

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION 2069522 TO REGISTER A TRADE MARK IN CLASS 20

DECISION AND GROUNDS OF DECISION

On 19 April 1996 Gratnell's Limited of 258 Church Road, London, E10 7JQ applied under the Trade Marks Act 1994 for registration of a series of two trade marks in Class 20 for the following goods:

Trays; storage trays; trays of plastic for storage; stackable trays, nestable trays; shelving; shelves; storage apparatus; storage frames; cabinets; storage trolleys; racks and racking; furniture; parts and fittings for all the aforesaid goods; all included in Class 20.

The marks for which registration is sought are represented at Annex A.

The following words appear on the form of application in respect of both marks:

The trade mark consists of the shape of the end of the tray shown in the representations.

Objection was taken to the marks under Sections 3(1)(b) and (c) of the Act because the marks consist exclusively of the device of a storage tray being signs which may serve in trade to designate the kind and intended purpose of the goods.

Objection was also taken under Sections 3(2)(a) and (b) of the Act because the marks consist exclusively of the shapes which result from the nature of the goods themselves and the shapes of goods which are necessary to obtain a technical result.

At a later date further objection was taken under Section 3(1)(a) of the Act. However, this objection was subsequently waived and I need make no further mention of it in this decision.

Evidence of use of the marks was filed on 28 July 1997 with the purpose of showing that the marks had acquired a distinctive character as a result of that use. However, this evidence was not considered sufficient to overcome the objections which were maintained.

At a hearing, at which the applicants were represented by Mr Lynd of Edward Evans & Co, their trade mark agents, the objections were maintained. Further evidence was filed in support of this application but the objections were again maintained and notice of refusal was issued on 16 May 2001.

Having considered the matter further I have concluded that the objection under Section 3(2)(a) of the Act may be waived. The objections under Section 3(1)(b), 3(1)(c) and 3(2)(b) of the Act are maintained.

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.

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,

The applicants submitted evidence in support of this application. This evidence is in the form of a Statutory Declaration dated 19 June 1997 by Mr N A Hudson, Managing Director of Gratnell's Limited (the applicants) together with supporting exhibits. Exhibit NAH-1 consists of a brochure produced by the applicants illustrating storage trays which the applicants refer to as "School Trays". This brochure clearly shows the shapes of the ends of the trays and demonstrates the various ways in which the trays may be used such as stacking, nesting or being divided. The brochure states that: "The tray can either have the handle cut-out with side stops or be plain in front to fit either way into wooden furniture". In my view this statement together with the representation of the trays when stacked, makes it perfectly clear that the applicants are referring to the shapes of the ends of the trays as a "handle cut-out". The photograph of the stacked trays makes it clear that the shapes applied for are the shapes of the handle cut-out which exists only to facilitate access to a particular tray. I note that the trays in question are available with the handle cut-out or in plain format. The same brochure shows the trays fitted in furniture and it is clear that the handle cut-out performs the function of facilitating access to a particular tray. There is nothing in this evidence which supports the view that the shapes applied for are anything but functional.

Further evidence was submitted in the form of a Statutory Declaration dated 4 June 1999 by Mr Hudson. In this Statutory Declaration Mr Hudson states that "The floor of the wedge shape extension appearing on the end of the tray does have a function in that when two identical trays are stacked together the floor portion of the wedge shape extension sits on an internal projection located at the other end of another tray. The concave depression at the top of the end of the tray is to act as handle but I emphasize that this concave depression does not have to be this shape and is therefore not "the shape of goods which is necessary to obtain a technical result"."

In a further Statutory Declaration dated 21 June 1999 Mr Hudson exhibits samples of different trays. Exhibits NAH10A, NAH10B and NAH11 are samples of trays produced by the applicants whereas Exhibits NAH12, NAH13, NAH14 AND NAH15 are trays which are different in shape and produced by other manufacturers.

It is clear from the evidence filed that the signs applied for are the shapes adopted by the applicants to form a cut-out handle at the ends of trays. It is also clear from the evidence that when the trays are placed in the stacked position the cut-out handle enables the trays incorporating the handle to be accessed and for the trays above to be accessed by lifting off those below. There are, of course, other shapes which may be utilised to form cut-out handles at the ends of a tray and details of some of these shapes are provided in the evidence.

In *Philips 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 shapes applied for solely achieve a technical result. I therefore conclude that the signs are 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 marks have in fact acquired a distinctive character through use. It is, therefore, unnecessary for me to go on and consider the evidence of distinctiveness put forwarded 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 proviso to Section 3(1) reads as follows:

A trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the relevant date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

It is clear from the proviso that the application must be judged as at the date of application i.e. 19 April 1996.

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 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.”

In my view the application is excluded from acceptance, *prima facie*, because the shapes applied for designate the kind and intended purpose of the goods and are thus excluded from registration under Sections 3(1)(b) and (c) of the Act. The applicant does not appear to dispute this but relies on evidence of acquired distinctiveness.

