

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2033242
BY DIXON INTERNATIONAL GROUP LIMITED
TO REGISTER A TRADE MARK
IN CLASS 06**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No 46520
BY HAZEL MARY ALLMAND SMITH
AND PETER JOHN ALLMAND SMITH
trading as STORMGUARD SILLS**

TRADE MARKS ACT 1994

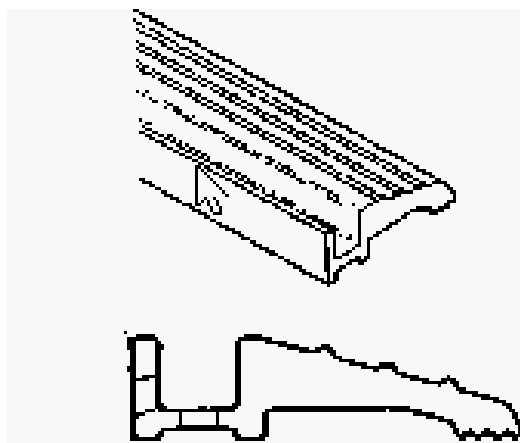
**IN THE MATTER OF Application No 2033242
by Dixon International Group Limited
to register a Trade Mark
in Class 06**

and

**IN THE MATTER OF Opposition thereto under No 46520
by Hazel Mary Allmand Smith and Peter John Allmand Smith
trading as Stormguard Sills**

BACKGROUND

1. On the 30th August 1995, Dixon International Group Limited (“the applicants”) applied to register a trade mark under application No. 2033242 in Class 06. The mark is reproduced below:



2. The application was accepted and published in Trade Marks Journal No 6154 on the 4th December 1996 for a specification reading:

“Seals; fire seals; smoke seals; acoustic seals; buffer seals; building elements; draught sealing; weather sealing; intumescent sealing; household seals; stop seals; door seals; window seals; door sills wholly or predominantly of metal; weatherboards; rain deflectors; threshold strips; metal extrusions for sealing purposes; aluminium extrusions; aluminium in strip form.”

The following clauses also appeared in the above advertisement:

“The mark consists of a 3-dimensional shape of an extrusion.”

“Proceeding because of distinctiveness acquired through use.”

3. On the 4th March 1997, Hazel Mary Allmand Smith and Peter John Allmand Smith trading as Stormguard Sills (“the opponents”), filed a notice of opposition, accompanied by a statement of grounds for the opposition. They say they are designers and manufacturers of, amongst other things, door seals, window sills, draught excluders and extrusions and have the benefit of Copyright/Design right in the same. They also give details of their United Kingdom Registered Design for a door draught excluder, United Kingdom Registered Design No 2040072.

4. The grounds on which the opponents rely are sections 1(1), 3(1)(a) (b), 3(2)(a)(b) (c), 3(3)(b), 3(4), 3(6), 5(2) (United Kingdom registered design No 2040072 for a door draught excluder is quoted Mr Allmand-Smith Mr Allmand-Smith the basis for this) and 5(4)(a) of the Act.

5. The applicants filed a counterstatement on the 30th May 1997 in which they deny all the above grounds of opposition. Both sides seek an award of costs in their favour.

6. After originally requesting to be heard, both parties then asked that a decision be taken from the papers provided in these proceedings. In fact I am also called upon to decide parallel opposition proceedings (Opposition No. 46518 against application No 2033252 for another “3-dimensional shape of an extrusion”) between these parties. The papers filed in both sets of proceedings were substantially similar and after a careful study of all the papers as they pertain to each case, I give this decision.

OPPONENTS’ EVIDENCE

7. The opponents filed a statutory declaration dated 12th February 1998 in the name of **Oliver Allmand-Smith** who describes himself as the General Manager of Stormguard Sills (the opponents). He states that the opponents have been trading since 1965 in goods such as door sills, window sills; door and window trims; threshold sills; rain excluders; rain deflectors; door and window sills, all having draught excluding qualities, draught excluders. He says that over the years the opponents have built up substantial reputation in relation to sales of these goods.

