

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION 2197415 TO REGISTER A TRADE MARK IN CLASS 30

DECISION AND GROUNDS OF DECISION

On 14 May 1999 Unilever PLC of Port Sunlight, Wirral, Merseyside applied under the Trade Marks Act 1994 for registration of a trade mark in Class 30 for the following goods:

Ice cream, water ices; frozen confectionery; preparations for making the aforesaid goods; all included in Class 30.

The mark for which registration is sought is represented at Annex A.

The following words appear on the form of application:

The mark consists of a three dimensional shape.

Objection was taken to the mark under Sections 3(1)(b) and (c) of the Act because the mark consists of a three dimensional device of a dispenser, being devoid of any distinctive character and a sign which may serve in trade to designate the intended purpose of the goods eg. dispenser/container for dispensing eg. ice cream, frozen confections.

Objection was also taken under Section 3(2)(b) of the Act because the mark consists of the three dimensional shape of the goods which is necessary to obtain a technical result.

Following a hearing, at which the applicants were represented by Mr Hickey of Castles, their trade mark attorneys, the objections were maintained and notice of refusal was issued on 9 May 2001.

Following refusal of the application under Section 37(4) of the Act I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Mark Rules 2000 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.

Firstly, I shall address the objection under Sections 3(2)(b) of the Act, details of which are set out below:

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

(b) the shape of goods which is necessary to obtain a technical result,

In his submissions Mr Hickey argued that the sign applied for does not consist exclusively of the shape of goods necessary to obtain a technical result. Mr Hickey submitted that the shape of the container is fanciful in respect of ice cream and likened the shape to that of a Dalek, which is a robot made famous by the Dr Who television series. Mr Hickey also argued that the aperture in the container could be placed anywhere but stated that it is more natural for such an opening to be placed at the top of the container.

The sign applied for consists of a container with a lid. The actual body of the container is cylindrical in shape but with the sides narrowing towards the top. The lid is domed in shape but has additional features. As far as I can ascertain the lid incorporates a hinged system which enables a recessed pouring spout to be accessed so that the contents may be poured from the container. At my request Mr Hickey forwarded a sample of the actual container for my perusal and I note that the packaging contains instructions on how to access the contents. It clearly states that the mechanism on the top of the lid should be lifted to allow access and pressed to close it after use.

Mr Hickey pressed upon me that I am required to consider the totality of the sign applied for and not to consider the lid in isolation and I accept that this is the appropriate test. However, in my view the sign applied for is a container in an ordinary shape which has no purpose other than to store and dispense the goods contained within it. In these circumstances I consider that the shape of goods includes the shape of packaging for the goods.

In *Phillips Electronic NV v Remington Consumer Products* [1999] RPC page 809 Aldous L J said:

“In my judgement the restriction upon registration imposed by the words “which is necessary to obtain a technical result” is not overcome by establishing that there are other shapes which can obtain the same technical result. All that has to be shown is that the essential features of the shape are attributable only to the technical result. It is in that sense that the shape is necessary to obtain the technical result. To adopt the meaning suggested by Philips will enable a trader or traders to obtain registration of all the alternative shapes that were practicable to achieve the desired technical result. That would result in the subsection being given a meaning which would not achieve the purpose for which I believe it was intended.”

and

“As I have already pointed out, the trade mark does not contain any feature having trade mark significance. It is a combination of technical features produced to achieve a good practical design.”

The Court submitted various questions to the European Court of Justice, including one intended to establish the true scope of Section 3(2)(b), which is intended to implement Article 3(1)(e), second indent, of Directive 104/89. Whilst the European Court of Justice has not yet provided answers to these queries the Advocate General has given his opinion as follows:

“The second indent of Article 3(1)(e) of the First Council Directive (89/104/EEC) of 21 December 1988 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning any shape the essential features of which serve

the achievement of a technical result must be regarded as a sign which consists exclusively of the shape of the goods which is necessary to obtain such a result, irrespective of whether it is possible to achieve that result using other shapes. If a sign meets those conditions, there is no need to consider whether it has any distinctive character.”

