

TRADE MARKS ACT 1994

TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996

IN THE MATTER OF:

THE REQUEST BY EKORNES ASA

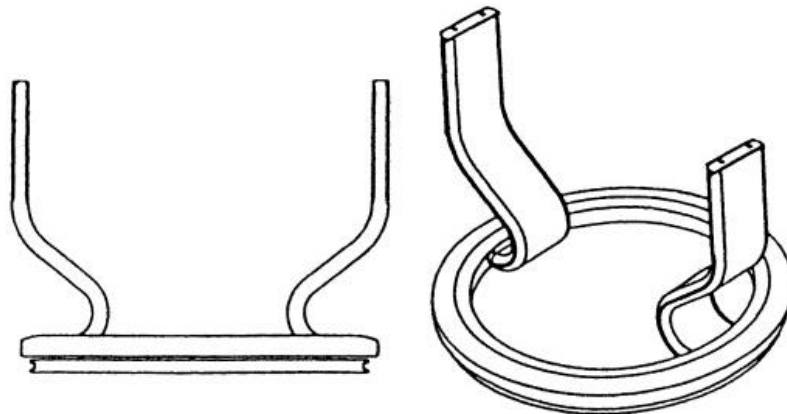
FOR PROTECTION IN THE UNITED KINGDOM

OF INTERNATIONAL TRADE MARK No. 802779

IN CLASS 20

DECISION

1. In the present case the Registrar of Trade Marks has refused the request of Ekornes ASA (**‘the Applicant’**) for protection in the United Kingdom under the provisions of the Madrid Protocol and the Trade Marks (International Registration) Order 1996 of the following three-dimensional mark:



for use in relation to the following goods specified in International Registration No. 802,779: *‘chairs; recliner chairs; recliner chairs with footstools’* in Class 20.

2. The reasons for refusal were given in a decision issued by Mr A J Pike on behalf of the Registrar on 9 May 2005 (BL 0-130-05). He decided that the request for protection should be refused under section 3(2)(b) of the Trade Marks Act 1994 on the ground that the sign in question ‘*consists exclusively of the shape of goods which is necessary to obtain a technical result*’, alternatively under section 3(1)(b) of the 1994 Act on the ground that the sign in question was ‘*devoid of any distinctive character*’ in relation to goods of the kind for which protection had been requested. The evidence filed on behalf of the Applicant (a witness statement of Svein Lunde with three exhibits and a witness statement of Chris Boiling with two exhibits) was considered insufficient to enable the request for protection to be accepted.

3. The objection under section 3(2)(b) was maintained on the following basis:

12. The Registrar’s objection to this particular shape is that its essential features are functional. It consists of two curved “S” shaped legs which link into a circular base. It is clear from the exhibits to the Witness Statement of Mr Lunde that these are used as a base to support both chairs and footstools. I consider it obvious that both chairs and footstools require such a base for them to properly function. The primary function of such bases is to raise the area of the chair and footstool to an appropriate height which results in chairs and footstools which are convenient to use and maximise comfort. Such bases provide the stability necessary for such products to properly function. Bases require a strong and durable design.

13. Both Mr Lunde and Mr Boiling make the point that the shape applied for is not the only shape which is used as bases for furniture. However, it is clear from *Philips* that establishing that there are other shapes which allow the same technical result to be obtained does not result in a shape for which registration may be granted. This shape is not a combination of simple straight chair legs. Its shape is more complex than that. The curved “S” shaped legs are curved in

an appropriate manner for either end to be connected to other parts of the product. This curved “S” shape is governed by the joined points of the base and the seat. The design of the base is such that it appears to incorporate a groove into which the legs are inserted and connected. In order to connect to the upper part of the chair or footstool the legs simply must be shaped the way that they are. This allows the top of the legs to be connected at a point which is directly above the connection to the actual base.

