

TRADE MARKS ACT 1994

TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 2008 (as amended)

IN THE MATTER OF:

THE REQUEST BY BEAUTÉ PRESTIGE INTERNATIONAL

FOR PROTECTION IN THE UNITED KINGDOM

OF INTERNATIONAL REGISTRATION No. 1074813

IN CLASS 3

DECISION

Introduction

1. In the present case the Registrar of Trade Marks has refused the request of Beauté Prestige International (*'the Applicant'*) for protection in the United Kingdom under the provisions of the Madrid Protocol and the Trade Marks (International Registration) Order 2008 (as amended) of the following 3 dimensional mark



for use in relation to the following goods in Class 3 specified in International Registration No. 1074813:

Perfumes, toilet water; deodorants for personal use; essential oils for personal use; oils for cosmetic purposes; liquid soaps for personal use; cleansing milk for toilet purposes; creams, lotions and cosmetic products for face care; creams, lotions and cosmetic products for body care; make-up removing lotions; cosmetic products and preparations for skin care, for weight loss, for the bath, for sun-tanning; beauty masks; bath and shower gels; bath foam; hair lotions and products for hair care; shampoos.

2. Written submissions on 19 July 2011 and 17 August 2011 were submitted on behalf of the Applicant in response to the objections raised by the Trade Marks Registry in various letters including the official letters dated 25 May 2011 and 27 July 2011.
3. At the request of the Applicant a telephone hearing to consider the Applicant's representations in support of the application for registration took place before Ms. Bridget Whatmough, acting as Hearing Officer on behalf of the Registrar of Trade Marks, on 7 February 2012.
4. At that hearing the objection was maintained. However, as Mr Reddington had indicated, on behalf of the Applicant, that the Applicant wished to file an example of the mark being used for consideration by the Hearing Officer, a further period of 2 months was allowed for that to be done.
5. After consideration of the specimen perfume container provided by the Applicant the Hearing Officer again maintained the objection but granted the Applicant further time to submit evidence in support of a claim to acquired distinctiveness.
6. No evidence of distinctiveness acquired through use was filed on behalf of the Applicant. Instead, on 29 June 2012, a request was made for a full statement of the grounds of the decision of the Hearing Officer to be given.

Hearing Officer's decision

7. The reasons for refusal on the basis of inherent distinctiveness case were given in a decision issued by Ms Whatmough on 20 November 2012 (BL O-457-12). She decided that the request for protection should be refused under section 3(1)(b) of the Trade Marks Act 1994 (*'the Act'*) on the grounds that *'the trade mark applied for will not be identified as an indicator of origin without first educating the public to that effect'*.
8. The principles governing the application of the absolute ground for refusal of registration under section 3(1)(b) have been extensively explored by the Court of Justice of the European Union (*'CJEU'*) in a number of cases. The Hearing Officer

instructed herself by reference to the Judgment of the CJEU in Joined Cases C-53/01 to C-55/01 Linde AG, Windward Industries Inc and Rao Uhren [2003] ECR I-3161. In particular, concerning the registrability of the shape of packaging, she cited paragraphs [48] to [53] of the Judgment of the CJEU in Case C-218/01 Henkel KGaA v. Deutsches Patent-und Markenamt [2004] ECR I-1725 and Case C-456/01 Henkel KGaA v. OHIM [2004] ECR I-5089.

9. The objection under section 3(1)(b) of the Act was maintained on the following basis (as there has been no suggestion that the Hearing Officer misstated the law I have not reproduced the entirety of the quotations of the case law from her decision):

15. It is beyond dispute that the sign applied for is a three dimensional representation of the shape of a perfume bottle. As regards the registrability of the shape of packaging, in *Henkel KGaA v Deutsches Patent-und Markenamt* (C-218/01) and *Henkel KGaA v Office for O-457-12 Harmonisation in the Internal Market* (C-456/01) the CJEU provided guidance on section 3(1)(b) . . .

16. On the basis of the 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 and services claimed, and the likely perception of the relevant consumer using those goods and services. Only by considering such factors will I 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. I should also add at this point that the ground under section 3(1)(b) is independent from the ground under section 3(2)(b), and the fact that this sign has *not* been found to be dictated by technical function is in no way an indicator as to the manner in which the mark is likely to be perceived by the average consumer.

