

**TRADE MARKS ACT 1938(AS AMENDED)
AND THE TRADE MARKS ACT 1994**

IN THE MATTER OF Application

5 **No 1577296 by Roho, Inc. to register
a trade mark in Class 10.**

DECISION

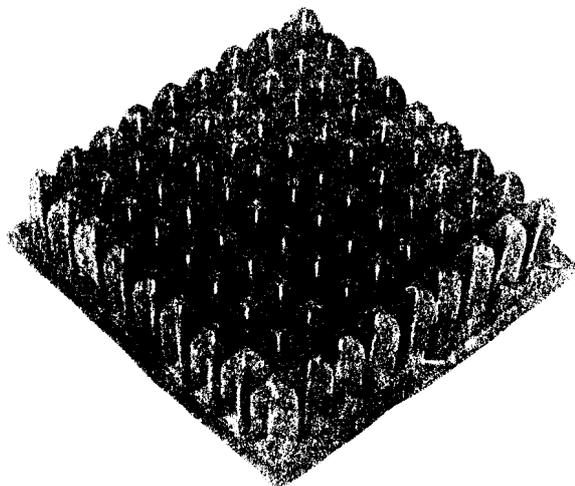
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On 5 July 1994, Roho, INC., applied under Section 17 of the Trade Marks Act 1938 for the registration of the mark shown below in respect of:

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Surgical and medical apparatus and instruments; cushions and mattresses for surgical, medical and curative purposes; childbirth mattresses.

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30 As a result of objections taken by the Registrar the applicants sought a hearing, at which they were represented by Mr Guy Tritton of Counsel, instructed by J A Kemp & Co. Following that hearing I maintained the objections that had been raised and the application was refused. I now

give my reasons for refusal. Since the application was filed the Trade Marks Act 1938 has been repealed. However, in accordance with paragraph 10 of Schedule 3 of the Trade Marks Act 1994 I must continue to apply the provisions of the old law to this application. Accordingly all references to sections of the Act which appear in this decision are references to the revisions of the Trade Marks Act 1938.

Sections 9 and 10 of the Act are as follows:

9.-(1) In order for a trade mark (other than a certification trade mark) to be registrable in Part A of the register, it must contain or consist of at least one of the following essential particulars:-

- (a) the name of a company, individual, or firm, represented in a special or particular manner;
- (b) the signature of the applicant for registration or some predecessor in his business;
- (c) an invented word or invented words;
- (d) a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname;
- (e) any other distinctive mark, but a name, signature, or word or words, other than such as fall within the descriptions in the foregoing paragraphs (a), (b), (c) and (d), shall not be registrable under the provisions of this paragraph except upon evidence of its distinctiveness.

(2) For the purposes of this section “distinctive” means adapted, in relation to the goods in respect of which a trade mark is registered or proposed to be registered, to distinguish goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.

(3) In determining whether a trade mark is adapted to distinguish as aforesaid the tribunal may have regard to the extent to which-

- (a) the trade mark is inherently adapted to distinguish as aforesaid; and
- (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact adapted to distinguish as aforesaid.

5 **10.-(1)** In order for a trade mark to be registrable in Part B of the register it must be capable, in relation to the goods in respect of which it is registered or proposed to be registered, of distinguishing goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.

10 (2) In determining whether a trade mark is capable of distinguishing as aforesaid the tribunal may have regard to the extent to which-

(a) the trade mark is inherently capable of distinguishing as aforesaid; and

15 (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid.

(3) A trade mark may be registered in Part B notwithstanding any registration in Part A in the name of the same proprietor of the same trade mark or any part or parts thereof.

20 It is well established that for a trade mark to be registrable under the old law, the mark must possess some inherent capacity to distinguish, and that remains the case even if the mark is shown to be distinctive in fact (see the comments of Lord Wilberforce in YORK trade mark 1984 RPC page 254 at lines 5 to 14). Thus, under the 1938 Act, it is possible for a mark to be distinctive in fact but not in law.