The applicants filed evidence in support of this application. Trays incorporating the signs applied for were initiated in 1987 and further developed in 1988. These trays are sold particularly to schools and hospitals through the local authorities within the United Kingdom. The applicants’ evidence did not include details of the numbers of trays sold but the following information was provided by Edward Evans & Co by way of a letter dated 9 January 1998:

TURNOVER		ADVERTISING AND PROMOTION	
DATE	£	DATE	£
1991	322,000	1991	66,050
1992	762,500	1992	59,240
1993	1,382,000	1993	91,990
1994	1,875,300	1994	115,240
1995	2,470,500	1995	122,330
1996	2,235,500	1996	132,580

However, I do not find this evidence persuasive as the use shown is not material. This evidence does not show that the applicant has set about educating the relevant public that goods of the shapes in question designate it's goods. In this conclusion I find support in the comments of Morritt L J in *Bach Flower Remedies* 2000 RPC 513 at page 530 lines 19 - 21 where he said:

“First, use of a mark does not prove that the mark is distinctive. Increased use, of itself, does not do so either. The use and and increased use must be in a distinctive sense to have any materiality.”

Further evidence is provided in the form of seven completed questionnaires which are exhibited at Exhibit NAH-7. However, there is no information regarding the total number of questionnaires sent out nor are there any details of the number of respondents, or potential respondents, who did not recognise the signs applied for. Furthermore, the questionnaire makes it clear that the respondents were shown representations of the signs applied for but no details of these representations were included in the evidence submitted. However, in his Statutory Declaration dated 21 June 1999, Mr Hudson declares that only seven questionnaires were sent out and that these were sent to seven of the applicants' largest customers for these goods. The questionnaires were not sent out with a covering letter but under the cover of a compliment slip bearing the applicants' name and address; a representation of this compliment slip is filed as Exhibit NAH9. In my view the presence of the compliment slip bearing the applicants' name and address will immediately inform the respondent of the identity of the applicants which will be an influencing factor as to the content of their responses. Furthermore I do not consider these goods to be specialised in any way but rather basic consumer items which are available in numerous retail and wholesale establishments. I also take note of the fact that the seven questionnaires were sent to the applicants' seven largest customers who will by definition be very familiar with this particular product and in my view little weight can be given to this evidence.

Following the hearing I rejected this evidence and maintained the objection.

Further evidence in the form of three Statutory Declarations together with three completed questionnaires were subsequently filed. Again there is no evidence explaining how these respondents were selected or if the applicants approached other possible respondents but received either unfavourable responses, or alternatively, no responses at all. I also note that

there is nothing to indicate if the questionnaires were again sent out under cover of a compliment slip or whether they were sent out under cover of an accompanying letter or indeed if they were sent out by the applicants or a third party acting on their behalf. However, each questionnaire is accompanied by a representation of the signs applied for which was shown to each respondent. Again it appears that the three respondents are all customers of the applicants. I also note that the respondents appear to be buyers for educational establishments. Even if their evidence proved that the marks are distinctive in the educational field this is just one sector of the market for plastic storage trays. For the reasons I gave earlier I consider that I can give little weight to this evidence.

In assessing this evidence I am guided by the appropriate section of the Trade Marks Work Manual, Chapter 6, paragraph 7.4.7 which states:

“Where the goods or services are not specialised, the fact that trade experts (who by definition, are likely to be much more familiar than the general public with the signs used in the trade) regard the applicant’s sign as a trade mark may not be representative of the public at large. However, such evidence may still assist an application to the extent that it establishes that the applicant’s mark is unique in the trade.”

The key authority for acquired distinctiveness is *Windsurfing Chiemsee Produktions Und Vertriebs GMBH v. Boots-Und Segelzubehor Wlater Huber* (C109/97) [1999] E.T.M.R. 585 at 46 and the relevant test, which is set out in the second emboldened answer following paragraph 55, is:

“2. The first sentence of Article 3(3) of the First Directive 89/104/EEC is to be interpreted as meaning that:

— a trade mark acquires distinctive character following the use which has been made of it where the mark has come to identify the product in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product from goods of other undertakings;

— it precludes differentiation as regards distinctiveness by reference to the perceived importance of keeping the geographical name available for use by other undertakings;

— in determining whether a trade mark has acquired distinctive character following the use which has been made of it, the competent authority must make an overall assessment of the evidence that the mark has come to identify the product concerned as originating from a particular undertaking and thus to distinguish that product from goods of other undertakings;

— if the competent authority finds that a significant proportion of the relevant class of persons identify goods as originating from a particular undertaking because of the trade mark, it must hold the requirement for registering the mark to be satisfied;

— where the competent authority has particular difficulty in assessing the distinctive character of the mark in respect of which registration is applied for,

Community law does not preclude it from having recourse, under the conditions laid down by its national law, to an opinion poll as guidance for its judgment.”

On the basis of this evidence the applicant has come nowhere near satisfying that test.

In my view the signs applied for have not acquired a distinctive character as a result of the use made of them and will not be taken as trade marks by the relevant public. It follows that this application is debarred from prima facie acceptance by Section 3(1)(b) and (c) 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 23 day of August 2001

A J PIKE

**For the Registrar
The Comptroller General**

Annex A: Order a copy

ANNEX A