8. Mr Allmand-Smith says that the opponents have sought to protect their reputation by registering a number of trade marks and designs in the United Kingdom and quotes and exhibits (at OA-S7) eight registered trade marks and three United Kingdom registered designs (OA-S8) including No 2040072 quoted in the pleadings. He goes on to give turnover figures amounting to not less than £50, 000, 000.00. He gives recent annual turnover figures before the relevant date ranging from £3, 000, 000. 00 to £3, 900, 000. 00. Advertising expenditure over the period from when the opponents first started trading is said to be not less than £1, 000, 000. 00. Exhibits OA-S9 - OA-S12 show examples of advertising, promotional literature and brochures.

9. Mr Allmand-Smith then goes on to argue that the application, whilst he admits is capable of being represented graphically, is not a sign which is capable of distinguishing the goods of

the applicants from those of other undertakings. He states that the applicants trade mark is a representation of a draught excluder which is very similar to other draught/rain excluders on the market, particularly the opponents' own registered design No 2040072. He then goes on to further argue the case under sections 1(1) and 3(1)(a), in particular stating that even if the application can be said to have become distinctive because of the use made of it, this might only be the case if the applicants had a monopoly on the sales of the relevant goods, such that consumers would only recognise this particular shape as indicating the goods of the applicants. He says this clearly is not the case.

10. Mr Allmand-Smith then argues the case under section 3(1)(b) that as the application is a representation of the goods for which registration is sought, it must be devoid of any distinctive character. Under the section 3(2) pleadings, Mr Allmand-Smith argues that the mark in suit being the shape of a draught/rain excluder, consists of the shape which results from the nature of the goods themselves. Further he says the product is not shaped to increase its aesthetic value, it is shaped that way to achieve a technical result ie to stop wind/rain from coming through doors/windows. He points out that unlike section 3(1), there is no proviso to section 3(2) allowing registration if the mark has acquired a distinctive character as a result of the use made of it.

11. Mr Allmand-Smith then goes on to refer to registered design No 2040072 again, but this time in the context of section 5(4)(b) of the Act. He provides the additional information (compared to that in the pleadings) that the date of registration for that registered design was the 2nd July 1994. He quotes from that section of the Act that "*a trade mark shall not be registered if..... its use in the United Kingdom is liable to be prevented...by virtue of an earlier right...in particular by virtue of the law of copyright, design right or **registered designs***".

12. He comments that the said design bears more than a passing similarity to the mark in suit, and if it were to be registered, it may well be that the said registered design would be said to be an infringement of this registration, or at least passing off. It is said that registration of the application would dilute the opponents' rights in their registered design.

13. Finally Mr Allmand-Smith comments that the applicants are seeking to protect their reputation in the shape of their door/draught excluder via trade mark registration, whereas design registration should have been the correct means of protection. Registration of the application would put other traders in this field at risk of infringing this registration.

APPLICANTS' EVIDENCE

14. This consisted of the following:

- (a) a statutory declaration dated 18th December 1998 from **Michael Domenico Bilewycz** a Registered Trade Mark Agent employed by Edward Evans & Co (agents for the applicants) who is authorised to make the statutory declaration on behalf of the applicants. He exhibits MDB1 a selection of United Kingdom trade mark registrations of 3-dimensional shape marks. At MDB2 is an example of another a 3-dimensional acceptance for guttering.

