

TRADE MARKS ACT 1994

AND

THE TRADEMARKS (INTERNATIONAL REGISTRATION) ORDER 1996

IN THE MATTER OF

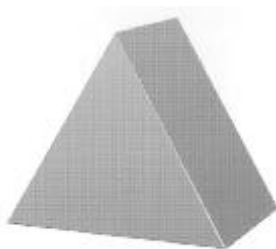
INTERNATIONAL REGISTRATION NO. 711078

AND THE REQUEST BY KRAFT JACOBS SUCHARD SA

TO PROTECT A TRADE MARK IN CLASS 30

Background

1. On 22 April 1999, Kraft Jacobs Suchard SA of Gewerblicher Rechtsschutz, Klausstrasse 4-6, CH-8008 Zürich, Switzerland, on the basis of International Registration No 711078, requested protection in the United Kingdom, under the provisions of the Madrid Protocol, of the following mark:



2. The following words appear beneath the mark on the form of notification:

Indication relating to the nature or kind of mark: three-dimensional mark.

3. The International Registration is numbered 711078 and protection is sought in Class 30 in respect of:

Chocolate and products containing chocolate.

4. It was considered that the request failed to satisfy the requirements for registration in accordance with Article 3 of the Trade Marks (International Registration) Order 1996 and notice of refusal under Article 9(3) was given because the mark is excluded from registration by Sections 3(1)(a) and (b) of the Trade Marks Act 1994. This is because the mark consists of a three-dimensional triangular shape which does not satisfy Section (1) of the Act as it is not graphically represented and it is devoid of any distinctive character. However, the objection under Section 3(1)(a) of the Act was subsequently waived and I need make no further mention of it in this decision.

5. At a hearing, at which the applicants were represented by Ms Lambeth of Haseltine Lake, their trade mark attorneys, the objection under Section 3(1)(b) of the Act was maintained. Notice of refusal was issued under Article 9(3) and 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.

6. No evidence of use has been put before me. I have therefore, only the prima facie case to consider.

The Law

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

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

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

The Case for Registration

8. It is clear from the Form of Notification and from the original Form of Application that this is a request for the protection of a three-dimensional trade mark. However, there is nothing in any of these documents to indicate if this shape relates to the goods themselves or to their packaging. In correspondence Ms Lambeth sought to persuade me that this is an application relating to the shape of the packaging but I remain unsure as to the actual nature of this mark. In the circumstances I propose to consider the mark in relation to both the goods and the packaging applied to the goods.

9. It is clear from the wording of Section 1(1) of the Act that:

“A trade mark may, in particular, consist of the shape of goods or their packaging.”

10. However, the shape in question must possess a distinctive character in the sense that it is capable of identifying the trade origin of the goods or services in question.

11. 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. It follows that an assessment of distinctive character cannot result in different outcomes for a three-dimensional mark consisting of the design of the product itself and for a figurative mark consisting of a faithful representation of the same product.”

12. In Yakult Honsha KK’s Application [2001] RPC 756, Laddie J described the correct approach under Section 3(1)(b) as:

“Where inherent distinctiveness is concerned, the Registry has to find that the mark performs the function of identifying origin even before the public is educated that it is 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.”

13. Guidance concerning the appropriate test for prima facie acceptance is provided by the Trade Marks Work Manual, Chapter 6, paragraph 6.4 which sets out the appropriate test for assessing prima facie acceptance which is as follows:

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 applicants’ 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.

Decision

14. The mark consists of a three dimensional triangular shape which may be either the shape of the goods themselves or the packaging for such goods. The goods in question are “chocolate and products containing chocolate”. Although the shape in question is three dimensional, the triangular aspect of it is an ordinary geometrical shape. Drawing on my own experience I am aware that goods such as the goods in question are sold in a variety of shapes. They are available individually or in boxed containers which may themselves contain several goods made of, or containing chocolate, all of the same shape, or several different goods of or containing chocolate comprising a number of different shapes. Insofar as the packaging is concerned this may be the first layer of wrapping which is applied directly to the product as a protective layer or it may be exterior packaging which would function as a container for several chocolate products.

15. Furthermore, I must consider this matter through the eyes of the average consumer who is deemed to be reasonably observant but whose level of attention will vary from one product to another: *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [1999] ETMR 690.

16. In my view the shape in question, whether applied to the goods or the packaging of such goods, would not be regarded, by the relevant consumer, as a sign identifying the origin of the goods of a single undertaking. The mark is therefore incapable of serving as an indication of trade origin and is considered to be devoid of any distinctive character. This application fails the test set out by section 3(1)(b) of the Act.

Conclusion

17. In this decision I have considered all 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 Section 3(1)(b) of the Act.

Dated this 30th Day of August 2002

A J PIKE

**For the Registrar
The Comptroller General**