

O-106-03

TRADE MARKS ACT 1994

TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996

IN THE MATTER OF :

THE REQUEST BY KRAFT JACOBS SUCHARD SA

FOR PROTECTION IN THE UNITED KINGDOM

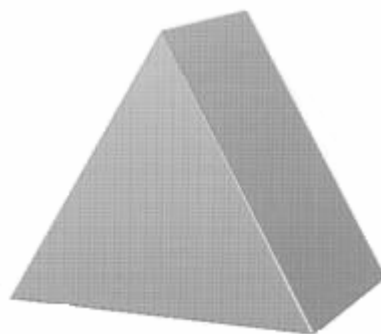
OF INTERNATIONAL TRADE MARK No. 711078

IN CLASS 30

DECISION

1. On 22nd April 1999 Kraft Jacobs Suchard SA (“*the Applicant*”) sought protection in the United Kingdom under the provisions of the Madrid Protocol and the Trade Marks (International Registration) Order 1996 for the trade mark recorded in International Registration No. 711078.

2. The mark was identified in the relevant WIPO Notification as a three-dimensional mark. It was graphically represented in the following manner:



Protection was requested in respect of “*chocolate and products containing chocolate*” in Class 30.

3. The Notification was ambiguous as to whether the mark consisted of the shape of the specified goods and/or the shape of their packaging. This caused uncertainty as to precisely what the Registrar was supposed to be examining for distinctiveness during the examination phase in the United Kingdom.

4. In order to defuse the uncertainty it has been necessary to treat the request as a twofold request for protection in respect of: (i) the shape of the specified goods; and (ii) the shape of their packaging. This pluralises the request for protection by covering packaging of the relevant shape for chocolate confectionery of any desired shape or assortment of shapes. In that state of affairs it is appropriate, in my view, to consider the request for protection on the basis that the mark in question must be distinctive in both of the envisaged forms of presentation in order to be acceptable under the Trade Marks (International Registration) Order 1996.

5. Although the relevant graphic representation is shaded, the Applicant does not claim colour as an element of the mark. Following the approach adopted by the Court of First Instance in paragraph 55 of its Judgments delivered in Cases T-128/00 and T-129/00 Procter & Gamble Company v. OHIM on 19th September 2001, I think it is necessary to proceed on the basis that no particular shade of any particular colour is said to be necessary for the sign in question to possess a distinctive character.

6. The Applicant’s trade mark attorney made representations in support of the request for protection at a hearing which took place before Mr. A.J. Pike acting on behalf of the

Registrar. I understand that the hearing officer was invited to consider the results of a consumer survey conducted in relation to a plain white cardboard box of the shape depicted above. I gather from what I have been told that he declined the invitation on the basis that the mark in question related to the shape of the specified goods, not the shape of their packaging. The Applicant tendered no other evidence in support of its request for protection in the United Kingdom.

7. The request for protection was rejected for the reasons subsequently given by the hearing officer in a written decision issued on 30th August 2002. He concluded that protection should be denied by reference to Section 3(1)(b) of the 1994 Act on the following grounds:

- “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 a 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.”

8. In reaching that conclusion he took account of the guidance contained in paragraphs 48 and 49 of the Judgment of the Court of First Instance in Case T-30/00 Henkel KGaA v. OHIM [2002] ETMR 25, p.278 to the effect that the criteria for assessing the distinctive character of a mark consisting of a representation of a product are no different from those applicable to other categories of trade marks, but due weight must be given to 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.

9. On 30th September 2002 the Applicant gave notice of appeal to an Appointed Person under Section 76 of the Act contending, in substance, that the hearing officer had erred:

- (1) by drawing upon his own experience in reaching the conclusion that he did;
- (2) by giving no or insufficient weight to the similarity between the triangularity of the mark in question and the triangularity of the Applicant’s TOBLERONE chocolate confectionery and its packaging;
- (3) by not regarding the triangularity of the relevant mark as sufficient to imbue it with a distinctive character in any event.

In subsequent correspondence the Applicant sought permission to rely on the survey referred to in paragraph 5 above at the hearing of the appeal.

10. There is no substance in the first of the Applicant's criticisms. General knowledge and experience of the manner and circumstances in which consumer goods are normally bought and sold can and should be brought to bear upon the determination of trade mark issues such as those arising in the present case. Although it can be "a task of some nicety" to decide how far a court or tribunal may act upon its own knowledge (see Phipson on Evidence 15th Edn (2000) paras 2-08 to 2-10) the observations I have quoted in paragraph 6 above do not on any view exceed the latitude that must necessarily be allowed to the Registrar for the purpose of enabling her to apply the "average consumer" test for distinctiveness prescribed by Community law.

11. The second of the Applicant's criticisms appears, upon analysis, to be directed to the consequences of its own failure to tender any evidence (other than the consumer survey I have mentioned) in support of the case of "distinctiveness by proxy" it seeks to substantiate on appeal.

12. I was told by Counsel for the Applicant that a conscious decision was taken to raise no complaint in the grounds of appeal in respect of the hearing officer's unwillingness to consider the consumer survey. That would normally have led me to conclude that the Applicant should not be permitted to rely on the survey in support of its objections to the hearing officer's decision. However, it emerged at the hearing before me that the survey might only have been left out of account as a result of the hearing officer's initially unyielding reluctance to accept that the relevant mark could take the form of packaging for

goods of the kind specified. In order to remove any lingering doubts as to the correctness of the hearing officer's approach to the survey, I permitted the Applicant to rely on it before me.

13. The need for circumspection in the assessment of questionnaire survey evidence is well-understood. The concern is that to a greater or lesser degree: *“Interviews and questionnaires intrude as a foreign element into the social setting they would describe, they create as well as measure attitudes, they elicit atypical roles and responses, they are limited to those who are accessible and will co-operate and the responses obtained are produced in part by dimensions of individual differences irrelevant to the topic at hand”* (Webb, Campbell, Schwartz and Sechrest Unobtrusive Measures (Revised Edition, 2000) Sage Publications Inc.). There is, accordingly, a practical requirement for information relating to the structure, method and results of questionnaire surveys to be full enough to enable the strengths and weaknesses of the research work to be evaluated: Imperial Group Plc v Philip Morris Ltd [1984] RPC 293 at 302, 303 (Whitford J.).

14. The material tendered on behalf of the Applicant in the present case consisted simply of a Report prepared by BMRB International Ltd in April 1999. The Report presented the results of administering a questionnaire to 2036 people over the age of 15 in the course of BMRB's weekly Access Face-to-Face omnibus survey between 15th and 21st April 1999. The interviews were conducted in-home, using a computer assisted personal interviewing system. The results of the research were presented in tabular form.

15. In an “omnibus survey” interviewers ask interviewees various different questions on behalf of a number of different clients. In Bach and Bach Flower Remedies Trade Marks [1999] RPC 1 at 20, 21 Neuberger J. accepted expert evidence to the effect that while

omnibus surveys are suitable for commercial purposes, they are generally considered to be inappropriate for the purposes of legal proceedings:

“It is difficult to weigh the value of an answer recorded by an interviewer in circumstances such as these. One cannot assess the context, either in the physical sense or in the sense of knowing precisely what was said before the interview started or precisely what was said by the interviewee (and, possibly, the interviewer) before the crucial question is asked. Nor does one know whether the interviewee asked for clarification of the vital questions and, indeed, whether the interviewer recorded verbatim the answers given.”

Issues of this kind remain unresolved in relation to the BMRB omnibus survey I am now considering.

16. The questions administered on behalf of the Applicant included the following:

SHOW CARDBOARD BOX

Q.1. Does this remind you of any chocolate confectionery product?

Yes
Perhaps
No
Don't Know

SHOW LIST A

Q.2. Do you agree with one of the following statements?

It reminds me of a particular chocolate product
It reminds me of a number of different chocolate products
Other (TYPE IN)
Don't know

SHOW ORANGE CARD A

Q.3. Which, if any, of these products does it remind you of?

Roses
Quality Street
Terry's Chocolate Orange
Maltesers
Ferrero Rocher

Toblerone
Toblerone Praline
Cadbury Dairy Milk
Galaxy
Mars Bar
Kit Kat
Other (TYPE IN)
Cannot remember
Don't know.

SHOW LIST C

Q.4. How often do you eat chocolate and/or buy chocolate for yourself and other people?

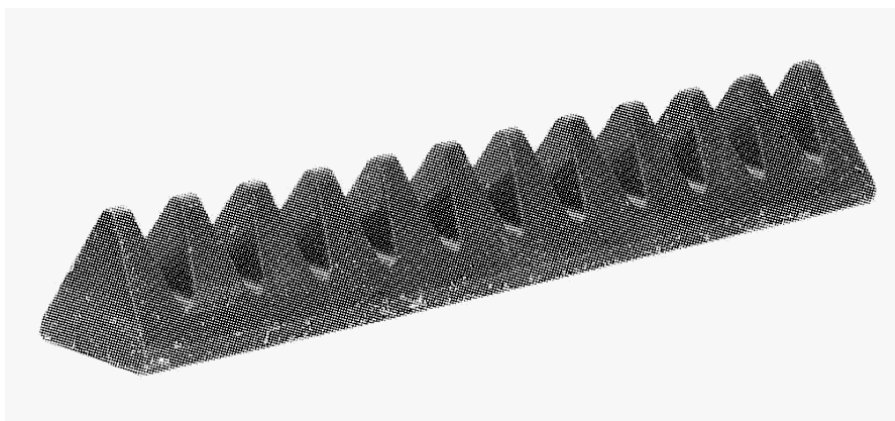
Often
Sometimes
Rarely
Never
Don't know.

17. Under the control of these questions, people with relatively little knowledge of chocolate confectionery products indicated that they were “reminded” of TOBLERONE: 576 interviewees are reported as saying “rarely” or “never” in answer to Question 4; 335 of them indicated that they were “reminded” of TOBLERONE confectionery in answer to Question 3. People with relatively good knowledge of chocolate confectionery products also indicated that they were not (or not solely) “reminded” of TOBLERONE: 1454 interviewees are reported as saying “often” or “sometimes” in answer to Question 4; 396 of them gave answers which did not mention TOBLERONE confectionery in response to Question 3. A total of 1393 out of the 2036 people interviewed mentioned TOBLERONE confectionery in response to Question 3.

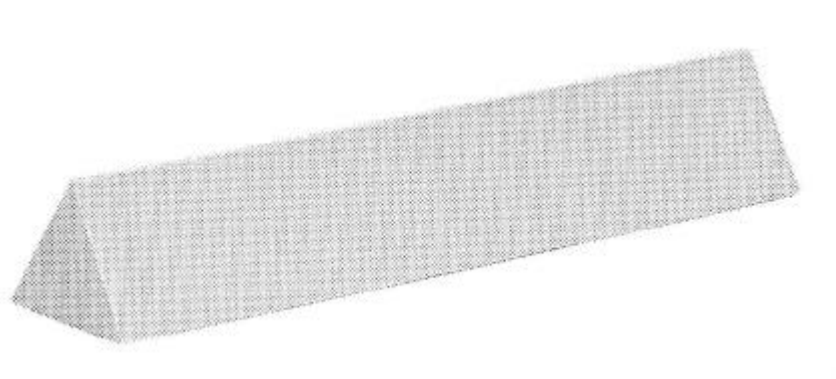
18. In order to come to any conclusion about the significance of the responses obtained by means of the survey it would be necessary to form a view as to what the interviewees actually thought they were being asked to do when directed by the survey questions to consider

(before and after being prompted by Card A) whether the plain white cardboard box “reminded” them of any chocolate confectionery product(s). However, the concept of something “reminding” someone of something else, particularly in the context of questions prompting them to be “reminded” of it, is so nebulous that it seems to me to elude any attempt to be specific as to what the interviewees might have been intending to convey to the interviewers when answering the prescribed questions in the way that they did. I certainly do not think it can be assumed or inferred that they were purporting to identify the shape of the cardboard box as an indication of trade origin.

19. For these reasons I consider that the BMRB survey provides no reliable support for the Applicant’s case based on “distinctiveness by proxy”. The request for protection on that basis rests on the proposition that chocolate confectionery and packaging for chocolate confectionery which conforms to the shape depicted above would, for that reason, be taken to come directly or indirectly from the undertaking responsible for marketing TOBLERONE chocolate confectionery of the following shape:



in packaging conforming to the outline shape of that confectionery:



In other words, the Applicant maintains that *TOBLERONE* = \triangle (*in cross-section*) and \triangle (*in cross-section*) = *TOBLERONE* irrespective of the actual proportions of the

triangular shape applied to the relevant confectionery or its packaging and irrespective of whether the relevant confectionery is presented either in elongated form or in segmented form as depicted in this paragraph.

20. That is a bold proposition. It postulates that, for lack of any material difference between them, the shape now put forward for protection should be assimilated to the generally well-known shape of the TOBLERONE confectionery and packaging identified in the preceding paragraph. However, the overall shapes are clearly different. There is no evidence to substantiate the proposition that consumers would assimilate them in the way that the Applicant suggests and I think they are different to a degree which dictates that they should not be assimilated for the purposes of the assessment required by Section 3(1)(b). I therefore reject the second of the criticisms levelled at the hearing officer's decision.

21. The Applicant's third criticism goes to the issue of distinctiveness under Section 3(1)(b) of the Act. The required approach has recently been summarised by the European

Court of Justice in paragraphs 37 to 42 and 46 to 49 of its Judgment in Joined Cases C-53/01 to C-55/01 Linde AG, Winward Industries Inc and Rado Uhren AG (8th April 2003) in the following terms:

- “37. It must first of all be observed 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 or services of one undertaking from those of other undertakings.
38. It follows that a three-dimensional shape of goods sign may in principle constitute a trade mark provided those two conditions are met (Case C-299/99 *Philips* [2002] ECR I-5475, paragraph 73).
39. Next, pursuant to the rule in 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).
42. Finally, the Court observed in paragraph 48 of its judgment in *Philips* that the criteria for assessing the distinctiveness of three-dimensional shape of goods marks are no different from those to be applied to other categories of trade mark. Article 3(1)(b) of the

Directive makes no distinction between different categories of trade mark for the purposes of assessing their distinctiveness.

.....

46. With reference to Article 3(1)(b) of the Directive, it must be observed that neither the scheme of the Directive nor the wording of that provision indicate that stricter criteria than those used for other categories of trade mark ought to be applied when assessing the distinctiveness of a three-dimensional shape of goods mark.
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 thus distinguishing it from those of other undertakings.
48. It is still true, as the Austrian and United Kingdom Governments and the Commission rightly argue, that in view of the test set out in paragraphs 40 and 41 of this judgment it may in practice be more difficult to establish distinctiveness in relation to a shape of goods mark than a word or figurative trade mark. But whilst that may be why such a mark is refused registration, it does not mean that it cannot acquire distinctive character following the use that has been made of it and thus be registered as a trade mark under Article 3(3) of the Directive.
49. Having regard to the foregoing considerations, the reply to the first question must be that, when assessing the distinctiveness of a three-dimensional shape of goods trade mark for the purposes of Article 3(1)(b) of the Directive, a stricter test than that used for other types of trade mark must not be applied.”

It is apparent that the approach adopted by the hearing officer in the present case accords with the approach envisaged in this judgment of the ECJ.

22. The Applicant raised no claim to distinctiveness through use of the sign in question prior to the date of the request for protection. The fate of the request for protection depended essentially upon the ordinariness or otherwise of the relevant sign in the context of the trade in chocolate and products containing chocolate. The more unusual the sign, the more likely it was to be perceived and remembered as an indication of trade origin; the less unusual the sign, the less likely that was to be the case. This was a matter upon which the Applicant could, if it wished, have filed evidence. It did not do so. The assessment of distinctiveness therefore had to be made on the basis of general knowledge as to the usages of the trade in the relevant area of commerce.

23. Chocolate confectionery and packaging for chocolate confectionery is, as the hearing officer rightly observed, presented to consumers in a wide variety of shapes. A wide variety of colouring is applied to such packaging. Shape and colour will often contribute to the identification of confectionery products in terms of their trade origin. However, shape (or a combination of shape and colour) may have the capacity to play a supporting role in the identification of trade origin without also having the capacity (necessary for registration) to stand alone as a non-verbal indication of trade origin.

24. I am willing to accept (without deciding) that the sign I am now considering is different to a degree which renders it visually distinguishable from other such signs in use in the relevant market. The question to be determined is whether it is *distinctively* different so as to be likely to be perceived and remembered by the average consumer as a non-verbal trade mark. I am unwilling to answer that question in favour of the Applicant because I consider that the sign, viewed either as a representation of the shape of the specified goods or their packaging, is insufficiently arresting to impact upon people in that way in a sector of the

market where reasonably well-informed and reasonably observant and circumspect consumers would appreciate, at a general level, that variations of shape or of shape and colour in combination might or might not be consistent with the goods thus differentiated coming either from economically-linked or from economically-independent undertakings.

25. In the result the appeal is dismissed. There being no reason to depart from the usual practice in relation to appeals of this kind, it is dismissed with no order as to costs.

Geoffrey Hobbs QC

11th April 2003

Tim Ludbrook instructed by Messrs Haseltine Lake appeared as Counsel on behalf of the Applicant.

Allan James, Principal Hearing Officer, appeared on behalf of the Registrar.