25 The applicants' position is that this application should be considered as a request to register a two dimensional photographic representation of the their goods, rather than the three dimensional shape of the goods as such.

30 The three dimensional shape represented in the mark has been the subject of other proceedings. Mr Tritton advised me that it has previously been the protected under a patent and design right. In this connection I understand that there are licence of right proceedings underway at the moment. Additionally, the applicants' United Kingdom distributors sued another party who proposed to sell a product of similar appearance in the United Kingdom for passing off. This
35 action before Jacob J. was unsuccessful (see FSR [1995] pages 169 - 183). In the passing-off proceedings Jacob J. described the applicants' goods in the following terms:

5 *“It is an odd looking device - a number of witnesses called it ugly. It is clearly striking to the eye and memorable. It has a more or less square black rubber base, upon which sit a rectangular array of inflatable rubber cells. The cells are all identical and are each square in cross-section at their base. Each square is closely adjacent to the others. When inflated the cells are close enough to provide each other with some sideways support when the weight of the user is applied. The cells have four ‘fins’, i.e. portions where the four sides meet. The fins rise from the corners and meet in a cruciform at the top of the cell. Between the fins the cell walls bow inwards when the cell is uninflated.”*

10 *“Functionally the cushion works thus: the base contains pipework through which the cells can be inflated. The cells are connected to each other through the base (which is a sandwich of rubber). Thus when a posterior exerts pressure on the cushion the cells adjust to accommodate the shape. In practice the user is placed on the cushion when it is fully inflated and a skilled and trained health-care professional then releases pressure through a valve. The posterior is accommodated by some of the cells sinking more than others. The carer endeavours to set the cushion so that there is even pressure over all of it. Moreover there is maximum surface contact so that pressure on the posterior is as low as it can be. The effect is said to be “air floatation” - the user is, as far as possible, sitting on compressed air.”*

20 The applicants filed a Statutory Declaration dated 27 September 1995 by Raymond Hodgkinson, who is the Chief Executive of Raymar, who act as the applicants’ exclusive distributor in the United Kingdom. Mr Hodgkinson states that the sign applied for has been in use in the United Kingdom since 1978. The evidence confirms what one might expect from the appearance of the goods, which is that the shape is functional. The following extracts are from a promotional booklet contained within exhibit RH/2 to Mr Hodgkinson’s declaration.

30 *“The ROHO Dry Flotation System of air inflatable wheelchair cushions and mattresses has been researched and developed with the objective of providing a fully flexible and adjustable device for effective prevention and treatment of pressure sores.*

ROHO cushions and mattresses provide optimum pressure distribution. They conform to the body's natural contours creating a uniform distribution of pressure over the body contact area.

5 *The ROHO System helps prevent tissue deformation because even pressures reduce distortion of the skin and allow blood to maintain its flow through the tiny capillaries that are located under the skin. Blood brings with it the nutritional products that the cells need to maintain tissue health and permit healing of a pressure sore. The ROHO System is constructed of flexible, interconnecting cells.”*

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“Increased Sitting Times

15 *With even pressure distribution ROHO cushions allow people to sit for longer periods of time. Research in the UK has shown that ROHO cushion users sit for an average of nearly 12 hours each day and many sit for up to 18 hours without skin problems. (L. Cheshire 1987)”*

20 The applicants also filed expert evidence in support of their application. This takes the form of a Statutory Declaration dated 25 October 1996 by Christopher Bar, who is a senior examiner for the National Institute of Physical Sciences in Medicine. Mr Bar says that he is also the Director of an MSC course called “Rehabilitation Technology” based in the Welsh National School of Medicine and has been a tutor for individual students studying for MSc and PhD through the Welsh National School of Medicine. Mr Bar further states that he has a BEng(Hons) in physics
25 and electronics, and MSc in Management and Technology and a PhD in the field of tissue biomechanics. Mr Bar states that he is familiar with the applicants’ products and that, until recently, there was nothing else like this commercially available. He states that the appearance of the applicants’ products is distinctive of ROHO cushions which incorporate the Dry Flotation technology of ROHO, Inc. Mr Bar describes the applicants’ goods like this:

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“Flotation cushions use membranes or containers which are filled with either air or liquid. The ROHO cushion is an air filled floatation cushion comprising vertical cells.

