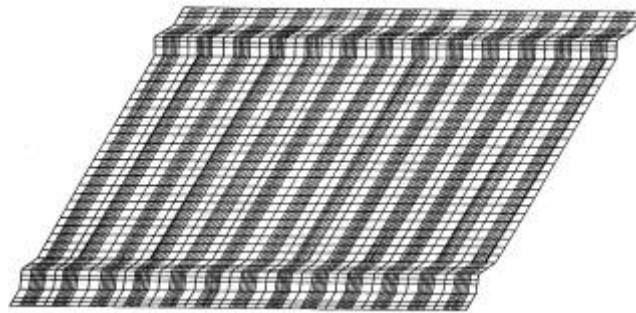


**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 2131647  
BY TWIL LIMITED  
TO REGISTER THE TRADE MARK:**



**IN CLASS 6**

**AND**

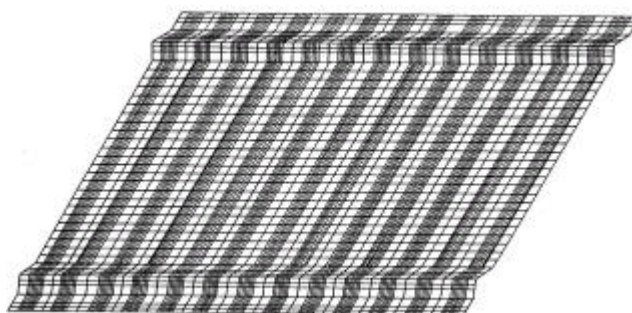
**IN THE MATTER OF OPPOSITION THERETO  
UNDER No 51972  
BY SIDDALL & HILTON MESH LIMITED**

## TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2131647  
by TWIL Limited  
to register a trade mark in class 6  
IN THE MATTER OF Opposition thereto under No 51972  
by Siddall & Hilton Mesh Limited**

### Background

1) On 2 May 1997 TWIL Limited applied to register a three dimensional trade mark. The application was published on 11 October 2000 with the following representation:



It was published with the following specification: *wire fencing*. The application was published with the following wording: “The mark consists of a 3 dimensional shape”.

2) On 10 January 2001 Siddall & Hilton Mesh Limited filed notice of opposition to this application.

3) The opponent states that the trade mark in suit appears similar to United Kingdom registered design no 1019668 which expired on 15 May 1999.

4) The opponent states that the trade mark in suit does not consist of a sign which is capable of distinguishing the goods of one undertaking from those of another and that its registration would, therefore, be contrary to section 3(1)(a) of the Act. The opponent states that the trade mark in suit consists of a picture or shape of a three dimensional article which is purely descriptive of that article. The opponent also states that the application in suit offends against section 3(1)(a) of the Act as the trade mark in suit is not represented graphically sufficiently to fully show the three dimensional article.

5) The opponent states that the trade mark in suit offends against the provisions of section 3(1)(b) of the Act as it consists of a sign which is devoid of any distinctive character. The opponent states that the trade mark consists of a picture of an article which traders might legitimately wish to manufacture and hence is equivalent to a common word for such an article.

6) The opponent states that the trade mark in suit offends against section 3(1)(c) of the Act in that it consists exclusively of a sign or indication which may serve in trade to designate the kind, quality, quantity, intended purpose of the goods or other characteristics of the goods.

7) The opponent states that the trade mark in suit offends against the provisions of section 3(2)(a) of the Act as it consists exclusively of the shape which results from the nature of the goods themselves.

8) The opponent states that the trade mark in suit offends against the provisions of section 3(2)(b) of the Act as the trade mark in suit consists exclusively of the shape of goods which is necessary to obtain a technical result.

9) The opponent states that the trade mark in suit offends against the provisions of section 3(2)(c) of the Act as it consists exclusively of the shape which gives substantial value to the goods.

10) The opponent states that the application in suit offends against section 39 of the Act in that the trade mark has been amended so as to substantially affect the identity of the trade mark. The opponent claims that the number of stripes, the position of view and the number of horizontal lines are amongst the unallowable amendments.

11) The applicant filed a counterstatement in which he denies the claims of the opponent.

12) Both parties filed evidence and seek an award of costs.

13) The matter came to be heard on 12 June 2001 when the opponent was represented by Mr Morcom of Her Majesty's Counsel, instructed by Potts Kerr & Co, and the applicant was represented by Mr Wyand of Her Majesty's Counsel, instructed by Hulse & Co. At the hearing it was agreed that the parties could make additional written submissions in relation to the judgement of the European Court of Justice in *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* Case C-299/99. This judgement was due on 18 June 2002 and the parties were allowed one month from that date to file written submissions as to how they considered the judgement affected this case. I have received these submissions and have taken them into account in my decision.

