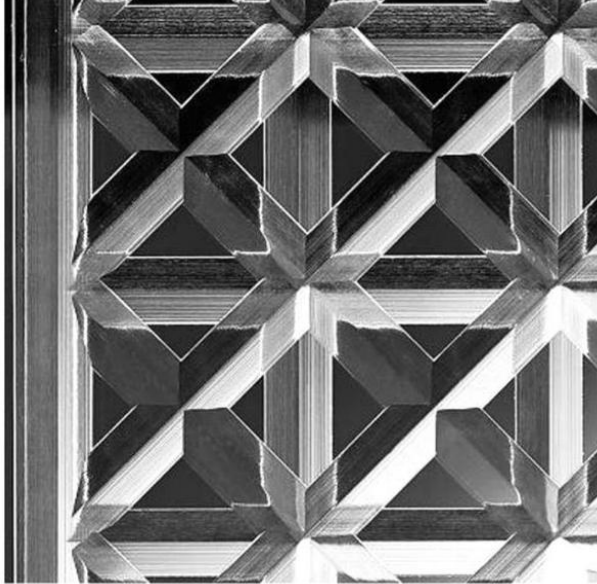


O-385-14

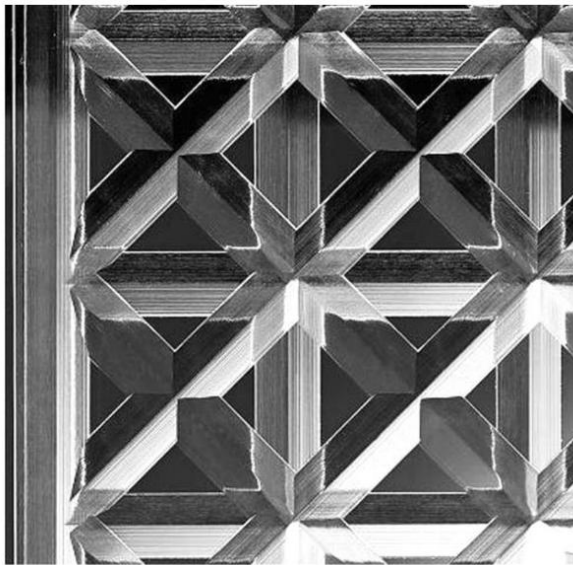
**TRADE MARKS ACT 1994 & THE TRADE MARKS (INTERNATIONAL REGISTRATION)
ORDER 2008 (as amended)
IN THE MATTER OF INTERNATIONAL REGISTRATION WO0000001150138
BY SAINT-GOBAIN GLASS FRANCE
TO PROTECT THE FOLLOWING TRADE MARK
IN CLASSES 19 AND 21:**



**THE TRADE MARKS ACT 1994 & THE TRADE MARKS (INTERNATIONAL
REGISTRATION) ORDER 2008 (as amended)
IN THE MATTER OF INTERNATIONAL REGISTRATION WO0000001150138
BY SAINT-GOBAIN GLASS FRANCE
TO PROTECT A TRADE MARK IN CLASSES 19 AND 21**

Background

1. On 7 March 2013, Saint Gobain Glass France ('the applicant') requested protection in the United Kingdom under the provisions of the Madrid Protocol for the following three-dimensional sign:



2. Protection was sought in classes 19 and 21 for the following goods:

Class 19: Non-metallic building materials, namely building glass; printed glass for building; glazing; doors and windows, not of metal; sheets, plates, panels, walls and glass for buildings, for fitting out and for exterior and interior decoration; glass walls and partitions for building.

Class 21: Glassware not included in other classes, namely unworked and semi-worked glass (except building glass); printed glass (other than for building); opaque or translucent enamelled glass (other than for building); lacquered glass (other than for building); glass produced by silkscreen printing (other than for building); stained glass (other than for building); unworked and semi-worked glass also in the form of sheets and plates used in the manufacture of sanitary installations, shower cubicles, shower screens, shower partitions and walls, refrigerator shelves, glazing, walls, partitions, doors, doors for cupboards and furniture; household or kitchen utensils and containers (not of precious metal or coated therewith).