17. In addition to assessing consumer perception, I must also be aware that the test is one of immediacy or first impression as confirmed by the General Court ("EGC") which, in its decision on *Sykes Enterprises v OHIM* (REAL PEOPLE REAL SOLUTIONS) [2002] ECR II-5179, stated the following:

"However, a sign which fulfils functions other than that of a trade mark is only distinctive for the purposes of Article 7(1)(b) of Regulation No 40/94 if it may be perceived immediately as an indication of the commercial origin of the goods or services in question, so as to enable the relevant public to distinguish,

without any possibility of confusion, the goods or services of the owner of the mark from those of a different commercial origin."

18. It is not appropriate to apply more stringent criteria or to impose stricter requirements when assessing the distinctiveness of three dimensional marks consisting of the shape of the goods (such as the one sought in the present case) than those which are applied in the case of other categories of marks (see judgments of the GC of 19 September 2001 in Case T-30/00 *Henkel KGaA v OHIM* ("Tablet for washing machines") [2001] ECR II-2663, at paragraph 48 and of 7 February 2002 in Case T-88/00 *Mag Instrument Inc. v OHIM*, [2002] ECR II-0467, at paragraph 32). A three-dimensional mark which consists of the shape of the container of the product itself is not necessarily perceived by the relevant consumers in the same way as a word or figurative mark which consists of a sign which is not dependent on the appearance of the goods designated by the mark (see CJEU judgments of 29 April 2004 in Joined Cases C-456/01 and C-457/01 *Henkel KGaA v OHIM* ('Tabs'), at paragraph 38; and of 12 February 2004 in Case C-218/01, referral for a preliminary ruling from the Bundespatentgericht: *Henkel KGaA, ('Perwoll')*, at paragraph 52). This is because the average consumer is not in the habit of making assumptions about the origin of products based on their shape in the absence of any graphic or word element.

19. In the present case, the mark in question consists of an angular glass bottle complete with lid, whilst the specification covers '*perfumes, toilet water; deodorants for personal use; essential oils for personal use; oils for cosmetic purposes; liquid soaps for personal use; cleansing milk for toilet purposes; creams, lotions and cosmetic products for face care; creams, lotions and cosmetic products for body care; make-up removing lotions; cosmetic products and preparations for skin care, for weight loss, for the bath, for sun-tanning; beauty masks; bath and shower gels; bath foam; hair lotions and products for hair care; shampoos.*' all in Class 3.

20. Given the goods claimed, it is reasonable to assume that the average consumer consists of the perfume-and-toiletries-buying general public. The level of consumer attention may vary a little depending on the customer; however, I consider it reasonable to assume that a prospective purchaser of the applicant's goods would apply at least a moderate level of attention and circumspection when considering whether or not to buy. This recognises the personal and sometimes expensive nature of the purchase and, as is often the case, the fact that

these goods are often sold in environments which enable the consumer to sample the goods with expert assistance.

21. I agree with Mr Reddington's submission that, in this particular sector, special attention is often paid to bottle shapes, and I also agree that consumers can look for such shapes in order to determine trade origin. However, for a bottle shape to function independently as a trade mark in such a way, it must be capable of doing so *without* the aid of more obvious trade mark material such as logos, word marks and/or figurative signs and, in respect of a *prima facie* assessment of distinctiveness at least, without any reliance on use and/or established public education that the shape is used to determine trade origin.

22. Referring back to the bottle designer's sentiments presented at paragraph 11 (sic) above, I do not think that those intentions, or his/her motivation for adopting this particular bottle shape can, in any way, be determinative upon, or reflective of, consumer perception. Nonetheless, it is interesting to note the designer's reference to creating something which is intentionally 'simple' and which incorporates *inter alia* 'straight lines'. Such comments support my own view that, by virtue of the inherent simplicity it demonstrates, there is nothing about this sign which could be said to be clearly outside the norms and customs of the trade. Whilst simple three dimensional packaging shapes are not barred from registration *per se*, there should be some aspect to, or element of, the sign which enables consumers to distinguish the goods or services of the applicant from those of other undertakings.

23. At the hearing, Mr Reddington submitted that there is a lower threshold of distinctiveness for perfume bottles, arguing that this proposition is supported by practice published in the IPO Examination Guide which states:

“If the essential features of the shape are characteristic of the goods or their intended purpose, the mark will be open to objection under section 3(1)(c). In order to avoid an objection under section 3(1)(b) and/or (c) a shape mark must be sufficiently different from a shape which is:

- (i) characteristic of the product;
- (ii) the norm or customary in the sector concerned;
- (iii) a shape likely to be taken by the product concerned;

so as to permit an average consumer, “without conducting an analytical or comparative examination or

paying particular attention, to distinguish the goods concerned from those of other traders”.