Taking the best view I can of the matter, I have come to the conclusion that in substance the shape applied for solely achieves a technical result. I therefore conclude that the sign is debarred from registration by Section 3(2)(b) of the Act.

Objection under Section 3(2)(b) of the Act cannot be overcome by the applicants demonstrating that the mark possesses distinctive character. It is, therefore, unnecessary for me to go on and consider the submissions on distinctiveness put forward by the applicants. Nevertheless, in case I am found to be wrong in my primary findings, and for the sake of completeness, I will do so.

Section 3(1)(b) and (c) of the Act reads as follows:

3.-(1)

(b) trade marks which are devoid of 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,

The test for 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?”

Further guidance may be found in Massland NV’s Application 2000RPC 893 at page 903 lines 49 - 50 and page 904 lines 1 - 6 where Geoffrey Hobbs QC, in his role as the Appointed Person, said:

“It would not be right, in the light of the words I have italicised, to overlook or ignore the presence of functional or technical features in a three-dimensional shape when assessing whether the shape in question possesses enough of “*a distinctive character*” to be registrable as a trade mark. Such features “*may serve, in trade, to designate the kind, quality ... intended purpose ... or other characteristics*” of the relevant goods to an extent that renders the shape as a whole unregistrable under one or more of the provisions of section 3(1)(a) to (d) of the Act (articles 3(1)(a) to (d) of the Directive).”

In his submissions in support of this application Mr Hickey argued that the sign applied for is unusual for ice cream packaging and is capable of signifying trade origin. I was referred to

Lloyd Achuhfabrik Meyer BmbH -v- Klijsen Handel BV [1999] ETMR 10 and reminded that there is a need to assess the sign globally when considering if the sign has any distinctive character. I was also referred to an application by S M Jaleel & Company Limited to register a three dimensional shape (Application No 2012542) where Geoffrey Hobbs QC in his role as The Appointed Person said:

“ 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).”

Mr Hickey sought to persuade me that as the same sign has been registered as a design by the Registry of Designs then the same sign should be prima facie registrable as a trade mark. However, I have difficulty in accepting this reasoning and I do not accept the submission that, should a sign achieve registration as a design, then registration as a trade mark shall follow automatically. In the Opinion of the Advocate General in the Phillips Electronic NV v Remington Consumer Products case (Case C-299/99) it was stated:

“First, a trade mark seeks to protect the identity of the origin of the goods and, therefore, indirectly, the *goodwill* which the goods attract, whereas designs - like patents - seek to protect the goods, in their own right, as an economic factor: their substantial value (in the case of designs) or the value which derives from their technical performance (in the case of patents). In that sense, it is entirely logical that the legislature is less concerned by the strict delimitation between designs and patents than by that which ought to exist between the latter and trade marks. Moreover, this makes it easier to give protection to designs that combine functional and aesthetic features.

Secondly, whereas trade marks enjoy protection unlimited in time, rights in designs - like rights in patents - are limited in time. From that viewpoint, too, it is appropriate to use a stricter test for excluding functional or ornamental shapes from registration as trade marks than that to be used in separating designs from patents.”

I do not accept that the sign applied for is distinctive as a trade mark. The sign consists of cylindrical container which tapers towards the top and a lid which is domed in shape but which incorporates additional features, the whole of which I consider to be totally functional. I do not see that there is anything in this sign which would serve to distinguish the goods of the applicant from those of other traders.

In the Proctor & Gamble Limited’s application (1999 RPC 673), Walker L J 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”

In this decision I have born in mind the comments in the unreported decision on an application by Henkel KAaG to register a 3-Dimensional shape of a tablet (International Application No 708442 dated 15 January 1999) where Geoffrey Hobbs QC in his role as The Appointed Person said:

“It seems to me that the tablet shape in question represents only a minor variation of a basic geometric shape. The colours have a degree of visual impact, but not to an extent that I would regard as particularly striking. There is every likelihood, in my view, that they would be taken to indicate the presence of two active ingredients in the relevant tablets and, as a corollary to that, every likelihood that they would not be perceived as possessing significance in terms of the trade origin of the goods.