3. On 25 March 2013, the Intellectual Property Office ('IPO') issued notification of a provisional total refusal of protection in response to the application. In that notification, an objection was raised under section 3(1)(b) of the Trade Marks Act 1994 ('the Act') on the basis that the mark is devoid of any distinctive character because it is considered to be a mere representation of the goods, and is therefore unlikely to be perceived by the average consumer as an indication of trade origin. An objection was also raised under section 3(2)(a) because the mark is a shape which results from the nature of the goods themselves.

4. On 23 April 2013, Eleanor Coates of Murgitroyd & Co ('the agent') submitted written arguments stating why she considered that these objections were unfounded. On 13 May 2013 the examiner responded, agreeing that the objection under section 3(2)(a) could be waived, but maintaining under section 3(1)(b).

5. On 11 June 2013, the agent requested an ex parte hearing which was held on 27 August 2013. At that hearing, I raised a late objection under section 3(1)(a) as I did not consider the mark to be graphically represented. I had not had the opportunity to notify the agent of this objection prior to the hearing, and as Ms Coates had not been given any opportunity to prepare a response, I offered her a further hearing in respect of section 3(1)(a). Ms Coates declined this offer, and chose to address the 'new' objection via correspondence.

6. Ensuing correspondence from the agent did not persuade me that the objections raised against the mark should be waived, and so on 22 January 2014 I refused the application. A TM5 was duly received on 11 February 2014 and I am now required to set out the reasons for refusal of protection in the United Kingdom. Regarding the objection raised under section 3(1)(b), no formal evidence has been put before me for the purposes of demonstrating acquired distinctiveness. Therefore, I only have the *prima facie* case to consider.

7. In her correspondence, Ms Coates submitted separate written arguments concerning the objections raised under sections 3(1)(a) and 3(1)(b). Those submissions are summarised below:

The applicant's case for registration under section 3(1)(a):

- The mark cannot be amended at WIPO ('the World Intellectual Property Organisation'), not least due to the fact that it has already been accepted and registered in a number of territories. An International mark has to be examined as filed. If additional graphical representations are filed in the UK, they cannot affect the mark.
- No other countries designated have raised an objection on the basis that the mark fails to meet the requirements for graphic representation. The 'Sieckman criteria' apply to all EU territories, and establishing whether or not a mark is graphically represented is the same across all member states.
- Whilst the UK IPO has repeatedly requested that further representations are necessary in order to clearly show the mark's three-dimensional form, it is quite apparent from the representation already filed that the V-cut shows the indentation of the shape. No further view of the sides would be appropriate. When the mark is applied to a plain glass panel

or other building material, it would be imprinted and the top view would be visible to the consumer.

- Despite the fact that the agent had advised the IPO that the mark should be considered as a 'maker's mark' (i.e. similar to the way in which jewellery has a 'maker's' mark stamped on it, and is an engraving which would be seen on the surface of the product only in the manner in which it is graphically represented in the current application, the IPO has failed to provide full reasons as to why, given the explanation provide, it is necessary to submit further views.
- The applicant's mark is three-dimensional, but only to the extent that you would feel the relief if you ran your finger over it. If viewed from the side or bottom it would not be visible, so further representations are not required. In terms of glass products, consumers are well used to them being of the type that can be 'felt' in this manner. If the mark appeared on a glass panel in the form as filed, and the remainder of the panel is clear, the mark would simply act as a maker's mark or badge of origin similar to the way that jewellery has the maker's mark stamped on it.