### **Opponent's evidence in chief**

14) This consists of two statutory declarations. The first declaration is by Kevin Steers who is the managing director of the opponent. Mr Steers states that he is familiar with the fencing manufactured by Twil Limited/Tinsley Wire Limited and of the metal mesh and fencing market in the United Kingdom. Mr Steers states that between 1974 and 1988 he was employed by Tinsley Wire (Sheffield) Limited. He states that between 1982 and 1985 he held the position of product manager in the marketing department and when he left in 1988 he was sales manager of the wire division.

15) Mr Steers states that he has reviewed the statement and counterstatement in respect of this opposition and also the application file documents in respect of the trade mark in suit.

16) Mr Steers states that he has been asked to outline his knowledge of fencing sold by Twil Limited under the trade mark PALADIN and to explain his understanding of the purpose of the stripe effect produced by spaced groups of seven more closely spaced vertical wires and also the purpose or function of the bent "V-forms" or "V-beams" and also to comment on his knowledge of the manner in which Tinsley Wire Limited (prior to 31 December 1996 Tinsley

Wire (Sheffield) Limited - TWSL) have promoted their PALADIN fencing.

17) Mr Steers states that in September 1983 when he was with TWSL a successful product in the fencing market was a particular form of metal palisade fencing produced from pressed metal strips. He states that palisade fencing might be defined as fencing of spaced vertical stakes e.g. a picket fence. Mr Steers states that wire meshes with regularly and equally spaced wires “were known”. There was a proposal to produce a wire mesh product which would be less expensive than the metal palisade fencing. Hugh Facey, the group sales and marketing director of TWSL, instructed Dr Ian Melton, product manager industrial fencing, to develop a welded mesh “look alike” variance on palisade. It was to be less expensive but suit the production processes of Tinsley Wire. The marketing strategy was to design a product to attack the pressed metal palisade market. At that time machines had become available which gave greater opportunity for variations in mesh design; prior to this only regular spacing was available. The PALADIN mesh was designed with the stripe effect produced by spacing apart groups of seven closely spaced vertical wires. This was considered to resemble a palisade and to be an attractive design. It had a less austere appearance and would be more attractive for use around such places as schools and car salesrooms. Mr Steers was a member of a small team who with the help of an advertising agency chose the name PALADIN from a large number of potential names.

18) Mr Steers states that as far as he is aware at no time have TWSL or TWIL Limited ever indicated in their marketing that the stripe-effect and the V-beams in their PALADIN fencing are anything other than an attractive design producing improved strength. He states that they have never suggested in their marketing that the design is a trade mark. Mr Steers states that he does not regard nor does he believe that the purchasers of PALADIN fencing regard the shape of PALADIN fencing as anything other than an attractive and practical design.

19) Mr Steers states that the arrangement of spaced groups of vertical wires produce an attractive stripe appearance suggestive of a palisade fence and additionally contribute to the strength and structural integrity of the mesh. The “V-forms” or “V-beams” also provide a “visual aspect” but are present specifically to increase the strength and rigidity of the fencing mesh. Mr Steers states that the increase in rigidity provided by the V-beam is because the V angling acts to resist the panel bending on impact and during normal use as a fence.

20) Mr Steers exhibits at KS1 a brochure and photograph furnished by Hulse & Co in relation to the ex parte application procedure. He states that he noted that reference is made to the aesthetic and distinctive appearance of the repetitive bands of narrow apertures and that the following is also stated: “The appearance is further enhanced by providing pressed “V” forms.... to provide rigidity between the posts.” He states that reference is also made in the brochure to United Kingdom registered design 1019668.

21) Mr Steers refers to exhibits furnished in relation to the ex parte application procedure. These have not been adduced into the current proceedings and so I will say no more about them.

22) Mr Steers states that Siddall & Hilton Mesh Limited mainly produce welded mesh fences and barriers for customers in response to their orders and specifications. In 1993 the opponent was advised by one of their customers, Kelcamp Steel Fencing Limited, that that company had received a letter threatening enforcement of registered design 1019668. He exhibits a copy of the letter at KS2. Mr Steers states that he believes that it is because of the monopoly afforded

by registered design 1019668 that the purchasing public up to now have recognised the PALADIN design as being produced by TWSL and TWIL Limited.