Each of these cells is in effect a vertical air column and the individual cells are interconnected to the surrounding cells through narrow passageways which allow the air to move between the cells in a controlled manner. As a result, air is contained within the cushion but is able to circulate freely between the cells so that a natural process of pressure equalisation occurs between the columns of air, or cells, when they are under load. The aggregate effect of these interconnected cells enables the cushion to act as a fluid and to synthesize floatation allowing the individual to be “immersed” into the cushion. The ability of the cells to move air between cells also enables the cushion to adjust over time to accommodate changes in posture or shape of the user. The ROHO cushion can be adjusted, if necessary, to allow the surface to be customised to each individual user’s body weight and shape by an increase of air volume within, or release of air from, the cells through a valve positioned at a conventional point on one of the sides of the cushion.

In particular, the shape and design of the four finned cushion is clearly not designed for aesthetic reasons and is not necessary to achieve the desired clinical effect. The use of finned air chambers is a design feature that relates to the mechanical mechanism whereby the cells or deform somewhat on being loaded, but the four finned cells are not necessary for this action. Deformation of the cells under load could be achieved through a number of other constructions such as piston or bellow type designs and even if finned cells are the selected method, there is no reason, mechanically why a different number of fins would not function as well. The ROHO cushion previously used seven finned chambers. Empirically, no change in function was detected as a result of this change in terms of pressure sore prevention in clinical practice.

In my opinion, any number of fins from three or more could provide the appropriate level of mechanical function. Similarly, as stated above an alternative design approach could be the use of air bellows instead of finned air chambers. These will provide the same function of a deforming air pillar. Thus, Talley uses a bellows design with success.”

It appears to me to be very unlikely that the average purchaser would discriminate between the

number of fins on this type of vertical cellular cushion for the purposes of identifying tradeorigin. Mr Bar states in his evidence that, to be effective, this type of cellular product needs to contain threeof more fins per cell. If there is no advantage in having more than three fins per cell, itseems very likely that the larger the number of fins in excess of three, the more the design would depart
5 from the usual manufacturing preference to keep designs as simple as is consistent with efficient performance. Mr Tritton had to accept that joining the vertical air cells together in a manner reminiscent of conventional “tiling” was likely to be the most convenient method of assembly where the desired overall shape is either square or rectangular - as most cushions and mattresses are. I conclude that the four finned cells of the applicants’ goods and the overall design is wholly
10 functional and devoid of the sort of capricious addition or feature which might allow the applicants to succeed in identifying some inherent capacity to distinguish, without which an application to register the shape itself would be bound to fail.

In the case of Philips Electronics NV v Remington Consumer Products 1998 RPC page 283
15 Jacob J. said (at 302 lines 16-20):

*“A picture of an article is equivalent to a description of it - both convey information. If the picture is simply of an artefact which traders might legitimately wish to manufacture then to my mind it is just like the common word for it and, like the word for
20 it, incapable of distinguishing.”*

A similar point was made by Hoffman J. in Unilever Limited’s (striped Toothpaste No 2) 1987
RPC 13 at 16, lines 30 -34:

*“The fact that a mark is descriptive of the appearance of a product may therefore
25 occasionally give rise to a second order question whether the appearance of the product itself is or would be distinctive to be registerable as a trade mark.”*

I have already found that the three dimensional shape of the applicants’ goods contains no
30 capricious additions or features. The shape consists exclusively of functional features. In these circumstances I think that a two dimensional photographic representation of the goods has no

inherent capacity to distinguish the goods of one trader from those of another. Consequently the mark fails to qualify for registration under Section 9(1)(e) - which is the only potentially relevant heading under Section 9(1), or Section 10 of the Act. If that is right, this finding effectively decides the matter because, as I have already indicated above, the absence of any inherent capacity to distinguish is a fatal barrier to the registration of a trade mark under Sections 9 & 10 of the 1938 Act. However, in case I am found to be wrong about this I will go on and consider the applicants' case that their mark is in fact capable of distinguishing by reason of the use made of it.

As I indicated earlier, the applicants filed a Statutory Declaration dated 27 September 1995 by Raymond Hodgkinson which states that the mark has been in use in the United Kingdom since 1978. Mr Hodgkinson states that the mark has been used continuously since that time in respect of "Cushions and mattresses for surgical, medical and curative purposes". The number of units sold has risen steadily from 30 in 1978 to 6,500 in 1992. Unit sales for 1993 and 1994 are not provided, but it is clear from the annual turnover figures, which are provided, that the number of units sold in those years must also have been in excess of 6,000. Mr Hodgkinson also provides details of the applicants' promotion of goods under the mark. From the information he provides it appears that between 1988 and 1994 the applicants spent, on average, around £30,000 per annum promoting goods under the mark. In the year ending March 1995 (half of which is, of course, after the date of this application) advertising expenditure increased to around £63,000.

Mr Hodgkinson provides details of the various publications in which the mark is promoted. Not surprisingly these are all aimed at health care professionals of one sort or another. Exhibits RH-2, RH-4 and RH-5 to Mr Hodgkinson's declaration consist of copies of various promotional leaflets and advertisements featuring the applicants' goods. It is clear from this material, and from Exhibit RH-5A to a further declaration from Mr Hodgkinson dated 7 August 1996, that the applicants do not rely upon the shape of their goods alone to distinguish their products: they always use the word mark ROHO. Although the word ROHO is not obviously visible on the goods themselves, the mark does appear very prominently on the packaging of the goods and also on the promotional material and advertisements.

In deciding what weight to attach to the evidence I must bear in mind the provisions of Section 68 (1) of the Act, which defines a trade mark as:

5 a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate, a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the mark, whether with or without any indication of the identity of that person.

10 In my judgement, there is no evidence that the applicants have used a photographic representation of the goods in question as a trade mark. A similar point arose in the case of INTERLEGO AG. 1998 RPC page 69 (see the comments of Neuberger J. at page 113 lines 20 - 31).

15 It is true that the applicants' promotional leaflets include photographic representations of their products, but that is true of just about every trader's products. In most cases this will not amount to trade mark use. In this case each such representation of the goods is accompanied by prominent use of the word mark ROHO, which is clearly the principal means of identification of trade origin. It is true that the packaging in which the goods are sold has a black "bobbly"
20 background which is reminiscent of the appearance of the goods, but it is far from being a photographic representation. I think it is right to add that the packaging for the goods also includes a stylised representation of a cross section of the goods, which does appear to be used as a trade mark. However, this representation bears even less resemblance to the mark applied for. I conclude that there has been no use of the mark applied for in a trade mark sense. It
25 follows that the applicants cannot succeed in their claim that the mark is distinctive in fact by reason of the use made of it.

It could be argued that, if the three dimensional shape of the applicants' goods is factually distinctive, I should take that into account under the heading of "any other circumstances" in
30 Sections 9(3)(b) and 10(2)(b) of the Act. However, in my view, the applicants have not established that the shape of their goods was factually distinctive at the relevant date. The passing off action referred to above, which was heard around the date of this application, was founded on the proposition that the shape of the applicants' goods had come to denote trade origin.

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Jacob J. considered the effect of the applicants' use and expressed his view in the following terms:

5 *“Mr Morcom pressed me with a proposition based on length of use. He suggested that where a particular trader had been the sole source of a product recognised by its appearance by users for a sufficient time, that recognition somehow turned into a relevant reputation: That it should be assumed average consumers had become to want the product not only for its functional or visual qualities but because they wanted the product from that particular trade origin and non other. Length and extent of use is obviously relevant to establishing recognition by the public. But it can never be enough on its own to establish what might be called “brand loyalty” for the shape of the product itself”.*

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The applicants also rely upon the evidence of persons in the trade who say that they recognise the shape of the applicants' products and associate products in that shape with the applicants. This evidence takes the form of seven Statutory Declarations by Anthony David Harman, Katharine Anna Fox, Elizabeth C Rogers, Lone Rose, Susan Hilsdon, June Sutherland and Norma Haynes. The first five declarations are dated in August of 1996. The last two are dated August and September 1997, respectively.