The applicant's case for registration under Section 3(1)(b):

- The mark is not a mere representation of the goods. It is not a basic shape which is required to be kept available for the public but is rather an intricate device mark presented in three, rather than two, dimensions. The device has numerous distinctive features, creating 'shapes within shapes' and with a distinctive star shape in the centre. The mark should be viewed as a 'device' applied to the products.
- The examiner has not provided any arguments or evidence to illustrate why a consumer would not consider the device distinctive. The applicant has applied for a wide range of goods, and the examiner has not cited which goods he considers the mark to be a representation of.
- The mark as filed does not show a repeating pattern, and IPO is trying to infer that one exists when it is not there.
- When the mark is considered as an imprinted mark on building materials or glass panels, and as an image which sits by itself as a 'maker's mark', it is clear that a 3(1)(b) objection would not apply.
- The Registry is attempting to view the mark as something it is not. In viewing the mark as filed, it does not appear to be a glass panel or actually glass, but rather appears to be wood, as one can see from the visible 'wood grain' effect.
- A glass panel implies that it is significantly larger than the two inch mark as filed. On the basis that the mark is no bigger than a two-inch square, it cannot be a glass panel.

The *prima facie* under Section 3

8. Section 3(1) of the Act reads as follows:

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) ...

(d) ...

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it."

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

9. Section (1)(1) of the Act states that:

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)(a) - Relevant authorities and general considerations

10. Article 2 of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks states that a trade mark may consist of *"...any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings"*.

11. In the context of 'graphical representation', I derive the following main guiding principles from the case of *Ralf Sieckmann v Deutsches Patent- und Markenamt* ('*Sieckmann*' C-273/00), where the Bundespatentgericht asked the Court for an interpretation of that concept within the meaning of the Directive. The Court of Justice of the European Union ('CJEU') held that in order to be eligible for registration as a trade mark, a sign must be identified graphically by means of a representation which satisfies the following criteria:

"46. That graphic representation must enable the sign to be represented visually, particularly by means of images, lines or characters, so that it can be precisely identified.

47. Such an interpretation is required to allow for the sound operation of the trade mark registration system.

48. First, the function of the graphic representability requirement is, in particular, to define the mark itself in order to determine the **precise subject** of the protection afforded by the registered mark to its proprietor.

49. Next, the entry of the mark in a public register has the aim of making it **accessible** to the competent authorities and the public, particularly to economic operators.

50. On the one hand, the **competent authorities** must know with **clarity and precision** the nature of the signs of which a mark consists in order to be able to fulfil their obligations in relation to the prior examination of registration applications and to the publication and maintenance of an appropriate and precise register of trade marks.

51. On the other hand, **economic operators** must, with **clarity and precision**, be able to find out about registrations or applications for registration made by their current or potential competitors and thus to receive relevant information about the rights of third parties.

52. If the users of that register are to be able to determine the precise nature of a mark on the basis of its registration, its graphic representation in the register must be **self-contained, easily accessible and intelligible**.

53. Furthermore, in order to fulfil its role as a registered trade mark a sign must always be perceived unambiguously and in the same way so that the mark is guaranteed as an indication of origin. In the light of the duration of a mark's registration and the fact that, as the Directive provides, it can be renewed for varying periods, the representation must be **durable**.

54. Finally, the object of the representation is specifically to avoid any element of subjectivity in the process of identifying and perceiving the sign. Consequently, the means of graphic representation must be unequivocal and **objective**.

55. In the light of the foregoing observations, the answer to the first question must be that Article 2 of the Directive must be interpreted as meaning that a trade mark may consist of a sign which is not in itself capable of being perceived visually, provided that it can be represented graphically, particularly by means of images, lines or characters, and that the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective." (My emphasis)

12. This exposition of the requirement for legal certainty has been affirmed and reaffirmed in later judgments of the Court. In an application to register a colour *per se* in *Libertel* (C-104/01), the CJEU took guidance from the *Sieckmann* decision and decided that to be represented graphically, colour marks must be presented in a way that is "clear, precise, self-contained, easily accessible, durable and objective" (referred to as the '*Sieckmann Criteria*'), stating:

“60. It therefore follows from the scheme of the Directive that it is the graphic representation of the sign set out in the application for registration that allows an assessment to be carried out as to whether all the conditions relating to the acquisition of rights to the trade mark are complied with and which determines the rights and obligations conferred by its registration.