23) Mr Steers exhibits at KS3 a copy of TWSL's original brochure on PALADIN, at KS4 a copy of a brochure for 1986 and at KS5 a copy of TWIL's brochure for June 1989. Mr Steers also exhibits at KS6 copies of pages from marketing plans of TWSL for August 1982, August 1983 and August 1986. He states that it will be noted that the "background and purchase of the "Paladin" fencing is made and no mention is made of the fence design being a trade mark".

24) The second declaration of the opponent is made by David Cedric Franklyn Gilmour who is a partner of the trade mark agents of the opponent. Mr Gilmour exhibits at DG1 a copy of a printout from the web site of Companies House in respect of TWIL Limited and copies of the cover sheet and pages 1, 9, 11 and 12 of the accounts for the year ended 31 December 1999. Mr Gilmour states that these accounts show that TWIL Limited is a holding company which owns 100% of Tinsley Wire Limited. Mr Gilmour exhibits at DG2 a printout from the web site of Companies House in respect of Tinsley Wire Limited showing its previous name as Tinsley Wire (Sheffield) Limited. Also exhibited at DG2 are the cover sheet and pages 1, 2 and 18 of the accounts for 31 December 1999 of Tinsley Wire Limited showing the immediate parent company is TWIL Limited. Mr Gilmour exhibits at DG3 a copy of registered design no 1019668 in the name of Tinsley Wire (Sheffield) Limited.

### **Applicant's evidence**

25) This consists of a witness statement by Michael Terrance Pollard. Mr Pollard is sales director of Tinsley Wire Limited, a wholly owned subsidiary of the applicant. In his statement Mr Pollard refers to the two companies together as the Tinsley Undertaking.

26) Mr Pollard states that the intent behind the production of PALADIN mesh does not have a bearing upon the issue as to whether what was created was distinctive and capable of being recognised by purchasers and users of such mesh as a product of a particular group or company. He states that what was achieved was a highly distinctive appearance for a wire mesh fence. Mr Pollard states that the distinctive nature of the appearance of the mesh was referred to in the promotional literature from as early as 1986. He refers, in support of, this to exhibit KS4 of Mr Steers.

27) Mr Pollard exhibits at MTP1 a photograph showing another mesh/fence product competitive with PALADIN together with an advertisement from the publication "Perimeter Systems" showing in particular STYLEGUARD by Fairmile Fencing Limited. He states that the appearance of PALADIN is the feature which distinguishes it from these and all competitive products.

28) Mr Pollard does not deny that in some traditional or conventional meshes or fencing a V-form or V-beam is employed. He states, however, that this does not stop the employment of a V-form or V-beam with PALADIN mesh/fencing from further enhancing the distinctiveness of the mesh/fencing.

29) Mr Pollard states that the evidence of Mr Steers shows that in all advertising of PALADIN mesh/fencing there is repeated reference to its distinctive visual appearance. Mr Pollard states

that this stems from the manner of grouping the number of vertical wires to generate a striped effect, and contrary to the statement of Mr Steers the grouping of vertical wires does not contribute to improving or increasing the strength of PALADIN fencing in comparison with conventional fencing. He states that this is confirmed by the statement of Mr S M Field exhibited at MTP2. Mr Field, who is director of Oakfield Design North West Limited, was asked to give an independent opinion as to the improvements in mechanical strength, if any, offered by use of vertical clusters of wires over the use of evenly spaced vertical wires in the construction of an open mesh steel fence panel. Mr Field concludes his opinion by stating: “In conclusion I suggest that the vertical pattern used in Paladin fence panels has no functional value and is a purely aesthetic feature”.

30) Mr Pollard states that the fact that PALADIN mesh/fencing has been the subject of extensive sales and advertising with emphasis on its distinct appearance has increased its inherent capacity to distinguish it from other sources for mesh/fencing. Mr Pollard exhibits at MTP3, 4 and 5 evidence put forward by the applicant at the ex parte examination stage. MTP3 is a statutory declaration by Mr Pollard. He states that the first sales were in August 1984. The following figures are given in relation to use:

<b>Year</b>	<b>Turnover</b>	<b>Tonnes</b>	<b>No of panels</b>	<b>Km</b>	<b>Sales/adv</b>
1992		570	22, 800	68.4	
1993		771	30, 840	92.5	
1994	1, 326, 671	757	30, 280	90.8	182, 000
1995	1, 234, 069	722	28, 880	86.6	198, 000
1996	1, 542, 163	869	34, 760	104.3	165, 000
1997	1, 847, 288	1070	42, 800	128.4	181, 000
1998	2, 168, 902	1118	44, 720	134.2	200, 000

Mr Pollard states that the sales of the fence panel are nation-wide and include sales in Wales, Scotland and Northern Ireland.