14. In his Witness Statement Mr Lunde makes the following statement:

“The Trade Mark consists of two curved “S” shapes which link into a circular base. The device has been chosen for its aesthetic qualities as well as to provide maximum strength and durability for the upper part of the recliner/chair/stool as required. The Trade Mark is the only base used for all of Ekornes’ recliners and matching stools. It is not the most functional shape for such a purpose and we instructed our design department to design a shape which would achieve several purposes: provide a suitable base for the furniture and make it recognisable in the market place. It is quite different to other shapes used as bases for furniture and our customers recognise it as Ekornes’.”

15. However good the intentions of the applicant may be in choosing this particular shape I must consider if the shape in question is exclusively the shape of goods which is necessary to obtain a technical result. As I have explained, the fact that the designers of the competitors’ products have adopted designs which differ from the applicant’s design is of no assistance as far as this application is concerned. There is no evidence as to why the applicant or the competitors arrived at different designs for the same products although I do not find such a fact to be particularly surprising. The competitors’ choice may well have been limited or constrained by real or perceived intellectual property rights or other considerations.

16. The evidence indicates that the shape for which registration is sought is one where the essential features are

functional and that these features are attributable only to a technical result.

4. The objection under section 3(1)(b) was maintained on the following basis:

21. In order for the trade mark applied for to be acceptable for prima facie registration it must convey trade mark significance to the relevant consumer who, in this case, I consider to be the general public. The goods in question are chairs, recliner chairs and recliner chairs with footstools. Such goods are not uniform in any way but are available in a wide variation of shapes and styles. This is supported by the Witness Statement of Mr Boiling and the exhibits attached thereto. As far as this particular style is concerned I do not consider it to be so different from the norm in the sector concerned as to permit an average consumer to distinguish the goods of the applicant from those of other traders.

...

36. It is clear from the evidence that although the mark applied for is a three-dimensional representation of the base of reclining chairs and footstools, several of the exhibits show the mark in use but only as a component within the complete chair or footstool. It is never shown on its own apart from a few photographs in the Annual Report which forms Exhibit SL1 to the Witness Statement of Svein Lunde. I note that there is no evidence that a significant proportion of the general public, who are the relevant consumer of these products, have access to or have ever seen this or any of the earlier Annual Reports. The mark is not referred to in any of the exhibits; it merely appears as an element in the complete article. The only trade mark reference that I have been able to identify from this evidence is the word STRESSLESS which is, in all probability, the name by which the general public will refer to these products.

37. There is one further point which leads me to determine that the mark applied for is not distinctive and does not depart significantly from the normal design of such base units for chairs and footstools. The exhibits attached to the Witness Statement of Chris Boiling demonstrate that the use of a circular base and curved legs are commonly used as a construction system for bases for reclining chairs and

footstools. They may not be identical to the trade mark for which registration is sought but they are, conceptually and visually, so similar that only an expert such as Mr Boiling would pay attention to the difference. In my view the general public, when faced with such an array of similar bases, would place no trade mark significance upon them at all. They may identify them as having some aesthetic appeal or they may perceive them as being of a particularly strong and durable design, but they would not provide any message to the general public that the goods emanate from a single undertaking. As far as the applicant's goods are concerned they are far more likely going to ask for a STRESSLESS chair or footstool because they would perceive that word as the trademark for the goods in question and would not even identify the mark applied for as any indication of the trade origin of the goods.

38. Clearly the evidence incorporates references to the trade mark applied for, but the evidence does not go so far as to indicate that the applicant has been successful in educating the relevant consumer that the trade mark applied for is a trade mark and that it distinguishes the goods of the applicant from goods of another trader.

39. On the basis of this evidence the applicant has not, in my view, been successful in satisfying the test identified in the judgement of the ECJ in *Windsurfing Chiemsee Produktions Und Vertriebs GMBH v. Boots-Und Segelzubehor Walter Huber* as set out earlier in this decision.

40. 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 applicant has 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.