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20 Mr Harman says he is a Special Seating Consultant and has worked in that capacity within the National Health Service and various other companies for many years. He states that he has known of the ROHO cushion for 15 - 18 years. He believes that the 'nodules' are characteristic of this cushion and very distinctive. Until recently, he says, there was nothing at all similar on the market.

25 Ms Fox states that she is a Chartered Physiotherapist and has, for the past 22 years, worked with people with physical disability. She states that she has known of the ROHO cushion for the past six years and has used it on numerous occasions for patients with profound disabilities. She further states that she regards the appearance of the applicants' cushion as being distinctive of their goods.

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Ms Rogers states that from 1971 until her retirement in 1990 she was a Senior Nurse Manager at the National Spinal Injury Centre at Stoke Mandeville Hospital. She states that she has been aware of the applicants' cushions since they were put on the market in 1978 or 1979 by Raymar. Ms Rogers describes the appearance of the applicants' cushions as "an inflatable egg box". She further states that over the last 2 or 3 years some other cushions have appeared on the market which look similar to the ROHO cushion, but nevertheless she regards the appearance of the ROHO cushion as distinctive.

Ms Rose describes herself as a Danish Chartered Physiotherapist and a member of the Chartered Society of Physiotherapist and a State Registered Physiotherapist. Since 1977 she has worked in the physiotherapy department of Stoke Mandeville Hospital. She states that she has been aware of a cushion having the appearance of the applicants' goods since the early 1980's. She further states that until quite recently when a substantially identical cushion came on the market the applicants' cushion was the only cushion having an appearance entirely different from other cushions on the market. She says this was due to its individual "cell" appearance.

Ms Hilsdon states that she has been a Senior Occupational Therapist with the Milton Keynes Wheelchair Service for the past 4 years. Before that she held a similar position in Maidenhead. She states that in 1987, she carried out some work on behalf of the Department of Health in evaluating wheelchair cushions. Ms Hilsdon further states that she has been familiar with the appearance of the applicants' cushions for the past 13 or 14 years. In her opinion it has a very distinctive profile. Ms Hilsdon further states that she is aware that a competitor has recently entered the market. However she says, if she were to be shown a black and white photograph of such a cushion she would have no doubt in saying that it was a ROHO cushion, or likely to be so.

Ms Sutherland is the Head Occupational Therapist at the Chelsea and Westminster Hospital in London. She states that she is familiar with all the different types of pressure sore cushions on the market, including the ROHO cushion. She explains that she has been asked how she identifies a ROHO cushion. She says that she identifies it because it has a unique design, although she is aware that very similar cushions have recently appeared on the market. She further states that she knows the trade mark ROHO appears on the underside of the cushion but she adds that this is not

visible when the cushion is in use in hospitals, when they are normally stacked up on cupboards and on shelves. She notes that the packaging in which the cushions come is frequently discarded to save space.

5 Ms Haynes is a Registered Mental Nurse and a Registered General Nurse who is currently employed by a private company managing a Nursing Home. Ms Haynes states that she knows of the ROHO cushion by its appearance. She describes it as a black, rubber, ‘bobbly’ looking cushion. She makes a similar observation to that made by Ms Sutherland as regards the appearance of the trade mark ROHO on the underside of the applicants’ goods and its
10 significance. She further states that during her period as a Nurse Manager she was responsible for ordering cushions for ward use. She states that she always ordered them as ROHO cushions, defining the size of the cushion that was needed.

In assessing what weight to give to this evidence I must bear in mind that the applicants have
15 enjoyed an exclusive statutory right to trade in goods of the shape in question. In truth they were the only manufacturers of this type of cushion and mattress. As Lord Davey said in Cellular Clothing Co Limited v Maxton & Murray 1899 AC 326 at page 344:

20 *“The evidence of persons who come forward and say that the name in question suggests to their minds and is associated by them with the plaintiff’s goods alone is of a very slender character, for the simple reason that the plaintiff was the only maker of the goods during the time that his monopoly lasted, and therefore there was nothing to compare it with.”*

25 I believe that the “association” that exists between the shape of the applicants’ goods and themselves is no more than a result of the statutory monopoly that they have enjoyed during the time that the shape of the product was protected by Patent and Design Rights.

At the hearing, Mr Tritton argued that the evidence contained in a third Statutory Declaration by
30 Raymond Hodgkinson dated the 29 October 1996, contradicted the view expressed above and showed that the shape of the applicants’ goods was indeed acting as a badge of origin. The

evidence in question consists of copies of three notes sent to Raymar, the applicants' UK distributors, by persons asking for the repair of FLOTAIR cushions. This is the rival product which was the subject of the passing off proceedings mentioned above, which I understand came on the market shortly after that action failed. Mr Tritton contended that this was evidence of origin confusion which could only have come about if the shape of the applicants' goods was regarded by those concerned as a badge of origin. The first note is from the Matron of St Wilfred's Hospice in Eastbourne. It is really no more than a compliment slip upon which is written:

10 *"To Roho*

For repair and return please.

Matron."

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Mr Hodgkinson exhibits a letter of response dated 23 February 1996 which states that the cushion sent to Raymar was not a ROHO but a FLOTAIR cushion. Similar evidence was given in the passing off proceedings referred to earlier. Jacob J. dealt with this evidence as follows:

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"I was invited to assume that whoever sent the products for repair thought that Orto's were made by ROHO, this I declined to do. There is simply not enough evidence to go on. I think it most unlikely that the person actually sending the cushion was anything other than a clerk or the like. I have no reason to suppose that any serious consideration of the maker of the cushion arose. It may well be that the senders thought ROHO could repair the cushion even though it was of a different make even though it was of a different make. Indeed, in one of the cases ORTO have gone off the market and Raymar were probably the only people who might be able to effect repair."

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The second note attached to Mr Hodgkinson's declaration appears to be in this category. It is from the Community Health Services NHS Trust South Derbyshire. It is also in the nature of a compliment slip. It is addressed to Raymar and refers to "four ROHOs and one FLOTAIR." The

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note is in the following terms:

“Leaking etc. Please examine and info how many can be repaired.”

5 However, the third note cannot be said to be a request to Raymar to repair another suppliers equivalent cushions. It is from the Wheelchair User Services of Greenwich District Hospital. This note is also addressed to Raymar. It is in the following terms:

“Please advise if this ROHO can be repaired.”

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Thanks. Jan Dias”

Raymar’s response is also included within Exhibit RH-6 to Mr Hodgkinson’s third Declaration. It points out that the cushion sent for repair was a FLOTAIR cushion and not a ROHO, as Ms
15 Dias apparently thought. I do not think that this evidence is sufficient to disturb the view I have expressed above. It is clear from the evidence before me (and it is also obvious) that the persons who are responsible for ordering such products in the National Health Service are not necessarily the same people who return goods for repair. There is absolutely no evidence that the shape of the applicants’ goods is relied upon to distinguish the applicants’ goods during the process of
20 selection and order. Bearing that in mind and also taking into account that the evidence shows that::

1. the goods are frequently stored apart from their original packaging;
- 25 2. the applicants’ word mark is not very prominent upon the product itself;
3. a rival product has only come on to the market relatively recently and it is therefore likely that some users of this type of product may still not be aware of the existence of more than one manufacturer (particularly those users who are not responsible for making
30 the initial selection of such products);

- it appears to me that the confusion evident in Jan Dias' note to Raymar, is likely to be no more than what one would expect in the immediate aftermath of the applicants' long period of statutory monopoly of products bearing the shape in question.

