

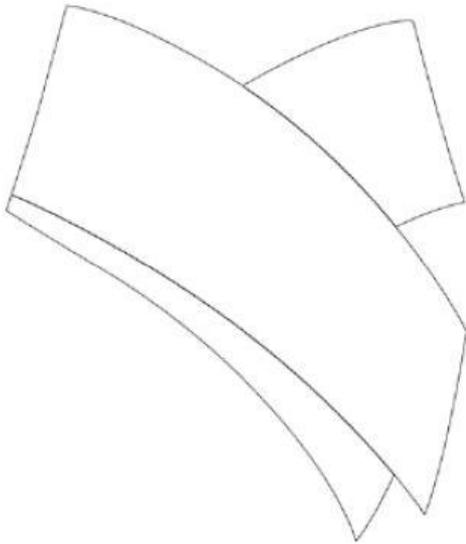
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TRADE MARKS ACT 1994

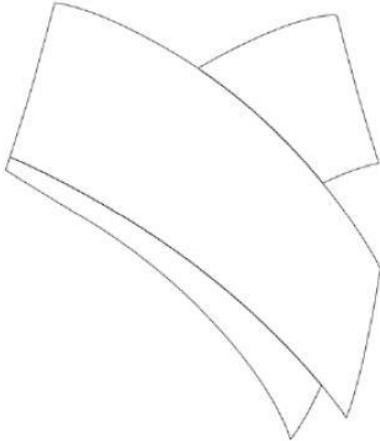
IN THE MATTER OF APPLICATION NUMBER 2599505

BY NYETIMBER LIMITED

TO REGISTER THE FOLLOWING TRADE MARKS IN CLASSES 16, 32 AND 33



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Background

1. On 28 October 2011, Nyetimber Limited ('the applicant') applied to register the trade mark shown above for the following goods:

Class 16: Printed matter; printed publications; books; booklets; guides; reference books; newsletters; programmes; information leaflets; bulletins; brochures; magazines; leaflets; posters; pictures; price lists; notelets; diaries; calendars; labels; cards; business cards; collars; packaging; bubble packs for packaging; bubble packs for wrapping; bubble wrapping for bottles; packaging in the form of a tube to protect bottles; bottle wrappers of cardboard; bottle wrappers of paper; paper tissue; tags; boxes; boxes in collapsible form; cartons; cartons in collapsible form; cardboard gift bags; cardboard carrying cases; gift boxes; gift cartons; gift wrapping materials; gift wrap; bows; bottle decorations; decanter mats; drink mats

Class 32: Alcohol free wine; alcohol free sparkling white wine; alcohol free red wine; alcohol free rosé wine; alcoholic beverages; alcoholic cocktails; alcoholic drinks; non-alcoholic aperitifs; punches (fruit drinks); rice wines; aerated drinks; aerated beverages; aerated water; aerated juices; fruit and vegetable drinks; still water; beverages.

Class 33: Sparkling wine; sparkling white wine; sparkling rosé wine; wine; white wine; red wine; rosé wine; flavoured sparkling wine; alcoholic beverages; spirits; beverages;

alcoholic cocktails; alcoholic drinks; aperitifs; liqueurs; mulled wine; nectars; punches (alcoholic fruit drinks).

2. On 11 November 2011, the Intellectual Property Office ('IPO') issued an examination report in response to the application. In that report, an objection was raised under section 3(1)(b) of the Trade Marks Act 1994 ('the Act') on the basis that the mark consists of a simple geometric shape that has the appearance of a label or bottle collar, which would not be perceived as having any trade mark significance. A separate objection was taken under section 3(1)(c) of the Act on the basis that the sign may serve in trade to designate the kind of goods e.g. paper labels and paper collars in Class 16.

3. On 10 February 2012, Mischon de Reya (a partnership) acting as the applicant's representative ('the agent') submitted written correspondence, setting out reasons in favour of acceptance of the mark, and also agreeing to some minor specification amendments.

4. On 16 February 2012, the examiner responded to those submissions stating that she was not persuaded by the arguments in favour of *prima facie* acceptance for all the goods claimed. However, she was persuaded that the sign is distinctive for certain goods, and waived the objection in respect of the following:

Class 16: Printed matter; printed publications; books; booklets; guides; reference books; newsletters; programmes; information leaflets; bulletins; brochures; magazines; leaflets; posters; pictures; price lists; notelets; diaries; calendars; business cards; packaging; bubble packs for packaging; bubble packs for wrapping; bubble wrapping for bottles; packaging in the form of a tube to protect bottles; bottle wrappers of cardboard; bottle wrappers of paper; paper tissue; boxes; boxes in collapsible form; cartons; cartons in collapsible form; cardboard gift bags; cardboard carrying cases; gift boxes; gift cartons; gift wrapping materials; gift wrap; bows; decanter mats; drink mats.

