

O-028-05

**TRADE MARKS ACT 1994
AND
THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996
(AS AMENDED)**

**IN THE MATTER OF INTERNATIONAL REGISTRATION NO 801391
AND THE REQUEST
BY S. OLIVER BERND FREIER GMBH & CO KG
TO PROTECT A TRADE MARK IN CLASSES 3, 9, 14, 18, 20, 25 AND 26**

TRADE MARKS ACT 1994

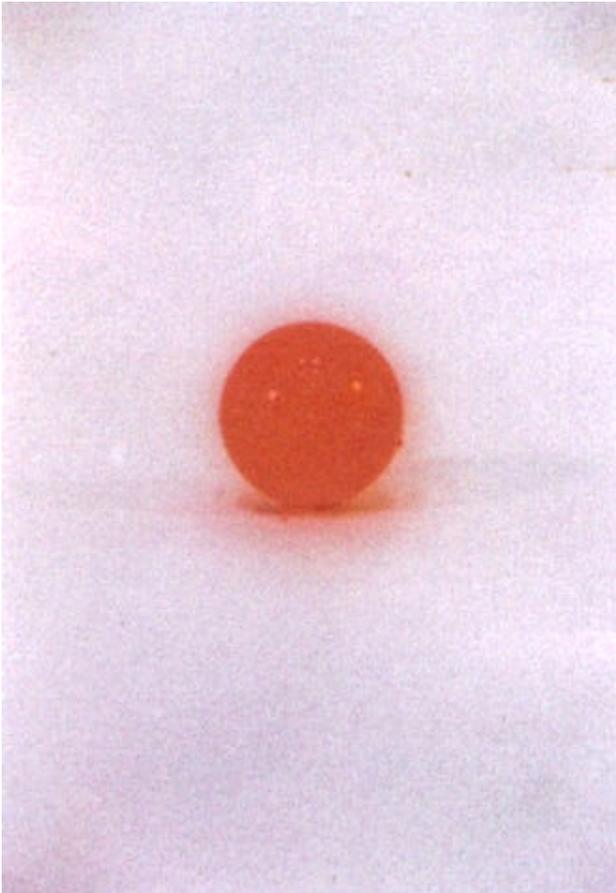
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25 AND 26.**

BACKGROUND

1. On 22nd May 2003, the World Intellectual Property Organisation ('WIPO') notified the United Kingdom of an international registration 801391, in the name of s.Oliver Bernd Freier GmbH & Co KG (the holder) for which protection was sought in the UK under the provisions of the Madrid Protocol. The details of the registration are as follows:



Class 3

Perfumes, essential oils, cosmetics, cosmetic preparations for baths, included in this class; shower gels, deodorant for own use, hair tonic, products for cleaning, care and embellishment of hair, setting lotion, hair colouring, hair tinting, nail polish, nail polish remover, cosmetic sun protection products, dentifrices, non medical mouth and tooth care products.

Class 9

Glasses made of metal and plastic, sun glasses, spectacle cases.

Class 14

Jewellery, in particular fashion jewellery, watches, chronometrical instruments.

Class 18

Products made of leather and imitations of leather included in this class, in particular travelling trunks and suitcases, bags, in particular sport and shopping bags, small leather products, in particular toilet bags, purses, key cases, umbrellas, parasols; products made of plastic and material, namely bags, in particular sports and shopping bags.

Class 20

Furniture, mirrors, frames.

Class 25

Clothing for women and men, including woven and knitted clothing, and clothing made of leather and imitation leather, in particular blouses, shirts, T-shirts, sweatshirts, jackets, pullover, tops, bustiers, trousers, skirts, twin sets, suits, coats, underwear, swimwear, headgear, scarves, headbands, jogging and fitness clothing, gloves, belts for clothing, shoes.

Class 26

Elastic ribbons and hair bands; buttons, hooks and eyelets for clothing, laces and embroideries.

2. The mark is indicated on the international register as a three dimensional mark and the colour claimed is red (RAL 3000). Although there is only one perspective view I have assumed, in the absence of anything stated to the contrary, that the device is a simple red ball of uncertain dimension or material composition.

