

**TRADE MARKS ACT 1994**  
**IN THE MATTER OF APPLICATION NOS. 1559532 AND 1559533**  
**BY MALAYSIA DAIRY INDUSTRIES PTE LTD.**  
**TO REGISTER THE THREE DIMENSIONAL SHAPE OF A CONTAINER AS A**  
**TRADE MARK IN CLASSES 29 AND 32**

## TRADE MARKS ACT 1994

### IN THE MATTER OF

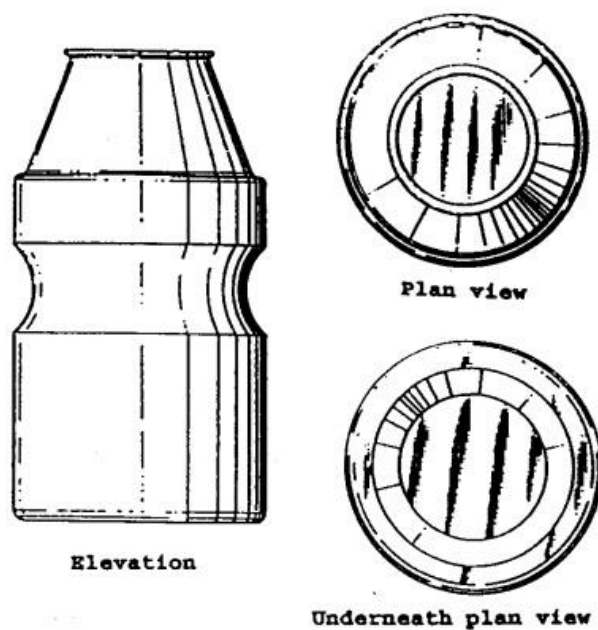
Application numbers 1559532 and 1559533

to register the three dimensional shape of a container as a  
Trade Mark in Classes 29 and 32

### DECISION

#### Background:

1. On 17 January 1994 Malaysia Dairy Industries Pte Ltd applied under the Trade Marks Act 1938 for the registration of the trade mark shown below in Classes 29 and 32. The applications were numbered 1559532 and 1559533.



2. The mark consists of the three dimensional shape of the container depicted above.

The specification of Application No 1559532 in Class 29 is as follows:

“Eggs, milk and dairy products”.

The specification of Application No 1559533 in Class 32 is as follows:

“Mineral waters, aerated waters, non-alcoholic drinks, syrups and preparations for making drinks”.

3. On 28 April 1995 the applicant gave notice under Paragraph 11 of Schedule 3 of the Trade Marks Act 1994, in respect of both applications, claiming to have the registrability of the mark determined in accordance with the provisions of the new Act. The consequences of this are that the registrability of the trade mark must be determined under the provisions of the Trade Marks Act 1994 and the application date is deemed to be 31 October 1994 (in accordance with Paragraph 11(3) of Schedule 3 to the Act).

#### **Examination of applications**

4. The Registrar subsequently examined the applications under the provisions of the 1994 Act and, as a result, raised objection under Section 3(1)(a), (b) and (c) of the Act on the grounds that the mark consisted of a representation of a container, which is not capable of distinguishing the goods from those of other traders, is devoid of any distinctive character and is a sign that other traders may legitimately wish to use.

5. Exceptionally, the further consideration of these applications was suspended pending the consideration of an appeal against the Registrar’s decision to refuse application numbers 1560017 and 1560018, standing in the name of Kabushiki Kaisha Yakult Honsha (Decision of Mr Allan James, acting for the Registrar of Trade Marks, dated 17 December 1998). These applications had been filed in respect of near identical marks and goods and had the same filing date of 31 October 1994 as the present applications. A judgement was issued confirming the Registrar’s refusal of application numbers 1560017 and 1560018, dated 8 March 2001 (Yakult Bottle Trade Mark [2001] RPC 756 Mr Justice Laddie, Shape of bottle) following which the present applications were refused.

## **The Law**

6. Sections 1(1) and 3(1)(a), (b) and (c) of the Trade Marks Act are as follows:

“Section 1. - (1)

*In this Act a “trade mark” means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.*

*A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.”*

“Section 3. - (1)

*The following shall not be registered-*

*(a) signs which do not satisfy the requirements of section 1(1),*

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

*(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,”*

## **Reasons for Decision:**

7. Following refusal of the applications under Section 37(4) of the Act I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Marks Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

8. No substantive reply or evidence of use has been filed by the applicant in response to the objections raised. I have, therefore, only the *prima facie* case to consider.

9. Having reviewed these applications I am content that the objections taken under Section 3(1)(a) & 3(1)(c) of the Act may be waived, but the objection under Section 3(1)(b) is to be maintained as the basis for the refusal of the applications for the reasons set out below.

10. Section 1(1) of the Act makes it clear that signs consisting of the shape of packaging for goods are capable of being registered as trade marks. I have therefore concluded that the objection raised against this application under Section 3(1)(a) of the Act should be waived.

11. Whilst it appears that the indentation in the bottle device may be there to provide users with a convenient means of gripping the bottle, this does not result in a trade mark which consists exclusively of features “...which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of the goods or services”. I am content that the objection under Section 3(1)(c) of the Act should therefore be waived accordingly.

12. In deciding that the objection under Section 3(1)(b) should be maintained I have noted that it is established that a sign may qualify as a trade mark under Section 1(1) of the Act yet be debarred from *prima facie* registration by Sections 3(1)(b)-(d) of the Act. In the AD2000 trade mark case ([1997] RPC 168 @ 174 lines 4-8), Geoffrey Hobbs QC, sitting as the Lord Chancellor’s Appointed Person, described the relationship between the sections in the following terms:

*“The proviso to section 3(1) indicates that the essence of the objection to registration under Section 3(1)(b) is immaturity: the sign in question is not incapable of distinguishing the goods or services of one undertaking from those of other undertakings, but it is not distinctive by nature and has not become distinctive by nurture.”*

13. In the TREAT trade mark case ([1996] RPC 281 @ 306) Jacob J. asked rhetorically:

*“What does devoid of any distinctive character mean?”*

To which he suggested the answer was:

*“I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark?”*

14. It appears to me that the average consumer’s first impression of the shape of the applicant’s container is likely to be that it is an ordinary shaped bottle with an indentation, possibly for use as a finger grip. The shape of the applicant’s bottle is therefore unlikely to be regarded as denoting trade origin until the public have been educated to such a secondary meaning. In reaching this view, I am informed by the aforementioned decision of Mr Allan James, acting for the Registrar of Trade Marks in the case of application numbers 1560017 and 1560018, standing in the name of Kabushiki Kaisha Yakult Honsha, dated 17 December 1998, and subsequent appeal decision of Mr Justice Laddie (Yakult Bottle Trade Mark [2001] RPC 756 Mr Justice Laddie, Shape of bottle). Mr Justice Laddie stated when considering the *prima facie* acceptability of the marks under Section 3(1)(b):

*“10. ....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 customer. 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.*

*11. 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.”*

**Conclusion:**

15. Taking the above guidance in to consideration and my own impression of the average consumers response to the mark in use, I conclude that the shape in question is devoid of any distinctive character and excluded from registration by Section 3(1)(b) of the Act.

16. The application is therefore refused under Section 37(4) of the Act because it is debarred from registration by Section 3(1)(b) of the Act.

**Dated this 25 Day of July 2002**

**Martin Layton**

**For the Registrar**

**The Comptroller General**