand name VIENETTA, the advertisement merely illustrating the appearance of the

product with the house mark WALLS.

67. It seems to me that the applicant's use and promotion of the VIENETTA product has invariably emphasised the products appearance including its shape, in effect the sign the subject of the application in suit. The nature and extent of the use may have therefore educated the customer that the shape and appearance of the product, identifies goods of one and the same undertaking ie it serves the function of a trade mark. In this regard I go on to consider the survey evidence filed on behalf of the applicant for registration. A summary of the survey evidence together with the opponent's evidence in reply is at paragraphs 29 to 51 of this decision.

68. At the hearing, Ms Hinsworth was highly critical of the survey evidence, stating that - the date of the survey was nearly four years after the date of application; that it was carried out using photographs of the products not the products themselves; that the formatting of the questions was leading; that at least one of the interviewees was prompted; that the size of the survey was insufficient; and that, at best, the results showed no more than product recognition, as opposed to trade mark recognition. However, it seems to me that the criticisms do not detract from the overall worth and value of this particular survey. The late date of the survey is not fatal given the extent and nature of the applicant's use prior to the date of application and in my opinion the applicant's have provided satisfactory explanations in relation to most of the criticisms eg the instance of prompting and the use of photographs of the products, none of which detract from my view that, overall, the survey was fairly conducted. As Mr Miller pointed out, all surveys can be subjected to some form of criticism.

69. Turning to whether the survey demonstrates recognition of the mark in suit as a trade mark, I have no doubt that, overall, the survey denotes a high degree of product recognition of the representation covered by application number 2000662. I acknowledge the opponent's concerns on the survey, including those of Mr Emsden in his Statutory Declaration of 9 December 1999, where amongst other criticisms he points out that the statistical accuracy of the survey is open to doubt - Mr Emsden says 6 to 10%. However, even if Mr Emsden's top figure is taken, this would suggest that the proportion of the relevant class of persons who recognised the product is 50 out of 82, rather than 55, and 96% of these identified the applicants as the source of the product. It must follow that the mark identified the source of the goods to at least 48 of the 82 asked. This is a significant proportion of the relevant public even if the survey is statistically flawed to the maximum extent suggested by the opponent. Staying with Mr Emsden's criticisms of the survey, in particular that question 3 - "Do you recognise any, and if so, can you identify them?" - invited people to guess an answer, I would comment that the relatively small number of persons (8) who named other products either alone or as well as the applicants mark No 2000662 as Vienetta, suggests that most respondents were not guessing. It seems instead to be an echo of the vast promotion of the shape and appearance of the product which the applicant has engaged in for many years. I regard the survey to be of considerable assistance to the applicant in this case.

70. In effect, the shape of the applicant's product possesses a distinctive character in that customers distinguish the applicant's product from competing products by virtue of its shape and appearance. I should add that as the applicant's survey evidence demonstrates no

likelihood of confusion by the average consumer between the shape and appearance of the applicant's product as depicted in the survey (Application No 2000662) and the shape and appearance of, to use the applicant's words "the products most similar the VIENETTA product available in the UK market", the scope of protection arising from the registration of such a mark must be somewhat narrow. A point accepted by Mr Miller at the hearing.

71. The opposition under Section 3(1) of the Act fails in relation to application number 2000662 as, in my view, the mark in suit has in fact acquired a distinctive character as a result of the particular use made of it. However, given that the scope of protection arising from marks of this nature is relatively narrow and as the applicant's evidence related only to the mark represented under application number 2000662, the opposition under Section 3(1) of the Act succeeds in relation to number 2000661 as, in my opinion, the evidence does not demonstrate that this particular mark has in fact acquired distinctive character.

72. Next, I turn to the ground of opposition raised under Section 3(2)(a) of the Act, which states:-

"A sign shall not be registered as a trade mark if it consists exclusively of -  
the shape which result from the nature of the goods themselves,"

73. At the hearing, the opponents submitted that following a technical development, the applicants were able to apply the generic shape for a type of cake (a Mille Feuille) to a new product made of ice cream and chocolate and that the application in suit seeks to monopolise the generic shape of a cake on the basis of a technology which allows production of an article that is of identical shape made of ice cream.

74. Firstly, as stated earlier in this decision, the opponent has submitted no evidence that the mark applied for consists of a generic shape. Secondly, in my view, Section 3(2)(a) is concerned with, in effect, the natural shape of goods and as pointed out by the applicant, given that the goods applied for are ice cream products, the shape of the mark in suit cannot be said to result from the nature of the goods themselves. I am fortified in this view by the following comments of Aldous L J in *Phillips Electronics NV v Remington Consumer Products Ltd* [1999] RPC 809, at page 820, lines 37-44:-

"Subsection 2(a) has to be construed in the context of subsections (b) and (c). It is intended to exclude from registration basic shapes that should be available for use by the public at large. It is difficult to envisage such shapes, except those that are produced in nature such as bananas. But I believe that the judge was right to conclude that the trade mark was not prevented from registration by this subsection. The trade mark is registered in respect of "electric shavers". There is no one shape, let alone that depicted in the trade mark, which results from the nature of such shavers."

The opposition under Section 3(2)(a) fails.

75. Finally, I consider the ground of opposition under Section 3(6) of the Act, which reads:

“A trade mark shall not be registered if or to the extent that the application is made in bad faith”.

76. At the hearing I was referred to *Gromax Plastics Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367, where Lindsay J stated at page 379:

“I shall not attempt to define bad faith in this context. Plainly it includes dishonesty and, as I would hold, includes also some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined. Parliament has wisely not attempted to explain in detail what is or is not bad faith in this context; how far a dealing must so fall-short in order to amount to bad faith is a matter best left to be adjudged not by some paraphrase by the courts (which leads to the danger of the courts then construing not the Act but the paraphrase) but by reference to the words of the Act and upon a regard to all material surrounding circumstances.”

77. Thus bad faith can be exercised where there is no actual dishonesty as such. Have the applicant’s fallen short of the standards of acceptable commercial behaviour, however? At the hearing, Ms Hinsworth’s submission on the issue was that the applicant, through the application in suit, was attempting to extend and/or prolong indefinitely the protection provided by their UK patents, thus preventing other manufacturers from producing products which they would otherwise be entitled to do after the expiry of the patents. In the light of my findings under Section 3(1) earlier in this decision, this ground cannot succeed. The opposition under Section 3(6) fails.

78. As the applicant has been successful in relation to application number 2000662 and the opponent successful in relation to number 2000661, I make no order as to costs.

**Dated this 09 Day of August 2001**

**John MacGillivray  
for the Registrar  
The Comptroller General**

Annex A: Order a copy