

O-130-05

TRADE MARKS ACT 1994

AND

THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996

IN THE MATTER OF INTERNATIONAL REGISTRATION NO. 802779

AND THE REQUEST BY EKORNES ASA

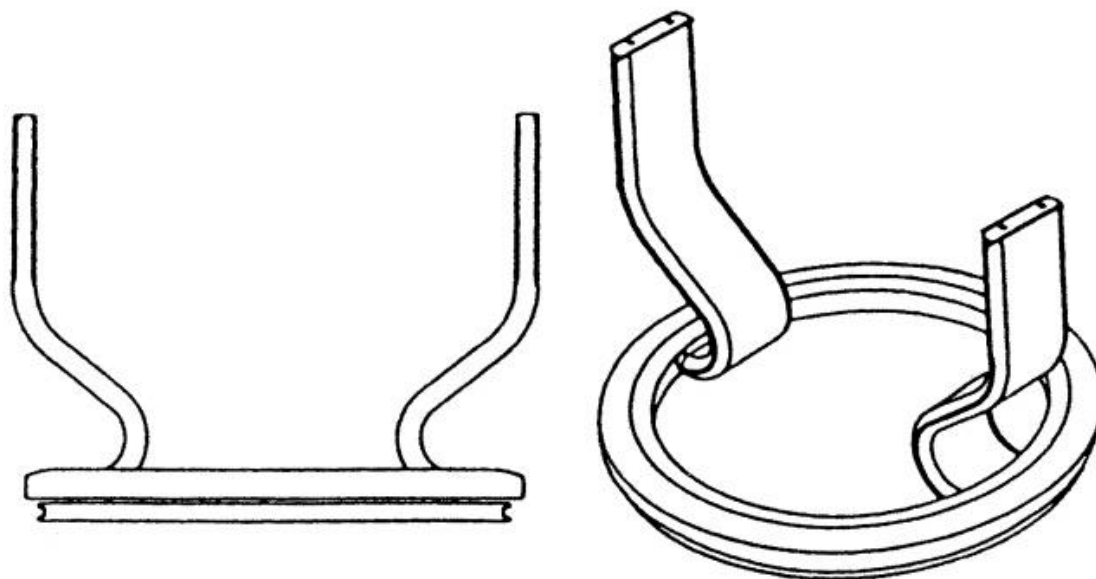
TO PROTECT A TRADE MARK IN CLASS 20

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**IN THE MATTER OF INTERNATIONAL REGISTRATION NO. 802779
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TO PROTECT A TRADE MARK IN CLASS 20**

Background

1. On 7 May 2003 Ekornes ASA of Postboks 23, N-6222 IKORNES, Norway on the basis of International Registration No. 802779 requested protection in the United Kingdom, under the provisions of the Madrid Protocol, of the trade mark



2. The application was made in respect of the following goods:

Class 20 Chairs; recliner chairs, recliner chairs with footstools.

3. It was considered that the request failed to satisfy the requirements for registration in accordance with Article 3 of the Trade Marks (International Registration) Order 1996 and Notice of Refusal was given because the mark is excluded from registration by Sections 3(1)(b) and 3(2)(b) of the Trade Marks Act 1994 because the mark is a

sign which is devoid of any distinctive character when used in relation to e.g. furniture and because the mark consists exclusively of the shape of the goods which is necessary to achieve a technical result.

4. In an attempt to overcome these objections the applicant submitted evidence in the form of two Witness Statements. The first is by Svein Lunde who is International Marketing Manager of Ekornes Limited, the UK wholly owned subsidiary of the applicant. The second is by Chris Boiling who is the Editor of a magazine entitled "Furnishing". The purpose of this evidence is two fold. Firstly it demonstrates that the trade mark applied for has been in use, within the United Kingdom since 1983 and, secondly, that other manufacturers of similar products use bases which are different in shape from the trade mark applied for.

5. Mr Lunde describes the trade mark as consisting of two curved "S" shapes which link into a circular base.

The Hearing

6. A hearing was held on 20 October 2004 when the applicant was represented by Ms Clark of Haseltine Lake, their trade mark attorneys. Following the hearing I wrote to Haseltine Lake maintaining the objections raised under Sections 3(1)(b) and 3(2)(b) of the Act.

7. Following refusal of the application I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Marks Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

The Law

Section 3(2)(b)

8. Section 3(2)(b) of the Act is as follows:

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

- (a) –
- (b) the shape of goods which is necessary to achieve a technical result, or
- (c) -.”

9. The provision has its origins in Article 3(1)(e), second indent, of EC Directive 104/89.

10. The European Court of Justice (ECJ) considered the meaning and scope of this provision in case C-299/99, *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* which is reported at [2003] RPC2.

11. In *Philips*, the Court was asked, inter alia, whether a shape is unregistrable if its essential features are shown to be attributable only to a technical result and whether such an objection can be overcome by showing that there are other shapes which could obtain the same technical result. The Court answered this question as follows:

“Article 3(1)(e), second indent, of Directive 104/89 must be interpreted to mean that a sign consisting exclusively of the shape of a product is unregistrable by virtue thereof if it is established that the essential functional features of that shape are attributable only to the technical result. Moreover, the ground for refusal or invalidity of registration imposed by that provision cannot be overcome by establishing that there are other shapes which allow the same technical result to be obtained.”

12. The Registrar’s objection to this particular shape is that its essential features are functional. It consists of two curved “S” shaped legs which link into a circular base. It is clear from the exhibits to the Witness Statement of Mr Lunde that these are used as a base to support both chairs and footstools. I consider it obvious that both chairs and footstools require such a base for them to properly function. The primary function of such bases is to raise the area of the chair and footstool to an appropriate height which results in chairs and footstools which are convenient to use and maximise comfort. Such bases provide the stability necessary for such products to properly function. Bases require a strong and durable design.

13. Both Mr Lunde and Mr Boiling make the point that the shape applied for is not the only shape which is used as bases for furniture. However, it is clear from *Philips* that establishing that there are other shapes which allow the same technical result to be obtained does not result in a shape for which registration may be granted. This shape is not a combination of simple straight chair legs. Its shape is more complex than that. The curved “S” shaped legs are curved in an appropriate manner for either end to be connected to other parts of the product. This curved “S” shape is governed by the joining points of the base and the seat. The design of the base is such that it appears to incorporate a groove into which the legs are inserted and connected. In order to connect to the upper part of the chair or footstool the legs simply must be shaped the way that they are. This allows the top of the legs to be connected at a point which is directly above the connection to the actual base.

14. In his Witness Statement Mr Lunde makes the following statement:

“The Trade Mark consists of two curved “S” shapes which link into a circular base. The device has been chosen for its aesthetic qualities as well as to provide maximum strength and durability for the upper part of the recliner/chair/stool as required. The Trade Mark is the only base used for all of Ekornes’ recliners and matching stools. It is not the most functional shape for such a purpose and we instructed our design department to design a shape which would achieve several purposes: provide a suitable base for the furniture and make it recognisable in the market place. It is quite different to other shapes used as bases for furniture and our customers recognise it as Ekornes’.”

15. However, good the intentions of the applicant may be in choosing this particular shape I must consider if the shape in question is exclusively the shape of goods which is necessary to obtain a technical result. As I have explained, the fact that the designers of the competitors’ products have adopted designs which differ from the applicant’s design is of no assistance as far as this application is concerned. There is

no evidence as to why the applicant or the competitors arrived at different designs for the same products although I do not find such a fact to be particularly surprising. The competitors' choice may well have been limited or constrained by real or perceived intellectual property rights or other considerations.

16. The evidence indicates that the shape for which registration is sought is one where the essential features are functional and that these features are attributable only to a technical result.

Section 3(1(b))

17. According to the ECJ in *Philips* (see paragraphs 75 and 76 of the judgement), a sign excluded by any of the provisions corresponding to Article 3(1)(e) of the Directive can never be registered as a trade mark. Consequently, if I am right in concluding that the applicant's shape is excluded by Section 3(2)(b) of the Act, there is no need to go into the reasons why Section 3(1)(b) may otherwise have applied. However, for the sake of completeness I shall do so.

18. The relevant parts of Section 3(1) are as follows:

“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 paragraphs (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.”

19. The approach to be adopted when considering the issue of distinctiveness under Section 3(1)(b) of the Act has recently been summarised by the European Court of Justice in paragraphs 37, 39 to 41 and 47 of its Judgment in *Joined Cases C-53/01 to C-55/01 Linde AG, Windward Industries Inc and Rado Uhren AG* (8th April 2003) in the following terms:

“37. It must first of all be observed that Article 2 of the Directive provides that any sign may constitute a trade mark provided that it is, first, capable of being represented graphically and, second, capable of distinguishing the goods and services of one undertaking from those of other undertakings.

.....

39. Next, pursuant to the rule 1 Article 3(1)(b) of the Directive, trade marks which are devoid of distinctive character are not to be registered or if registered are liable to be declared invalid.

40. For a mark to possess distinctive character within the meaning of that provision it must serve 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 products of other undertakings (see Philips, paragraph 35).
41. In addition, a trade mark's distinctiveness must be assessed by reference to, first, the goods or services in respect of which registration is sought and, second, the perception of the relevant persons, namely the consumers of the goods or services. According to the Court's case-law, that means the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and circumspect (*see Case C-210/96 Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 31, and Philips, paragraph 63).
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47. As paragraph 40 of this judgment makes clear, distinctive character means, for all trade marks, that the mark must be capable of identifying the product as originating from a particular undertaking, and thus distinguishing it from those of other undertakings."

20. In order to achieve registration I acknowledge that there is no requirement for a trade mark to possess a specific level of linguistic or artistic creativity or imaginativeness. I must determine whether the trade marks applied for are capable of enabling the relevant consumer of the services in question to identify the origin of the services and thereby to distinguish them from other undertakings. In *OHIM v SAT.1* (Case C-329/02) the European Court of Justice provided the following guidance at paragraph 41:

"41 Registration of a sign as a trade mark is not subject to a finding of a specific level of linguistic or artistic creativity or imaginativeness on the part of the proprietor of the trade mark. It suffices that the trade mark should enable the relevant public to identify the origin of the goods or services protected thereby and to distinguish them from those of other undertakings."

21. In order for the trade mark applied for to be acceptable for prima facie registration it must convey trade mark significance to the relevant consumer who, in this case, I consider to be the general public. The goods in question are chairs, recliner chairs and recliner chairs with footstools. Such goods are not uniform in any way but are available in a wide variation of shapes and styles. This is supported by the Witness Statement of Mr Boiling and the exhibits attached thereto. As far as this particular style is concerned I do not consider it to be so different from the norm in the sector concerned as to permit an average consumer to distinguish the goods of the applicant from those of other traders.

22. The applicant has not contested the assessment by the examiner that when considered as an unused mark it is devoid of any distinctive character. That must be right and I am satisfied that when considered as an unused mark the average consumer

of the goods in question would not conclude that this sign is an indication of the origin of the goods. It follows that this application is debarred from prima facie acceptance by Section 3(1)(b) of the Act.

The Case for Registration based on Acquired Distinctiveness

23. Evidence in support of this application was filed on 4 June 2004. This consisted of Witness Statements together with accompanying exhibits by Svein Lunde and Chris Boiling.

24. The first Witness Statement is by Mr Lunde who is the International Marketing Director of Ekornes Limited which is a wholly owned subsidiary of Ekornes ASA, the applicant. Mr Lunde has held this position since March 2003. Prior to that appointment he held the position of Managing Director with Ekornes Limited from August 1994 to February 2003. In his Witness Statement Mr Lunde explains that the goods in question are at the luxury end of the furniture market with an average price of £1,000 for each piece of furniture. He goes on to advise that the mark was first used in the United Kingdom in 1983 and provides details of turnover and advertising figures from 1995 to 2003 as follows:

TURNOVER		ADVERTISING	
YEAR	£	YEAR	£
1995	3,303	1993	103
1996	4,465	1994	119
1997	7,682	1995	110
1998	9,159	1996	175
1999	10,193	1997	218
2000	11,057	1998	276
2001	14,845	1999	674
2002	16,149	2000	678
2003	6,108 (by end April)	2001	779
		2002	1762
		2003	473

25. It should be noted that at the hearing Ms Clark confirmed that these figures are incorrect. They are quoted as pounds sterling but these figures are in fact £,000s.

26. I have assumed that a supplementary witness statement could be filed confirming that the above figures represent £,000s and not pounds sterling, on that basis sales appear to be at a reasonable level, but given the size of the furniture market within the United Kingdom it is not possible to determine with any degree of accuracy the actual

size of the market for chairs, reclining chairs and reclining chairs with footstools. It is equally impossible to judge the applicant's market share within that market.

27. Mr Lunde states that the trade mark is widely promoted at exhibitions and in magazines but he does not go so far as to state that the goods in question are available throughout the United Kingdom.

28. Exhibit SL1 is a copy of the applicant's Annual Report dated 2002. This provides detailed information about the applicant but also features several photographs which demonstrate the mark in use. Exhibit SL2 is a selection of articles and promotional leaflets which again show the mark in use. I note that all of these promote the complete chair under the trade mark STRESSLESS in a slightly stylised presentation. I note that none of these make any reference to the mark applied for but simply promote the comfort and relaxation qualities of the complete chair. Exhibit SL3 contains a selection of invoices. These confirm the extent and area of sales but do not carry any representation of the trade mark applied for.

29. The second Witness Statement is by Chris Boiling who is the Editor of a magazine entitled "Furnishing" which is a specialist magazine distributed in the United Kingdom on a monthly basis featuring articles on all types of furniture. There is no evidence to indicate whether Mr Boiling has any professional connection or association with the applicant nor is there any explanation as to why he was chosen to provide evidence in support of this application. It is apparent from Exhibit CB2 of his Witness Statement that the applicant's products appear in the magazine of which he is editor but there is no information as to what other such magazines are in circulation and why this particular one was chosen.

30. Mr Boiling makes reference to other manufacturers of the goods in question and suggests that the bases of the products vary and are distinctive of the various products because the upper parts of the goods are invariably similar in style. He makes the following comments regarding these products:

"4 I am aware of the range of recliners and matching footstools marketed by Ekornes and particularly the "Stressless" range with its distinctive slimmer and sleeker look than the US equivalent of recliners which tend to (be) larger and chunkier.

5 The base used by Ekornes is a particularly distinctive one and I readily recognise it as belonging to the Ekornes group of furniture. I would not confuse it with any others and each major furniture company has developed its own look as in CB1 above. I would view this base as an identifying mark for Ekornes' products and a distinguishing feature which is known throughout the UK and any other countries where the Ekornes goods are distributed".

31. Exhibit CB1 provides copies of promotional leaflets from a selection of products available from other manufacturers. Exhibit CB2 is a selection of articles in the "Furnishing" magazine which cover what Mr Boiling describes as "The Ekornes "Stressless" range with its distinctive base.....".

Decision

32. The question to be determined is whether, through the use made of it, the sign applied for has acquired a distinctive character in respect of the goods for which registration is sought. In doing so this question must be asked through the eyes of the average consumer who is reasonably well informed and reasonably observant and circumspect (*Lloyd Schufabrik Meyer & Co. GmbH v. Klijsen Handel BV*, Case C-342/97[1999] ECR I-3830 para.26).

33. 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.”

34. The goods in question are defined in the exhibits as reclining chairs and footstools. They are sold to the general public who, in respect of this application, must be considered to be the relevant consumer of the goods in question. It is clear from

paragraph 4 of the Witness Statement of Mr Lunde that the goods in question are at “the luxury end of the furniture market” costing, as they do, in the region of £1,000 each. Mr Lunde makes no further comment regarding the price of this furniture. Ms Clark of Haseltine Lake makes further reference to the price of these goods in her letter of 4 June 2004. I should make it clear that this matter must be judged by reference to the market for chairs, reclining chairs and footstools generally and should not be restricted to the luxury end of the furniture market (*see Dualit Ltd’s Trade Mark Application(No.2023846)* [1999] RPC 890 paragraph 25).

35. Mr Boiling states that he considers the mark applied for as distinctive and states that he would recognise it as identifying furniture belonging to the applicant. I note that he does not make any comment as to how the general public would perceive this mark. In *Dualit* Lloyd J. made the following comment regarding evidence from trade experts such as Mr Boiling:

“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.”

36. It is clear from the evidence that although the mark applied for is a three-dimensional representation of the base of reclining chairs and footstools, several of the exhibits show the mark in use but only as a component within the complete chair or footstool. It is never shown on its own apart from a few photographs in the Annual Report which forms Exhibit SL1 to the Witness Statement of Svein Lunde. I note that there is no evidence that a significant proportion of the general public, who are the relevant consumer of these products, have access to or have ever seen this or any of the earlier Annual Reports. The mark is not referred to in any of the exhibits; it merely appears as an element in the complete article. The only trade mark reference that I have been able to identify from this evidence is the word STRESSLESS which is, in all probability, the name by which the general public will refer to these products.

37. There is one further point which leads me to determine that the mark applied for is not distinctive and does not depart significantly from the normal design of such base units for chairs and footstools. The exhibits attached to the Witness Statement of Chris Boiling demonstrate that the use of a circular base and curved legs are commonly used as a construction system for bases for reclining chairs and footstools. They may not be identical to the trade mark for which registration is sought but they are, conceptually and visually, so similar that only an expert such as Mr Boiling would pay attention to the difference. In my view the general public, when faced with such an array of similar bases, would place no trade mark significance upon them at all. They may identify them as having some aesthetic appeal or they may perceive them as being of a particularly strong and durable design but they would not provide any message, to the general public that the goods emanate from a single undertaking.

As far as the applicant's goods are concerned they are far more likely going to ask for a STRESSLESS chair or footstool because they would perceive that word as the trademark for the goods in question and would not even identify the mark applied for as any indication of the trade origin of the goods.

38. Clearly the evidence incorporates references to the trade mark applied for, but the evidence does not go so far as to indicate that the applicant has been successful in educating the relevant consumer that the trade mark applied for is a trade mark and that it distinguishes the goods of the applicant from goods of another trader.

39. On the basis of this evidence the applicant has not, in my view, been successful in satisfying the test identified in the judgement of the ECJ in *Windsurfing Chiemsee Produktions Und Vertriebs GMBH v. Boots-Und Segelzubehor Wlater Huber* as set out earlier in this decision.

40. In my view, the sign applied for will not be taken as a trade mark without first educating the relevant consumer that it is a trade mark and there is insufficient evidence that the applicant has educated such consumers to this perception. It follows that this application is debarred from prima facie acceptance by Section 3(1)(b) of the Act.

Conclusion

41. In this decision I have considered all the documents filed by the applicant 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 because it fails to qualify under Sections 3(2)(b) and 3(1)(b) of the Act.

Dated this 9th day of May 2005

A J PIKE

**For the Registrar
The Comptroller General**