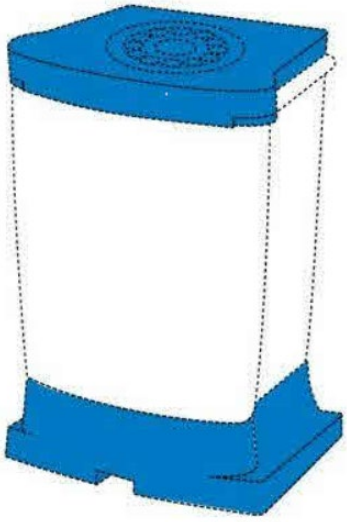
BL O/0841/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER 3817184

BY CEPHEID

TO REGISTER THE FOLLOWING MARK IN CLASSES 9 and 10



The mark was applied for as a 'figurative' mark and included the following mark description:

The mark consists of the colour blue, Pantone reference PMS 300, applied to the cap and base of a container. The black broken or dotted lines are not part of the mark and serve only to show the position or placement of the mark.

Background

1. On 5 August 2022, Cepheid ("the applicant") applied to register the above figurative mark for the following goods in Classes 9 and 10:

Class 9
Laboratory equipment, namely, reaction vessels, fluidic blocks for preparing and processing biological samples, cartridges for preparing and processing biological samples.

Class 10
Clinical and medical equipment, namely, reaction vessels, fluidic blocks for preparing and processing biological samples, cartridges for preparing and processing biological samples.

2. Initially there was some uncertainty as to what constituted the mark because the dotted lines appearing within it are generally used to indicate elements that do not form part of the mark. This was subsequently satisfied with the addition of the mark description as above.

3. On 5 December 2022 the Intellectual Property Office ("IPO") issued an examination report in response to the application. In that report, an objection was raised under sections 3(1)(b) of the Trade Marks Act 1994 ("the Act"):

> *Section 3(1)(b)*
>
> *The application is not acceptable in Classes 9 and 10. There is an objection under Section 3(1)(b) of the Act as the mark is devoid of any distinctive character. This is because the mark is a representation of a container with nothing more than the colour blue applied to the surface of the container. It is considered that consumers are not in the habit of perceiving colour applied to the surface of the lid and bottom of a container as a trade mark originating from a single source. The colour would simply be seen as a visual element of the goods rather than as a distinctive element. It is for this reason that an objection must be raised.*

4. In line with standard IPO procedure, a period of two months was allowed for the applicant to respond.

5. On 26 January 2023 the attorney Lane IP Limited, acting on behalf of the applicant, requested a hearing.

6. The hearing took place on 23 February 2023 with the Hearing Officer, myself, acting for the Registrar and Mr Mark Hickey of Lane IP limited, representing the applicant. The objection was maintained at the hearing and the report issued on 24 February 2023 with a period of two months allowed for Mr Hickey to consider the option of filing evidence to demonstrate that the mark had acquired distinctiveness through use.

7. On 24 April 2023 a Form TM9 (Request for an extension of time before the period has expired) was received requesting a further two months in which to compile and submit the evidence. The extension was agreed and a new response date set at 4 July 2023.

8. On 22 June 2023 a further request to extend the response period by four weeks was received to obtain additional UK specific evidence. This was agreed by the hearing officer and a new response date set at 1 August 2023.

9. At the expiry of the response date, no evidence had been submitted so on 14 August 2023 the application was formally refused.

10. A form TM5 (Request for a statement of reasons for registrar's decision) was received on 16 August 2023.

11. Having received a request for a statement of reasons for the registrar's decision, I am now obliged to set out the reasons for my decision. As no evidence of acquired

distinctiveness was filed, I am basing my decision solely on the inherent distinctiveness of the mark.

The Law

12. The relevant parts of section 3 of the Act read as follows:

> *3.-(1) The following shall not be registered –*
>
> *(a) …*
>
> *(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 relevant legal principles

13. The principles to be applied under article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation, and is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act) were conveniently summarised by the CJEU in OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG (C-265/09 P) as follows:

> "*29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P Henkel v OHIM [2004] ECR I-5089, paragraph 32).*
>
> *30. Under that provision, marks which are devoid of any distinctive character are not to be registered.*
>
> *31. According to settled case-law, for a trade mark to possess distinctive character for the purposes 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 those of other undertakings (Henkel v OHIM, paragraph 34; Case C-304/06 P Eurohypo v OHIM [2008] ECR I-3297, paragraph 66; and Case C-398/08 P Audi v OHIM [2010] ECR I-0000, paragraph 33).*
>
> *32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been*

applied for and, second, by reference to the perception of them by the relevant public (Storck v OHIM, paragraph 25; Henkel v OHIM, paragraph 35; and Eurohypo v OHIM, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P KWS Sat v OHIM [2004] ECR I-10107, paragraph 78; Storck v OHIM, paragraph 26; and Audi v OHIM, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P Proctor & Gamble v OHIM [2004] ECR I-5173, paragraph 36; Case C-64/02 P OHIM v Erpo Möbelwerk [2004] ECR I-10031, paragraph 34; Henkel v OHIM, paragraphs 36 and 38; and Audi v OHIM, paragraph 37)."

14. I refer also to the *CJEU's* judgment in Libertel Groep BV and Benelux-Merkenbureau, Case C-104/01 and in particular paragraphs 64 to 67 which refers to colour marks as follows:

"64. Account should be taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect picture of them that he has kept in his mind (see, in different contexts, Lloyd Schuhfabrik Meyer, paragraph 26, and Case C-291/00 LTJ Diffusion [2003] ECR I-2799, paragraph 52).

65. The perception of the relevant public is not necessarily the same in the case of a sign consisting of a colour per se as it is in the case of a word or figurative mark consisting of a sign that bears no relation to the appearance of the goods it denotes. While the public is accustomed to perceiving word or figurative marks instantly as signs identifying the commercial origin of the goods, the same is not necessarily true where the sign forms part of the look of the goods in respect of which registration of the sign as a trade mark is sought. Consumers are not in the habit of making assumptions about the origin of goods based on their colour or the colour of their packaging, in the absence of any graphic or word element, because as a rule a colour per se is not, in current commercial practice, used as a means of identification. A colour per se is not normally inherently capable of distinguishing the goods of a particular undertaking.

66. In the case of a colour per se, distinctiveness without any prior use is inconceivable save in exceptional circumstances, and particularly where the number of goods or services for which the mark is claimed is very restricted and the relevant market very specific.

67. However, even if a colour per se does not initially have any distinctive character within the meaning of Article 3(1)(b) of the Directive, it may acquire such character in relation to the goods or services claimed following the use

made of it, pursuant to Article 3(3) of the Directive. That distinctive character may be acquired, inter alia, after the normal process of familiarising the relevant public has taken place. In such cases, 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 (Windsurfing Chiemsee…)."

Application of the law

15. The mark consists of the colour blue, Pantone reference PMS 300, applied to the cap and base of a container. The application covers Classes 9 and 10.

16. In *Libertel* the CJEU confirmed at paragraph 16 that a colour *per se* is capable of constituting a trade mark providing it satisfies the following requirements: 1. That it is a sign; 2. That it is capable of being represented graphically; and 3. That it is capable of distinguishing the goods and services of one undertaking from another. It is my view that the mark satisfies requirements 1 and 2 but not requirement 3. Furthermore, in paragraph 66, as above, it is held that distinctiveness of a colour, without any prior use, is inconceivable except in exceptional circumstances.

17. The distinctiveness of a mark must be assessed by reference to all of the goods or services on which it is to be used. Depending on the nature of the goods or services and how the consumer will perceive them might result in a different outcome. The goods in Class 9 are "*Laboratory equipment, namely, reaction vessels, fluidic blocks for preparing and processing biological samples, cartridges for preparing and processing biological samples"* and those in Class 10 are "*Clinical and medical equipment, namely, reaction vessels, fluidic blocks for preparing and processing biological samples, cartridges for preparing and processing biological samples".* The goods are homogenous, in my view. By this I mean that, on the face of it, although they are specialised, there are no obvious grounds for me to make any clear distinction between the goods, such that would render my overall finding in relation to trade mark capacity any different. This would entitle me to provide general reasoning as to the distinctiveness of the mark (C-239/05 *BVBA management, Training en Consultancy v Benelux-Merkenbureau* para 38)

18. The attorney submitted that due to the specialist nature of the goods, the consumer would levy a high level of attention at them. I accept, as I have said, they are specialist goods that would not be purchased by the general public but are those for which the relevant consumer will be professionals working in laboratories and those in the medical profession. But whilst these goods are specialist and the attention paid to their purchase higher than may be the case with everyday consumable items, this fact would not displace the legal presumption that the mark is but a characteristic of the product itself and the law tells us that in such circumstances consumers are not in the habit, or predisposed to, regarding such a feature as a trade mark (Libertel, paragraph 65).

19. Thus, having considered the kind of goods included in this application and the level of attention the relevant consumer will afford the mark, I must consider if, in

normal and fair use the mark has any capacity in the *prima facie* to distinguish the goods of one provider from those of another.

20. The mark comprises of the colour blue applied to the cap and base of a container. There is nothing to suggest any unusual nature of the container itself, including its scale or dimensions which are not evident. There is nothing either to suggest that colour of any sort would itself be in any way unusual in such context or that the colour blue, being a simple primary colour, would be unusual, let alone impart or suggest trade mark origin. I am left, then, with the inevitable conclusion that in my view the sign as filed is, or would be considered to be, but a feature of the product. The European Courts have provided guidance in respect of similar types of marks, for example, T-187/19 *Glaxo Group Ltd v EUIPO* (Purple colour inhaler), C-49/02 *Heidelberger Bauchemie,* T-547/08 *X Technology Swiss GmbH v OHIM* (orange toe of a sock), with the overall conclusion being that signs of this nature are, in the prima facie, unlikely to perform the essential function of a trade mark because the relevant consumer is likely to perceive the mark as either purely decorative or functional with little inherent capacity to communicate specific information. Consequently, I am of the opinion, and taking into account of the legal presumption I have mentioned, that in regard to this sign, the relevant consumer would not afford the colour blue in the positions indicated on the product any trade mark significance.

21. I conclude that the mark as applied for is inherently non-distinctive and without education, the relevant consumer will not perceive it as a sign designating the goods as those originating from a single undertaking.

Conclusion

22. In this decision, I have considered the 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 section 3(1)(b) of the Act.

Dated this 6th day of September 2023

Deborah Steele
For the Registrar
The Comptroller-General