- (b) A further statutory declaration from **Michael Domenico Bilewycz**, originally dated 20th January 1999, but re-declared on 9th April 1999 after technical clarification of the accompanying statutory declarations from **Linda Parry** (an Independent Fire Consultant of some 9 years experience); **Robert Mann**, Managing Director of a fire, smoke and acoustic seal manufacturing firm of some 26 years experience and **Norman England**, Principal Partner in a firm of building hardware consultants who has been in the trade for 44 years. All three attach as exhibits a completed questionnaire supplied to them by the opponents' agents (Edward Evans & Co).
- (c) A third statutory declaration of **Michael Domenico Bilewycz** dated 27th January 1999, with accompanying statutory declarations (MDB/D/E/F respectively) from **Simon Ham**, a Director, architect and fire safety engineer with some 25 years experience; **Jonathon Agar**, a Director of a firedoor/specialist door manufacturer, with 15 years experience and **Clive Andrew Edgeley**, a Commercial Director in a firm of architectural hardware distributors, with 29 years experience in the trade. Each of the above attach the same completed questionnaires referred to above on sub-paragraph (b).
- (d) A fourth statutory declaration of **Michael Domenico Bilewycz** (dated 3rd February 1999) in which he explains how and why his firm adopted the policy of attempting to gather trade evidence to support these (and other) applications by means of a questionnaire (the same questionnaire referred to at sub-paragraphs (b) and (c) above) and how the experts were selected. Exhibit MDB/trade evidence 1 is a list of twenty experts from within the door threshold seals, weatherboard strips, fire and smoke seals, stop seals for door and windows, draught and weather seals businesses. MDB/trade evidence 2 is a copy of the standard letter which formed the approach to each of the experts, together with a copy of the questionnaire and illustrations of all the marks concerned, including the mark the subject of these proceedings. MDB/trade evidence 3 are the unsworn responses from ten of the experts. One further questionnaire was returned blank. Four did not respond in any way. In total, fifteen experts are said to have returned their completed questionnaires - ten unsworn and five others (see sub-paragraphs (b) and (c) above) who were selected for statutory declarations. One further declarant (Simon Ham of Firesec - see sub-paragraph (c) above) was not on the list of twenty experts at MDB/trade evidence 1, but has submitted a statutory declaration). In total, sixteen questionnaires (ten unsworn, six sworn) have been submitted in evidence. The declarants were said to have been selected because they represented a cross section of the trade. These statutory declaration are those referred to above at sub-paragraphs (b) and (c).
- (e) A statutory declaration of **Eric Southern**, Technical Director of the applicants and of their "Sealmaster Division". Mr Southern explains the relationship between the applicants and Sealmaster (formerly a wholly owned subsidiary, now a division of the applicants). He gives some historical background to Sealmaster eg been engaged for 36 years in the manufacture and selling of draught and weather seals and of instrument seals; conceived numerous original designs for its seals, etc. Mr Southern adopts at exhibit ES1 a copy of

a statutory declaration of a late colleague and former director of the applicants (**Mr Kenneth Charles Jones**), the contents of which is summarised below but which is said to set out the trading history associated with the mark. The mark is said to have been in continuous use since 1982 and exhibit ES2/3 are catalogues said to illustrate the mark in use. The remainder of Mr Southern's statutory declaration is concerned with commenting on the legal considerations which I shall of course consider elsewhere in this decision.

- (f) Exhibit ES1 as mentioned above, is the statutory declaration of Mr Jones a former director of the applicants. He confirms the historical background of the applicants including the date of first use from 1982 and gives the turnover figures under the trade mark from 1985-1995. These range from £36,700 in 1985, to 348,400 in 1992, to £508,900 in 1994 and £500,800 in 1995. These figures are said to represent a "significant percentage" of the total British market for products of the type in suit. (NB - see also my comments at paragraph 43). Exhibits 1-5 are all said to be illustrations of the mark in use.

OPPONENTS' EVIDENCE IN REPLY

15. This is a statutory declaration of **Oliver Timothy Allmand-Smith** (the Operations Director of the opponents). Mr Allmand-Smith's evidence is a detailed response to the applicants' evidence and consists almost exclusively of comment and argument on the legal considerations under each of the pleaded grounds. I of course take account of all of these during my decision making process.

DECISION

16. As can be seen from the foregoing, a veritable plethora of grounds have been pleaded by the opponents in these proceedings. Having carefully read all the evidence and considered the issues raised and addressed therein by both parties, it is clear that there is one primary ground for the opposition case which needs to be addressed before all others and that is the section 3(2)(b) one.

17. The trade mark being opposed in these proceedings is "a 3-dimensional shape of an extrusion". In applications for shape marks, functionality or potential functionality often has an obvious and in some cases, over-riding bearing. This, I think it is fair to say, is one of those cases, although in this decision I shall also be addressing the distinctiveness grounds.

18. When first viewing the mark in conjunction with the goods for which it is applied, the first thought that appears in ones mind is, I suggest, that this is the goods for which registration is sought. It looks for all the world, like a functional object, and not an obvious subject of a trade mark application. That is not to pre-judge the issues, but merely a statement of first impression.