5 I believe there is a further objection which prevents me from importing any benefit arising from the alleged distinctiveness of the three dimensional shape of the applicants' goods into my consideration of the registrability of the two dimensional photographic representation of the goods applied for. As I have already mentioned, the applicants have not sought to pursue their application for registration of the shape itself under the 1938 Act. In the COCA COLA trade mark
10 case (1986 RPC page 421), Lord Templeman said (at page 457, lines 11 to 28):

*“It is not sufficient for the COCA COLA bottle to be distinctive. The Coca Cola Company must succeed in the startling proposition that a bottle is a trade mark. If so, then any other container or any article of a distinctive shape is capable of being a trade
15 mark. This raises the spectre of a total and perpetual monopoly in containers and articles achieved by means of the Act of 1938. Once the container or article has become associated with the manufacturer and distinctiveness has been established, with or without the help of monopolies traded by the Patents Act, the perpetual trade mark monopoly in the container or article can be achieved. In my opinion the Act of 1938 was
20 not intended to confer on the manufacturer of a container or on the manufacturer of an article a statutory monopoly on the ground that the manufacturer has in the eyes of the public established a connection between the shape of the container or article and the manufacturer. A rival manufacturer must be free to sell any container or article of similar shape provided the container or article is labelled or packaged in a manner
25 which avoids confusion as to the origin as to the goods in the container or the origin of the article. The Registrar of trade marks has always taken the view that the function of trade mark legislation is to protect the mark but not the article which is marked. I agree”.*

30 In the light of the Coca Cola case I do not think that there is any doubt that the three dimensional shape of the applicants' goods could not be registered as a trade mark under the 1938 Act. The

applicants appear to have recognised this because two other applications for the registration of the shape of the goods in three dimensional form, which were filed on the same date as this application, were subsequently converted to applications under the Trade Marks Act 1994 by virtue of the transitional provisions contained within that Act.

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In the Phillips v Remington case also mentioned above, Jacob J. said that:

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“It is the validity and, if valid, the scope of this registration which is the principal issue which I have to decide. Even though it is only a picture which is formerly the subject of the registration, both sides, in my judgement rightly, treated it as a registration covering also a three dimensional shape. It would be quite artificial to regard a straight picture of a thing, and the thing itself, as significantly different under a law of trade marks which admits shapes to be registered.”

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Of course Jacob J. was considering the validity of the Phillips shaver head under the Trade Marks Act 1994, which makes provision for the registration of shapes. However, where there is no evidence of the use of a photographic representation of the goods as a trade mark, and where one has reached a finding that the shape of the article itself would be unregistrable under the relevant Act, it appears to me that it would be wrong in principle to regard the evidence of distinctiveness of the shape of the article itself as a circumstance which should be taken to assist an application to register a two dimensional photographic representation of the article itself.

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It appears to me that this application is objectionable because it is really a “back door” attempt to protect the shape of the applicants’ goods under an Act which does not provide protection as such. In those circumstances, I would be inclined to refuse the application in the exercise of the Registrar’s discretion under Section 17(2) of the Act if it were not for my earlier findings under Sections 9 and 10.

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I conclude that:

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1. The mark applied for is not a trade mark within the meaning of Section 68(1) of

the Act;

2. the mark has no inherent capacity to distinguish the applicants' goods and is therefore incapable of distinguishing in law;

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3. the mark applied for has not acquired a distinctive character in fact as a trade mark because there has been no such use of it;

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4. the shape of the article represented by the mark has not acquired a distinctive character in fact as a result of the use made of it;

5. even if it had, that would not be a circumstance which should be taken into account in determining the registrability of the mark applied for;

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6. the mark does not meet the requirements of Section 9 or 10 of the Act and must therefore be refused;

7. that the mark should otherwise be refused in the exercise of the Registrar's discretion under Section 17(2) of the Act.

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Dated this 18 Day of August 1998

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Allan James

For the Registrar

The Comptroller General