3. It was considered that the request failed to satisfy the requirements for registration in accordance with Art 3 of the Trade Marks (International Registration) Order 1996 (as amended) and under Art 9(3) of that Order, Notice of Provisional Total Refusal was sent to the holder via WIPO. Such a Notice is issued in accordance with Rule 17(1) and (2) of the Common Regulations under the Madrid Protocol. It constitutes a provisional notice, subject to final confirmation, against which the holder is entitled to argue, subject to the provision of an address for service in the United Kingdom.
4. The ground of refusal was stated as being under section 3(1)(b) in that the mark consisted of a three dimensional device of a 'red ball', being devoid of distinctive character and therefore unable to serve as an indicator of origin.
5. Attorneys based in the UK were subsequently appointed by the holder to contest the provisional refusal.
6. In a letter dated 8th March 2004, they said that the mark in question was a three dimensional red ball and not a two dimensional red circle. Had the mark been two dimensional it would simply have constituted a plain geometrical figure which ought, in accordance with registry practice, to be available for all to use. Being three dimensional however meant that it is not a usual border or outline but rather, in relation to the goods, it is highly unusual. In notional use, attached to the arm of a pair of sunglasses, the neck of a perfume bottle or the zip on a bag or item of clothing, the average consumer would perceive it as a trade mark.
7. This did not persuade the examiner who maintained the objection, saying in a letter dated 25th March 2004 that the average consumer would not perceive it as a trade mark but rather as simple decoration in relation to the goods.
8. Attorneys acting for the holder then asked to be heard, but before that the Registrar asked for information as to how the mark is used or proposed to be used. Although the letter did not state the legal authority for making this request, it is rule 57 of the Trade Marks Rules 2000 as amended which reads:

“Registrar's power to require documents, information or evidence
57. At any stage of any proceedings before the registrar, she may direct that such documents, information or evidence as she may reasonably require shall be filed within such period as she may specify.”
9. This rule is often used by the registry in both domestic and Madrid prosecutions to illicit information from an applicant/holder which may then assist with the examiner's consideration of the case. Rule 57 'evidence' is not to be equated with 'evidence of use', supporting a case of acquired distinctiveness, and nor should it be regarded as decisive, of itself, of the case for registration.
10. The attorneys responded to the request under rule 57 by letter of 14th July 2004, providing samples of clothing, brochures and photographs showing the mark in use in Germany. Annex A (i- iv) comprises photographs I have arranged in the registry of the items of clothing supplied by the agent showing the sign. Annex A (iii) and (iv) can be referred to provide an idea of the size of the sign in question

in relation to the whole garment. Annex B (i-ii) comprises copies of photographs supplied by the agent. Annex B(ii) shows that the sign is not only affixed as a seemingly non-functional 'tag', but has been incorporated as part of a zip.

11. This failed to persuade the examiner who wrote on 20th July 2004 saying that the red circular device appeared to only serve a decorative purpose, the goods being sold by reference to the predominant verbal trade mark 's.Oliver (stylised)' or 's.Oliver SPORTS' – the letter 'O' being infilled in red.
12. I would mention at this point that in my view the rule 57 evidence filed by the attorney does not show the mark which is the subject of the international registration. The evidence of the mark as used shows, in the main, a small plastic tag affixed to the clothing with a red dot impressed in the centre. As an alternative configuration, the red dot is seen to be incorporated into a zip. There is also evidence of a red dot being used to infill the letter 'O' in the word SPORTS on the clothing. Importantly however it is not a red ball that is shown in use but rather a red dot. It will be recalled that the mark on the international register comprises a three dimensional red ball of uncertain dimensions or composition. The legal effect, if any, of this observation will be considered below in my decision.
13. The attorneys then withdrew their request for a hearing, asking that final decision of refusal should be issued from which they could decide whether or not to appeal. No hearing took place. The registry issued a standard letter of refusal known as a RAPP 12, which invited the attorneys to file a Form TM5 and fee in order that the registry may supply a full reasoned statement of grounds which can then be appealed. Form TM5 and fee has been filed and in accordance with the request, this decision comprises the statement of grounds for refusal.

DECISION

14. The only ground for refusal is section 3(1)(b) which reads:

“Absolute grounds for refusal of registration

3- (1) The following shall not be registered –

(a).....

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

15. Section 3(1)(b) has been summarised by the European Court of Justice in paragraphs 37, 39 to 41 and 47 of its Judgment in Joined Cases C-53/01 to C-5501 Linde AG, Windward Industries Inc and Rado Uhren AG (8th April 2003) in the following terms:

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

.....

39. Next, pursuant to the 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*, para 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 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, para 31 and *Philips*, para 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 other undertakings.”
16. The case for registration, as argued in correspondence, thus rests on the simple submission that the three dimensional red ball would, from the relevant consumer perspective be unusual and therefore perceived as a trade mark. The case against registration, so far stated, relies on the belief that the relevant consumer would be more likely to see the red ball as purely decorative.
 17. No ‘formal’ evidence or other submissions have been presented by the registry or by the holder. Therefore I only have the prima facie case to consider.

The rule 57 information

18. The case for or against registration must be confined to the mark which is the subject of international registration which, as I have said, is a three dimensional red ball of uncertain dimension or material composition. The evidence, more properly ‘information’, supplied by the attorneys regarding use of the sign in Germany must not deflect from or prejudice examination of the registration as it stands on the international register.
19. I have already observed that the material supplied under rule 57 does not, in my view, show the mark as registered, but this finding of itself is not determinative of

the request for protection. It simply means that the only material on which to base my decision is the registration itself and the submissions made in support of protection.

Submissions and argument

20. The attorneys' main submission is that a red ball, attached to for example glasses, would be 'unusual', so unusual in fact that the relevant consumer, the general public in this case, would perceive it to be a trade mark.
21. This submission rather takes the case away from the normal 'shape' mark. Where shapes are sought to be registered, it is more common for them to either represent the goods themselves or their packaging. The European Court of Justice in *Proctor and Gamble v OHIM* Joined Cases 468/01 P to 472/01 P and in *Henkel C-218/01* has pronounced on such shape applications, saying that to be registrable they must differ significantly from the norms or customs of the sector.
22. In accordance with the *Linde* case, firstly I am required to identify the average consumer in relation to the goods applied for. This is straightforward enough; it must be the general public.
23. Secondly, and this is much harder in a case such as this which contains a wide specification, I need to consider what the average consumer's perception would be on seeing this sign in use in relation to all the goods of the specification. This is particularly difficult as there has been precious little argument in relation to the specific goods of the specification. What follows must, of necessity, take account of my own general knowledge in relation to these goods.
24. Concerning the class 3 goods, the goods of this sector may be packaged in ball shapes or, in relation to soaps or bath 'ballistics' for example, actually be produced in ball shapes. It could well be that in normal and fair use, the red ball could be attached to a perfume bottle or other class 3 container, but as such, I believe that the average consumer would only see it as a packaging embellishment of no 'origin' significance. I have come to the conclusion that in relation to any of the class 3 goods, the shape is not substantially different from the norms or customs of the sector. That is, norms and customs in relation to the packaging used to house such goods or the shape they are actually produced in.
25. In relation to the more mundane class 9 goods, it is more arguable. Certainly, I can see that as an attachment to glasses or their cases it would be visually unusual. Being unusual or memorable however is not the legal standard (see eg para 10 *Yakult's Trade Mark Application* [2001] RPC 39, recently approved in *Bongrain SA's application* [2004] EWCA Civ 1690) but rather whether, *by itself*, the shape's appearance would convey trade mark significance to the average consumer. This is a simple banal shape. Even if I were to accept that being unusual were the standard, I would have to ask what exactly was unusual, the shape *itself*, or the fact it was attached to the glasses? Taking the best view I can, I do not believe that this sign, meets the required threshold in relation to the class 9 goods.

26. As regards the class 14 goods, I think the case against registration is very strong in relation to jewellery. Earrings for example frequently comprise this sort of shape. As regards watches and chronometrical instruments, I think the reasons given in relation to glasses above apply also to these goods. Certainly the sight of a red ball dangling from a watch or clock may be unusual but this isn't the test.
27. As regards the goods of class 18, my concern here lies in the fact that such bags have fasteners to which the red ball could be attached, or the red ball could simply form part of the fastener itself. As such, a trade mark function is unlikely to be served. This is less arguable in relation to travel trunks, suitcases, umbrellas and parasols but I am not sufficiently confident to rule out the possibility that such a sign would not be used purely decoratively for these goods as well.
28. As for the goods of class 20, as with class 9 and 14, I can see that in relation to furniture such a sign as an attachment would be unusual. Less so with mirrors and frames perhaps, which may well be decorated with balls. Despite this, and for the reasons given in relation to class 9 and 14, I feel that the mark would not function as a trade mark.
29. In class 25, the main difficulty lies in the fact that such goods routinely have decorative buttons or fasteners, both of which could take the form of red balls. Shoes, such as moccasins and loafers, often have decorative attachments to the 'in step', or have decorative laces. Because of this I am not confident enough to find that it would be beyond the realms of probability that the norms and customs of this sector would include red ball attachments.
30. Finally, in class 26, these items could also take to the form of decorative red balls, or otherwise have red balls attached for purely decorative reasons. I am thinking especially of hair accessories and buttons.
31. To sum up, I have tried to consider the norms and customs of the trade in relation to all goods applied for, and how those norms and customs might effect the perception of the average consumer in relation to all goods specified. This is what the authorities tell me I must do. The objection is clearly strongest where the goods themselves may well comprise a red ball shape, or be packaged in that shape, or where a red ball attachment would be simply seen as decoration. Even for those goods where the objection does not obviously apply, I have nevertheless concluded that practically speaking, such a mark would not convey an 'origin message'.

CONCLUSION

32. Consideration of this international registration has been hampered by a lack of certainty in relation to the mark as registered on the international register. It would have been clearly in the holder's best interests had the representation on the register more closely matched the precise sign for which protection was in fact sought, as shown in actual use by the rule 57 information. That is not to say that such a sign would necessarily be registrable.
33. As it is, I have been constrained to pass judgment on a simple red ball of uncertain dimension or material composition.
34. I am not persuaded that the relevant consumer's perceptions of this sign in relation to the goods applied for would lead them to a conclusion that the sign indicates origin.
35. In this decision I have considered all the documents filed by the holder and all the arguments submitted to me in relation to the international registration and, for the reasons given, it is refused under the terms of Articles 3, 9(3) and 11(5) of the Trade Marks (International Registration) Order 1996 (as amended) because it fails to qualify under section 3(1)(b) of the Act.

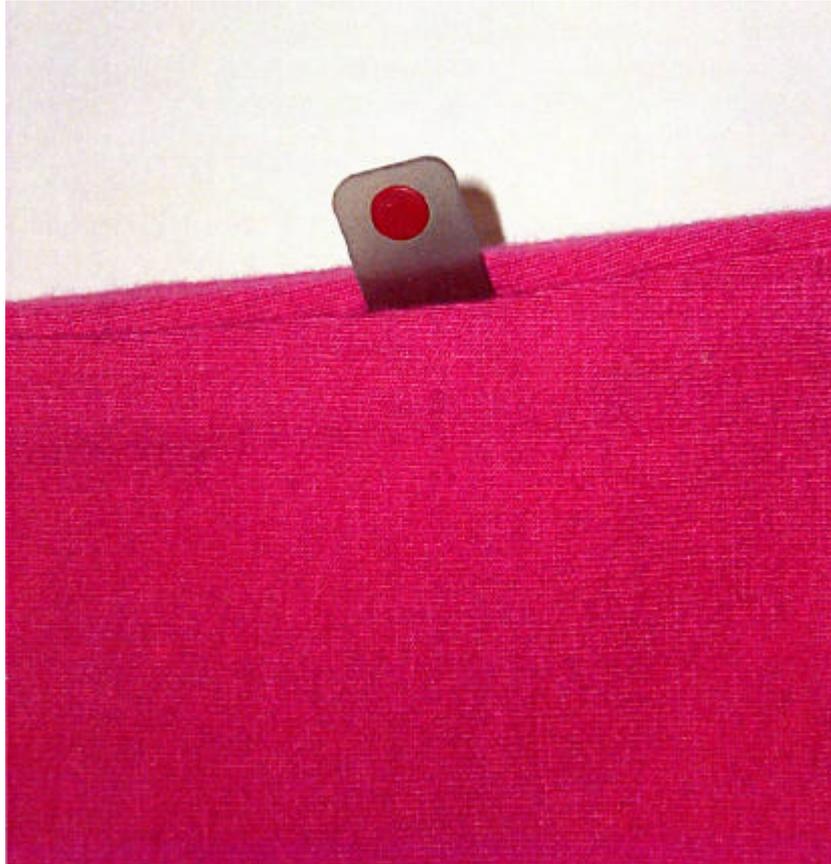
Dated this 27th day of January 2005

**Edward Smith
For the Registrar,
The Comptroller-General**

ANNEX A (i)



ANNEX A (ii)



ANNEX A (iii)



ANNEX A (iv)



ANNEX B (i)

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ANNEX B (ii)

roter ball-zipper.ufo