In other words, the shape must not be descriptive, must stand out from the crowd and, in the case of new product developments, must not be a shape likely to be taken for the product concerned. The amount of attention that an average consumer pays to the goods and the significance he or she attaches to their shape varies from product to product. Consequently, if there is evidence, or it is well known, that shapes are a customary means of distinguishing the source of a particular category of goods, shapes which stand out to a lesser degree may be acceptable as trade marks. Examples of such goods include perfume bottles.”

24. Such a statement cannot in my opinion be taken to supplant or undermine the relevant case law to the effect that there can be no presumption of distinctiveness in relation to the registration of such bottles. The sign presented for registration must still be capable of performing the essential function of a trade mark; that is to say, in this particular example, there must be something about the particular shape which could be said to be outside the norms and customs of the trade. Even taking into consideration that, within in the perfumes and toiletries sector, shapes are a customary means of distinguishing the goods, this must still be the case. The applicant has provided no comparative evidence that the shape of this particular bottle is indeed outside the norm and customs of the trade. Mere reliance on the Examination Guide is manifestly insufficient in this regard.

25. I consider that the shape, being made of apparently dense glass, with a conventional top which appears to incorporate a spray nozzle, and employing straightforward design features such as a tapered bottom and lid, is an ordinary and unexceptional example of a perfume bottle. Cuboid-shaped bottles such as the mark are commonly used in respect of perfume and toiletry bottles, as are caps that mirror the shape of the bottle (this is a matter of which I can take judicial notice, given my own experience as an average consumer). As a result, the three-dimensional sign as applied for is not one which is sufficiently different from other shapes of bottles on the market and, in the absence of other elements such as verbal or graphic elements, one which I do *not* find to be inherently distinctive.

26. Finally, and for the sake of completeness, I have noted the fact that in his written submissions and at the hearing, Mr Reddington made reference to the applicant’s ‘precedents’ (by

which I mean prior acceptances by other non-EU registries) which had been accepted for registration. Whilst I acknowledge these submissions and precedents, they can in no way be persuasive on me (still less binding) without, for example, some indication of the nature of the regime under which they were accepted, and the underlying rationale behind such decisions.

27. Nor was I swayed by Mr Reddington's reference at the hearing to the fact that the mark has been accepted in other EU member states. Notwithstanding the substantive harmonisation effected by Council Directive 89/104/EEC (as subsequently codified), the Registrar is still 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 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.”

28. I have concluded that the trade mark applied for will not be identified as an indicator of trade origin without first educating the public to that effect. I therefore conclude that it is devoid of any distinctive character, and thus excluded from *prima facie* acceptance under section 3(1)(b) of the Act.

10. There seems to me to be nothing wrong with the Hearing Officer's analysis of the relevant law from the CJEU, and indeed it was rightly accepted on behalf of the Applicant in the course of the hearing that the principles from the judgment of the CJEU in Case C-218/01 *Henkel KGaA v. Deutsches Patent-und Markenamt* [2004] ECR I-1725 should be applied to the present case.

The Grounds of Appeal

11. The Applicant appealed to the Appointed Person under section 76 of the Act contending in substance that:
 - (1) The Hearing Officer had attached insufficient weight to the design features of the trade mark as being capable of distinguishing the Applicant's goods from the goods of other undertakings;
 - (2) The Hearing Officer had failed to assess correctly the impact of the design features of the Applicant's mark were likely to have on the relevant consumer, in particular, whether the Applicant's mark would be seen by consumers as striking, unique and memorable; and
 - (3) The Hearing Officer had failed to take into account circumstances peculiar to the perfume industry, contrary to the Registrar's own guidance as set out in the Registry Work Manual.
12. These points were developed in the skeleton argument and oral submissions on behalf of the Applicant at the hearing before me.
13. Mr Abraham on behalf of the Registrar maintained that the Hearing Officer had: (1) considered the application in the context of the relevant guidance of the CJEU; and (2) taken fully into account both the design features which combined to form the shape in question, the level of customer attention likely to be exercised in respect for the goods intended for protection, and the norms and customs of the perfume sector.
14. Mr Abraham also referred me to the decision of Geoffrey Hobbs QC sitting as the Appointed Person in EUROLAMB Trade Mark [1997] RPC 279 in which it was made clear that (emphasis added):

With reference to the point which has been argued before me relating to the question of burden – whether the Registrar is obliged to register marks unless he can demonstrate that they are ineligible for registration --- I take the view that the position . . . is neutral; i.e. that there is generally no presumption in favour of registration and no presumption against registration. Every mark needs to be considered for registrability on its own merits. . . .

