

TRADE MARKS ACT 1994

**IN THE MATTER OF
APPLICATION NO. 2215669**

**TO REGISTER A
TRADE MARK IN CLASSES 32 & 33**

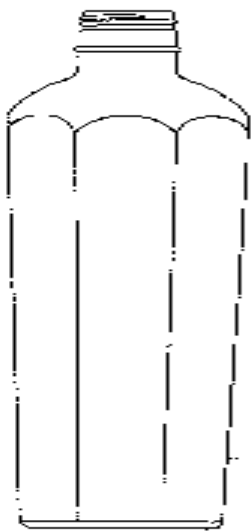
TRADE MARKS ACT

**IN THE MATTER OF
APPLICATION NO. 2215669
BY UDV Amsterdam BV, Kabelweg Amsterdam BV
TO REGISTER A TRADE MARK
IN CLASSES 32 & 33**

DECISION AND GROUNDS OF DECISION

Background

1. On 28th October 1999, UDV Amsterdam BV, Kabelweg Amsterdam BV, a firm incorporated in the Netherlands, applied to register the following 3-dimensional trade mark in Classes 32 and 33:



2. The goods for which registration is sought are as follows:

Class 32: Alcoholic beverages.

Class 33: All goods in Class 33.

3. Objection was taken under Section 3(1)(a) and (b) of the Act because the mark consists of the non-distinctive device of a container.

4. A query was also raised in relation to the specification in Class 33 because it does not list the goods.

The Hearing

5. A hearing was held on 15th May 2001 at which the applicants were represented by Mr Paul Walsh of Bristows. At that hearing I was persuaded to waive the objection taken under Section 3(1)(a) of the Act, but the objection under Section 3(1)(b) was maintained.

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

7. No evidence that the mark has acquired a distinctive character has been put before me. I have, therefore, only the prima facie case to consider.

8. At the hearing Mr Walsh referred me to paragraph 2-76 in Kerly's Law of Trade Marks and Trade Names. Under that paragraph the commentary reads:

To achieve registration, a sign must possess a distinctive character, whether by nature or by nurture. To be a little more precise "capable of distinguishing" means the sign must possess an ability to distinguish-a distinctive character. The sign, if used, must serve to distinguish the goods or services of one undertaking from the goods or services of other undertakings.

Mr Walsh argued that the mark is inherently distinctive and passed this threshold.

9. Mr Walsh also directed me to the guidance set out in Chapter 6 of the Registry Work Manual, Examination and Practice under paragraph 6.4 which states:

The appropriate test for prima facie acceptance will be whether because:

- 1. the shape in question immediately strikes the eye as different and therefore memorable;*
- 2. and the differences between the applicant's shape and those used by other traders are arbitrary and not dictated by function or some other non-trade mark purpose.*

the public are likely to assume that the goods or services with reference to which the shape is to be used recurrently are those of one and the same undertaking.

10. The mark satisfied this test, Mr Walsh contended. The shape applied for is arbitrary and there were no design parameters used in its creation. The mark was at least as distinctive as the

examples shown in the Registry Work Manual. Mr Walsh further drew my attention to the remarks made in the Proctor & Gamble Ltd's Trade Mark Applications (1999) RPC 673, page 680, line 21, in which Lord Justice Robert Walker said:

“Marks which are unusual (or even absurd, like North Pole bananas) arrest the eye and the mind and are recognised for what they are. They are distinctive in that they can perform the essential function of a trade mark.”

Mr Walsh said these comments support the view that the mark is a shape that is inherently distinctive and not devoid of any distinctive character.

11. Although no evidence of acquired distinctiveness was filed in support of the application, Mr Walsh referred to the Statement of Mr Craig Markus, together with exhibits, which had been submitted before the hearing. In his view, this evidence showed that the mark is inherently distinctive.

12. In the Statement filed by Mr Markus, he says he is an art director/creative director employed by Deutsch Inc, New York, who were commissioned to design the bottle which is now subject of this application. He says he has held this position from September 1996 to November 2000 and has been in the advertising and design business over the last 10 years in which he gained extensive knowledge of the spirits industry.

13. Mr Markus says he had first hand involvement in the design of the bottle which took eight months from creative brief to final stage. When launched in the UK it will be used to contain a “super premium” gin known as TANQUERAY NO. TEN brand. Mr Markus goes on to explain the derivation of the design and emphasises that the combination of angular and round creates a striking and distinctive appearance.

14. Mr Markus in exhibit CM1 shows a photograph of the bottle which he says is very different from what is available in the market place. He says bottles in the drinks industry fall into four basic categories, namely:

- (a) classic round bottles with a high shoulder (the classic claret/cabernet wine shape);
- (b) classic round bottles with lower sloped shoulders (the classic burgundy shape);
- (c) bottles which are square or oval in cross section;
- (d) dumpy bottles with elongated necks commonly used for brandy and other spirits.

14. In his ten years in the design industry, Mr Markus says he has never seen a bottle design for alcoholic beverages like that in the application. The design has proved a great success with over 30,000 cases of gin sold after its launch in the United States of America and furthermore it was awarded a Starpack award. Mr Markus explains that Starpack is a prestigious award given by the UK packaging industry every year to innovative packaging. The success it has gained in the US leaves Mr Markus in no doubt that it is a design which distinguishes TANQUERAY NO. TEN from other products.

15. In exhibit CM2, Mr Markus shows various photographs of industry standard bottles alongside the design of the applicants' bottle. He says none of the industry bottles resemble the design.

16. Mr Markus concludes by stating that because it is so far away from any bottle design, he believes that any similar design introduced by a competitor would be taken for the TANQUEREAY NO. TEN design. The uniqueness of the design would aggravate the confusion caused.

Decision

17. The substantive objection which I upheld is made under Section 3(1)(b) which reads:

The following shall not be registered-

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

18. The mark consists of the three dimensional shape of a bottle and although an attractive and eye-catching design, it possesses no inherent trade mark character. Whilst I have no reason to doubt the expert opinion of Mr Craig Markus that the bottle is a unique design, that does not mean that the public would perceive such a design as a trade mark. The public would need to be educated through use of the design in the market place that it has become a trade mark. In Yakult Honsha KK's Trade Mark Application [2001] RPC 756 at page 759, paragraphs 10 and 11, Mr Justice Laddie said:

*“ Where inherent distinctiveness is concerned, the Registry has to find that the mark performs the function of identifying origin even before the public educated that it so used for that purpose. Where invented, non-descriptive word marks are concerned, it may be easy to come to such a finding. But where a container is in issue it may well be much more difficult. As Mr Thorley rightly conceded, the fact that a container is unusual or attractive does not, per se mean that it will be taken by the public as an indication of origin. The relevant question is not whether the container would be recognised on being seen a second time, that is to say, whether it is of memorable appearance, but whether **by itself** its appearance would convey trade mark significance to the average consumer. For the purpose of this appeal, I am prepared to accept that the bottle shape which is the subject of these applications is both new and visually distinctive, meaning that it would be recognised as different to other bottles on the market. That does not mean that it is inherently distinctive in a trade mark sense.*

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

bottles on the market, there is nothing inherent in it which proclaims it as having trade mark significance.”

19. Although the applicant has demonstrated that alcoholic beverage containers come in a wide range of shapes and sizes, nonetheless, I am not persuaded that the design conveys any trade mark significance. Whilst it is acknowledged that some of the goods included in the scope of the specifications are generally contained in bottles of a limited range of traditional shapes, in respect of some beverages, such as liqueurs and alcopops, these tend to come in fancy bottle shapes.

20. Mr Walsh referred to the guidance on the registrability of “Shape of the goods and containers” included in Chapter 6 of the Registry Work Manual. The extract that Mr Walsh highlighted should not be read in isolation from the guidance that follows it. The Manual goes on to state:

Shapes, or elements of shapes, which are likely to be taken by the public as serving:

c) a purely decorative or aesthetic purpose (such as a novelty shape for goods aimed at children or the attractive shape of an ornament)

*are unlikely to be regarded by the public as identifying the **origin** of the goods, at least until they have been educated to that perception.*

21. I acknowledge the amount of work that has gone into the design of this bottle and although the resulting product is aesthetically pleasing, it is my view that its shape would not be one which is regarded by the public as identifying the origin of the goods of one undertaking. The mark cannot function in the prima facie as an indication of trade origin and therefore under Section 3(1)(b) of the Act I conclude that it is devoid of any distinctive character.

22. There is one final point, namely the query raised in relation to the specification of goods in Class 33. The problem with the specification as filed is that it does not satisfy Rule 8(2) of the Trade Marks Rules 2000 (as amended) (Statutory Instruments 2000 No.136 and 2001 No. 3832) which reads:

8.-(2) Every application shall specify the class in Schedule 4 to which it relates and shall list the goods or services appropriate to that class.

23. The specification in Class 33 which reads “All goods in Class 33” does not comply with Rule 8(2) since a list of goods has not been provided. Therefore, in the event that the application proceeds, the goods sought to be registered under Class 33 will need to be itemised by their product names.

Conclusion

24. In this decision I have considered all documents filed by the agent, and for the reasons given the application is refused under the terms of Section 37(4) of the Act because the mark fails to qualify under Section 3(1)(b) of the Act.

Dated this 28th day of February 2002.

Charles Hamilton
For the Registrar
the Comptroller General