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TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION 1074813 (SHOWN BELOW)
IN THE NAME OF BEAUTE PRESTIGE INTERNATIONAL
IN CLASS 3



**THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 2008 (as amended)
IN THE MATTER OF INTERNATIONAL REGISTRATION 1074813
AND THE REQUEST BY BEAUTE PRESTIGE INTERNATIONAL
TO PROTECT A TRADE MARK IN CLASS 3**

Background

1. On 18 March 2011, Beaute Prestige International requested protection in the United Kingdom under the provisions of the Madrid Protocol for the following sign:



2. Protection was sought in class 3 for the following goods:

Perfumes, toilet water; deodorants for personal use; essential oils for personal use; oils for cosmetic purposes; liquid soaps for personal use; cleansing milk for toilet purposes; creams, lotions and cosmetic products for face care; creams, lotions and cosmetic products for body care; make-up removing lotions; cosmetic products and preparations for skin care, for weight loss, for the bath, for sun-tanning; beauty masks; bath and shower gels; bath foam; hair lotions and products for hair care; shampoos.

3. On 25 May 2011, the Intellectual Property Office ('IPO') issued notification of a provisional total refusal of protection in response to the application. In that notification, an objection was raised under section 3(1)(b) of the Trade Marks Act 1994 ('the Act') on the basis that the mark is devoid of any distinctive character because the container has no distinctive features that render it different from other containers used for products such as those intended for protection.

4. On 19 July 2011, Mr John Reddington of Williams Powell, acting as the applicant's representative ('the agent'), submitted written arguments stating why he considered that the objection was not well-founded. Along with this correspondence, Mr Reddington submitted exhibits to support his submissions.

5. On 27 July 2011, the examiner issued a letter maintaining the objection, and stating that he was not persuaded the mark was *prima facie* distinctive. The agent responded by

requesting a fuller response to his earlier letter of 19 July 2011, which then resulted in a second letter from the examiner setting out more detailed reasons for both raising and maintaining the objection.

6. On 15 September 2011, Mr Reddington requested an *ex parte* hearing. At the hearing before me on 7 February 2012, the objection was maintained. However, as the agent expressed his intention to submit an example of the article for my further consideration, I agreed to a further period of two months.

7. On 28 March 2012, Mr Reddington provided a specimen perfume container which, after careful consideration, still failed to persuade me that the mark is *prima facie* distinctive. As a result, I granted further time for the agent to submit evidence in support of a claim to acquired distinctiveness.

8. In a response dated 14 June 2012, Mr Reddington then filed notice of an appeal to the Appointed Person on Form TM55, along with a statement setting out the grounds for appeal. In view of the fact that IPO had not, at that time, issued any formal refusal, Mr Reddington was advised to submit a Form TM5 requesting a full decision which could then, if so wished, be used as the basis for an appeal. A TM5 was duly received on 29 June 2012.

9. Having received that For TM5, I am now required to set out the reasons for refusal of protection in the United Kingdom. No formal evidence has been put before me for the purposes of demonstrating acquired distinctiveness. Therefore, I have only the *prima facie* case to consider.

The applicant's case for registration

10. On 19 July 2011 and 17 August 2011 (i.e. *before* the *ex parte* hearing), Mr Reddington submitted written arguments to the examiner in support of the mark's alleged *prima facie* distinctiveness. The submissions contained in those two letters are summarised as follows:

- The mark is based upon a French national registration dated 4 February 2011, and has already been found to be registerable in numerous national offices including those of other EU member states. Mr Reddington listed 20 countries where the mark is deemed to be registerable, pointing out that the only exceptions were the UK and the US.
- The shape of the perfume flask is striking, unique, memorable, and perfectly capable of guaranteeing trade origin without the need to first educate consumers.
- Because no objection had been raised pursuant to section 3(2) of the Trade Marks Act 1994, then by extension, the mark applied for is a shape which is not closely bound up with the goods in a 'descriptive' or 'functional' way, and is not pure embellishment which is limited to adding only aesthetic value to the goods, but rather, *is* capable of identifying trade origin.
- Reference was made to guidance published in IPO's Examination Guide (part of the Manual of Trade Marks Practice) relating to shape marks, and it was submitted that the IPO has already publicly conceded that the perfume industry is one where elements such

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as bottle shape are habitually used to distinguish the goods of one undertaking from those of another.

