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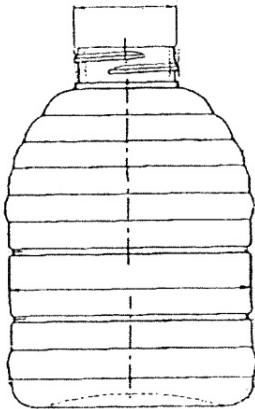
**TRADE MARKS ACT 1994**  
**IN THE MATTER OF APPLICATION No. 2339960**  
**BY ROWSE HONEY LIMITED**  
**TO REGISTER A TRADE MARK**  
**IN CLASSES 29, 30 & 31**

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### BACKGROUND

1. On 4 August 2003 Rowse Honey Limited applied for registration of the following trade mark:



2. The mark was applied for as a “form only” mark. This means that the mark consists of the shape (in three dimensions) illustrated above. The shape is a bottle or similar container – this is confirmed by evidence and information filed later on by the applicant. The goods for which registration is sought are:

**Class 29:**

Preserved, dried and cooked fruits; jellies, jams; fruit preserves, butters; pickles; food spreads; dairy products; fruit sauces.

**Class 30:**

Honey; products containing honey; sauces (condiments); spices; vinegars; mustards; sauces and toppings included in Class 30; confectionery; treacle.

**Class 31:**

Fruit juices and non-alcoholic drinks.

3. An objection under Section 3(1)(b) of the Trade Marks Act 1994 (“the Act”) was raised against the mark in relation to all the goods sought for registration. The objection was raised on the basis that the mark consists of a shape of a bottle that was devoid of distinctive character as the average consumer would not perceive the particular shape as unusual or distinctive.

4. Following a hearing, at which the applicant was represented by Ms Sally Schupke of Chancery Trade Marks, I maintained the objection. 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. The applicant filed evidence in support of the application which I took into account when coming to my decision; the evidence is summarised below.

### **The Law**

5. Sections 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 applicant’s case for registration**

6. The applicant filed evidence in support of the application. The case for registration was also put to me in a number of submissions made in writing prior to the hearing and also orally at the hearing before me.

### Evidence

7. The applicant’s evidence is given in the statutory declaration of Mr Stuart Bailey, the Managing Director of the applicant company. He confirms that his evidence comes from his own knowledge or from the records of the applicant company.

8. Mr Bailey begins his evidence by stating that the mark has been used continuously in the UK. The following table shows the annual retail sales figures relating to the sale of goods under the trade mark:

	Rowse label	Supermarket own label
Year ending Sept. 2003	£2, 247, 816	£924, 487
Year ending Sept. 2002	£1, 743, 948	£766, 913
Year ending Sept. 2001	£1, 119, 865	£485, 123
Year ending Sept. 2000	£638, 794	£440, 158

9. In the context of the above table, it is explained that the applicant, in addition to selling honey products to the end consumer under its own Rowse label, also sells its honey in the shaped bottle the subject of the application to other companies (e.g. supermarkets such as Morrisons and Sainsburys) who then sell them on to the end

consumer under their own brand labels (but still in the shape put forward for registration). Mr Bailey informs us that the average unit cost of the honey products is £1.

10. Mr Bailey then refers to exhibit SB1. This consists of lists of various products and dates to demonstrate the date of first use of the mark. It should be noted that the source of this information is not given, but, it appears to be a document internal to the applicant. It shows that the Rowse Easy Squeezy Honey bottle was first launched at the beginning of 1998. Although the trade mark is not shown on this document, later evidence shows that the Rowse Easy Squeezy product consists of the shape the subject of the application together with its label and honey content. From the evidence, supermarket own brands have been sold from at least 1999.

11. Mr Bailey next refers to exhibit SB2 which contains various promotional materials and sample labels. The advertising expenditure in relation to the mark is then provided, namely, 2003: £6000, 2002: £6578 and 2001: £2995. Circulation figures are then provided for the monthly Tesco Recipe magazine (253,000 copies per month) and the weekly Grocer magazine (40,000 copies weekly). The applicant's advertising is made extensively through these publications. The frequency of advertising in the publications is not detailed.