The question is whether the degree of individuality imparted to the tablets by the features of shape and colour in combination is sufficient to render them not merely distinguishable from other such goods, but distinctive in terms of trade origin.

Giving the matter the best consideration I can, I think that the appearance of the tablets put forward for registration is not sufficiently arresting to perform the essential function of a trade mark. In the absence of distinctiveness acquired through use, the mark put forward for registration was, in my view, devoid, by which I mean unpossessed, of a distinctive character, and therefore excluded from registration by section 3(1)(b) of the Act at the relevant date.

In the unreported decision on the applications by Reemtsma Cigarettenfabriken GmbH to register a 3-Dimensional shape of a cigarette packet (Applications Nos 2031898 and 2031899 dated 25 August 1995) Geoffrey Hobbs QC, in his role as the Appointed Person, said:

“On the basis of my general awareness of cigarette packaging acquired through exposure to it as a (non-smoking) member of the public, I think that the features I have mentioned render the Applicant’s packaging distinguishable from the general run of cigarette packaging in relatively small details which provide it with a low, but not negligible, degree of individuality. The question is whether the degree of individuality imparted by those features is sufficient to render the packaging not merely distinguishable, but distinctive of the trade origin of the goods it contains. I have not found it easy to answer that question on the basis of the materials before me. Giving the matter the best consideration I can, I think that the get-up (in terms of the shape and colour) of the packaging put forward for registration is aesthetically pleasing without also being sufficiently arresting *per se* to perform the “essential function” of a trade mark (as identified in Canon paragraph 28). In the absence of distinctiveness acquired through use it was, in my view, devoid (by which I mean unpossessed) of “*a distinctive character*” and therefore excluded from registration by Section 3(1)(b) of the Act (Article 3(1)(b) of the Directive) at the relevant date.”

At the hearing Mr Hickey explained that in relation to this sign the main goods of interest are “Ice cream and water ices”. I note that the specification of goods have not been limited to

reflect this particular area of interest but even if it was so limited my decision would not require any amendment as I consider the objections to be equally valid for these particular goods.

In my view the sign applied for will not be taken as a trade mark without first educating the public that it is a trade mark. It follows that this application is debarred from prima facie acceptance by Section 3(1)(b) of the Act.

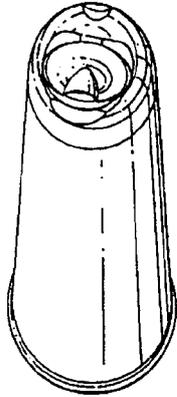
In this decision I have considered all the documents filed by the applicants and all the arguments submitted to me in relation to this application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act in that it fails to qualify under Sections 3(1)(b), 3(1)(c) and 3(2)(b) of the Act.

Dated this 23RD day of August 2001

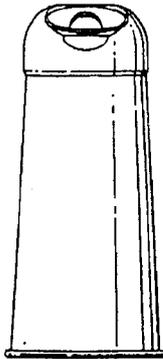
A J PIKE

**For the Registrar
The Comptroller General**

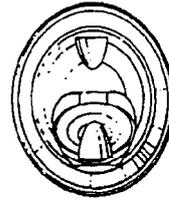
ANNEX A



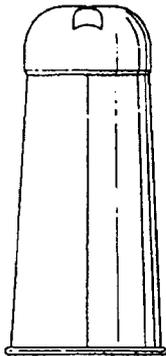
FRONT PERSPECTIVE FROM ABOVE
AND ONE SIDE



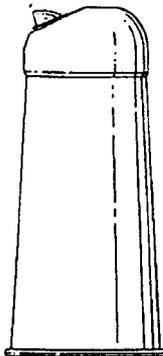
FRONT VIEW



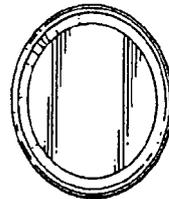
PLAN VIEW



REAR VIEW



SIDE VIEW
OTHER SIDE CORRESPONDS



UNDERNEATH PLAN VIEW