5. The objection was therefore maintained against '*labels, cards, collars, tags and bottle decorations*' in Class 16 and *all of the goods* in Classes 32 and 33. Following receipt of the examiner's letter, the agent requested an *ex parte* hearing.

6. The hearing was held on 16 May 2012, with Ms Jackie Bolton and Mr Simon Tracey of Mischon de Reya (a partnership) representing the applicant. At the hearing, the partial objection was maintained, and further time was granted for the agent to submit materials which, it was submitted, would demonstrate that the sign is distinctive.

7. No further evidence was filed, and on 31 July 2021 a formal notice of refusal was issued. In response, Ms Bolton filed a form TM5 seeking a statement of reasons for the Registrar's decision.

8. I am now asked under section 76 of the Trade Marks Act 1994 and rule 69 of the Trade Marks Rules 2008 to state in writing the grounds of my decision and the materials used in arriving at it. No formal evidence has been put before me for the purposes of demonstrating acquired distinctiveness. Therefore, I have only the *prima facie* case to consider.

The applicant's case for registration

9. Prior to setting out the law in relation to section 3(1)(b) of the Act, I must emphasise that the following decision will set out my reasons for maintaining the objection by reviewing and assessing the mark applied for. On 10 February 2011 the agent submitted arguments in writing in support of the mark's alleged *prima facie* distinctiveness which are summarised as follows:

- The mark applied for is a two-dimensional representation of a cordon, or collar, which is a feature of the get-up of sparkling wine and champagne bottles. The cordon is found on or around the neck of the bottle; cordons are distinct from the label of the bottle.
- Reference was made to decisions of the Court of Justice of the European Union (CJEU), in relation to „shape’ marks, due to the characteristic of the mark applied for.
- Exhibits were provided showing extracts from Tesco and Majestic Wines’ websites which show bottles bearing cordons on or at the neck of the bottle. Further exhibits were provided in respect of precedents which have been accepted as Community Trade Marks, along with submissions as to why the applicant’s cordon is different from conventional cordons by virtue of it being purposefully 'stark' or 'bare'.
- Reference was made to the fact that the goods intended for protection are at the higher end of the market, particularly so in supermarkets, where alcohol products are often amongst the most expensive foodstuffs available for purchase. It was submitted that the average consumer will be very knowledgeable, observant and circumspect, and that the level of attention will vary depending on whether the goods are purchased in a supermarket or specialist wine shop.
- Due to the fact that these goods are arranged by type or variety, and are often found side-by-side on the supermarket or off-licence shelf, consumers will be able to easily view and compare competing products. Distinction between brands would be assisted by generic styles of label and/or foil wrapping on the neck of the bottle, in addition to the cordon.
- The applicant’s mark would assist in distinguishing one bottle from another because it departs significantly from the appearance of other cordons in the market place.
- Cordons are unique to the sparkling wine and champagne industry as they are only used on these goods, and not on wines *per se*. Cordons are as vital to the „get up’ of a bottle as a label, but they serve a different purpose. They are not a necessity; rather, they are an embellishment to the bottle and, as such, can present whatever information the wine producer chooses. Cordons, in their position at, or on, the neck of the bottle, are sufficiently capable of acting as an identifier of the producer’s goods.
- The mark is unique in the sector because of the presence of its two „protrusions’, and its allusory „scarf wrap’ characteristic.

10. Prior to the hearing, Ms Bolton provided exhibits demonstrating the fact that a special purpose-built labelling machine was necessary in order to affix this particular cordon to bottles. Along with these exhibits, the agent also provided materials showing how the

applicant uses the sign in trade. At the hearing, Ms Bolton reiterated the arguments made previously in correspondence, and also presented new arguments. Oral submissions made at the hearing by both Ms Bolton and Mr Tracey are summarised below:

- Ms Bolton disagreed with the wording of the objection and the fact that the mark had been referred to as a simple geometric shape. She referred to the Examination Guide (part of the IPO Trade Marks Work Manual), stating that a „simple geometric shape’ is a circle, a rectangle or a square.
- The mark is simple and minimalist and, in the abstract, would not be perceived as a cordon or neck label by the average consumer.
- Because the mark does not have additional wording or any crest, its appearance as filed does not constitute any basis for concluding that the sign lacks distinctive character.
- From research, cordons are historically used as brand identifiers.
- The investment, time, and effort which have gone into this mark should be considered when assessing its distinctiveness.

11. I have noted the fact that in written submissions and at hearing, Ms Bolton and Mr Tracey both made reference to precedents which had been accepted for registration. Whilst I acknowledge these submissions, I have assessed the mark on its own merits and therefore attach limited significance to the fact that other „cordon’ marks have already been registered.

12. Nor have I been swayed by the agent’s reference to the fact that the mark has been accepted in other member states. Notwithstanding Council Directive 89/104/EEC, the Registrar is not bound by the decisions of other national offices, as confirmed by the CJEU in its judgement on *Henkel KGaA v Deustches Patent und Markenamt* (C-218/01) where it was stated that:

“The fact that an identical trade mark has been registered in one Member State for identical goods or services may be taken into consideration by the competent authority of another Member State among all the circumstances which that authority must take into account in assessing the distinctive character of a trade mark, but it is not decisive regarding the latter’s decision to grant or refuse registration of a trade mark.

On the other hand, the fact that a trade mark has been registered in a Member State for certain goods or services can have no bearing on the examination by the competent trade mark registration authority of another Member State of the distinctive character of a similar trade mark application for registration of a similar mark for goods or services similar to those for which the first mark was registered.”

13. I should emphasise that, at the hearing, the objection was maintained under section 3(1)(b) on the basis that the sign is devoid of distinctive character - not on the basis that it would serve to designate a characteristic of the goods pursuant to section 3(1)(c). In view of the fact that an objection under section 3(1)(c) was initially raised against class 16, I should

reiterate here that the 3(1)(c) objection against those goods was subsequently waived at the ex parte hearing. Refusal of the sign is under section 3(1)(b) only.

The Law

14. Section 3(1) of the Act reads as follows:

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

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

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.”

The above provisions mirror Article 3(1)(b) of First Council Directive 89/104 of 21 December 1988. The proviso to section 3 is based on the equivalent provision of Article 3(3).

Decision - Section 3(1)(b)

15. It is apparent from settled case-law that, for a trade mark to possess distinctive character within the meaning of section 3(1)(b), it must serve to identify the goods in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish those goods from those of other undertakings (see judgments of the Court of 29 April 2004 in Joined Cases C-473/01 P and C-474/01 P *Procter & Gamble Company v OHIM* („Tabs’) [2004] ECR I-5173, at paragraph 32; and 4 October 2007 in Case C-144/06 P *Henkel KgaA v OHIM* („Tabs’) [2007] ECR I-8109, at paragraph 34).

16. Thus, the signs referred to in section 3(1)(b) as being unregistrable are signs which are regarded as incapable of performing such a function.

17. Further, the distinctive character of a trade mark must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of the relevant public which consists of average consumers of the goods or services in question who are reasonably well informed and reasonably observant and circumspect (see, *Procter & Gamble v OHIM*, cited above, paragraph 33; and judgment of the Court of 22 June 2006 in Case C-25/05 P *August Storck KG v OHIM* („Bonbonverpackung’) [2006] ECR I-5719, at paragraph 25).

18. On the basis of guidance presented above, it is clear that any assessment of a mark’s distinctiveness pursuant to section 3(1)(b) must take into account both the nature of the goods claimed, and the likely perception of the relevant consumer using those goods. By considering such factors, I will be able to determine the likelihood of any potential consumer perceiving the sign applied for as either a distinctive indicator of origin, or simply as an origin-neutral sign.

19. The objectionable goods are ‘*labels, cards, collars, tags, and bottle decorations*’ in class 16; ‘*alcohol free wine; alcohol free sparkling white wine; alcohol free red wine; alcohol free rosé wine; non-alcoholic aperitifs; punches (fruit drinks); aerated drinks; aerated beverages*;

aerated water; aerated juices; fruit and vegetable drinks; still water; beverages in class 32; and *'sparkling wine; sparkling white wine; sparkling rosé wine; wine; white wine; red wine; rosé wine; flavoured sparkling wine; alcoholic beverages; spirits; beverages; alcoholic cocktails; alcoholic drinks; aperitifs; liqueurs; mulled wine; nectars; punches (alcoholic fruit drinks); rice wines* in class 33.

20 It is reasonable to assume that, in respect of the goods in Class 32, the average consumer is the general public at large, whilst in respect of the goods in class 33, it is the *adult* general public at large. With regard to the class 16 goods, it would appear that they are targeted at both the general public and also beverage manufacturers. The level of consumer attention may therefore vary a little depending on the customer; however, I consider it reasonable to assume that a prospective user of the applicant's goods would apply a moderate level of attention at the point of considering a purchase.

21. Given that the objection has been maintained under section 3(1)(b), the issue here is whether the two-dimensional representation of a cordon, when used in respect of both 'labels, cards, collars, tags and bottle decorations' and various beverages proper to classes 32 and 33, would be perceived as one which simply lacks any capacity *prima facie* to distinguish the products of one trader from those of another. At the hearing it was submitted that 'in the abstract' the sign would not be perceived as a cordon or a neck label. However, the agent has both informed and shown me how it is being used in trade via submission of the materials presented at Annex A, all of which show the mark as filed attached to the outer surface of the bottle neck. Given that these materials have been submitted, it seems reasonable for me to now consider the perception of the relevant consumer by reference to such use in trade.

