

# **TRADE MARKS ACT 1994**

## **IN THE MATTER OF APPLICATION No 2121479 BY SOCIETE AUTONOME DE VERRERIES TO REGISTER A TRADE MARK IN CLASS 21**

### **DECISION AND GROUNDS OF DECISION**

#### **Background**

1. On 20 January 1997 Societe Autonome De Verreries of 3 Place de la Gare, 60960 Feuquieres, France applied under the Trade Marks Act 1994 to register a series of four marks in Class 21 for the following goods:

“Unworked or semi-worked glass (except glass used in building); tableware not of precious metal; glass bottles; glass containers”.

2. Objections were taken to the application under Sections 41(2) of the Act because the marks do not form a series of marks because they differ in material detail and under Section 3(1)(a) of the Act because the marks are not graphically represented. However, these objections were subsequently waived on deletion of three of the marks and the application was restricted to the following single mark:

“The mark consists of a brown-green colour of a tinted bottle, a representation of the colour (plus samples of the mark) being given with the form of application.”

3. Further objections were taken under Sections 3(1)(b) and (d) of the Act. However, on reflection I am of the view that the objection under Section 3(1)(d) may be waived. Therefore, the only remaining objection is that taken under Section 3(1)(b).

4. At the hearing held on 27 August 1998, at which the applicants were represented by Mr Richards of Page White & Farrer, their trade mark attorneys, this objection was maintained.

5. On 10 May 1999 the applicants filed evidence which was intended to demonstrate that the mark had acquired a distinctive character as a result of that use. However, this evidence was not considered sufficient to overcome the objection which was maintained. Further evidence was filed on 8 January 2001 and 13 February 2001 but the objection was again maintained. A further hearing was held on 23 February 2001 at which the applicants were again represented by Mr Richards but the objection taken under Section 3(1)(b) of the Act was maintained.

6. Following refusal of the application under Section 37(4) of the Act 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.

## The Law

7. The relevant parts of Section 3(1) of the Act are as follows:

*“The following shall not be registered -*

*(a) .....*

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

*(c) .....*

*(d) .....*

*Provided that, a trade mark shall not be refused registration by virtue of 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 Prima Facie Case for Registration

8. It is clear from the proviso that the application must be judged as at the date of application, i.e. 20 January 1997.

9. In Henkel KGaA v OHIM which is reported at [2002] ETMR 25, The Court of First Instance said at paragraphs 48 - 49:

*“Article 7(1)(b) of Regulation No 40/94 does not distinguish between different categories of trade marks. The criteria for assessing the distinctive character of figurative marks consisting of the representation of the product itself are therefore no different from those applicable to other categories of trade marks.*

*Nevertheless, when those criteria are applied, account must be taken of the fact that the perception of the relevant section of the public is not necessarily the same in relation to a three-dimensional mark consisting of the shape and the colours of the product itself as it is in relation to a word mark, a figurative mark or a three-dimensional mark not consisting of the shape of the product. Whilst the public is used to recognising the latter marks instantly as signs identifying the product, this is not necessarily so where the sign is indistinguishable from the appearance of the product itself.”*

10. Further guidance is available in an appeal by WM. Wrigley Jr. Company against a decision to refuse an application to register the colour Light Green for Chewing Gum where The Third Board of Appeal said:

*“20 As regards Article 7(1)(b) CTMR, a trade mark which is devoid of any distinctive character, namely, one that is not capable of distinguishing the goods of one undertaking from those of another, cannot be registered. The essential function of a trade mark is to guarantee the identity of the origin of the marked product to the consumer or end user, i.e. that all goods and services bearing it have originated from under the control of a single undertaking responsible for its quality (see *inter alia* the judgment of the Court of Justice of 29 September 1998 in the Case C-39/97, *Canon Kabushiki Kaisha**

v *Metro-Goldwyn -Mayer Inc.*, paragraph 28). A trade mark must, therefore, be distinctive and be capable of serving as an indication of origin (see the seventh recital CTMR). It must have the inherent property of distinguishing the goods claimed by their origin from an undertaking. In assessing those properties, both the customary use of trade marks as indications of origin in the industry concerned and the views of the relevant consumer must be taken into consideration.”

“21 A colour *per se* normally lacks those properties. Consumers are not accustomed to making an assumption about the origin of goods on the basis of colour or the colour of their packaging, in the absence of a graphic or textual element, because a colour *per se* is not normally used as a means of identification in practice. That rule may not apply in the case of, firstly, very specific clientele and, secondly, a colour exhibiting a shade which is extremely unusual and peculiar in the relevant trade.”