- It therefore follows that fragrance producers have a legitimate interest in protecting the shape of their perfume containers and bottles because they serve to function as primary visual identifiers of trade origin.
- The proprietor of the present international registration and its associated company already own several such registrations, details of which have been provided in an exhibit, together with other examples of what Mr Reddington alleges to be inherently distinctive perfume bottles.
- Perfumes are expensive and highly personal items in which consumers invest a great deal of deliberation and, as such, pay particular attention when making a purchase. Whilst the primary consideration when purchasing a perfume may be the fragrance, the primary visual identifier is the container shape.
- Consumers of perfume products are more likely to notice a striking new perfume container and rely upon the shape of that container as an identifier of commercial origin, than are consumers of, for example, groceries or household cleaning fluids.
- The bottle design was commissioned in order to distinguish the applicant's product from all other fragrances which the designer has been involved in. Mr Reddington presented me with a quotation from the designer which, it is alleged, reflects the individuality (and inherent distinctiveness) of the sign intended for protection: *"I wanted something simple, straight lines, the rigor of a cube and the sensation of an object made to be held in the hand, but with the density of beautiful objects. And as always, light as the overarching theme. For me, light is eternal strength"*.

11. Having found that these submissions did not persuade the examiner to waive the objection, Mr Reddington alleged that the official reasons for maintaining the objection were unsatisfactory, and were based upon a subjective personal response, unsubstantiated by any legal reasoning. As a result, the examiner presented the agent with relevant case law from the Court of Justice of the European Union (CJEU), in particular, C-286/06 *Develey Holding GmbH & Co. Beteiligungs KG, vs OHIM*, and C-218/01 *Henkel KGaA vs Deutsches Patent-und Markenamt*.

12. At the *ex parte* hearing, Mr Reddington reiterated his arguments made previously in correspondence. He submitted that the 'threshold for distinctiveness' in respect of perfume bottles is lower and different to other sectors, and again made reference to the IPO Examination Guide's statement in respect to the role of bottle shapes within the perfume sector.

The Law

13. 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,

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 above provision mirror Article 3(1)(b) of First Council Directive 89/104 of 21 December 1988 (as subsequently codified). The proviso to section 3 is based on the equivalent provision of Article 3(3).

Decision - Section 3(1)(b)

14. In assessing whether the mark applied for falls foul of section 3(1)(b), I refer to a judgment issued by the CJEU in Joined Cases C-53/01 to C-55/01 *Linde AG, Windward Industries Inc and Rado Uhren AG* (8 April 2003) where, in paragraphs 37, 39 to 41, and 47, the following is stated:

"37. It is to be noted at the outset that Article 2 of the Directive provides that any sign may constitute a trade mark provided that it is, first, capable of being represented graphically and, second, capable of distinguishing the goods and services of one undertaking from those of other undertakings.

39. Next, pursuant to rule 1 Article 3(1)(b) of the Directive, trade marks which are devoid of distinctive character are not to be registered or if registered are liable to be declared invalid.

40. For a mark to possess distinctive character within the meaning of that provision it must serve 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 products of other undertakings (see *Philips*, paragraph 35).

41. In addition, a trade mark's distinctiveness must be assessed by reference to, first, the goods or services in respect of which registration is sought and, second, the perception of the relevant persons, namely the consumers of the goods or services. According to the Court's case law, that means the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and circumspect (see Case C-210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 31, and *Philips*, paragraph 63).

47. As paragraph 40 of this judgment makes clear, distinctive character means, for all trade marks, that the mark must be capable of identifying the product as originating from a particular undertaking, and those distinguishing it from those of other undertakings."