31) Exhibit MTP4 is a copy of a statutory declaration made by Wendy Anne Baker. Ms Baker is the chief executive of The Fencing Contractors Association. She confirms in her declaration that the answers given by her to a questionnaire are correct. Exhibit MTP5 is a copy of a statutory declaration made by Robert Henry Jennings. Mr Jennings is the chief executive of European Fencing Industry Association. He confirms in his declaration that the answers given to a questionnaire by him are correct. Ms Baker and Mr Jennings responded to the same questions. There are eight questions in the questionnaire. Both identify the design of the fence with the applicant and both consider that the product has a unique and distinctive visual appearance. It is to be noted that Ms Baker and Mr Jennings were given a representation that differs from the application in suit. The representation represents a side elevation, a front elevation, an enlarged view of the vertical clusters of wires and an enlarged view of the V-beam. The letters which would have accompanied the questionnaires are not exhibited.

32) Mr Pollard goes on to state that he is not aware that overlapping protection as between registered design and trade mark is prohibited. He does not accept that PALADIN mesh/fencing cannot become distinctive in a trade mark sense, simply because it was once registered as a Design.

33) Mr Pollard expresses surprise that Mr Steers still has in his possession documents the

property of Tinsley Wire (Sheffield) Limited that he would have thought to be confidential, particularly the marketing plans of his former employer. However, he does not see what relevance those plans have. He states that as registration of product shapes as trade marks was not possible in 1982 it does not appear to him to be surprising that marketing plans created in 1982 were silent on the question of promoting the mesh/fencing as a trade mark.

### **Opponent's evidence in reply**

34) This consists of further statutory declarations by Mr Steers and Mr Gilmour. Mr Steers confirms that in his opinion that the V-beams also contribute to the rigidity of the structure. Mr Steers comments on the opinion of Mr Field, he argues that if the groups of vertical wires were omitted altogether then the structure would be weaker. This was not a matter that Mr Steers was asked to give an opinion upon; his opinion relates to the issue of what would be the effect if the wires were placed evenly rather than in groups.

35) Mr Steers believes that no one has produced similar looking wire mesh fencing to the PALADIN fencing because for a considerable period TWIL or Tinsley Wire enjoyed a monopoly resulting from their registered design.

36) Mr Gilmour notes that Ms Baker and Mr Jennings make references to PALADIN and TWIL in their questionnaires. He states that a search of The Patent Office web site reveals that these are both registered trade marks of Tinsley Wire Limited. In fact neither Ms Baker nor Mr Jennings refer to TWIL as a trade mark. They both identify TWIL as the manufacturer of the product. Only Ms Baker identifies the product with the trade mark PALADIN.

### **Decision**

37) Mr Morcom ran all the grounds of opposition at the hearing. However, in his written submissions he dropped the grounds of opposition under section 3(2)(a). I have considered all the evidence and submissions very carefully and have come to the conclusion that I can dispose of the opposition by consideration of the section 3(1)(b) objection alone. I will, therefore, make no comment upon the other grounds of objection.

38) I am fortified in this conclusion by the comments of Jacobs AG in his opinion in *Procter & Gamble v. Office for Harmonization In the Internal Market* [2001] ETMR 75 where he stated:

“As the Court of First Instance rightly noted, it is sufficient for one of the absolute grounds for refusal to apply for a sign to be ineligible for registration as a trade mark. Moreover, I cannot envisage any circumstances in which, in practice, it might be important to determine whether more than one absolute ground might apply.”

39) Section 3(1)(b) of the Act states that trade marks which are devoid of any distinctive character shall not be registered. The proviso to section 3(1) of the Act states:

“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) What does devoid of any distinctive character mean? In *British Sugar Plc v. James Robertson & Sons Ltd* [1996] RPC 281 Jacob J stated that:

“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 but the idea is much the same) devoid of any distinctive *inherently* character.”

