

TRADE MARKS ACT 1994

AND

**THE TRADE MARKS (INTERNATIONAL REGISTRATION)
ORDER 1996**

IN THE MATTER OF

INTERNATIONAL REGISTRATION NO. 722571

AND THE REQUEST BY DEUTSCHE SISI-WERKE GMBH & CO

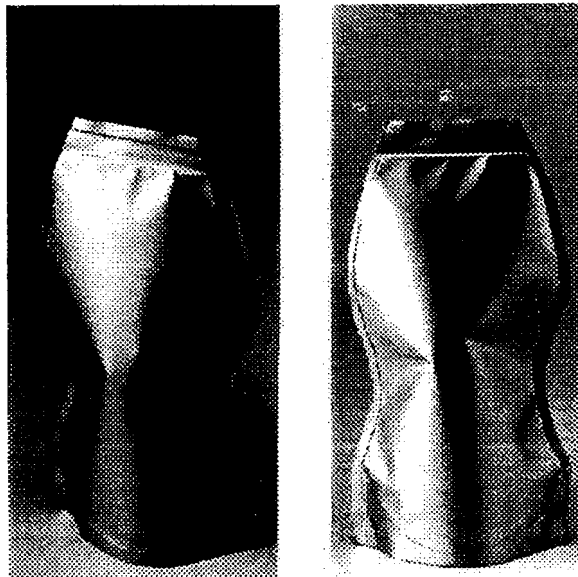
TO PROTECT A TRADE MARK IN CLASS 32

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TO PROTECT A TRADE MARK IN CLASS 32**

DECISION AND GROUNDS FOR DECISION

1. On 9 July 1999, Deutsche SiSi-Werke GmbH & Co, Betriebs KG of Rudolf-Wild-Strasse 4-6, D-69214 Eppelheim, Germany, on the basis of an International Registration, requested protection in the United Kingdom under the provisions of the Madrid Protocol of the mark:



2. The following words appear alongside the mark on the form of notification:

Indication relating to the nature or kind of mark: three dimensional mark

3. The International Registration is numbered 722571 and protection is sought in respect of:

Class 32: Non-alcoholic beverages, fruit drinks, fruit juices and fruit nectars; compounds and essences (all included in this class) for the preparation of such drinks.

4. On 21 January 2000, the notification of a total refusal of protection by the United Kingdom Patent Office was issued. Objection was taken to the mark under paragraphs (b) and (c) of Section 3(1) of the 1994 Trade Marks Act on the grounds that the mark consists of the non-distinctive device of packaging and may be a device in use in the trade.

5. Through Appleyard Lees, their UK trade mark attorneys, the holder requested a hearing. Mr A P Brierley of Appleyard Lees appeared before me at a hearing at which I maintained the objections. Notice of final refusal under Article 9(3) of the Trade Marks (International Registration) Order 1996 was issued on 16 April 2002. I am now asked by the holder's UK attorneys, Appleyard Lees, under Section 76 of the 1994 Trade Marks Act and Rule 62(2) of the Trade Marks Rules 2000 to state in writing the grounds of the decision and the materials used in arriving at it.

6. Article 3 of the 1996 Order states that protection shall depend upon whether an equivalent national application would succeed. The relevant part of the 1994 Act under which objection was taken is as follows:

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

- (b) trade marks which are devoid of any distinctive character,
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services or other characteristics of goods or services,

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."

7. No evidence that the mark has acquired a distinctive character as a result of the use made of it has been put before me. Therefore, the proviso to this Section of the Act does not apply and I have only the prima facie case to consider.

8. The mark consists of two representations, the first being presented at an angle, the second presented face-on. It is clear that they are intended to show the three-dimensional shape of a foil container for beverages. At the top, sides and base there is what appears to be a flattened edge where the two sides of the packaging are sealed together. The container is also curved in the middle to give it the appearance of having a "waist".

9. In correspondence and at the hearing, the agent made it clear that the applicants were not seeking to obtain a monopoly in foil containers but argued that the overall get-up of the mark at issue was different from other containers and "configured in a manner that distinguishes the resultant whole from the usual way of designating the goods or services concerned or their essential characteristics.". This is a direct quote from paragraph 39 of the judgement issued by the European Court of Justice on 20 September 2001, *Procter & Gamble Company v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) OHIM, Case 383/99P* which gives guidance on the scope and purpose of Article 7(1)(c) of the Community Trade Mark Regulation (equivalent to Section 3(1)(c) of the Trade Marks Act). Paragraph 39 of the Judgement, together with related paragraph 37 are reproduced below:

“37. It is clear from those two provisions taken together that the purpose of the prohibition of registration of purely descriptive signs or indications as trade marks is, as both Procter & Gamble and the OHIM acknowledge, to prevent registration as trade marks signs or indication which, because they are not different from the usual way of designating the relevant goods or services or their characteristics, could not fulfil the function of identifying the undertaking that markets them and are thus devoid of the distinctive character needed for that function.

39. The signs and indications referred to in Article 7(1)(c) of Regulation 40/94 are thus only those which may service in normal usage from a consumer’s point of view to designate, either directly or by reference to one of their essential characteristics, goods or services such as those in respect of which registration is sought. Furthermore, a mark composed of signs or indications satisfying that definition should not be refused registration unless it comprises no other signs or indications and, in addition, the purely descriptive signs or indications of which it is composed are not presented or configured in a manner that distinguishes the resultant whole from the usual way of designating the goods or services concerned or their essential characteristics.”

10. It is clear from the judgement in the BABY-DRY case that the purpose of Article 7(1)(c) of Regulation 40/94 (Section 3(1)(c) of the UK Act) is to prohibit the registration of trade marks that are directly descriptive and thus devoid of the distinctive character required to function as a trade mark. This judgement refers to word marks but there seems no reason why different legal criteria should apply for other types of marks, including three-dimensional marks. I am reinforced in my view by the comments in the Court of First Instance, *Henkel KgaA v. OHIM* case, T-30/00, 2002 ETMR25 at paragraphs 48 and 49 (detergent tablet):

“Article 7(1)(b) of Regulation 40/94 does not distinguish between different categories of trade marks. The criteria for assessing the distinctive character of figurative marks consisting 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 figurative mark consisting of a faithful representation of the product itself as it is in relation to a word mark or a figurative or three-dimensional mark not

faithfully representing 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. It follows that an assessment of distinctive character cannot result in different outcomes for a three-dimensional mark consisting of the design of the product itself and for a figurative mark consisting of a faithful representation of the same product.”

11. Although these comments were made in respect of a "product appearance" mark, I am of the opinion that it applies similarly to other less conventional trade marks such as bottles, sachets or other forms of container, particularly in the case of liquid products where the appearance of the packaging is indistinguishable from the appearance of the product itself, as presented to the consumer.

12. In my view, the mark applied for does not differ greatly from other such foil containers - examples which were copied to the agent are attached as Annex A. Clearly the mark is not the same as these examples. However, I have no evidence that any trade mark significance attaches to the overall shape of the packaging. To my mind the only element which is particularly noticeable is the "waist" effect of the shape. In my view it is likely to be seen only as a means of holding the container more easily, especially given its non-rigid "feel" as it will contain liquid. Even if the overall appearance was considered to be different from other foil containers this would not, in my view, be sufficient to indicate trade mark significance. I bear in mind the comments by Laddie J in Yakult Honsha KK's Trade Mark Application [2001] RPC 39 (page 756) at paragraphs 10 and 11:

“10. Where inherent distinctiveness is concerned, the Registry has to find that the mark performs the function of identifying origin even before the public is educated that it is so used for that purpose. Where invented, non-descriptive word marks are concerned, it may be easy to come to such a finding. But where a container is in issue it may well be much more difficult. As Mr Thorley rightly conceded, the fact that a container is unusual or attractive does not, per se, mean that it will be taken by the public as an indication of origin. The relevant question is not whether the container would be recognised on being seen a second time, that is to say, whether it is of 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 which is the subject of these applications 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.

11. Mr James came to the conclusion that the average consumer was likely to conclude that the design in the applications was nothing more than a bottle of pretty ordinary shape. I agree. Like Mr James, I can see nothing which would convey to someone who was not a trade mark specialist that this bottle was intended to be an indication of origin or that it performed that function.

Even were it to be recognised as of different shape to other bottles on the market, there is nothing inherent in it which proclaims it as having trade mark significance.”

13. In my view the mark applied for will not be taken as a trade mark without first educating the public that it is. The overall impression of the mark is not sufficiently different from other such containers as to convey trade mark significance. I therefore conclude that the mark applied for is devoid of any distinctive character and consists exclusively of a sign that may serve in trade to designate the kind and intended purpose of the goods and is thus excluded from protection in the United Kingdom under Sections 3(1)(b) & (c) of the 1994 Act.

14. In this decision, I have considered all the documents filed by the applicant and all the arguments submitted to me in relation to this designation and, for the reasons given, it is refused under the terms of Articles 3 and 9(3) of the Trade Marks (International Registration) Order 1996 (as amended) because it would fail to qualify under Sections 3(1)(b) & (c) of the Act.

Dated this 26 day of July 2002

R A Jones
For the Registrar
The Comptroller General

Annex A: Available as ‘order a copy’.