12. The promotional material can be split into two categories. Firstly are the more traditional forms of advertising, i.e. advertisements placed by Rowse to simply promote their products. The second form consists of editorial articles that would strike the consumer as originating from the magazine's producers. These articles highlight the qualities of the applicant's honey products. The majority of both categories of material clearly depict the sign in question (with a Rowse label appearing thereon), they describe the virtues of the particular shape (being non-drip and squeezable etc), and they describe the shape itself as the bee-hive shaped bottle.

13. Exhibit SB3 contains a sample list of locations throughout the UK where sales under the mark have taken place. It is fair to say that this is quite extensive. Mr Bailey concludes his evidence by stating that he is not aware of any instances of confusion and that any reputation built up in the mark has been to the benefit of the applicant.

14. In addition to Mr Bailey's evidence, the applicant also provided letters from three of the supermarkets they supply. One is from the "Product Developer" at Marks & Spencer, another is from the "Central Buyer Grocery" of Waitrose, the final letter is from the "Home Baking Buyer" of Wm Morrison Supermarket. Each of these letters is identically worded and consists, essentially, of the following statement:

"I first became aware of the Rowse Beehive Bottle in August 1998 (Marks and Spencers), January 2003 (Waitrose), October 2003 (Morrison's) and I recognize this as being a trade mark belonging to Rowse Honey Limited"

15. Although not formal evidence, I have nevertheless taken these letters into account when reaching my decision. A letter is also provided from Mr Bailey to re-enforce the

points made in his evidence, namely, that the mark has been used since 1998, that its popularity has increased significantly over the years, and, the applicant is keen to ensure that the shape remains exclusive to the applicant.

### Submissions

16. I also took into account the submissions of the applicant's trade mark attorney, Ms Shupke of Chancery Trade Marks. Her submissions were made orally at the hearing before me and also in writing. They are summarised below:

- Although Ms Shupke did not argue to any great extent that the mark was inherently distinctive, she did submit that the shape was not commonplace in the relevant field and was, in fact, unique.
- It was argued that the evidence put forward was sufficient to demonstrate that the average consumer would recognise the specific shape and would indicate to them that the goods sold in connection with the sign originated from the applicant.
- That goods sold within the shape mark were sold to supermarkets (for own branding purposes) and that the supermarkets themselves were therefore average consumers of the goods in question. The evidence, especially the evidence from the supermarkets, meant that the mark was distinctive.
- That the sign would also be distinctive to the general public. It was argued that the consumer would recognise the shape, regardless of whether it had a Rowse label or a supermarket own brand label on it, and would see it as a sign of trade origin in a single undertaking, namely, the applicant.

### **DECISION**

17. The grounds of objection relate to Section 3(1)(b) of the Act, the purpose of which is to prohibit registration of signs which are incapable of distinguishing the goods and services of one undertaking from those of other undertakings. The approach to be adopted when considering the issue of distinctiveness under Section 3(1)(b) has been summarised by the European Court of Justice ("ECJ") in paragraph 37, 39 to 41 and 47 of its Judgment in Joined Cases C-53/01 to C-55/01 *Linde AHG, Windward Industries Inc and Rado Uhren AG* (8th April 2003) in the following terms:

"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 or services of one undertaking from those of other undertakings.

.....

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).

.....  
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”.

18. In view of the above, the mark's distinctiveness must be assessed in relation to the goods sought to be registered by the applicant. I must also have regard to the perception of the average consumer who is deemed to be reasonably well informed and reasonably observant and circumspect. I will return later in this decision to the question of who I consider the average consumer to be.

19. I must, of course, assume notional and fair use of the mark in relation to the goods applied for when assessing the impact that it will have on the average consumer. Taking into account the nature of the mark itself, together with the fact that it has been applied for as a three-dimensional shape mark, I can do little else other than to assume that the mark is used as a container for the goods applied for which include (but is not limited to) honey. Although the mark could, potentially, be sold without a label of any sort on it, it would seem to me that a notional and fair use of the mark must include use together with other marks intended to function as a guarantee to the consumer that the goods come from a particular trade origin; this corresponds with the use demonstrated in the applicant's evidence.

20. Although the agent focused most of her submissions on the significance, or otherwise, of the evidence filed to prove acquired distinctiveness, I considered both the inherent nature of the mark and its capacity to perform the distinguishing function of a trade mark (the *prima facie* case) and also whether the capacity of the mark to distinguish was improved by the evidence filed. For ease of explanation, I will break down these two propositions.

### **The *prima facie* case**

21. As indicated above, the test to be applied is whether the average consumer would, when encountering goods sold in the shape put forward for registration, see the shape as a sign that, by itself, guarantees to them the trade origin of the goods.

22. Despite Ms Shupke's submissions that the average consumer of the goods (or at least part of them) would be supermarkets who buy the applicant's product for the purpose of own-branding, I find that the average consumer of the goods would be the general public at large. The goods cover a number of items which all appear to be general consumer food products. There are a number of uses for the items including uses as spreads, flavourings or constituent ingredients for cooking purposes. There is nothing technical about these goods and would be items that the general public would, from time to time, purchase. I accept that honey (to which most of the applicant's evidence relates) is probably purchased less frequently than a preserve such as jam. However, I do not consider that this equates to a honey purchaser being any more sophisticated than the purchaser of jam. It is still a basic consumer product purchased with varying degrees of frequency.

23. The fact that supermarket buyers are customers of the applicant does not, in my opinion, make them an average consumer or even one of the relevant public. The enquiry of who is the average consumer must focus to a large extent on the end-users of the goods. Supermarkets are not the end-users of the goods; to the contrary, they take the goods together with the shape consisting of the trade mark and sell them on to the general public. They are therefore either intermediaries between the producer and the relevant public or, in the case of own branded products, usually the party regarded by the public as being responsible for the marketing of the product.

24. Having decided to whom the analysis is made, I next consider the impact that the sign will have when taking into account the notional and fair use of the mark that I have already identified. Whilst the test for distinctiveness is the same for shape marks as for any other mark (see *Linde* para 49) non-traditional marks may be less readily accepted by the average consumer as indications of trade origin. In *Procter and Gamble v OHIM*, Joined Cases 468/01 P to 472/01 the ECJ stated at paragraph 36:

“Average consumers are not in the habit of making assumptions about the origin of the products on the basis of their shape or the shape of their packaging in the absence of any graphic or word element...”

25. The ECJ provided further guidance on the test to be applied by explaining (in addition to *Procter & Gamble v OHIM*, also see *Henkel* C-218/01 at paragraph 45) that the test was whether the mark enabled an average consumer “..without conducting an analytical or comparative examination or paying particular attention.” to distinguish the goods concerned from those of other traders. It was also stated that only a mark which departs significantly from the norms or customs of the sector and thereby fulfils its

essential function of indicating origin possesses the distinctive character necessary for registration.

26. Whilst there is no specific material on the official file to demonstrate what the norms or customs are in this particular field, I am aware, from my own general consumer knowledge, that goods of the type sold under the sign are sold in various shapes of container ranging from the most basic and plain type to those that have more detail and design. Those with more detail or design do not necessarily function as guarantees of origin, they may simply be designed in that way to give the product a more attractive feel. Some containers may also have a design element that succeeds in imparting some form of functional purpose such as assisting with grip. In short, there is no single norm or custom for containers in this particular field.

27. The case law instructs me that to function as a guarantee of origin the mark must depart significantly from the norm or customs. The fact that various shapes are used as containers in the relevant field means that a *prima facie* registrable shape mark must at least be relatively unusual in order for it to stand out from the crowd and be seen by the average consumer as more than just another shape that has been placed on the market for the goods in question.

28. Turning to the sign in question, I do not consider that it will not be seen as anything other than just another shape. It does not strike me as being particularly unusual so that the consumer, when they encounter it in use, will see it as a guaranteeing sign of trade origin. It has a basic overall configuration of a bottle with a lid or cap. Whilst it has a contoured or beveled appearance, this aspect does not strike me as being particularly unusual. Many shapes possess such contoured appearance, often being used to assist in grip or to give the shape a more attractive feel.

29. I am conscious that one of the goods put forward for registration is honey. I am aware from the evidence that it is honey that the applicant has been using the mark in relation to and the mark is intended to evoke a conceptual link to the appearance of a beehive. The registrability of the mark must be assessed by reference to the representation of the mark put forward for registration. I do not believe it likely that an average consumer would recognise such a conceptual resemblance from the features of the mark which are visible from the representation filed. Further, even if I am wrong about that and the average consumer recognised this link, this would not, in my opinion, necessarily equate to distinctiveness in a trade mark sense. The selection of this configuration would not be surprising for a trader in the field of honey and is one that could equally be used by other traders of honey in order to send a similar evocative message. I am therefore of the view that such a link would most likely be regarded, *prima facie*, as serving a purely promotional purpose rather than conveying information about the undertaking responsible for the product.

30. In summary, I do not find that the shape put forward departs significantly from the norm so that the average consumer will appreciate it, as a matter of first impression, as a



guarantee that the goods sold in it are the goods of a particular undertaking. Therefore, the mark fails the *prima facie* test for registration.

### **The case for acquired distinctiveness**

31. The proviso to Section 3 of the Act permits acceptance of a mark that is otherwise unacceptable under the provisions of Section 3(1)(b) if it has in fact acquired a distinctive character because of the use made of it. Guidance on the test to be applied was provided by the ECJ in *Windsurfing Chiemsee (C108&109/97) [1999] ETMR 585* where it was stated:

“If the competent authority finds that a significant proportion of the relevant class of persons identify goods as originating from a particular undertaking because of the trade mark, it must hold the requirement for registering the mark to be satisfied.”

32. The same case provides useful guidance on some of the factors to consider when deciding whether the relevant class of persons identifies the goods as originating from a particular undertaking; the court identified that:

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:

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

33. Further guidance on the test to be applied can be gleaned from the ECJ in the *Philips* judgment (C-299/99) which, although in the context of a mark that was a particular shape of a kind of goods from only one known supplier, it was nevertheless found that the proviso could only be relied upon where reliable evidence shows that recognition of the mark as indicating the goods/services of one undertaking is as a result of its use as a trade mark. The ECJ, in *Societe des produits Nestle SA v Mars UK Ltd* (case C-353/03), at paragraph 29, indicated that this later point means “use of the mark for the purposes of the identification, by the relevant class of persons, of the product or services as originating from a given undertaking.”

34. Taking the case law in the round, it seems to me that the evidence must show that the sign is taken by the average consumer as a guarantee that the goods originate from a particular undertaking because of the use of the sign for that purpose.

35. Has the mark been used in a manner which has permitted it to fulfill the essential function of a trade mark (which is to guarantee that all the goods offered for sale under it are the responsibility of one undertaking responsible for their quality)? In trade, it is often the case that more than one trade mark is used by a trader to guarantee the trade origin of the goods to the consumer. These are commonly referred to as “secondary” trade marks. It is fair to say that the evidence relied upon by the applicant demonstrates that the Rowse label is the primary trade mark used to distinguish their goods. Mere use of a particular shape (or other sign) may not be enough to prove that it has acquired a meaning as a secondary trade mark. The less plausible it appears on the face of it that consumers would take the mark in question as serving a trade mark function (such as containers that carry the goods) the more important it is to consider what, if anything, has been done to highlight to the consumer that the mark is a distinguishing sign.

36. The evidence filed does not, in my opinion, demonstrate that anything significant has been done to highlight to the consumer that the mark is a distinguishing sign. I acknowledge that some of the promotional material may bring the bottle itself to the attention of the consumer, this being achieved by the promotional material not only depicting the bottle but also going on to highlight the particular virtues (such as ease of application) of the bottle whilst also describing it by referring to it as the bee-hive shaped bottle. However, this does not necessarily equate to the average consumer being educated that the shape itself is a guaranteeing sign of trade origin.

37. Nevertheless, in terms of some of the factors identified in the *Windsurfing* case, the evidence filed ticks some of the boxes. Although the turnover figures supplied are not contextualised into market share, it is reasonable to assume that they are not insignificant in relation to the sale of honey. The use, in terms of length, is reasonable. I would not describe the promotional activity as particularly significant due to the nature of it (no national magazine or newspaper advertising) and, furthermore, the absence of detail on the frequency of promotion does not assist. However, some promotion has taken place and the advertisements, particularly in the Tesco recipe magazine, will no doubt have been noticed by its not insignificant readership. I take less cognisance of the Grocer magazine given that this appears to be a trade publication and, therefore, has little impact on the perception of the sign by the average consumer. The geographical spread of the use is good.

38. No public perception evidence has been filed so there is no direct evidence as to the proportion of the relevant public who identify the goods (because of its use) as coming from a particular undertaking. There is no evidence from relevant chambers of commerce. There is information from a number of supermarket buyers who recognise the shape as the Rowse honey bottle but I do not regard this as persuasive because it tells me nothing about the views of consumers and end users of the product. Similar observations

were made (in relation to evidence from the trade) in *Dualit Ltd's (Toaster Shapes) Trade Mark Applications* [1999] R.P.C. 890 at 898/9 where it was stated:

“These, however, are people whose business it is to know the applicant’s products and the products of other manufacturers in the market. The fact that they knew their job and could recognise the shapes as being those of the applicant’s products does not seem to me to begin to show 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”. The relevant class of persons is not trade buyers such as these witnesses but customers”.

39. An interesting factor in the evidence is that the average consumer may encounter the sign in use not just with a Rowse label, but also with a number of supermarket own brand labels. Ms Shupke’s submissions on this point centered on the fact that the consumer was sophisticated enough to still see the shape as a guarantee of origin even though it had been used by others.

40. The use by the supermarkets for own brand products (the evidence shows this to date from close to the date of the applicant’s own use) is, despite being less than the applicant’s use, still significant. In my view, this evidence points away from the conclusion that the consumer has been educated to regard goods sold in connection with packaging of that shape as being the goods of one undertaking. I recognise that goods can be co-branded, that is, to bear the trade marks of more than one undertaking, both of which are responsible for their quality. However, this is the exception to the norm and would be outside the experience of consumers when it comes to own brand supermarket products which are normally defined by the absence of third party trade marks.

41. I am left with the impression that the use by a number of (from a consumer point of view) unrelated undertakings of a particular shape would simply send an overall message that this is a common way of packaging honey products. In effect, any limited distinctiveness the sign may otherwise have attracted has been diluted by the use in the course of trade of the sign by other traders.

42. I do not consider the average consumer to be sophisticated (or interested) enough to look behind the obvious message that the mark could indicate the goods of a number of undertakings in order to draw the less obvious message that the shape is still, even when bearing a supermarket own brand word mark, nevertheless indicating that the applicant is the party responsible for the goods and their quality. In this connection, I note that it would not be consistent with the essential function of a trade mark for it merely to be recognised that the applicant manufacturers goods for the supermarkets which they then market as their own, and for which they are wholly responsible.

43. In summary, I do not consider that the mark, even taking into account the use made of it, will perform the essential distinguishing function of a trade mark.

## **CONCLUSION**

**44. I therefore conclude that the mark applied for is devoid of any distinctive character and is thus excluded from acceptance under Section 3(1)(b) of the Act.**

45. In this decision I have considered all the documents and evidence submitted by the applicant and all the arguments submitted to me in relation to this application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because the mark fails to qualify under Sections 3(1)(b) of the Act.

**Dated this 7th day of March 2007**

**OLIVER MORRIS  
For the Registrar  
the Comptroller-General**