19. In the Opinion of Advocate General Ruiz-Jarabo Colomer in the Court of Justice of the European Community in Case C-299/99 Philips Electronics NV v. Remington Consumer Products Ltd [2001] R.P.C. 38. having found that the mark in question did *not* qualify under

Article 3(1)(e)(ii) corresponding to section 3(2)(b), he opined that it was not relevant to go further in resolving the questions of distinctiveness put to him by the National Court. I intend to at least partially adopt this approach.

The section 3(2)(b) ground:

20. Section 3(2) (b) of the Act states:

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

(a) -----

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

(c) -----

21. As well as in the Opinion of the Advocate General referred to above, the question as to what degree of functionality is permissible in a shape mark before it falls foul of this section, was considered in the Court of Appeal in the appeal which was ultimately stayed and referred to the European Court (see Philips Electronics NV v. Remington Consumer Products Ltd [1999] R.P.C. 809). In both of these authorities (bearing in mind the Advocate General's Opinion has yet to be confirmed by the European Court), the conclusion on the issues of construction and interpretation of the law were the same. In assessing the questions as they relate to these proceedings therefore, I have clear guidance on the approach to adopt.

22. As can be seen from my summary of the evidence, the applicants rely heavily on evidence in the form of questionnaires sent to a number of experts in the trade in question.

23. The questionnaire consisted of 10 questions, which essentially addressed three main areas. Questions 1-3 were of a nature to establish personal details and relevant experience etc. I do not question the suitability of any of those questioned in terms of their individual experience in the relevant fields. Questions 4, 5 and 6 relate to matters of distinctiveness and I shall comment on these later. (Question 7 is specific to section 3(2)(a) and needs no further mention). Questions 8 and 9 relate to section 3(2)(b). (Question 10 asks if the expert would be willing to submit a statutory declaration if requested).

24. In so far as the section 3(2)(b) issue is concerned then, only the responses to questions 8 and 9 are evidentially important. For ease of reference I reproduce these questions (and Question 4 by way of context) as worded on the Questionnaire:

Q4. Do you know of seals of the shapes attached? [The mark in suit was included in the attachments to the questionnaire]

Q8. In your opinion are those shapes necessary to enable the products to perform their function?

Q9. Are these shapes the only shapes required to perform the same function and with the same effect? If not. Do you know of other shapes which can perform the same function with equal effect?

25. Of the 16 responses supplied in the evidence, a pure numerical analysis of the response to Questions 8 was:

Q8. “Yes”= 3, “No” = 12. 1 response was somewhat equivocal.

26. Question 9 is a little more difficult to analyse in purely numerical terms because it is a two part question and not all responses reflected this. However, my analysis of the results is that in all but one of the 16 responses, the answers reflected a “no, these are not the only shapes required to perform the same function and with the same effect” and “there are other shapes available which can perform the same function”, although “with equal effect” being dependent on other factors” (eg material, technical test data etc).

27. It is difficult to draw too many conclusions from the questions which demand “yes/no” answers. The results to Question 8 suggest strongly however, that the shape of the trade mark in suit is *not* necessary to perform its function. The corollary of this is that other shapes could do the same job. This seems to be more specifically confirmed by the responses to Question 9.

28. How does this evidence affect the considerations under section 3(2)(b)? In my view, looking at the trade mark in question and the evidence of the applicants themselves, the answer is self-evident. Clearly the essential purpose of the product is to perform a function ie to stop draughts, smoke, water etc from entering through windows/doors etc. Within its design, the products essential features seek to fulfill this requirement (see particularly the exhibits to the statutory declaration of Mr Southern - ES1 which in itself is a statutory declaration of Mr Jones and his exhibits 1- 5). For example, at page 4 to exhibit 4 of Mr Jones’ statutory declaration there is a technical description of the mark in suit which describes (eg) how the height of the seal presents minimum obstruction to wheeled and pedestrian traffic; the hollow towards the back of the seal is a trough for collecting water; the angle of the ridged section is to direct water away etc. Indeed there a number of features which any layman could easily discern the intended functionality. There is evidence to suggest strongly that the product performs its function to good effect.

29. The evidence also clearly shows that there are other products of differing shapes, which nevertheless perform the same function as those in suit. The applicants themselves produce products of different shapes, but same or similar functions - again see the statutory declarations and exhibits of Messrs Southern & Jones. The opponents’ evidence shows this too (see exhibit OA-S9 - OA-S12).

30. As I have said, there are two clear authorities on the issues at hand here - the Philips/ Remington decision in the Court of Appeal and the Opinion of the Advocate General in European Court of Justice (ECJ).

31. In short, in the above cases, Philips argued that for their three headed rotary shaver, registration of a trade mark for the shape of the same, was not excluded by section 3(2)(b) because the technical result required of the product (ie shaving with rotary cutters) can be achieved at equivalent cost and efficiency with a number of different shapes of three headed rotary shavers. They had shown through their evidence that this could be achieved, thus they concluded that as equally good shapes are available, the subsection does not bar registration.

32. Remington by contrast argued that the evidence had shown that the essential features of

the shape shown in Philips' trade mark are designed to achieve and do achieve a technical result. They argued that that is sufficient to bar registration. If a total analysis of the essential features of the shape concludes that they are there for technical reasons, namely to obtain the technical results, then the shape is not registrable.

33. The Court of Appeal found in favour of Remington. Aldous L.J said at page 821 in the afore mentioned Philips Electronics NV v. Remington Consumer Products Ltd [1999] R.P.C. 809) case:

“ In my judgement the restriction upon the 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 results. All that has to be shown is that the essential features of the shape are attributable only to the technical result.”

34. However, the matter was passed to the ECJ for final determination. In the Opinion of Advocate General Ruiz-Jarabo Colomer in the Court of Justice of the European Community in Case C-299/99 Philips Electronics NV v. Remington Consumer Products Ltd [2001] R.P.C. 38 he said at page 752:

“The national court seeks to ascertain, in particular, whether a purely functional shape is caught by the exclusion provided for in sub-paragraph (e) [the equivalent to section 3(2) of the Act] even when it can be shown that the same technical result can be achieved by other different shapes.

“Merely functional” is to be understood - as suggested by the national court - as any function whose essential features are attributable to the achievement of a technical result. Use of the phrase “essential features” means that a shape containing an arbitrary element which, from a functional point of view, is minor, such as its colour, does not escape the prohibition. There is nothing in the wording of sub-paragraph (e) of Article 3(1) which makes it possible to conclude that a merely functional shape could be registered if another shape, capable of achieving a comparable result, exists. It suffices that the signs of which the trade mark consists should comprise exclusively features which are necessary in order to achieve a particular technical result”.

35. Given my findings on the evidence submitted by the applicants in these proceedings and the authoritative guidance above, it is clear that my conclusion must be that this ground of opposition succeeds.

36. If I were to follow fully the approach of the Advocate General, this would largely be an end to the matter. He said in his conclusion to his opinion:

“The second indent of Article 3(1)(e)....must be interpreted as meaning that 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.” [emphasis added]

37. However, as that approach has not been confirmed by the ECJ, and in case I am wrong in

my above conclusions on the evidence as filed, I intend to comment briefly on the question of distinctiveness, as it is the other significant area addressed in the applicants' evidence and trade evidence.

The section 3(1)(b) ground

38. On the basis of the Advocate General's view that there is not a category of marks which are incapable of acquiring a distinctive character (see his comments at [2001] R.P.C. 38 page 754 paragraph 43 and 44), I think it is appropriate to look at the section 3(1)(b) ground. Section 3(1)(c) was not pleaded.

39. Section 3(1)(b) states:

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

(a) -----

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

(c) -----

(d) -----

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.

40. As can be seen from my comments above, this trade mark is a somewhat unusual type of application for registration. The mark, looking as it does, attracted at the examination stage in the Registry, a section 3(1)(b) objection which was later overcome on the basis of evidence of distinctiveness acquired prior to the date of application. In these proceedings where section 3(1)(b) is also pleaded, I too am tasked with looking at the issue of whether the evidence of acquired distinctiveness filed in these proceedings, together now with the supplementary evidence from the trade and the arguments put forward elsewhere in the evidence, is sufficient to overcome the ground, which I should say at this point is, in my view, prima facie, well founded.