5. The Applicant appealed to an Appointed Person under section 76 of the Act contending, in substance, that the hearing officer had erred:

- (1) by regarding the sign in question as ‘*a shape which is necessary to obtain a technical result*’ when applied to goods of the kind specified in the request for protection;
- (2) by holding that the sign in question consisted ‘exclusively’ of such a shape;
- (3) by regarding the sign in question as insignificantly different from the shapes applied to the goods of other suppliers in the same sector of trade;
- (4) by not regarding the evidence before him as sufficient to establish that the sign in question did indeed serve to distinguish the Applicant’s goods from those of other suppliers of such goods in the United Kingdom.

These points were developed in argument at the hearing before me. I shall deal with each of them in turn.

Point (1)

6. The Applicant submits that the word ‘*necessary*’ as used in the expression ‘*necessary to obtain a technical result*’ should be taken to mean ‘*required*’. That undoubtedly accords with the usual meaning of the word ‘*necessary*’. However, the expression ‘*necessary to obtain a technical result*’ has been interpreted and applied purposively by reference to the aim of the exclusion rather than strictly grammatically by reference to the linguistic function of the word ‘*necessary*’. As a result, it appears to be settled that technically efficacious shapes should be regarded as ‘*necessary*’ to achieve

the particular technical results they actually achieve (a variant of the proposition that handsome is as handsome does).

7. In Case C-299/00 Koninklijke Philips Electronics NV v Remington Consumer Products Ltd [2002] ECR I-5475 at paragraph 79 the ECJ confirmed that the exclusion:

is intended to preclude the registration of shapes whose essential characteristics perform a technical function, with the result that the exclusivity inherent in the trade mark right would limit the possibility of competitors supplying a product incorporating such a function or at least limit their freedom of choice in regard to the technical solution they wish to adopt in order to incorporate such a function in their product

8. The High Court and the Court of Appeal in England had already found, consistently with that approach, that the shape in question was necessary to obtain a technical result in relation to goods of the kind specified in the contested registration: [1998] RPC 283 at pp.305 to 309 per Jacob J; [1999] RPC 809 at pp. 820 to 822 per Aldous LJ. Aldous LJ came to that conclusion on the following basis:

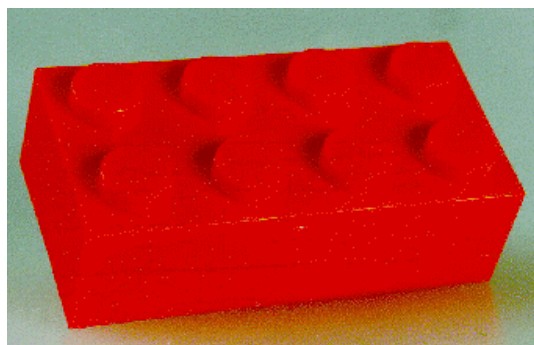
All that has to be shown is that the essential features of the shape are attributable only to the technical result. It is in that sense that the shape is necessary to obtain the technical result. ... As I have already pointed out, the trade mark does not contain any feature having trade mark significance. It is a combination of technical features produced to achieve a good practical design. I conclude that [Jacob J] was right in this respect also.

9. These findings were made in relation to the following sign:



which had been registered in respect of *‘electric shavers included in Class 8’*. The shape was *‘necessary to obtain a technical result’* in the sense that it supplied *‘a combination of technical features produced to achieve a good practical design’*. The correctness of that approach was affirmed in the subsequent Judgment of the ECJ at paragraph 85.

10. On the basis of the ruling in Case C-299/00 Philips Electronics, the Cancellation Division of the Community Trade Marks Office has held that Community trade mark registration number 107,029 for the three-dimensional shape of a Lego brick in the colour red:



was invalid and should be cancelled under Article 7(1)(e)(ii) of the Community Trade Mark Regulation, corresponding to section 3(2)(b) of the 1994 Act: Case 63 C 107029 Mega Bloks Inc v. Kirkbi A/S [2005] ETMR 87, p.1029. I refer to the following observations in the decision concerning the meaning and effect of the word ‘*necessary*’:

45. It is therefore clear from the judgment of the court that the term “necessary” contained in Art. 7(1)(e)(ii) CTMR does not mean that the shape is necessarily the only shape to achieve the particular result.

46. Rather, the term “necessary” must be interpreted as meaning that the respective shape or element of the shape is necessary in the sense of a condition *sine qua non* for achieving the result. Thus, the test is whether if the respective element was absent, the technical result would not be obtained, and if the respective element was altered substantially, the technical result would also alter substantially.

...

51. A qualifier must also be made insofar as the court uses, in [83] of the *Remington* judgment, the word “functional”. The question is not whether the design of the item is functional, but whether the function of the item is actually performed by the shape. To clarify this point, one can give the example of the washing tablets having bevelled edges. This is done so as to avoid sharp edges which could deteriorate the laundry during the washing process, and is therefore essentially a functional consideration, but the result obtained through the use of washing tablets is to clean the laundry, and that result is not at all due to a particular shape of the washing tablet, but would in a similar manner be achieved by washing powder.

52. Rather, it matters under the judgment of the Court of Justice whether the characteristics of the shape perform a technical function and were chosen to fulfil that function, and that in as much as those characteristics of the shape could be protected by a trade mark, the access of third parties to utilising that technical result would be hampered. To put it in other words, the rationale of Art. 7(1)(e)(ii) is that when

third parties want to achieve a technical result and when in doing so they have necessarily to produce an item in a particular shape, they are not restricted through trade marks in the choice of the shape and do not need to invent a different shape for achieving the same or an approximately like advantageous technical result.

These observations appear to me to conform to the ‘result ordained by shape rather than shape ordained by result’ approach to the word ‘*necessary*’ that the ECJ has upheld as correct in the Philips Electronics case.

11. I do not think it can be denied that the shape of the sign in issue in the present case is technically efficacious. The mechanical properties of it are readily apparent. It was acknowledged in the Witness Statement of Svein Lunde that the sign:

consists of two curved ‘S’ shapes which link into a circular base. The device has been chosen for its aesthetic qualities as well as to provide maximum strength and durability for the upper part of the recliner/chair/stool as required (emphasis added).

These considerations bring it within reach of an objection under section 3(2)(b) on the basis of the meaning to be attributed to the expression ‘*necessary to obtain a technical result*’. Point (1) of the argument advanced on appeal is therefore rejected.

Point (2)

12. Section 3(2) of the 1994 Act gives effect to article 3(1)(e) of the Trade Marks Directive (Council Directive 89/104/EEC of 21 December 1988). It comprehensively denies protection to signs which ‘*consist exclusively of: (i) the shape which results from*

the nature of the goods themselves; or (ii) the shape of goods which is necessary to obtain a technical result; or (iii) the shape which gives substantial value to the goods’.

13. In the context of the exclusion from protection contained in section 3(1)(c) of the Act (article 3(1)(c) of the Directive) it is clear that the words ‘*consists exclusively*’ are directed to the form and content of the sign in question and provide for refusal of protection if and when the sign as a whole fulfils the specified requirement for exclusion: see paragraphs 33 to 37 of the Judgment of the Court and paragraphs 37 to 48 of the Opinion of Advocate General Jacobs in Case C-191/01 P OHIM v Wm Wrigley Jr Company (DOUBLEMINT) [2003] ECR I-12447. I believe that the same must be true of the words ‘*consist exclusively*’ in the context of the exclusion from protection contained in section 3(2) and article 3(1)(e). Any other approach would conflict with the basic principle that marks and signs should be considered and assessed without dismemberment or excision.

14. It does not follow that every single constituent of the mark or sign must fulfil the requirement for exclusion: see Koninklijke Philips NV v Remington Consumer Products Ltd [2004] EWHC 2327 (Ch) at paragraphs 29 to 31 (Rimer J). The question whether the sign as a whole fulfils the requirement for exclusion must be answered realistically, by reference to the sum and substance of the matter.

15. A finding that a sign fulfils the requirement for exclusion cannot be avoided by showing:

- (1) that there are other ways of achieving the same result, see Case C-299/99 Philips Electronics at paragraphs 80 to 84;
- (2) that it is presented in stylised form if the stylisation is '*significant both for the technical result and the appearance of the shape as such*', see Mega Bloks Inc v. Kirkbi A/S (above) at para. 47 and compare the Judgment of the ECJ in Case C-37/03 P BioID AG v. OHIM (15 September 2005) at paragraphs 69 to 75;
- (3) that the person(s) who devised it did not believe or intend that to be the case, see [2004] EWHC 2327 (Ch) at paragraph 32 (Rimer J).

16. The hearing officer clearly adhered to the propositions noted in paragraphs 15(1) and 15(3) above. In relation to the propositions noted in paragraphs 14 and 15(2) above, his approach was as follows:

The curved S shaped legs are curved in an appropriate manner for either end to be connected to other parts of the product. This curved S shape is governed by the joining points of the base and the seat. The design of the base is such that it appears to incorporate a groove into which the legs are inserted and connected. In order to connect the upper part of the chair or footstool the legs simply must be shaped the way they are. This allows the top of the legs to be connected at a point which is directly above the connection to the actual base.

I see in these observations a rather austere assessment of the shape in question: a base is a base, a seat is a seat, legs are legs and thereby seats and bases are connected. However, it seems to me that there is more to be said about the aesthetics of the shape. The evidence on file contains illustrations of chairs and footstools incorporating the sign. They

reinforce me in the view that the sign consists of a technically efficacious shape presented in stylised form with a discernible, although not high, degree of stylisation. The degree of stylisation is, I believe, sufficient to counter the suggestion that the shape as a whole consists essentially of features attributable only to the technical result of using that shape (i.e. the test for exclusion under section 3(2)(b) and article 3(1)(e)(ii) as applied in Philips Electronics). Since I consider the surplus of form over function to be aesthetically significant, I am willing to accept point (2) of the argument advanced on appeal. In doing so, I should emphasise that no question has at any stage been raised as to the acceptability of the sign in issue under section 3(2)(c) and article 3(1)(e)(iii).

Point (3)

17. A shape must by nature or nurture possess a distinctive character when applied to goods of the kind specified in the request for protection in order to be free of objection under section 3(1)(b) of the Act. Distinctiveness is a relative concept in the sense that it falls to be assessed with proper regard for the norms and variations likely to be encountered in use in the market sector(s) in which protection has been requested. Moreover, it cannot be assumed that an assessment made in the light of circumstances prevailing in the marketplace at one point in time will necessarily hold good in the light of circumstances prevailing in the marketplace at a substantially earlier or substantially later point in time.

18. The Applicant provided evidence in the form of trade literature and magazines (at Exhibits SL2, CB1 and CB2) from which it appears that the shape of the sign in issue is of a genre that might be described as modern Scandinavian. In terms of norms and

variations it is distinguishable from the other shapes illustrated in the evidence, 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 they are goods which are likely to be purchased for their appearance, but having considered the hearing officer's assessment in the light of the evidence on file and my general awareness of the form and presentation of such goods I take the view that he was right to reach the conclusion he did for the reasons he did with regard to exclusion of the sign from registration under section 3(1)(b). I therefore reject point (3) of the argument advanced on appeal.

Point (4)

19. It was submitted on behalf of the Applicant that public inertia with regard to the perception of shape as an indication of trade origin should readily be taken to have been overcome by substantial commercial use of a shape which is as idiosyncratic as the shape in issue in the present case. On behalf of the Registrar it was pointed out that the Applicant had acknowledged in correspondence with the Registry that a plethora of shapes could be found in use in the relevant sector of the market and it should therefore recognise the commensurately heavy burden of establishing that the sign in issue had acquired a distinctive character through use: it is harder to stand out in a large crowd than in a small group. I do not need to dwell on these lines of argument. The evidence filed by the Applicant is not sufficient to substantiate a claim to acquired distinctiveness on either or any other view of the matter. I therefore reject point (4) of the appeal.

Conclusion

20. The request for protection of 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.

Geoffrey Hobbs QC
16 January 2006

Mr Martin Krause of Messrs Haseltine Lake appeared on behalf of the Applicant

Mr Allan James appeared on behalf of the Registrar