I therefore do not think that there was anything in the nature of a burden for the Registrar to discharge in order to justify his decision to refuse registration in the present case. What he had to do was to make a judgment

as to the meaning that would be conveyed to members of the public by the particular mark in question.

Decision

15. In order for the shape of packaging to be given protection as a registered trade mark *ab initio* the shape must be sufficient, in and of itself, of performing the essential function of a trade mark. That is to say the shape of the packaging must be sufficiently arresting to achieve immediate and certain recognition as an indication of trade origin when seen through the eyes of consumers who are not in the habit of making assumptions about the trade origin of goods on the basis of their shape in the absence of any graphic word or element. It follows that the shape of packaging can be the embodiment of high quality design without also serving as an indication of the trade origin: *c.f.* Case C-136/02P Mag Instrument Inc v. OHIM at paragraphs [64] to [68].
16. As noted above the Applicant has supplied a physical example of the perfume container represented in the international trade mark registration. However the Applicant relied on submissions without comparative evidence in support of its position that the design features of this particular bottle were striking, unique and memorable in the perfume and toiletries sector in the United Kingdom; and on submissions without evidence as to the effect of such design features upon the perceptions and recollections of the average consumer of such goods.
17. As part of its submissions the Applicant sought to rely on a statement in a magazine article said to be from the designer of the perfume bottle himself who explained the idea behind the bottle '*I wanted something simple, straight lines, the rigor of a cube and the sensation of an object made to be held in the hand, but with the density of beautiful objects. And as always, light as the overarching theme. For me light is eternal strength*' (attached as Exhibit 1 to the TM55).
18. With respect to the designer's intentions, as said to be reflected in the magazine article referred to above, I do not see anything in the quotation that can be said to be of assistance to the Applicant in establishing that the design was striking, unique and memorable in the perfume and toiletries sector in the United Kingdom. In addition I agree with the observation of the Hearing Officer that the statement cannot be in any way determinative upon or reflective of consumer perception of the mark applied for.
19. Distinctiveness is a relative concept in the sense that it must be assessed with proper regard to the norms and variations likely to be encountered in use in the market sector(s) in which protection has been requested.

20. It was submitted on behalf of the Applicant that the Hearing Officer failed to take into account the circumstances peculiar to the perfume industry, contrary to the Registrar's own guidance set out in the Registry Work Manual.
21. With regard to the guidance provided by the Registry Work Manual this cannot, as was suggested on behalf of the Applicant, supplant or undermine the relevant case law from the CJEU such as to lower the threshold for; or create a presumption of distinctiveness in relation to the registration of such bottles as a trade mark. In each case the Hearing Officer must undertake a specific assessment of the distinctive character of the particular sign in issue, having proper regard to the norms and variations to be encountered in use in the relevant market sector, in order to verify that it fulfils its essential function, namely of guaranteeing the origin of the product.
22. This was clearly and correctly recognised by the Hearing Officer as can be seen from:
- (1) Paragraph 21 of her Decision where she said '*I agree with Mr Reddington's submission that, in this particular sector, special attention is often paid to bottle shapes, and I also agree that consumers can look for such shapes in order to determine trade origin. However, for a bottle shape to function independently as a trade mark in such a way, it must be capable of doing so without the aid of more obvious trade mark material such as logos, word marks and/or figurative signs and, in respect of a prima facie assessment of distinctiveness at least, without any reliance on use and/or established public education that the shape is used to determine trade origin*'; and
- (2) Paragraph 24 of her Decision where she said that '*The sign presented for registration must still be capable of performing the essential function of a trade mark; that is to say, in this particular example, there must be something about the particular shape which could be said to be outside the norms and customs of the trade. Even taking into consideration that, within in the perfumes and toiletries sector, shapes are a customary means of distinguishing the goods, this must still be the case*'.
23. Moreover it is in my view apparent that the Hearing Officer's Decision was taken with proper regard to the norms and variations likely to be encountered in use in the perfumes and toiletries sector (see in particular paragraph 25 of the Decision); and from the perspective of the relevant average consumer of such goods (see paragraph 20 of the Decision).
24. In my view, in terms of norms and variations within the perfumes and toiletries sector the mark is distinguishable from other shapes but not to a degree that would lead me to think it was by its nature sufficiently arresting to be regarded as indicative of trade origin in the market for goods of the kind specified. I do not overlook the fact that

within the market for perfumes and toiletries shapes are a customary means of distinguishing the goods, but having considered the Hearing Officer's assessment in the light of the submissions and materials on file and my general awareness of the form and presentation of such goods I take the view that she was entitled to reach the conclusion she did for the reasons given.