41. In this regard, I am guided by the comments of Mr Justice Jacob in the British Sugar Plc and James Robertson and Sons Ltd case (the "TREAT" case) (1996) RPC 281, comments (which also go to Section 3(1)(c) of the Act), when he said:

"Next, is "Treat" within Section 3(1)(b)? What does devoid of any 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? A meaningless word or a word inappropriate for the goods concerned ("North Pole" for bananas) can clearly do. But a common laudatory word such as "Treat" is, absent use and recognition as a trade mark, in itself (I hesitate to borrow the word from the old Act "inherently" but the idea is much the same) devoid of distinctive

character”.

42. In my opinion this is the type of mark which clearly would require the education of the public referred to above before it can begin to serve the function of a trade mark.

43. From the evidence of use submitted in these proceedings, it can be seen that in terms of length of use, it is good (since 1982). However, the turnover in the relevant period is difficult to assimilate accurately from the evidence. I say this because from the figures given in paragraph 3 of the statutory declaration of Mr Jones, a former director of the applicants (see paragraph 14(f) above) the turnover is said to reflect that generated “under the Trade Mark for each of the years 1985 to 1995”. There is no reason to suspect these to be anything other than a statement of fact. However, I note from the evidence adduced in the parallel opposition proceedings which I am also called upon to decide between these parties (Opposition No. 46518 against application No 2033252 for another “3-dimensional shape of an extrusion” - another one of the fifteen marks attached to the questionnaire) Mr Jones states exactly the same turnover figures in every one of the represented years as for this case. He also attests those figures to be representative of turnover “under the Trade Mark for each of the years 1985 to 1995” (the trade mark this time of course being application No 2033242). It would seem improbable in the extreme for two products to have generated identical turnover figures in identical periods of time. I suspect this is a case of the figures reflecting total company turnover for this type of product range, or perhaps the fact that the products which are the subject of the two applications in question being sold together ie to be used in conjunction with each other - see the illustration at exhibit 1 to Mr Jones’ statutory declaration at pages 4, 6 and 7, which seem to show the two seals the subjects of opposition numbers 46518 and 46520 being used together. Whatever the reality (and this is not conclusive from the evidence), the turnover figures in both cases must be called into doubt as to their reliability to act as an indication of the level of use of either mark. In any case, it is well decided that the extent to which a mark is used is not conclusive in establishing distinctiveness. Also in “Treat”, Jacob J (although referring to word marks, I think the comment also applies here) said:

“Mere evidence of use of a highly descriptive or laudatory word will not suffice, without more, to prove that it is distinctive of one particular trader - is taken by the public as a badge of trade origin.”

44. And in *Bach Flower Remedies Ltd v Healing Herbs Ltd* [2000] R.P.C. 513 Morrit L.J. put it thus:

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

45. On the question of the “materiality” of the use, the evidence falls far short of convincing me that use of the shape of an extrusion applied for as the subject of this application, is use as a trade mark. Looking at the brochures exhibited by Mr Southern at ES2 & 3 and Mr Jones in exhibits 1-5, I do not perceive one instance of what I would recognise as trade mark use of the sign in question. It is illustrated in the brochures as what I would describe as technical drawings of the product, along with other technical illustrations of other products. See for

example exhibit 1 pages 4, 6 and 7 of Jones and the second page of ES2. There is no use of the sign (eg) on the front covers of the brochures or any indications pointing to it specifically as an identifier in its own right (eg “look for the seal with this stylish face” etc). Indeed the brochures largely refer to the seals therein, including the one the subject of this application, as “Sealmaster” products. It is this word that adorns the front covers (where provided) and many of the internal pages of the exhibited brochures, often with the ® symbol and it is that word which is the most recognisable identifier or trade mark.