22. With regard to the class 16 goods, I note that the mark consists of an outline representation which resembles the appearance of a ribbon, and also note the following definition for '*cordon*' contained in Chambers Dictionary (other dictionaries contain similar definitions):

cordon *noun* 2. A ribbon bestowed as a mark of honour.

The mark applied for has the overall appearance of a standard cordon. Indeed, the mark is comprised of a combination of presentational features which come naturally to the mind, and which are typical of the goods listed under class 16. I note the agent's claim that the sign does possess uniqueness - most notably due to the 'wraparound' effect and the two lower protrusions - but I do not think that such features would enable the relevant public to distinguish immediately and with certainty the applicant's goods from those of another trader. In respect of labels, cards, collars, tags, and other decorative materials intended for use on the outer surface of a bottle, the sign is therefore devoid of any distinctive character.

23. Turning to classes 32 and 33, the agent has already advised and demonstrated how the mark is being used on those goods, and it is therefore obvious from these exhibits that the cordon is intended to be part of the trade dress and packaging of the drink products. Although Ms Bolton submitted that cordons have historically been used as brand identifiers. I am not aware of any evidence to support this fact. I am, however, aware that the use of cordons on champagne and sparkling wine bottles goes back to the early nineteenth century

when they were often used to denote an award, or to certify a particular quality. However, I do not believe that such historical facts support the claim to inherent distinctiveness.

24. I am also aware, both from the materials presented to me and from my own knowledge, that champagne and sparkling wine bottles often carry a range of decorative labelling materials on their outer surface - some of which are there to indicate trade origin, and some of which are there to perform a simple aesthetic function. In most cases, consumers would look to the most prominent and/or obvious signifiers visible on the labelling in order to identify trade origin. These might most obviously be in the form of a distinctive brand name, the name of the winemaker and/or the name of the vineyard. In the present case, where the cordon does not contain any additional information but which instead takes on the form of an essentially 'blank' label, I find its graphical form to be visually unsurprising. As noted at paragraph 15 above, the agent submitted that the absence of any additional material in the cordon actually serves to support, rather than detract from, the claim to inherent distinctiveness. However, in my own view, the absence of any additional elements such as a brand name, only serves to reinforce my belief that the sign would *not* be perceived as an indicator of origin by the relevant consumer.

25. In light of all of the above, the mark is devoid of any distinctive character, and thus excluded from *prima facie* acceptance under section 3(1)(b) of the Act in respect of:

Class 16: Labels, cards, collars, tags and bottle decorations.

Class 32: Alcohol free wine; alcohol free sparkling white wine; alcohol free red wine; alcohol free rosé wine; non-alcoholic aperitifs; punches (fruit drinks); aerated drinks; aerated beverages; aerated water; aerated juices; fruit and vegetable drinks; still water; beverages.

Class 33: Sparkling wine; sparkling white wine; sparkling rosé wine; wine; white wine; red wine; rosé wine; flavoured sparkling wine; alcoholic beverages; spirits; beverages; alcoholic cocktails; alcoholic drinks; aperitifs; liqueurs; mulled wine; nectars; punches (alcoholic fruit drinks); rice wines.

The mark is, however, acceptable in respect of:

Class 16: Printed matter; printed publications; books; booklets; guides; reference books; newsletters; programmes; information leaflets; bulletins; brochures; magazines; leaflets; posters; pictures; price lists; notelets; diaries; calendars; business cards; packaging; bubble packs for packaging; bubble packs for wrapping; bubble wrapping for bottles; packaging in the form of a tube to protect bottles; bottle wrappers of cardboard; bottle wrappers of paper; paper tissue; boxes; boxes in collapsible form; cartons; cartons in collapsible form; cardboard gift bags; cardboard carrying cases; gift boxes; gift cartons; gift wrapping materials; gift wrap; bows; decanter mats; drink mats.

Conclusion

26. In this decision, I have considered all documents filed by the applicant, and all arguments submitted to me in relation to this application. Used in relation to the goods in classes 32 and 33, there is nothing within the sign that departs significantly from the norm or

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customs of the sector thereby enabling it to distinguish the goods of the undertaking and so, in the absence of any consumer education, it would not serve to indicate trade origin. Therefore, the application is partially refused because it fails to qualify under sections 3(1)(b) of the Act.

Dated this 4th day of December 2012

Bridget Whatmough

For the Registrar

The Comptroller-General

ANNEX A

The following images were submitted by the attorney prior to the *ex parte* hearing, in order to demonstrate how the sign is being used in trade:

