

O-375-04

TRADE MARKS ACT 1994

TRADE MARK APPLICATION NUMBERS 2303706 & 2309201

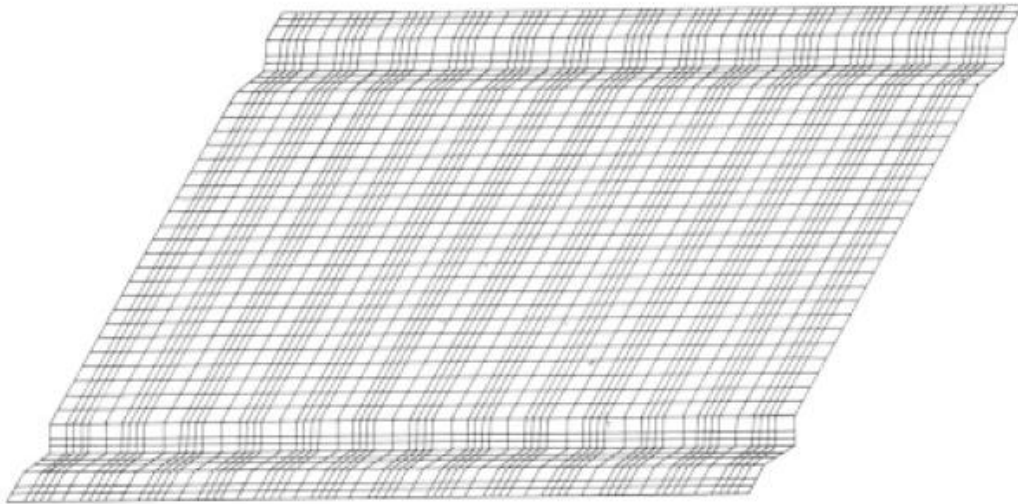
BY TINSLEY WIRE LIMITED

TO REGISTER THE SHAPES OF TWO FENCING PANELS

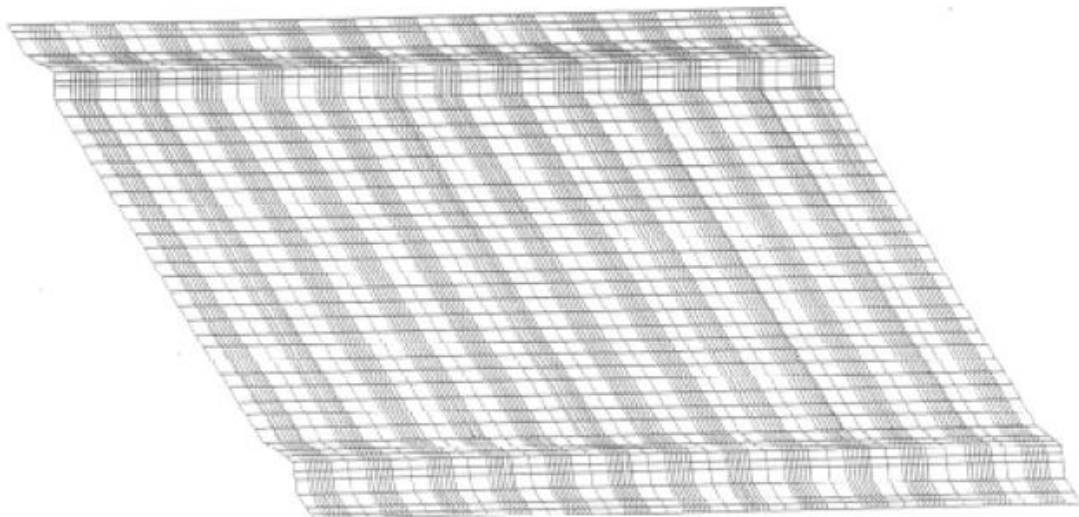
AS TRADE MARKS FOR WIRE FENCING IN CLASS 6

Background

1. On the 26 June 2002, Tinsley Wire Limited applied to register the trade mark shown below in Class 6 of the Register in respect of wire fencing.



2. The trade mark consists of the shape and configuration of a fencing panel but it is not described on the application form as being three dimensional. The number given to this application is 2303706. I will call this the 706 application. On 23 August of the same year the applicant made a further application to register the trade mark shown below in respect of the same goods.



3. This trade mark is self evidently also the shape and configuration of a fencing panel but this trade mark is described as being three dimensional. Apart from the number of dimensions, there is a further difference from the 706 application which is not particularly clear from the above representations. This is that the 706 mark has vertical wires arranged in a close group of four, then a single wire, and then another group of four and so on. The groups of vertical wires in the later mark comprise

seven wires. This application was given the number 2309201. I will call it the 201 application.

4. This is not the first application to register the 201 mark. The current applicant's holding company, Twil Limited, originally applied to register the mark in May 1997. The Registrar initially accepted that application, but following opposition it was eventually refused as being contrary to Section 3(1)(b) of the Act. The trade mark was held to be devoid of any distinctive character and had not been shown to have acquired such a character as a result of the use made of it prior to the date of the application for registration. There was no appeal against that decision. The applicant is, however, entitled to have the matter determined again at the dates of the current applications and on the basis of the evidence it has now filed.

The Hearing

5. Both the current applications met with objections from the Examiner under Section 3(1)(b) & (c) of the Act. The applicant filed evidence which was intended to show that the marks had acquired a distinctive character through use. The Examiner maintained the objections in the face of that evidence and the matter came to be heard on 27 July 2004, when the applicant was represented by Mr Roger Wyand Q.C., instructed by Hulse & Co.

6. At my invitation the applicant filed further evidence clarifying certain points of uncertainty which I had identified at the hearing. However, this did not persuade me to waive the objections and I subsequently refused the application on 29 September. These are my reasons for doing so.

The Prima Facie Case for Registration

7. Section 3(1)(b) prohibits the registration of trade marks which are "devoid of any distinctive character." Section 3(1)(c) prohibits the registration of trade marks which consist exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods. Both provisions are subject to the proviso to Section 3(1) which states that the registration of a trade mark shall not be refused by virtue of these provisions where the trade mark has acquired a distinctive character through use prior to the date of the application for registration.

8. Before me, Mr Wyand accepted that, in the light of the case law of the European Court of Justice (ECJ) with regard to the interpretation of those provisions of Directive 89/104 from which Section 3(1)(b) and (c) of the Act are derived, he faced some difficulty in making out the case for registration *prima facie*. He had in mind two cases involving Henkel KGaA. These are Cases C-218/01 and C-456/01 P. The former is a preliminary reference from a German court seeking the court's guidance on the applicability of Article 3(1)(b) and (c) of the Directive (which correspond to Section 3(1)(b) and (c) of the Act) to shapes consisting of the packaging of goods. 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.

9. In the later case the court applied similar reasoning in upholding a judgement of the Court of First Instance refusing the registration of trade marks consisting exclusively of the shape and appearance of certain dishwasher tablets.

10. Mr Wyand accepted that the net effect of these cases was that a shape of goods trade mark was seldom going to succeed on the basis of its inherent distinctiveness. He therefore concentrated instead on the case based upon acquired distinctiveness.

11. Given that the correctness of the Examiner's view as to the *prima facie* registrability of the shapes in question has not been seriously challenged, I do not believe that I need to say much more about the *prima facie* applicability of Section 3(1)(b) & (c) to the shapes in question. The requirement to avoid the prohibition under Section 3(1)(b) is that the shape must enable the relevant public to distinguish the product concerned as originating from one undertaking and to distinguish it from the products of other undertakings without such consumers having to undertake an analytical or comparative examination of the shape, and without them having to pay particular attention. The shape must therefore be more than a simple departure from the norms and customs of the sector. It must represent a significant departure from such norms. Further, in assessing the extent to which the shape departs from such norms and the impact this is likely to have on the relevant public, one is required to bear in mind that average consumers are not in the habit of making assumptions about the origin of goods based upon their shape in the absence of any graphic or word elements.

12. The ECJ provided guidance as to the correct approach to the assessment of the relevant public in the case of *Bjornekulla Fruktindustrier AB v Procordia Food AB*, Case C-371/02. The court said (at paragraphs 20-25 of the judgement) that:

“The essential function of the trade mark is to guarantee the identity of the origin of the marked goods or service to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or service from others which have another origin (see, inter alia, Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 28, and Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 22). For the trade mark to be able to fulfil its essential role in the system of undistorted competition which the EC Treaty seeks to establish, it must offer a guarantee that all the goods or services bearing it have been produced under the control of a single undertaking which is responsible for their quality (*Canon*, paragraph 28).

That essential function of trade marks has been incorporated by the Community legislature into Article 2 of the Directive, which provides that signs which are capable of being represented graphically may only constitute a trade mark if they are capable of distinguishing the goods or services of one undertaking from those of other undertakings (*Merz & Krell*, paragraph 23).

That condition is given effect to in, inter alia, Articles 3 and 12 of the Directive. While Article 3 specifies the circumstances in which a trade mark is incapable, *ab initio*, of fulfilling its function as an indication of origin, Article 12(2)(a) addresses the situation where the trade mark is no longer capable of fulfilling that function.

If the function of the trade mark as an indication of origin is of primary importance to the consumer or end user, it is also relevant to intermediaries

who deal with the product commercially. As with consumers or end users, it will tend to influence their conduct in the market.

In general, the perception of consumers or end users will play a decisive role. The whole aim of the commercialisation process is the purchase of the product by those persons and the role of the intermediary consists as much in detecting and anticipating the demand for that product as in increasing or directing it.

Accordingly, the relevant classes of persons comprise principally consumers and end users. However, depending on the features of the product market concerned, the influence of intermediaries on decisions to purchase, and thus their perception of the trade mark, must also be taken into consideration.”

13. For present purposes, I am therefore prepared to assume that the relevant public for wire fencing consists of the property owning general public, businesses, and public bodies, and those who may influence purchasing decisions, such as architects and designers.

14. I would not have thought that such consumers would be in the habit of making assumptions about the origin of fencing based on its shape, and there is nothing in the evidence the applicant has filed (see below) which changes my view about that. The shapes applied for create a visual impression which is reminiscent of palisade fencing. Creating a similar effect with wire fences may well have created a departure from the norm for that type of fence, but it does not create a departure from the norms and customs of the sector such as to cause average consumers of the sort in question to look upon the shape of the fence as a means of designating the origin of the goods, without being educated to this perception. I therefore find that the marks in question are *prima facie* debarred from registration by Section 3(1)(b) of the Act. As it is sufficient for one ground for refusal to apply there is no need for me to consider separately whether Section 3(1)(c) also applies. Mr Wyand correctly decided to focus on the case for registration based upon distinctiveness acquired through use.

The Case for Registration based upon Acquired Distinctiveness

15. In the *Windsurfing Chiemsee* case [1999] ETMR 585, the ECJ set out the test to be applied in order to determine whether a trade mark has acquired a distinctive character under Article 3(3) of the Directive (Section 3(1) proviso). It held that the national courts may take into account evidence from a variety of sources, but a finding that the mark has come to denote the goods as coming from a particular undertaking must necessarily mean that the provisions of Article 3(3) are met. The Court held that:

“In determining whether a mark has acquired distinctive character following the use made of it, the competent authority must make an overall assessment of the evidence that the mark has come to identify the product concerned as originating from a particular undertaking, and thus to distinguish that product from goods of other undertakings.” (paragraph 49)

“In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into

account: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations@ (paragraph 51).

AIf, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify the goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied. However, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general abstract data such as predetermined percentages.@ (paragraph 52).

The Evidence

16. The applicant's evidence includes Statutory Declarations by Michael Terrence Pollard (2), who is the General Manager of the applicant, Tinsley Wire Limited, Wendy Anne Baker, who is the Chief Executive of The Fencing Contractors Association, and Robert Henry Jennings, who is The Chief Executive of European Fencing Industry Association. The evidence also includes witness statements by David Houghton, who is a Trade Mark Attorney working for the firm of agents responsible for these applications, John Allen, who is a qualified metallurgist working for Sheffield Hallam University, and Mr Pollard. The Statutory Declarations were made between 1998 and 2000 and were originally filed in support of the earlier 1997 application to register the 201 mark. The evidence has been transferred to these applications at the applicant's request. The witness statements were made in December 2003 and September 2004, and represent additional evidence.

17. Mr Pollard's Statutory Declarations provide evidence about the applicant's use of fencing panels with configurations corresponding to the 201 mark, and provides information about the panels used by the applicant's competitors. Ms Baker and Mr Jennings testify as to the correctness of the answers they gave to a questionnaire that was sent to them in 1998. They indicated at that time that they regarded the shape of the applicant's 201 mark as having a unique visual appearance and that they were aware that the applicant's holding company (Twil Limited – the original applicant) was the manufacturer of such fences. Mr Allen gives expert evidence about the strength of the fencing which is the subject of the 201 application as compared to some other fences. Mr Allen's evidence appears to be intended to meet an objection that the marks consist exclusively of a shape of goods necessary to achieve a technical result and , as such, is absolutely excluded from registration by Section 3(2) of the Act. An objection of this sort was raised (but not determined) in the opposition to the earlier application to register the 201 mark, but the Registrar has not taken such an objection to these applications. Consequently, I need say no more about Mr Allen's evidence. Mr Houghton introduces as evidence the result of a public survey carried out by Hulse & Co in March 2003. The survey was intended to test public recognition of the 201 mark and to establish whether those surveyed were aware of the

undertaking responsible for such fencing. The applicant relies heavily on this evidence. Mr Pollard's witness statement provides certain information I requested at the hearing about the way the survey was conducted and the market circumstances under which users make their choice between competing fencing products.

18. According to Mr Pollard, the position in October 1999 was that the Bekaert Group, of which the applicant forms a part, were the market leaders in relation to wire and wire products in the UK. Wire fencing falls into three categories; (i) Chain link and welded mesh fencing ordinarily sold in rolls, (ii) rigid panel fencing for general boundary security, and (iii) specialist high security fencing for prisons and other secure establishments. The panels the subject of these applications would fall into category (ii). In October 1999, the position was that panels corresponding to the 201 mark accounted for 40% of the market for this category of wire fencing. The applicant produces a number of other types of wire fencing panels which compete in the same category of fencing, and these collectively account for a further 10% of that section of the market. Competitors products account for the other 50%. Numerous examples of competitors products are in evidence.

19. Sales of the 201 mark amounted to £2m per annum by 1999. Panels of this design were first sold in 1984, some 18 years prior to the dates of the current applications. By 1992, the applicant was selling 570 tonnes of wire fencing per annum which corresponds to the 201 mark. The amount of such fencing sold roughly doubled between that date and 1999. I do not have direct evidence as to the position after 1999, but I was advised at the hearing that the market may have slipped a bit since then. I do not know whether this means that the overall market for this type of fencing has reduced or merely the applicant's share of it. I gave the applicant the opportunity to file further evidence on this point but, although further evidence was filed, it did not cover this matter.

20. The evidence of the fencing panels offered by the applicant's competitors in category (ii) fencing panels reveal that the V-shaped protrusions towards the bottom and top of the applicant's fence panels are for re-enforcement purposes and are common to the trade. In this category of wire fencing, the majority of comparable fence panels appear to be constructed of evenly spaced vertical and horizontal wires. There is a significant variation in the appearance of these panels generally determined by the size of the gap between the wires. The evidence suggests that chain link fencing is also used for general boundary security. This has the appearance of a diagonal pattern resembling that of a fishing net. Expanded steel fences also appear to be used for this purpose, which generally have a similar appearance to chain link, but can be given different appearances (see, Exhibit MTP2 to Mr Pollard's declaration of 10 December 1999). Traditional palisade fences composed of metal bars or railings are, of course, also used for boundary security. All three types of fencing appears to compete with rigid panel wire boundary fencing. The applicant may therefore have been viewing the market a little narrowly in asserting that it has 40% of the relevant market.

21. Welded mesh fencing sold in rolls (and generally for other purposes, such as the garden) appears to come in a wider range of designs (see, for example, exhibit MTP15 to the declaration referred to above).

22. There is no evidence that the applicant's competitors rely upon the shape of their fencing to distinguish its commercial source.

23. Mr Pollard gave evidence (again in 1999) that the group of companies of which the applicant forms a part expends £200k per annum in advertising its products. He says that it is not possible to isolate the amount spent in promoting the 201 mark but that it features "prominently" in this expenditure. Exhibit MTP1 consists of a compendium of brochures showing Bekaert Group's fencing product range from 1999. It shows that the Group at that time produced at least 12 different types of fencing, most of these fences differed in appearance from one to another. The fencing which corresponds to the 201 mark is identified by the brand name "Sentinel Paladin." The brochure promoting this fence describes it as being:

"...the most popular Weldmesh fence panel due to its innovative and unique appearance and is regularly specified where an aesthetically pleasing appearance is essential. The panels feature pressed 'V' forms containing 4mm diameter wires for the full panel width for strength, rigidity and sophisticated good looks whilst providing a cost-effective anti-intruder barrier."

24. The decorative purpose of the design is again mentioned in the section of the brochure where the principal features are listed. The first such feature states:

"A sophisticated decorative type mesh pattern, with integral horizontal 'V' forms to further enhance the appearance and performance."

25. The second bullet point in the "principal features" section of the brochure describes the 201 mark as a:

"Strong but lightweight construction having an improved performance against 'cut-through' and climbing, whilst providing clear visibility beyond the fence line."

26. I take the reference to 'clear visibility' to be a reference to the design feature whereby most of the vertical wires are grouped together in groups of seven. The result of this is to create a relatively large gap between the groups of vertical wires, interrupted only by a single vertical wire. This feature provides someone looking at the fence from one side to have a particularly clear view of whatever is on the other side.

27. The 201 mark has therefore been promoted on the basis of its functional and aesthetic appeal. There is nothing in the brochure which identifies one of the purposes of the design in question as being a means to distinguish the goods of a particular undertaking. The way in which the 201 mark is depicted in the brochure promoting the Sentinel Paladin fencing system is not materially different to the ways in which the Bekaert Group's other fences are shown in the individual brochures in which they are promoted. In each case there is a photographic representation of the fencing system shown in a typical installation, together with a line drawing of the fence in question, usually within a red rectangle.

28. I turn now to consider the effect of the use that has been shown of the 201 mark. First there is the evidence of Ms Baker and Mr Jennings. The evidence of trade association witnesses can be given weight. These witnesses confirm that the design of the 201 mark is unique in the marketplace (although Mr Jennings notes that a company called ‘Lippi’ make a similar one) but their evidence does not assist me in assessing what the significance of that uniqueness of shape would have upon the relevant public for the goods in question. In the case of a product whose purpose is semi-decorative, to notice that a design is different to others does not necessarily involve looking upon the shape as an indication of the commercial source of the goods.

29. The applicant relies primarily upon its public survey evidence to show that the shape is regarded as an indication of origin by the relevant public. The applicant’s Trade Mark Attorney wrote a letter to 131 people on a list supplied to him by the applicant. The letter stated:

“We have been given your name as a purchaser/specifier of welded wire security fencing. We are currently carrying out a survey for a client and would appreciate it if you could spend a few moments completing the enclosed form and sending it back to us.”

30. Despite the description of the recipient in the covering letter, it appears that the letter was in fact sent to 78 end users, 41 fencing contractors, 11 merchants who sold fencing products, and a member of the trade press. To further complicate matters, Mr Pollard’s witness statement uses the term “end users” to cover both “ultimate customers” and advisors to such customers, such as an architect or designer. Mr Pollard states that he regards both groups as together constituting the relevant buying public. This would be consistent with the case law of the Court of Justice cited at paragraph 12 above if such intermediaries tend to influence purchasing decisions.

31. Mr Pollard’s witness statement goes on to state that:

“In my experience, it is the views and opinions of an ultimate customer that results in a decision to fit a particular security fence panel at a particular location. An architect or designer might recommend a selection of fence panels with a recommendation as to which one is erected where, and it is frequently so that an ultimate customer will choose one panel type for one location and a different panel type for a different location. The architect or designer will engage a fencing contractor and instruct which fence panels are to be installed, leaving the fencing contractor to obtain those panels from a merchant as [the applicant] do not ordinarily sell our products direct.”

32. It is clear from this description of the selection process that merchants and fencing contractors have no influence on the decision to purchase one fence as opposed to another. They are not therefore members of the relevant public. Although at first blush this evidence may appear to suggest that the ability of the architect or designer to influence a purchasing decision of this sort is also somewhat marginal, I believe that, on closer analysis, this evidence is consistent with the view that such intermediaries do have some influence on the purchasing decision. They are therefore a part of the relevant public. However, it is clear from Mr Pollard’s evidence that it is

the ultimate customer who has the final say and they must therefore be regarded as being the relevant consumer. As the ECJ has made clear (see paragraph 12 above) the relevant public consists principally of consumers and end users. And it is their perception of the mark which is likely to be decisive.

33. This is highly significant when it comes to assessing the potential value of the survey evidence. 66 completed responses were received. Of these, 10 were from fencing merchants. They are plainly not the relevant public. 24 were from fencing contractors (19 of which were from firms approved to fit the applicant's products). They are not members of the relevant public either. 32 responses came from what the applicant calls end users. It is not clear how many of these were "ultimate customers" and how many were advisors, such as architects and designers. I suspect that the majority of these 32 fall into the latter category. I say this because, earlier in his witness statement Mr Pollard states that:

"The route of our products to the market place is such that other than in a small percentage of instances all fencing contractors and end users would contact merchants for the supply of fence panels, and we do not have customer lists reflecting those end users who have used or have recommended the use of the fence panel of the [the 201 mark] or indeed any of our other fencing panels and systems. We do have a number of full time advisors who if approached will advise end users as to which of our products would best suit their needs, and we do invest heavily in market research to ensure that our products will meet market requirements. We regularly hold seminars to give impartial advice to interested parties as to security fence panels and their attributes, but it remains as said above that most of our products are supplied to merchants and we have little knowledge of the customers of the merchants who take our product."

34. This suggests that the list provided by the applicant to his Trade Mark Attorney would have contained only a small number of ultimate customers for the applicant's products – the group whose perception of the 201 mark is of primary significance to the question of whether that mark has acquired a distinctive character through use. It appears to me that this finding is sufficient, of itself, to conclude that the survey does not establish that the 201 mark has come to distinguish the wire fencing of a particular undertaking in the perception of a significant proportion of the relevant class of persons.

35. The questionnaire itself was simple. The first 7 questions asked the respondent to record details of himself, his firm, experience, whether he or she was familiar with welded security fences (to which all respondents answered positively), whether the respondent was involved in the purchasing/specifying of such fences (again nearly everyone answered positively – the merchants presumably meaning that they sell them and the fencing contractors that they order the one they are instructed to purchase from merchants). The key question is number 8. This asks the respondent to record a) whether they recognise the fence panel in the picture attached, if so, b) what is it? And finally c), who makes it? All but 5 of the respondents recognised the panel as a Paladin fence panel and named Bekaert (or Twil, the previous applicant) as the maker.

Findings on the Evidence

36. I regard this evidence as showing that a significant proportion of the trade can distinguish the shape of the fencing represented in the 201 mark from other fence panels, and know that there is only one maker of that type of fence panel. I do not find this surprising. The shape the subject of the 201 application was registered as a design under number 1019668. The registration expired in 1999. The original application to register the shape as a trade mark was pending at that time. The timing of the current applications roughly corresponds with the date of refusal of the earlier trade mark application. Consequently, the applicant has at all material times enjoyed a registered design, or a prospective registered trade mark, which provided the applicant with the exclusive right to the use of the 201 mark (in the case of the trade mark, subject to its eventual registration).

37. In Case C-299/99, *Koninklijke Philips Electronics NV v Remington Consumer Products* [2003] RPC 2, the ECJ was asked:

“ Where a trader has been the only supplier of particular goods to the market, is extensive use of a sign, which consists of the shape (or part of the shape) of those goods and which does not include any capricious addition, sufficient to give the sign a distinctive character for the purposes of Article 3(3) in circumstances where as a result of that use a substantial proportion of the relevant trade and public

- a) associate the shape with that trader and no other undertaking;
- b) believe that goods of that shape come from that trader absent a statement to the contrary?”

38. The court’s response indicated that it was possible for a shape to acquire a distinctive character in these circumstances but that:

- a) the requirement cannot be shown to be satisfied purely on the basis of general abstract data, such as predetermined percentages (paragraph 62);
- b) the distinctive character of a shape, even that acquired by the use made of it, must be assessed in the light of the presumed expectations of an average consumer of the product, who is deemed to be reasonably well informed and reasonably observant and circumspect (paragraph 63);
- c) the identification of the shape as originating from a given undertaking must be as a result of the mark as a trade mark and thus as a result of the nature and effect of it, which make it capable of distinguishing the product concerned from those of other undertakings (paragraph 64);
- d) it is for the national court to verify that the requirements of the provision are satisfied on the basis of specific and reliable data (paragraph 65).

39. It is now well established that (Section 3(2) apart), shape marks are subject to the same legal requirements as apply to other categories of trade mark. If a trader were to use a descriptive word mark, such as, for example, BUDGET for car hire services, in a non-distinctive way, simply as a description of a class of his car hire service, he could not hope to register it as a trade mark simply by showing that he was most closely associated with budget class car hire in the minds of the public. He would

have to show that he had used BUDGET distinctively, as a trade mark. The same would appear to apply to shape marks. It appears that it is not sufficient to have used a shape for a fence panel simply as a design. It seems to be necessary to have used it as a trade mark: that is to have used it in ways that are apt to distinguish the commercial origin of the goods so that consumers have come to rely upon the mark, in the course of trade in the goods, as a sign which distinguishes the goods of an undertaking.

40. As I noted above, there is no evidence that the applicant has used the 201 mark as a trade mark. The 201 mark is not represented as a point of reference for the products of a particular undertaking. The applicant's promotional material emphasises its functional and aesthetic features, and other aspects of its specification. I would expect that it would be these considerations, along with cost, which would influence the end consumer's decision to select a particular fence panel for a particular purpose from the range of options identified for them by their architect or designer. There is no independent evidence that an average consumer of the applicant's wire fencing has been educated to the expectation the shape of the 201 mark is a sign upon which he or she can rely for the purpose of identifying the goods of a particular undertaking.

41. I do not regard the survey as establishing that the trade, and more particularly the relevant members of the trade, such as architects and designers, use the shape of the 201 mark to influence the ultimate consumer's purchasing decision by reference to the preferred commercial source for the goods. What the survey shows is product recognition by the trade.

42. In making these findings I have not overlooked the evidence given by Mr Pollard on behalf of the applicant. He says that:

“[He] has total conviction that when an ultimate customer is shown a selection of fence panels, the choice of panels of the [201 mark] is a direct consequence of the ultimate customer recognising the panel because of its unique patterning, as one of high quality and from my company. It is worth mentioning here, that the ultimate customer choice is despite the fact that panels in accordance with the [201] application are more expensive than other forms of security panel and which may well have better security attributes. That price premium has been secured because our panel was the first wire security fence panel and became widely known in fencing circles, for its quality and suitability for high profile installations.”

43. I do not doubt that these views are earnestly held, but it is not clear to me on what they are based. In the same witness statement, Mr Pollard says that he has little knowledge of the customers of the merchants who, he says, account for all but a small percentage of the sales of his company's products. I am left with the impression that, despite attributing his opinion as corresponding to the expectations of an ultimate customer, Mr Pollard is in fact projecting his view of the way in which the trade (in the broad sense) look upon his company's panels. Even in that context, there is room for doubt as to how much of the premium to which Mr Pollard draws attention is attributable to the perceived quality of panels, because they originate from the applicant (the trade mark function), and how much is due to the enhanced aesthetic appeal of the 201 mark when compared with other security fences (the design function).

44. Further, Mr Pollard's attempt to give evidence on this point serves to draw attention to the absence of any relevant evidence on this point from consumers/end users, or from those with first hand knowledge of the selection process, such as architects or designers.

Conclusion

45. I conclude that:

- i) Both marks are *prima facie* excluded from registration by Section 3(1)(b) of the Act.
- ii) The evidence shows no use of the 706 mark;
- iii) The evidence shows no use of the 201 mark as a trade mark;
- iv) The survey evidence does not shed light on the expectations of a significant proportion of consumers or end users;
- v) The survey shows only product recognition within the wider trade;
- vi) Only those that influence the purchasing decision, such as architects and designers, are members of the relevant class of persons for the purposes of the enquiry;
- vii) There is no independent evidence that the shape of the 201 mark influences the purchasing decisions of consumers or end users in the sense of distinguishing between the products of different undertakings (as opposed to distinguishing between different fence panels).

46. The case for registering the marks as trade marks on the basis of acquired distinctiveness through use therefore fails and the applications stand refused.

Dated this 24th day of December 2004

**Allan James
Hearing Officer**