15. It is beyond dispute that the sign applied for is a three dimensional representation of the shape of a perfume bottle. As regards the registrability of the shape of packaging, in *Henkel KGaA v Deutsches Patent-und Markenamt* (C-218/01) and *Henkel KGaA v Office for*

Harmonisation in the Internal Market (C-456/01) the CJEU provided guidance on section 3(1)(b) via its second question, wherein the national court asked whether, for three dimensional marks consisting of the packaging of goods which are generally packaged in trade, their distinctive character within the meaning of Article 3(1)(b) of the Directive depends on whether an average consumer who is reasonably well informed and reasonably observant and circumspect is able, even without conducting an analytical or comparative examination and without paying particular attention, to recognise the characteristic features of the three-dimensional trade mark applied for as differing from the norm or custom in the sector, so that they are capable of distinguishing the goods concerned from those of other undertakings. The court's response, at paragraphs 49-53, stated that:

"48. According to the case-law of the Court, for a mark to possess distinctive character within the meaning of Article 3(1)(b), it must serve 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 products of other undertakings (*Linde and Others*, paragraph 40).

49. It follows that a simple departure from the norm or customs of the sector is not sufficient to render inapplicable the ground for refusal given in Article 3(1)(b) of the Directive. In contrast, a trade mark which significantly departs from the norm or customs of the sector and thereby fulfils its essential origin function is not devoid of distinctive character.

50. That distinctive character of a trade mark within the meaning of Article 3(1)(b) must be assessed by reference, first, to the goods or services in respect of which registration is sought and, second, to the perception of the relevant persons, namely the consumers of the goods or services. That means the presumed expectations of an average consumer who is reasonably well informed and reasonably observant and circumspect (see, to that effect, Case C-210/96 *Gut Springenheide and Tusky*, paragraph 31, *Philips*, paragraph 63, and *Linde and Others*, paragraph 41).

51. The competent authority must therefore undertake a specific assessment of the distinctive character of the trade mark at issue, referring to the perception of the average consumer as defined in paragraph 50 of this judgement, in order to verify that it fulfils its essential function, namely that of guaranteeing the origin of the product.

52. In any event, the perception of the average consumer is not necessarily the same in the case of a three-dimensional trade mark, consisting of the packaging of a product, as it is in the case of a word or a figurative mark which consists of a sign that is independent from the appearance of the goods it denotes. Average consumers are not in the habit of making assumptions about the origin of goods based on the shape of their packaging, in the absence of any graphic or word element, and it could therefore prove more difficult to establish distinctive character in the case of such a three dimensional trade mark than in the case of a word or figurative mark (see, to that effect, *Linde and Others*, cited above, paragraph 48, and, as regards a mark consisting of a colour, Case C-104/01 *Libertel* [2003] ECR I-3793, paragraph 65).

53. In view of the foregoing considerations, the answer to the second question must be that, for three-dimensional trade marks consisting of the packaging of goods which are packaged in trade for reasons linked to the very nature of the product, their distinctive character within the meaning of Article 3(1)(b) of the Directive must be assessed by reference to the perception of the average consumer of such goods, who is reasonably well informed and reasonably observant and circumspect. Such a trade mark must enable such a consumer to distinguish the product concerned from those of other undertakings without conducting an analytical or comparative examination and without paying particular attention."

16. On the basis of the guidance presented above, it is clear that any assessment of a mark's distinctiveness pursuant to section 3(1)(b) must take into account both the nature of the goods and services claimed, and the likely perception of the relevant consumer using those goods and services. Only by considering such factors will I be able to determine the likelihood of any potential consumer perceiving the sign applied for as either a distinctive indicator of origin, or simply as an „origin-neutral' sign. I should also add at this point that the ground under section 3(1)(b) is independent from the ground under section 3(2)(b), and the fact that this sign has *not* been found to be dictated by technical function is in no way an indicator as to the manner in which the mark is likely to be perceived by the average consumer.