41) Mr Hobbs, sitting as the appointed person, has referred to trade marks which are origin neutral and those which are origin specific; ie those signs which act as indicators of origin and those which do not. The purpose of a trade mark is to act as an indicator of origin. To effect this it must be distinctive of an enterprise. If it does not effect this then it is not distinctive of the enterprise, and so is liable to fall foul of section 3(1)(b). With certain trade marks there is a presumption that they can act as an indicator of origin; for instance an invented word with no allusion to the goods in relation to which it is used. In other cases the presumption is that a sign cannot act as an indicator of origin, without evidence of factual distinctiveness; this might be the case of a single letter mark. Sections 3(1)(c) and (d) define clear parameters as to the nature of the objection, section 3(1)(b) does not give any such definition. It is the section of the Act which gathers those trade marks which fall through the net of sections 3(1)(c) and (d) but still do not fulfil the function of a trade mark.

42) In this case the trade mark is the goods, a fencing panel. The Court of First Instance in *Henkel KgaA v OHIM* [2002] ETMR 25 held the following in relation to issue of signs which are devoid of distinctive character:

“Article 7(1)(b) of Regulation No 40/94 does not distinguish between different categories of trade marks. The criteria for assessing the distinctive character of three-dimensional trade marks consisting of the shape of the product itself are therefore no different from those applicable to other categories of trade marks.

Nevertheless, when those criteria are applied, account must be taken of the fact that the perception of the relevant section of the public is not necessarily the same in relation to a three-dimensional mark consisting of the shape and the colours of the product itself as it is in relation to a word mark, a figurative mark or a three-dimensional mark not consisting of the shape of the product. Whilst the public is used to recognising the latter marks instantly as signs identifying the product, this is not necessarily so where the sign is indistinguishable from the appearance of the product itself.”

So where the sign is the goods there is the issue of public perception, will the public see the sign as being a trade mark? Or will they simply see it as being the goods? Mr Wyand was of the view that this application could be distinguished from *Henkel* as the sign is a distinctive shape for a fence panel rather than a common one.

43) Mr Wyand argued at the hearing and in his written submission that the trade mark in suit is distinctive a priori. It does not require evidence of use. At the hearing he referred to the



sign as having a tartan pattern and that the impression created as a whole by the sign is distinctive. He stated that there was no evidence of fencing panels of a similar appearance being upon the market. I do not consider that the absence of other panels with a similar appearance shows that the trade mark in suit is necessarily distinctive. This absence does not demonstrate that the sign will be seen as being an indicator of origin. Mr Wyand sought support from the decision of the Court of First Instance in *Mag Instrument Inc. v Office for Harmonization in the Internal Market (Trade Marks and Designs)* Case T-88/00. In that decision the court stated:

“Under Article 7(1)(b) of Regulation No 40/94, moreover, it is sufficient, in order to defeat the absolute ground for refusal, to demonstrate that the mark possesses a minimum degree of distinctiveness. It is therefore necessary to determine - in the context of an a priori examination and without reference to any actual use of the sign within the meaning of Article 7(3) of Regulation No 40/94 - whether the claimed mark will enable the targeted public to distinguish the marked goods or services from those of other undertakings when they come to make a purchasing choice.”

44) The court requires the minimum degree of distinctiveness to be such that it allows the sign to perform the trade mark function of distinguishing the goods of one undertaking from those of others when the purchaser comes to making his choice. So the decision for trade marks purposes does not turn upon the design of the fencing panel being different but whether that design will be an indicator of origin.

45) In *Yakult Honsha KK's Trade Mark Application* [2001] RPC 39 Laddie J held:

"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 of origin ... 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 memorable appearance, but whether by itself its appearance would convey trade mark significance to the average customer. For the purpose of this appeal, I am prepared to accept that the bottle shape 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 mark sense.”

So being eye-catching or unusual or decorative is not enough. Again the key to the issue is whether the sign will be seen as an indicator of origin.

46) Where the sign is the goods there must be some additional factor that will lead the relevant public to see it also as an indicator of origin; to perform the dual function of being the goods and identifying the origin of the goods. Mr Wyand argued that the sign of the application in suit does have this ability. The applicant at exhibit MTP1 furnished pictures of other types of fencing to demonstrate the distinctiveness of the sign in suit. I would not classify myself as the relevant public for wire fencing. From my lay position the examples exhibited have the opposite effect to that which was intended; they lead me to view the sign of the application in suit to be very similar to other designs. There is nothing which shouts out to me, or even whispers, that the fence panel would also be seen as a trade mark.

47) The public, whether a specialised public or the general public, do not normally see the goods themselves as having trade mark significance. It takes something special for them to identify the goods a priori as having trade mark significance. In this case the sign is a panel of fencing. Mr Wyand has argued that the combination of the various elements in the fencing, including the grouping together of seven horizontal wires, gives rise to a distinctive whole. I cannot agree. All that I see is the goods. I cannot see that a priori these goods also have a trade mark significance. **A priori registration of the sign of the application in suit would be contrary to section 3(1)(b) as it is devoid of any distinctive character.**

### **Use of the trade mark**

48) It is possible for the sign of the application in suit to overcome the objection under section 3(1)(b) if it has in fact acquired a distinctive character as a result of the use made of it. The evidence in respect of acquired distinctiveness rests on sales and advertising figures and expert testimony.

49) Promotional material of the applicant has been furnished in the evidence of the opponent. In this material the fencing is clearly identified by the trade mark PALADIN. Reference is made to the fencing being attractive and its distinctive appearance. A large number of goods are designed to be aesthetically pleasing. People prefer the pretty to the ugly. That a product is pleasing to the eye or has some difference in its appearance does not mean that it will be seen necessarily as acting as a trade mark. There is nothing in the promotional material that would lead the purchaser to see the design of the goods as being of trade mark significance. The opponent has stated that there is no suggestion in the promotional material that the sign is a trade mark. I do not consider that anything turns upon this. There is no necessity to claim trade mark significance; I just have to consider whether there is any such significance.

50) There are the turnover figures to consider. Mr Morcom criticised these figures as not being put into any context. It is not known what the market for wire fencing is. The figures could, in relation to the trade as a whole, be of a very low level. The last figures that I can take into account are those for 1996 when 34,760 panels were sold, these panels had a value of £1,542,163. It is true that I cannot put these sales into a context. However, it does seem to me to represent a sizeable trade. This in itself does not do much for the case of the applicant. Where the goods and the sign are one and the same use per se shows nothing. If it did this could be extrapolated into stating that if there is extensive sales of a product then the product becomes a trade mark. Whether it acts as a trade mark depends on the perception of the purchaser; does he see the goods in themselves as an indicator of origin or does he see, for instance, the word trade mark used with them as the trade mark? In this case the trade mark PALADIN is used with the goods. Mr Wyand submitted that when the goods are erected one would not be aware of the trade mark; so the only trade mark is the goods. When in use many goods do not display their trade marks. Few house owners would be happy if all the building materials were emblazoned with the trade marks of the manufacturers. In sale, display and promotion such goods do display their trade mark. I cannot see that the bare turnover figures greatly assist the applicant.

51) I turn now to the expert testimony of Mr Jennings and Ms Baker. The letters that elicited the replies from Mr Jennings and Ms Baker have not been furnished. So it is not known if these letters would have prompted the responses. It could have been that the letters identified that the request was being made on behalf of the applicant. Mr Jennings and Ms Baker were

not asked to identify the sign the subject of the application in suit but another representation of the goods. Taking these two factors into account I can give very little weight to their evidence. I also take into account that both the experts are from trade associations; persons who would have a refined and somewhat arcane knowledge of the goods. The problems with evidence by such persons was identified by Lloyd J in *Dualit Ltd's (Toaster Shapes) Trade Mark Applications* [1990] RPC 890:

“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 evidence of Mr Jennings and Ms Baker does little to tip the scales in favour of the applicant.

52) In this case I consider that the relevant class of persons would be the type of people who order and buy wire fencing. I do not consider, like Mr Morcom, that this is the population as a whole. In my own experience wire fencing is not something which is found in DIY shops and the like. The relevant class of persons will be made up of architects, clerks of works, site managers, landscape designers and the like. No evidence has been put in by such persons.

53) I have taken into account the nature of the sign of the application in suit and the nature of the evidence in relation to it. This evidence does not indicate to me that the sign of the application in suit has acquired a distinctive character owing to the use made of it. Mr Morcom considered that I should take into account in my consideration that the applicant had a monopoly in the design owing to his registered design rights. This was not an argument that swayed me. If the trade mark has become distinctive as a trade mark this is a fact and I do not consider how this distinctiveness to have come about to have a bearing upon the issue. I expressed this view at the hearing and from my reading of the *Philips* decision it strikes me as being in accordance with the European Court of Justice's interpretation of the law. However, in this case nothing turns upon this. **The application in suit cannot benefit from the proviso in relation to acquired distinctiveness.**

**54) The application is refused as being devoid of any distinctive character and not having acquired a distinctive character through use.**

**55) The opponent is entitled to a contribution towards his costs and I therefore order the applicant to pay him the sum of £2800. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.**

**Dated this 19 day of July 2002**

**D.W. Landau  
For the Registrar  
the Comptroller-General**