46. In these proceedings, the applicants have indeed provided the “more” referred to by Jacob J. in “Treat” to try and establish that the mark in question has acquired the requisite level of distinctiveness for registration. However, it is my view that the evidence submitted does not provide me with the basis for accepting the mark for registration. As I said earlier, the supplementary information in the questionnaire regarding the distinctiveness issue can be found in Questions 4,5 & 6. Of the 16 questionnaires received back, all of the experts say that they “know of the seals of the shapes attached” to the questionnaire (including the one in suit) (Q.4); they all “associate seals of these shapes” with the applicants’ or their Sealmaster Division (Q.5) and they have all done so for considerable periods, including significant periods prior to the date of application (Q.6).

47. The experts selected were all done so because they represented a broad spectrum of the business in question. I, nor indeed the opponents, dispute their expertise or experience, but it is this very expertise that militates against the worth of this evidence. The statutory declaration of Mr Bilewycz dated 3rd February 1999 explains that “an approach was made to various members of the trade for their expert views...”. Seemingly no approach was made to any other group of people, who in total with the experts, could be said to make up a more representative proportion of “average consumers” of these products. Given that they are clearly products which can be purchased by the layman (ie for DIY installation) as well as by specialists such as those selected, I do not consider the expert evidence as being adequately representative of customers in general. It is therefore hardly surprising that amongst a group of sixteen experienced professionals within the relevant trade, they would be able to distinguish the products of one trader from another.

48. The weight to be attached to such trade evidence was commented on by Lloyd J in Dualit Ltd’s (Toaster Shapes) Trade Mark Applications [1999] R.P.C. 890 at 898/9 and also seems to encapsulate the criticism of the trade evidence in these proceedings:

“These, however, are people whose business it is to know the applicant’s products and the products of other manufacturers in the market. The fact that they knew their job and could recognise the shapes as being those of the applicant’s products does not seem to me to begin to show that “the relevant class of persons, or at least a significant proportion thereof, identify [the] goods as originating from a particular undertaking because of the trade mark”. The relevant class of persons is not trade buyers such as these witnesses but customers”.

49. The evidence of the experts cannot and does not represent the views of a significant part of the relevant class of persons for these products, the weight I attach to the evidence therefore must be commensurately lowered.

50. Indeed, I consider that there are other significant flaws in the expert evidence as filed. I do not intend to forensically dissect all of those flaws, save to mention one or two important ones.

51. The first of these is the methodology chosen to go to the experts with a group of some 15 marks attached to the questionnaire, with the questions relating to all of them. It is a point also made by the opponents. Whilst I can fully appreciate the need for efficiency and practicality in these matters, having blanket responses to 15 different designs of seals, excluders etc, really does not help any of the cases individually, because recognition of any one of the seals will clearly have influenced responses to others. The persuasive nature of any of the comments must be diluted by such an approach.

52. Secondly the wording of the questions in general in such questionnaires is often open to criticism, and I do not intend to go into each one individually. However, in the context of establishing distinctiveness and the ability of the mark in suit to act as the indicator of one particular trader, the wording of Question 5 “Do you *associate* seals of the shapes attached with a particular company?” (my italics) is particularly unhelpful. In this extract taken from Dualit Ltd’s (Toaster Shapes) Trade Mark Applications [1999] R.P.C 304 at 317, the registrar’s hearing officer said:

“As Jacob J. noted in the *Philips* case, the word “associates” can have a number of meanings. The word could be used by those that mean “first come to mind”, “best known one”, “only one I can think of - but there may be others”. None of the meanings amount to recognition of the sign as a trade mark”.

53. All in all, the aggregation of all the evidence of use of the mark prior to the application date, the expert evidence, the state of the register evidence of Mr Bilewycz (MDB1), which as always is in principal irrelevant in any case, and the arguments set out in the papers, do not persuade me that the proviso to section 3(1) has been satisfied. The burden of proof to satisfy this proviso is on the applicant (see “Dualit” [1999] R.P.C. 890 again at page 898). As such the section 3(1)(b) ground also succeeds

54. In view of my findings under section 3(2)(b) and section 3(1)(b), I regard all the other pleadings as significantly subordinate in these proceedings and as such do not intend to consider them further.

55. The opponents are entitled to a contribution towards their costs. I order the applicants to pay the opponents the sum of £750. This sum is to be paid within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 3RD day of October 2001

**G J Rose’Meyer
For the Registrar
the Comptroller-General**