11. It is clear from the Act and from the Registry’s own guidance issued in Chapter 6 of the Work Manual that colours *per se* are not excluded from registration by Section 1(1) of the Act. For ease of reference a copy of this guidance is attached at Annex A. However, colour is extensively used for marketing and decorative purposes in relation to many if not all goods and services. I am satisfied that the relevant public are unlikely to identify any particular colour as a sign indicating trade origin. The colour applied for is described as a brown-green colour applied to a bottle and I see nothing unusual or arresting in such a colour being applied to the goods in question. Drawing on my own experience I am aware that perfume and alcoholic beverage bottles (and probably other bottles besides) are frequently of brown or green glass. Brown-green glass is therefore a mere minor variation on two of the most popular shades of tinted glass. I can see nothing in this sign which is of trade mark significance or anything which enables it to act as a badge of origin and identify the goods of one particular trader.

12. In my view the application is excluded from acceptance, *prima facie*, because the sign applied for will not be taken as a trade mark without first educating the relevant public that it is a trade mark. It follows that this application is debarred from *prima facie* acceptance under Section 3(1)(b) of the Act.

### **The Case for Registration based on Acquired Distinctiveness.**

13. Evidence in support of this application has been filed in several tranches over a period of eighteen months.

14. Evidence filed on 10 May 1999 consists of an Affidavit dated 7 May 1999 by Loic Quentin de Gromard who is President and Chairman of Societe Autonome de Verreries, the applicants in this matter. Mr Gromard has held this position since 1985. Mr Gromard states that the colour applied for is referred to in the evidence as “Antique”, “Antique Green” or “Olive Green” and that the colour, together with these names, has been used in relation to glass bottles throughout the United Kingdom since 1981. Exhibit LQDG 1 consists of officially certified copies of the applicants’ French Trade Mark Registrations which are all dated 25 April 1997. I note that all of these registrations are for three dimensional bottles of various

shapes coloured green and not just the colour green *per se*. Further, the colours appear different to that in the United Kingdom application and are applied to the bottles in such a way that the colour is darker in some places and lighter in others, giving an “antique” appearance that cannot be readily discerned from the representations of the mark filed in the United Kingdom. Exhibit LQDG 2 consists of copies of press releases and publicity material relating to the launch of the colour. Mr Gromard goes on to provide details of customers who have placed orders for bottles in this colour. With the exception of 1987 turnover figures are provided for the period 1981 to 1998. Details of these are reproduced below:

YEAR	TURNOVER (in French Francs)
1981	575,000
1982	306,000
1983	821,000
1984	267,000
1985	1,337,000
1986	1,564,000
1988	994,000
1989	1,353,000
1990	1,216,000
1991	1,434,000
1992	767,000
1993	713,000
1994	621,000
1995	767,000
1996	2,960,000
1997	2,200,000
1998	1,149,000

15. Exhibit LQDG 3 consists of sample invoices in which the colour applied for is referred to as “Antique”, “Antique Green” or “Olive Green”. Mr Gromard further states that promotion of the mark has been carried out continuously since 1981 by sending material directly to customers and prospective customers. He states that because the applicants do not sell to the general public they consider it inappropriate to advertise through television, radio or press advertisements. Exhibit LQDG 4 consists of a selection of promotional material distributed in the United Kingdom since 1981. Finally Mr Gromard states that the goods have been exhibited under the mark at the Creative Packaging Exhibition in March 1994 and at PAKEX in March

1995. Invoices relating to these exhibitions are included as Exhibit LQDG 5.

16. Further evidence in support of this application was filed on 8 January 2001. This consisted of an Affidavit by Daniel J LeFrancois and two Statutory Declarations by Lyn T Evans and Ian MacEacheran. From 1991 to 1999 Mr LeFrancois was New Product Development Manager for Camus International Limited and states that in 1993 he developed glass packaging with the applicants utilising the “Antique Green” colour for use in relation to whiskey. Mr LeFrancois further states that he is not aware of any other source for this bottle in this unique tint of glass. Mr Evans is the proprietor of Link Design Development and states that he has designed and developed glass packaging with the applicants, some of which utilised the “Antique Green” glass colour. He also states that he is not aware of any other glass container company offering this distinctive colour. From 1985 to 1997 Mr MacEacheran was Package Development Project Manager for Chivas Brothers Limited. He states that he developed glass packaging with the applicants utilising the “Antique Green” glass colour and that he is not aware of any other glass container company offering this distinctive colour.

17. Further evidence in the form of two Statutory Declarations was filed on 13 February 2001. The first is by Patricia Parnell who was, from 1989 to 1997, Brand Development Director at Berry Bros. & Rudd. She states that she developed glass packaging with the applicants utilising the “Antique Green” glass colour. She further states that she is not aware of any glass container company offering this distinctive colour. The second Statutory Declaration is by John G Daniels who was, from 1985 to 1995, Sales and Marketing Director for United Glass Limited who are, he states, the leading glass bottle manufacturer in the United Kingdom. He states that he is well acquainted with the European market for glass containers and that he subsequently became Managing Director of Lewis & Towers Limited, a manufacturer of glass containers specialising in small production runs of spirits bottles. He goes on to confirm that the United Kingdom glass container marketplace (namely bottlers and distillers) is well aware that the “Antique Green” colour is a glass colour developed and marketed by Saverglass. It appears from the evidence that Saverglass is another name identifying the applicants but there is nothing in the papers before me to confirm this.

## **Decision**

18. The question to be determined is whether, through the use made of it, the sign applied for has acquired a distinctive character in respect of all of the goods contained within the specification as filed on the form of application.

19. It is now well established that this question must be asked through the eyes of the average consumer who is reasonably well informed and reasonably observant and circumspect (*Lloyd Schufabrik Meyer & Co. GmbH v. Klijsen Handel BV, Case C-342/97 [1999] ECR I-3830* para. 26). In the *Windsurfing Chiemsee* case, the European Court of Justice ruled on the nature of the enquiry as to whether a mark has acquired a distinctive character under Article 3(3) (section 3(1) proviso). It held that the national authorities may take into account evidence from a variety of sources. The Court said:

“In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: the market share held

by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations” (paragraph 51).

20. It is clear from the evidence that the goods are glass bottles coloured green which are sold by special order to customers who will fill the bottles with consumable liquids such as whiskey or brandy etc. The bottles do not reach the general public until they have been filled, capped and had labels identifying the contents of the bottles attached to them.

21. The specification of goods contains goods for which the average consumer will vary depending on the actual goods in question. The average consumer for “Tableware” is likely to be the general public but the average consumer for “Unworked and semi-worked glass” is more likely to be the trade. While it appears that the applicants’ customer is the trade I must consider this question in relation to glass bottles *per se* and not only the type of glass bottle produced by the applicants. However, after taking account of this, I consider it more likely that the average consumer of bottles *per se* will be the trade although I am aware that the general public do purchase glass bottles for decorative use and/or storage e.g. home made wine. Glass containers are, in my view, likely to be purchased by the trade and the general public.

22. It may be claimed that trade customers are more discerning than the public at large but there is no evidence that even the trade are accustomed to identifying the trade source of glass bottles by the shades of colours used. Insofar as acquired distinctiveness is concerned the relevant consumer is the average consumer for glass bottles because these are the goods supported by the evidence.

23. The evidence indicates that the applicants specialise in the production of special or unusually shaped glass bottles for the wine and spirit market in low minimum production runs. These bottles are produced in a wide range of colours, one of which is the colour for which registration is sought. This colour is referred to by one of three names: “Antique”, “Antique Green” or “Olive green”. This particular colour was introduced in 1981. It is one of a range of seven colours offered by the applicants. At Exhibit LQDG 4 in the publication entitled “SAVERGLASS THE EXPRESSION OF GLASS” these seven colours are displayed. They consist of four shades of green, two shades of brown and one apparently clear colour named “Extra white flint”.

24. The Statutory Declaration provides turnover figures in French Francs from 1981 to 1998. The turnover figures vary from year to year and with fluctuating conversion rates it is not possible to accurately arrive at their equivalent in Pounds Sterling. Neither is there any way of calculating the total number of bottles that these figures represent. On any view, the figures quoted must represent no more than a tiny fraction of the total UK market for glass bottles, and must also be a tiny proportion of even the market for glass bottles of alcoholic drinks.

25. There is nothing in this evidence to indicate that the applicants have been successful in promoting this sign as a trade mark to the extent that the relevant public identify the colour of their bottles as a sign which distinguishes their goods from goods of other traders.

26. At Exhibit LQDG 4 in the publication entitled THE SHAPE OF SALES SUCCESS the applicants state the following:

*“The package has reflected the product, creating a specific image, brand awareness and instant on-the-shelf recognition. And in glass packaging this is primarily achieved by **shape** - the shape that comes from having a bottle specially designed for the product.”*

27. In the same publication the applicants refer to the colour as one of a range of design options:

*“Though shape is of the essence, many other design options are brought into the creative process. Perhaps the most obvious is **colour** where, in addition to the “standard” white flint and amber, you may choose from Champagne Green, Feuille Mort, new Antique Green or Dark Amber.”*

28. Further on in that publication the applicants state:

*“This extra weight, together with the special “antique” or olive green colour, both enhances the feel and appearance of the bottle and protects the delicate fine wine from ultra violet rays.”*

29. This evidence indicates that the applicants do not promote the sign as a trade mark but as a simple colour option which has the additional benefit of enhancing the appearance of a bottle and offering a degree of protection from ultra violet rays.

30. There is, of course, further evidence in support of this application. In their evidence Mr LeFrancois, Mr Evans, Mr MacEarcheran and Ms Parnell all state that they “developed glass packaging” with the applicants. Furthermore they all state that they are not aware of any other glass container company offering products in this particular colour. None of these declarants go as far as to state that they recognise this sign as a trade mark distinguishing the goods of the applicants from those of other traders.

31. Mr Daniels states that he is well acquainted with the European market for glass containers and simply states that the applicants developed and marketed bottles in the “Antique Green” colour and that the United Kingdom glass container marketplace (namely bottlers and distillers) is well aware that the “Antique Green” colour is a glass colour originally developed and marketed by the applicants. Again Mr Daniels does not go as far as to state that he recognises the sign as a trade mark distinguishing the goods of the applicants. Additionally, it is not known what colour the declarants have in mind when they refer to “antique green”. There is no indication that they have seen the colours filed. This is particularly significant in circumstances where there seems to be a difference between these colours, the examples shown in evidence and those on the French register. The mark applied for must be defined by

virtue of the representation of the colours with the form of application and not the samples. The sample of the bottle is not a graphical representation of the trade mark, nor is it any substitute in such a representation.

32. Clearly the evidence incorporates references to the sign applied for but the evidence does not go as far as to indicate that the applicants have been successful in educating the relevant public that the colour applied for is a trade mark and that it distinguishes the goods of the applicant from goods of another trader. In this conclusion I find support in the comments of Morritt L J in *Bach Flower Remedies* 2000 RPC 513 at page 530 lines 19 - 21 where he said:

“First, use of a mark does not prove that the mark is distinctive. Increased use, of itself, does not do so either. The use and increased use must be in a distinctive sense to have any materiality.”

33. The key authority for acquired distinctiveness is *Windsurfing Chiemsee Produktions Und Vertriebs GMBH v. Boots-Und Segelzubehor Wlater Huber* (C109/97) [1999] E.T.M.R. 585 at 46 and the relevant test, which is set out in the second emboldened answer following paragraph 55, is:

“2. The first sentence of Article 3(3) of the First Directive 89/104/EEC is to be interpreted as meaning that:

— a trade mark acquires distinctive character following the use which has been made of it where the mark has come to identify the product in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product from goods of other undertakings;

— it precludes differentiation as regards distinctiveness by reference to the perceived importance of keeping the geographical name available for use by other undertakings;

— in determining whether a trade mark has acquired distinctive character following the use which has been made of it, the competent authority must make an overall assessment of the evidence that the mark has come to identify the product concerned as originating from a particular undertaking and thus to distinguish that product from goods of other undertakings;

— if the competent authority finds that a significant proportion of the relevant class of persons identify goods as originating from a particular undertaking because of the trade mark, it must hold the requirement for registering the mark to be satisfied;

— where the competent authority has particular difficulty in assessing the distinctive character of the mark in respect of which registration is applied for, Community law does not preclude it from having recourse, under the conditions laid down by its national law, to an opinion poll as guidance for its judgment.”



34. On the basis of this evidence the applicants have not, in my view, been successful in satisfying that test.

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

### **Conclusion**

36. In this decision I have considered all the documents filed by the applicants and all the arguments submitted to me in relation to this application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act in that it fails to qualify under Sections 3(1)(b) of the Act.

**Dated this 19<sup>TH</sup> day of July 2002**

**A J PIKE**

**For the Registrar  
The Comptroller General.**

**Annex in paper copy**