25. For the sake of completeness I must deal with 3 further points that were raised on behalf of the Applicant in the course of the Appeal.
26. In its Grounds of Appeal the Applicant sought to rely on the fact that no objection was raised by the Registrar under section 3(2) of the Act was relevant to the question of whether the mark was distinctive under section 3(1)(b) of the Act. Section 3(2) of the Act states as follows:

A sign shall not be registered as a trade mark if it consists exclusively of—

(a) the shape which results from the nature of the goods themselves,

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

(c) the shape which gives substantial value to the goods.

It was accepted on behalf of the Applicant at the hearing that because a mark does not fall found of section 3(2) of the Act that it must necessarily be distinctive. In my view, the fact that no objection has been raised under section 3(2) of the Act has no bearing on the determination of the present appeal against the Hearing Officer's findings under section 3(1)(b) of the Act.

27. In the written submissions on behalf of the Applicant it was submitted that anti-counterfeiting considerations played a role in the assessment for registrability on the basis that perfumes are high value goods that are an attractive target for counterfeiters who often seek to reproduce every visual aspect of the product.
28. In my view such a policy consideration cannot impact on the assessment for registrability. As the CJEU has emphasised in Case C-51/10P Agencja Wydawnicza Technopol sp. Z o.o. v. OHIM the Registry has a frontline role in preventing the granting of undue monopolies and does so by applying specific criteria:

77. Moreover, for reasons of legal certainty and, indeed, of sound administration, the examination of any trade mark application must be stringent and full, in order to prevent trade

marks from being improperly registered (*OHIM v Erpo Möbelwerk*, paragraph 45, and *OHIM v BORCO-Marken-Import Matthiesen*, paragraph 45). That examination must be undertaken in each individual case. The registration of a sign as a mark depends on specific criteria, which are applicable in the factual circumstances of the particular case and the purpose of which is to ascertain whether the sign at issue is caught by a ground for refusal (see, to that effect, as regards Article 3 of Directive 89/104, Case C-218/01 *Henkel* [2004] ECR I-1725, paragraph 62).

If on the application of the specific criteria laid down by the CJEU the mark is caught by a ground for refusal anti-counterfeiting considerations cannot produce a different result.

29. At the hearing of the Appeal submissions were made on behalf of the Applicant to certain ‘precedents’ being overseas registrations. Although this issue had been raised before the Hearing Officer it was not referred to in the Notice of Appeal. So far as the question of the Applicant’s ‘precedents’ is concerned, I feel some sympathy for the position in which the Applicant finds itself in so far as the same relate to acceptance of the mark for registration in other EU Member States. Nonetheless, it remains the position that the Registrar is not bound by the decisions of other national offices and if the mark does not meet the requirements of section 3 of the Act then the application for protection must be refused. For that reason, even if this issue had been raised in the Notice of Appeal, I could not be deflected from the inevitable decision by the Applicant’s ‘precedents’.

Conclusion

30. In the end, it is in my view clear that each case must be determined on its own facts and in accordance with the law. The Hearing Officer decided that the mark would not be identified as an indicator of origin without first educating the public to that effect and therefore excluded from *prima facie* acceptance under section 3(1)(b) of the Act.
31. The Applicant has not persuaded me that the Hearing Officer was wrong to refuse the request for the protection of the international trade mark in the United Kingdom for the reasons she gave in her decision. In my view it was open to the Hearing Officer to come to the conclusion that she did.

32. In the circumstances the request for the sign in issue stands refused. The appeal from the Hearing Officer's Decision is dismissed. In accordance with the usual practice, the appeal is dismissed with no order as to costs.

Emma Himsworth Q.C.

21 February 2014

Mr. John Reddington of Williams Powell appeared on behalf of the Applicant.

Mr. Nathan Abraham appeared on behalf of the Registrar.