17. In addition to assessing consumer perception, I must also be aware that the test is one of immediacy or first impression as confirmed by the General Court ('EGC') which, in its decision on *Sykes Enterprises v OHIM* (REAL PEOPLE REAL SOLUTIONS) [2002] ECR II-5179, stated the following:

"However, a sign which fulfils functions other than that of a trade mark is only distinctive for the purposes of Article 7(1)(b) of Regulation No 40/94 if it may be perceived immediately as an indication of the commercial origin of the goods or services in question, so as to enable the relevant public to distinguish, without any possibility of confusion, the goods or services of the owner of the mark from those of a different commercial origin."

18. It is not appropriate to apply more stringent criteria or to impose stricter requirements when assessing the distinctiveness of three dimensional marks consisting of the shape of the goods (such as the one sought in the present case) than those which are applied in the case of other categories of marks (see judgments of the GC of 19 September 2001 in Case T-30/00 *Henkel KGaA v OHIM* („Tablet for washing machines') [2001] ECR II-2663, at paragraph 48 and of 7 February 2002 in Case T-88/00 *Mag Instrument Inc. v OHIM*, [2002] ECR II-0467, at paragraph 32). A three-dimensional mark which consists of the shape of the container of the product itself is not necessarily perceived by the relevant consumers in the same way as a word or figurative mark which consists of a sign which is not dependent on the appearance of the goods designated by the mark (see CJEU judgments of 29 April 2004 in Joined Cases C-456/01 and C-457/01 *Henkel KGaA v OHIM* („Tabs'), at paragraph 38; and of 12 February 2004 in Case C-218/01, referral for a preliminary ruling from the Bundespatentgericht: *Henkel KGaA*, („Perwoll'), at paragraph 52). This is because the average consumer is not in the habit of making assumptions about the origin of products based on their shape in the absence of any graphic or word element.

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19. In the present case, the mark in question consists of an angular glass bottle complete with lid, whilst the specification covers *„perfumes, toilet water; deodorants for personal use; essential oils for personal use; oils for cosmetic purposes; liquid soaps for personal use; cleansing milk for toilet purposes; creams, lotions and cosmetic products for face care; creams, lotions and cosmetic products for body care; make-up removing lotions; cosmetic products and preparations for skin care, for weight loss, for the bath, for sun-tanning; beauty masks; bath and shower gels; bath foam; hair lotions and products for hair care; shampoos.’* all in Class 3.

20. Given the goods claimed, it is reasonable to assume that the average consumer consists of the perfume-and-toiletries-buying general public. The level of consumer attention may vary a little depending on the customer; however, I consider it reasonable to assume that a prospective purchaser of the applicant's goods would apply at least a moderate level of attention and circumspection when considering whether or not to buy. This recognises the personal and sometimes expensive nature of the purchase and, as is often the case, the fact that these goods are often sold in environments which enable the consumer to sample the goods with expert assistance.

21. I agree with Mr Reddington's submission that, in this particular sector, special attention is often paid to bottle shapes, and I also agree that consumers can look for such shapes in order to determine trade origin. However, for a bottle shape to function independently as a trade mark in such a way, it must be capable of doing so *without* the aid of more obvious trade mark material such as logos, word marks and/or figurative signs and, in respect of a *prima facie* assessment of distinctiveness at least, without any reliance on use and/or established public education that the shape is used to determine trade origin.

22. Referring back to the bottle designer's sentiments presented at paragraph 11 above, I do not think that those intentions, or his/her motivation for adopting this particular bottle shape can, in any way, be determinative upon, or reflective of, consumer perception. Nonetheless, it is interesting to note the designer's reference to creating something which is intentionally 'simple' and which incorporates *inter alia* 'straight lines'. Such comments support my own view that, by virtue of the inherent simplicity it demonstrates, there is nothing about this sign which could be said to be clearly outside the norms and customs of the trade. Whilst simple three dimensional packaging shapes are not barred from registration *per se*, there should be some aspect to, or element of, the sign which enables consumers to distinguish the goods or services of the applicant from those of other undertakings.

23. At the hearing, Mr Reddington submitted that there is a lower threshold of distinctiveness for perfume bottles, arguing that this proposition is supported by practice published in the IPO Examination Guide which states:

“If the essential features of the shape are characteristic of the goods or their intended purpose, the mark will be open to objection under section 3(1)(c). In order to avoid an objection under section 3(1)(b) and/or (c) a shape mark must be sufficiently different from a shape which is:

(i) characteristic of the product;

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- (ii) the norm or customary in the sector concerned;
- (iii) a shape likely to be taken by the product concerned;

- so as to permit an average consumer, “without conducting an analytical or comparative examination or paying particular attention, to distinguish the goods concerned from those of other traders”.

In other words, the shape must not be descriptive, must stand out from the crowd and, in the case of new product developments, must not be a shape likely to be taken for the product concerned. The amount of attention that an average consumer pays to the goods and the significance he or she attaches to their shape varies from product to product. Consequently, if there is evidence, or it is well known, that shapes are a customary means of distinguishing the source of a particular category of goods, shapes which stand out to a lesser degree may be acceptable as trade marks. Examples of such goods include perfume bottles.”

24. Such a statement cannot in my opinion be taken to supplant or undermine the relevant case law to the effect that there can be no presumption of distinctiveness in relation to the registration of such bottles. The sign presented for registration must still be capable of performing the essential function of a trade mark; that is to say, in this particular example, there must be something about the particular shape which could be said to be outside the norms and customs of the trade. Even taking into consideration that, within in the perfumes and toiletries sector, shapes are a customary means of distinguishing the goods, this must still be the case. The applicant has provided no comparative evidence that the shape of this particular bottle is indeed outside the norm and customs of the trade. Mere reliance on the Examination Guide is manifestly insufficient in this regard.

25. I consider that the shape, being made of apparently dense glass, with a conventional top which appears to incorporate a spray nozzle, and employing straightforward design features such as a tapered bottom and lid, is an ordinary and unexceptional example of a perfume bottle. Cuboid-shaped bottles such as the mark are commonly used in respect of perfume and toiletry bottles, as are caps that mirror the shape of the bottle (this is a matter of which I can take judicial notice, given my own experience as an average consumer). As a result, the three-dimensional sign as applied for is not one which is sufficiently different from other shapes of bottles on the market and, in the absence of other elements such as verbal or graphic elements, one which I do *not* find to be inherently distinctive.

26.. Finally, and for the sake of completeness, I have noted the fact that in his written submissions and at the hearing, Mr Reddington made reference to the applicant’s ‘precedents’ (by which I mean prior acceptances by other non-EU registries) which had been accepted for registration. Whilst I acknowledge these submissions and precedents, they can in no way be persuasive on me (still less binding) without, for example, some indication of the nature of the regime under which they were accepted, and the underlying rationale behind such decisions.

27. Nor was I swayed by Mr Reddington’s reference at the hearing to the fact that the mark has been accepted in other EU member states. Notwithstanding the substantive harmonisation effected by Council Directive 89/104/EEC (as subsequently codified), the

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Registrar is still not bound by the decisions of other national offices, as confirmed by the CJEU in its judgement on *Henkel KGaA v Deustches Patent und Markenamt* (C-218/01), where it stated that:

“The fact that an identical trade mark has been registered in one Member State for identical goods or services may be taken into consideration by the competent authority of another Member State among all the circumstances which that authority must take into account in assessing the distinctive character of a trade mark, but it is not decisive regarding the latter’s decision to grant or refuse registration of a trade mark.

On the other hand, the fact that a trade mark has been registered in a Member State for certain goods or services can have no bearing on the examination by the competent trade mark registration authority of another Member State of the distinctive character of a similar trade mark application for registration of a similar mark for goods or services similar to those for which the first mark was registered.”

28. I have concluded that the trade mark applied for will not be identified as an indicator of trade origin without first educating the public to that effect. I therefore conclude that it is devoid of any distinctive character, and thus excluded from *prima facie* acceptance under section 3(1)(b) of the Act.

Conclusion

29. In this decision, I have considered all documents filed by the applicant, and all arguments submitted to me in relation to this application. Having done so, and for the reasons given above, the application is refused because it fails to qualify under sections 3(1)(b) of the Act.

Dated this 20th day of November 2012

Bridget Whatmough
For the Registrar
The Comptroller-General