61. The scheme of the Directive thus indicates that the first condition under Article 2 is designed to allow precise identification of the sign that will be used by the applicant in order to distinguish his goods and services.

62. This interpretation is supported by the purpose underlying the requirement in question. As Advocate General Ruiz-Jarabo Colomer explained in his Opinion in the Sieckmann case (Case C-273/00) pending before the Court, (52) the requirement that the sign be capable of being represented graphically is based on the principle of legal certainty.

63. According to the Advocate General, [a] registered trade mark confers a monopoly on its proprietor, allowing him exclusive use of the signs constituting it, to the exclusion of all other parties. An inspection of the register should allow a person to know, with as much certainty as the registration system will allow the nature and scope of the signs, indications and symbols appearing on the register and it is for this reason that they require to be represented graphically. If an undertaking acquires a monopoly in certain signs and indications in order to distinguish its goods and services from those of other undertakings, it is necessary to be able to establish clearly what the symbols are which constitute it so that the others are aware of what it is they must refrain from doing’. (53) The counterpart of the monopoly conferred by registration of the trade mark is that third parties must be clearly informed as to the sign which is protected.

64. It follows that not every form of graphic representation will suffice. Two conditions must be met. First, the representation must be clear and precise in order that one may know beyond any possible doubt what it is that is being given the benefit of exclusive rights. Secondly, it must be intelligible to persons wishing to inspect the register, namely other manufacturers and consumers. It should not be necessary to go to inordinate lengths to ascertain what sign the applicant will actually use.”

Although the *Libertel* decision concerned an application for a colour mark, the reasons why a mark must be adequately graphically represented are the same for shape marks as colour marks, and therefore the rationale given in the *Libertel* decision applies equally to this mark.

Decision

13. An objection under section 3(1)(a) had *not* been raised at the examination stage. Objections under this provision are rarely raised against Madrid Protocol applications because such marks will have already been accepted by WIPO on the basis of the base registration. However, this does not mean that a designated country cannot raise an objection under section 3(1)(a) if it considers - in accordance with the national law - that the mark has not been graphically represented.

14. In *Creola* [1997] RPC 507, Counsel appearing for the Registrar submitted that the representation filed as part of an application for registration must be sufficiently clear and distinct to allow all the significant features of the relevant mark to be readily discernible. In the case of this application, protection is clearly being sought in respect of a three-dimensional shape (under 'mark type', the application form states 'three dimensional'. That being the case, I do not consider that the supplied one single view of the shape is sufficient to define the scope of the application and to reveal all the significant features of the mark. 'Three dimensional' is defined in MacMillan Dictionary as "*not flat, but able to be measured in height, depth, and width*". The image we have of the mark does not give any impression of depth and we cannot see what the mark looks like in relief. This is the reason why I deemed it necessary to raise an objection under section 3(1)(a). I did not, as the agent has suggested, request further copies of the mark - given my knowledge that an applicant is precluded from amending an International mark following its acceptance by WIPO, there would be no value or merit in making such a request. The agent has also informed me that this objection has not been raised by any of the other designated countries. I do not know why this is so, but it does not alter my opinion that the mark is *not* adequately graphically represented.

15. Why is it necessary for a mark to be represented graphically? As Kerly's Law of Trade Marks and Trade Names (15th edition) states:

"The requirement that a mark be capable of being represented graphically arises from important practical considerations concerned with certainty. First, the relevant trade mark office must know with certainty what is comprised in the sign in question, so that it can maintain an accessible Register of Trade Marks and fulfil its functions of examination and publication of applications. Secondly, and of greater importance, other traders must be able to ascertain with certainty exactly what their competitors (actual or potential) have registered or have applied to register."

This reasoning was reflected in the comments of Geoffrey Hobbs QC in his capacity as the Appointed Person in *Ty Nant Spring Water Ltd's Application* [2000] RPC 55:

"The degree of precision with which the sign is represented must be sufficient to permit full and effective implementation of the provisions of the Act relating to absolute unregistrability (Section 3), relative unregistrability (Section 5), infringement (Section 10) and public inspection of the Register (Section 63). These provisions call for a fixed point of reference: a graphic representation in which the identity of the relevant sign is clearly and unambiguously recorded."

16. The agent has argued that the sign would denote trade origin (in the *prima facie*) if it appeared on a glass panel "*in the form as filed*" and "*if the remainder of the glass panel is clear*". However, it should be noted that the applicant has not applied for a two-dimensional design or pattern which could be etched onto glass panels. The application is for a three-dimensional sign (i.e. a shape), and so in the event of it being published, any third party viewing the mark (for example, via IPO's online search facility, or in the Trade Marks Journal) should be able to understand - from the graphical representation alone - exactly what the trade mark *is*. The representation should stand on its own to identify the trade mark

and one should not have to wonder whether it is something which is going to be etched into a glass panel or whether it is a representation of the panel itself. As stated in *Kerly's*:

“...if undue effort is required to understand the graphic representation, or if the observer is left in a state of uncertainty, it is likely to be an indication that the representation as filed does not adequately represent the sign which lies behind the application.”

17. In applying the *Sieckmann* criteria, I am required to consider whether this representation is ‘clear’, ‘precise’ and ‘intelligible’. If the mark being sought was a two-dimensional image, then the protection conferred by registration would be clear for all. However, as a three-dimensional sign, the parameters of the protection are vague and undefined. As the representation shows only one view of what is - by virtue of it being applied for as a three-dimensional mark - a three-dimensional shape, we do not know the depth of the mark or what it looks like from all sides. We only have one representation showing one side of the mark. The mark is therefore neither clear, nor precise, nor intelligible. I am also required to assess whether the mark is ‘self contained’. In that regard, the representation of the mark should stand on its own, and so will fail the test if one needs to rely on further descriptions in order to identify its nature. It does not, and so the mark fails the *Sieckmann* criteria on at least four counts. In the circumstances, because the section 3(1)(a) objection has been maintained, this effectively puts an end to the application. However, in case I am found to be wrong in this regard, I will go on to determine the matter under section 3(1)(b) of the Act. I am basing my decision in respect of that provision on the single representation of the mark before me.

Section 3(1)(b)

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

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

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

40. For a mark to possess distinctive character within the meaning of that provision it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product from products of other undertakings (see Philips, paragraph 35).

41. In addition, a trade mark's distinctiveness must be assessed by reference to, first, the goods or services in respect of which registration is sought and, second, the perception of the relevant persons, namely the consumers of the goods or services.

According to the Court's case law, that means the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and circumspect (see Case C-210/96 Gut Springenheide and Tusky [1998] ECR I-4657, paragraph 31, and Philips, paragraph 63).

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

19. On the basis of the guidance presented above, it is clear that any assessment of a mark's distinctiveness pursuant to section 3(1)(b) must take into account both the nature of the goods claimed, and the likely perception of the relevant consumer using those goods and services. Only by considering such factors will I be able to determine the likelihood of any potential consumer perceiving the sign applied for as either a distinctive indicator of origin, or simply as an 'origin-neutral' sign.

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

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

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

22. In the present case, the goods claimed cover glassware, building materials made of glass, shower screens, doors etc. I consider it reasonable to assume that the average consumer could include both members of the public seeking to purchase such goods for home improvement purposes, and builders who may be engaged in varying scales of building projects, but I also have to consider that, for building materials, the average

consumer could include those who might influence purchasing decisions, such as architects and designers. The consumer's level of attention is therefore likely to vary according to the cost and scale of the purchase. If the consumer is one who is purchasing goods for a large scale building project, it is likely they will pay a great deal of attention and circumspection when considering their purchase. A lesser degree of attention may be paid by the general public who merely wish to carry out some work on their home, although even in those circumstances, window replacement is a considered and often costly process, and so would involve a reasonable level of attention.

23. Chapter 3 of the current IPO Manual of Trade Marks Practice ('the Examination Guide') provides guidance on the acceptance or otherwise of shape marks. It advises that in order to avoid an objection under section 3(1)(b) and/or (c), a shape mark must be sufficiently different from one which is:

- i) A characteristic of the product;
- ii) The norm or customary in the sector concerned;
- iii) A shape likely to be taken by the product concerned so as to permit an average consumer, without conducting an analytical or comparative examination or paying particular attention, to distinguish the goods concerned from those of other traders. In other words, the shape must not be descriptive, must stand out from the crowd and, in the case of new product developments, must not be a shape likely to be taken for the product concerned.

24. The examiner objected to the mark on the basis that it is a mere representation of the goods. The agent has argued that the mark is not a basic shape, but is an intricate device mark in three, rather than two, dimensions. It has been submitted that the device has numerous distinctive features: it creates "*shapes within shapes*", it has "*a distinctive star shape in the centre*", and it should therefore be viewed as "*a device applied to the products*".¹ However, when a mark has been applied for as three-dimensional, we have to consider the mark in that context and not, as the agent has requested, as a 'device applied to the goods'.

25. The agent also pointed out that the application covers a wide range of goods, and that the examiner has not stated *which* of the goods the mark is meant to represent. Notwithstanding the need for further representations, I can, with an eye to the specifications filed, make an educated guess that the sign is intended to represent a form of glass panel. That being a reasonable assumption, I have to consider whether the average consumer would see this representation of a glass panel as indicating the origin of the goods.

26. As stated above, It is not appropriate to apply more stringent criteria or to impose stricter requirements when assessing the distinctiveness of three-dimensional marks consisting of the shape of the goods (such as the one sought in the present case) than other categories of marks, but I do have to keep in mind that the average consumer is not used to making assumptions on the origin of goods based on the shape of the goods themselves. It may be

¹ See Agent's letter of 23 April 2013

easier to show that a shape has the necessary distinctive character where there is evidence demonstrating that, contrary to the normal assumption made about consumer habits, potential purchasers and/or consumers in the relevant sector do, in fact, rely upon the appearance of the shape of the product or its packaging as a means of identifying the origin of the product. An example of this is the use of vehicle radiator grilles, which can be used by manufacturers as a means of differentiating their products from those of other traders, thereby performing the function of a trade mark. This formed the basis for the Court of First Instance's (now the General Court) judgment in the *DaimlerChrysler 'Jeep grille'* case (T-128/01) where it was found that the appearance of the grille did have the necessary capacity to distinguish the product of that vehicle manufacturer from those of other economic operators in that trade. In this case, no evidence has been put before me to indicate that, in the glass, window and building material sectors, consumers rely upon the appearance of the shape of a product as a means of identifying the origin of that product.

27. As already referred to in paragraphs 7 and 24 above, the agent has claimed that the device has numerous distinctive features such as 'the creation of shapes within shapes' and a 'star shape in the centre'. It may be that the shape has features which are *attractive*. However this is not in itself enough to give the sign any trade mark significance. In this respect, I refer to the comments by Laddie J in *Kabushiki Kaisha Yakult Honsha's Application* (Chancery Division 8 March 2001), in an appeal relating to the application to register the shape of a container, where the judge stated the law to be as follows:

"The fact that a particular design is eye-catching because it is unusual or decorative is not enough by itself. At all times the Registry has to ask whether the design is distinctive as a badge or origin."

I also refer to the comments made in the decision of *Glaverbel v OHIM* (T-36/01) relating to an application to register as a trade mark a design applied to the surface of the goods:

"It must moreover be noted that the fact that the design claimed is complex and fanciful, as was emphasised by the applicant, is not sufficient to establish that it is distinctive. Its complexity and fancifulness are attributable to the ornamental and decorative nature of the design's finish, rather than indicating the trade origin of the goods. In addition, the complexity of the design overall and the fact that it is applied to the external surface of the product do not allow the design's individual details to be committed to memory or the design to be apprehended without the product's inherent qualities being perceived simultaneously. The design claimed is not therefore capable of being easily and instantly recalled by the target market as a distinctive sign."

28. In the *Henkel* case referred to above, it was 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. In the decision of *Louis Vuitton Malletier v OHIM* (C-97/12), similar guidance was provided at paragraphs 51 and 52:

"51. The criteria for assessing the distinctive character of three-dimensional marks consisting of the appearance of the product itself are no different from those applicable to other categories of trade mark. For the purposes of applying those criteria, the

average consumer's perception is not necessarily the same in the case of a three-dimensional mark consisting of the appearance of the product itself as it is in the case of a word or figurative mark consisting of a sign which is independent of the appearance of the products it designates. Average consumers are not in the habit of making assumptions as to the origin of products on the basis of their shape or the shape of their packaging in the absence of any graphic or word element, and it may therefore prove more difficult to establish distinctiveness in relation to such a three-dimensional mark than in relation to a word or figurative mark (order in Wilfer v OHIM, paragraph 53 and the case-law cited).

52. In those circumstances, only a mark which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin is not devoid of any distinctive character for the purposes of Article 7(1)(b) of Regulation No 40/94 (order in Wilfer v OHIM, paragraph 54 and the case-law cited)

29. I have not been supplied with any information to indicate what might be considered the 'norm' in the glass panel trade. However, I do know from my own knowledge and experience that glass panels come with varying degrees of decoration.. As stated in paragraph 25 above, I have made what I consider to be a reasonable assumption, based on the specification and the sign itself, that the mark is a representation of a glass panel and it does not appear that this particular panel departs significantly from other glass panels on the market. See Annex A for some images of decorative glass panels retrieved from a Google search. Although the agent has told me what I should consider the mark to be, she has not provided any examples of the mark in use.

30. The agent has submitted that our perception and assessment of the mark as a 'glass panel' undermines the fact that the 'shape' as presented on the application form actually measures no more than two inches square. I have taken this submission to mean that assumptions on my part regarding the actual size of the three-dimensional shape have distorted my attempts to assess the sign for evidence of inherent distinctiveness. These comments are irrelevant because the size of the shape/product represented by the product is irrelevant. The representation of a mark is not necessarily the size of a mark in use, and in general a registered proprietor may use his mark in any size. As stated in Kerly's, "...for any mark there is a degree of permissible variation in its graphical representation" (fifteenth edition, paragraph 2.049, page 19).

31. In her submissions, the agent stated that "a mark must be examined as filed, without the officers of the Registry imagining or inferring that there is something there which is not, such as a repeating pattern", and went on to mention UK registration number 2530957 consisting of a two-dimensional 'lion's head' device as used by the proprietor, the British Olympic Association. I cannot see that there is any comparison between a two-dimensional, self-contained device, and a three-dimensional mark which, given the goods intended for protection, would appear to be some type of a glass panel. At this point in the decision, I should also emphasise that at no time have the examiner or I raised an objection on the basis that the mark consists of a repeating pattern. Throughout the prosecution of this application, the Registrar has repeatedly based the section 3(1)(b) objection on the mark as filed i.e. a three dimensional shape. At no point have we objected on the basis that the mark is a two-dimensional representation of a repeating pattern.

32. In correspondence, the agent provided me with details of other designated offices which have already accepted this mark. Notwithstanding the substantive harmonisation effected by Council Directive 89/104/EEC (as subsequently codified), the Registrar is still not bound by the decisions of other national offices, as confirmed by the CJEU in its judgement on *Henkel KGaA v Deustches Patent und Markenamt (C-218/01)*, where it stated that:

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

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

Conclusion

33. Taking the above comments into account I conclude that the average consumer, when seeing this mark in respect of glassware, will merely see it as a representation of the goods and would not perceive it as being anything else (such as trade mark, for instance) without first being educated to that effect. I therefore conclude that it is devoid of any distinctive character, and thus is excluded from *prima facie* acceptance under section 3(1)(b) of the Act.

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

Dated this 3rd day of September 2014

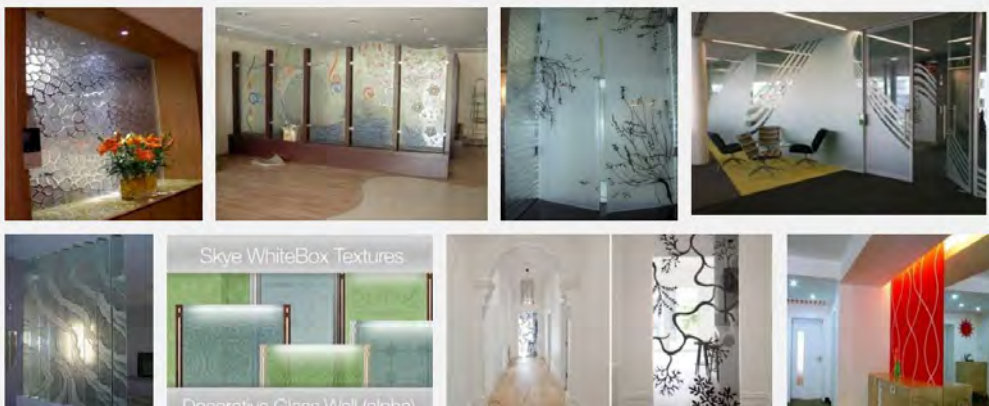
**Linda Smith
For the Registrar
The Comptroller General**

Annex A

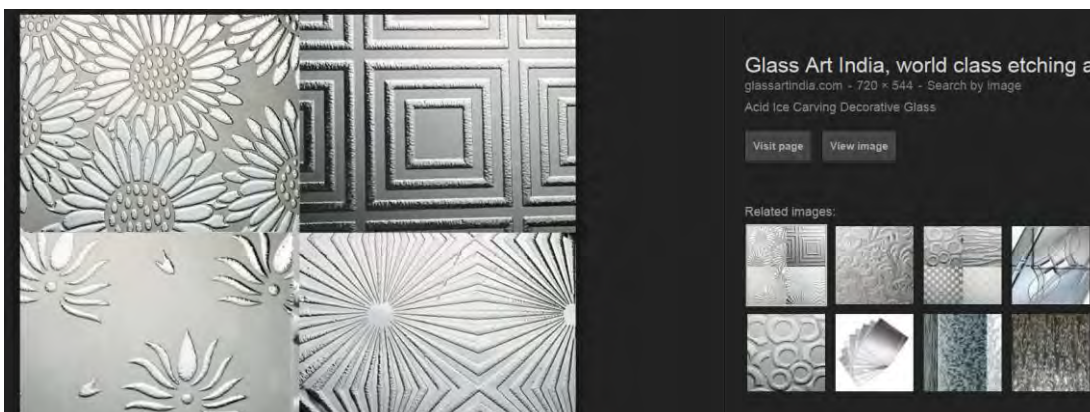
https://www.google.co.uk/search?q=glass+panels&source=lnms&tbn=isch&sa=X&ei=VtQmU4zdKseShgeF7IDQDA&ved=0CAgQ_AUoAg&biw=1237&bih=580#facrc=0%3Bglass%20panels%20for%20doors&imgdii=&imgrc=



https://www.google.co.uk/search?q=glass+panels&source=lnms&tbn=isch&sa=X&ei=VtQmU4zdKseShgeF7IDQDA&ved=0CAgQ_AUoAg&biw=1237&bih=580#q=decorative%20glass%20panels&revid=1290593501&tbn=isch&imgdii=



<http://glassartindia.com/products3.htm>



And from the applicant's own website:

