

O/086/19

TRADE MARKS ACT 1994

TRADE MARK REGISTRATION No. 2060882

IN THE NAME OF FROMAGERIES BEL S.A.

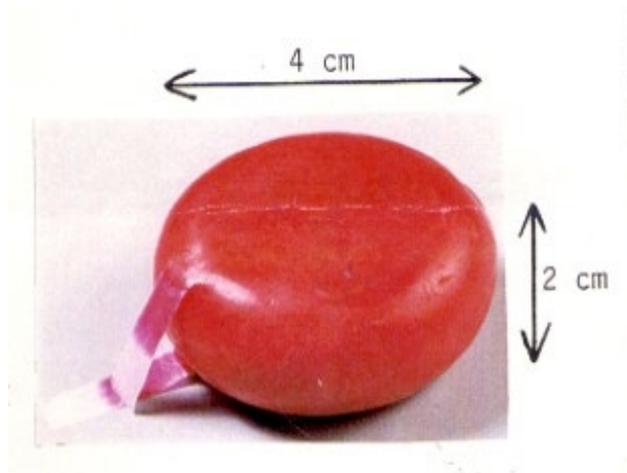
AND

APPLICATION No. 501849 BY J. SAINBURY PLC

TO INVALIDATE THE REGISTRATION OF THE TRADE MARK

Background and pleadings

1. This is an application filed on 26th October 2017 by J Sainsbury plc (“the applicant”) to invalidate the registration of the trade mark shown below.



2. The trade mark is described as follows.

“The mark is limited to the colour red. The mark consists of a three dimensional shape and is limited to the dimensions shown above.”

3. Fromageries Bel S.A. (“the proprietor”) applied to register the mark on 12th March 1996 (“the relevant date”). The mark was entered in the register on 29th August 1997. The mark is registered in class 29 in relation to *cheese*.

4. The application to invalidate the trade mark is made under section 47(1) of the Trade Marks Act 1994 (“the Act”). The original grounds for invalidation were that the trade mark does not comply with the requirements of:

- (i) Section 3(1)(a) of the Act because the mark consists of the goods themselves in an unadorned red wax/plastic wrapper which is customary in the trade.
- (ii) Section 3(1)(b) because the mark consists exclusively of the shape of the goods themselves and is devoid of any distinctive character.
- (iii) Section 3(1)(b) because the trade mark is not graphically represented, as required.

- (iv) Section 3(1)(c) because (a) it is customary to preserve cheese in wax/plastic wrapping, (b) certain Dutch cheeses are particularly associated with this type of wrapping, (c) the dimensions used in the representation of the mark indicate the amount of cheese in the product; therefore, the mark designates the kind, quality, quantity and/or geographical origin of the goods.
- (i) Section 3(1)(d) because the trade mark consists exclusively of a sign which has become customary in the current language or in the *bona fide* and established practices of the trade.
- (ii) Section 3(2)(a) because the trade mark consists exclusively of a shape which results from the nature of the goods themselves.
- (iii) Section 3(2)(b) because the trade mark consists exclusively of a shape which is necessary to achieve a technical result.
- (iv) Section 3(2)(c) because the trade mark consists exclusively of a shape which gives substantial value to the goods.

5. The proprietor filed a counterstatement denying the grounds for invalidation. Insofar as the application under s.3(1)(b) was based on the alleged defective graphical representation of the mark, the proprietor pointed out that the ground was misconceived because s.3(1)(b) is not relevant to such matters. Insofar as the application was based on an allegation that the trade mark lacked inherent distinctiveness, the proprietor indicated that, if necessary, it relied on its substantial use of the mark in the UK and the consequential acquisition of distinctiveness through use.

Representation

6. The applicant is represented by Lewis Silkin LLP. The proprietor is represented by HGF Limited.

Case management

7. A case management conference (“CMC”) was held on 24th January 2018. David Ivison took part as counsel for the applicant. Lee Curtis of HGF represented the

proprietor. Following the CMC, I issued directions to the parties identifying the relevant issues and setting limits on the volume of evidence that could be filed. This included a requirement that evidence going to the trade mark's inherent distinctive character should be directed to the position at the relevant date in 1996. In response to a request made at the CMC (that expert evidence should be permitted going to the matters covered by the s.3(2) grounds for invalidation), I directed the parties to try and agree one suitable expert witness.

8. On 16th February 2018, the applicant's representatives wrote a letter indicating that the grounds for invalidation would be narrowed. The grounds under ss.3(1)(a) and (d) of the Act were to be dropped. However, despite the proprietor having pointed out in its counterstatement that s.3(1)(b) was not relevant to an alleged lack of graphical representation, the applicant indicated that it still intended to pursue this claim as one of the grounds for invalidation based on s.3(1)(b).

8. On my instructions, the caseworker wrote to the applicant on 19th February 2018 pointing out that, as was clear from ss.1 and 3 of the Act, s.3(1)(b) was plainly an inappropriate legal ground for the complaint about the alleged lack of graphical representation of the trade mark. That matter could only be pursued under ss.1(1) and 3(1)(a) of the Act.

9. The applicant responded to that communication on 14th March, thanking the registrar for pointing out the error in its pleadings and asking the registrar to issue further directions setting out the evidence which would be allowed to support the narrowed grounds for invalidation. In the absence of such directions, the applicant's representatives indicated that the applicant would pursue all the original grounds.

10. As the directions issued following the CMC set maximum limits on the issues and volume of evidence, it did not appear to me that narrowing the pleadings required further directions about evidence. Therefore, beyond pointing out that no evidence was required to support the grounds that were no longer being pursued, I declined to issue further directions. However, in view of the chaotic and unhelpful way in which the application was being pursued, on 26th March 2018, I directed the applicant to clearly state which issues were being pursued and under which legal provisions.

11. The applicant did so on 1st May 2018 at the same time as filing its evidence-in-chief. The applicant dropped its grounds under ss.3(1)(b), (c) and (d) of the Act. The ground based on s.3(1)(a) was amended to a claim that the trade mark does not satisfy ss.1(1) and 3(1)(a) of the Act because it is not graphically represented. The grounds under s.3(2) were maintained.

12. The caseworker wrote to the proprietor on 30th May 2018 stating that the registrar proposed to accept the revised pleadings and move forward accordingly. This prompted a response from the proprietor's representatives dated 6th June 2018 which stated that:

- The proprietor had not been sure, prior to receiving the registrar's letter of 30th May, which grounds the applicant was being permitted to pursue;
- Now that the revised grounds were clear, it was necessary to revise the period allowed for the proprietor to file evidence so that it could be directed to the remaining grounds;
- The proprietor had started to prepare evidence showing that the mark had acquired a distinctive character through use, which was useless now that the s.3(1)(b), (c) and (d) grounds had been dropped;
- The applicant's conduct should be taken account of when it comes awarding costs.

13. The deadline for the proprietor to file its evidence was amended from 1st July 2018 to 16th July 2018. The proprietor's request to reset the date to 1st August 2018 was rejected. This was because although narrowing the pleaded grounds appeared to have wasted time and costs, it had not prevented the proprietor from collecting evidence going to the grounds still pursued.

The evidence

14. The applicant's evidence consists of two witness statements by Nicholas Walker, a partner at Lewis Silkin (the second of which was filed in reply to the proprietor's

evidence), and one by Katherine Lynch, who is a Product Developer at Sainsbury's supermarkets.

15. Ms Lynch describes her relevant experience like this:

"I have a First class (honours) degree in Natural Sciences (Chemistry and Biochemistry) from the University of Leeds. I have been employed by Sainsbury's since 2013 and have worked in the area of cheese for Sainsbury's since 2015.

Between August 2015 and January 2017, I worked as a Product Technologist for yoghurts, seasonal and snacking cheese. Since January 2017, I have worked as a Product Developer for the whole of the cheese market.

My roles have involved recipe development, product launches and product consistency as well as attending cheese shows and working with suppliers and manufacturers in the development of cheese products."

16. Ms Lynch's evidence is as follows:

"The production and shape of Mini Babybel

7. I have seen two videos which describe how Mini Babybel cheese is produced [Youtube reference provided] (the "Unwrapped Video") and [Youtube reference provided] (the "Food Factory USA Video"). These videos were shot at manufacturing facilities for Mini Babybel in the United States and feature employees of Bel Brands USA. Screen shots from the videos are at pages 1 to 17 of Exhibit KL 1 and copies of the videos are on the USB stick at Exhibit KL2.

8. From these videos, my understanding is that milk is heated and an enzyme added in order to coagulate it and then separate it into curds and whey. The curds are drained and then put into moulds, where each mould is the diameter

of an individual Mini Babybel cheese. The moulds are then covered with lids and pressed under high pressure. This is how each Mini Babybel cheese gets its rounded disc shape.

9. The cheeses are then left to ripen, following which they are removed from their moulds, bathed in salted water and then dried. After being removed from the moulds, the cheeses are moved along conveyer belts without any coating or moulds to protect them. I believe that the round shape makes the cheeses easier to handle in mass production at this stage. If they were square or rectangular in shape, the corners would provide more potential fracture points, increasing the likelihood of the cheeses becoming damaged during production.

10. After the cheeses have dried, the red wax coating is added. While this is not shown in the videos, the audio in the Unwrapped Video (at 3:40 to 3:50) refers to the cheese being "double-dipped"; first it is dipped in clear wax to seal the cheese and then it is given its red colour. I understand from this that the cheeses are twice dipped into liquid wax, which is then allowed to set.

11. The wax coating simply follows the form of the underlying Mini Babybel cheese and adopts the same shape as the cheese.

12. Between 3:45 and 3:50 of the Unwrapped Video, the cheeses are shown hanging from clear tape. This appears to be the pull-tag (i.e. the tear-away strip which is used to open the wax coating) which has been set into the wax. The pull-tag therefore appears to serve two functional purposes. First, it is used to suspend and dip the cheese during the waxing process and then it serves as a means for consumers to pull the wax coating apart to access the cheese without using a knife.

13. I believe that the process of making Mini Babybel outlined at paragraphs 8 and 9 above is a standard method of cheese production. The majority of cheeses would use larger moulds but the method itself appears to be a standard method.

Cheese shapes

14. In my experience, cheeses are often produced and sold in a round shape. One of the reasons for this is that the homogenous nature of a round shape means that moisture can drain consistently across the cheese during its production. If cheese is made in square or rectangular shapes with corners, there is a risk that, during the drying process, the corners will dry more quickly and become crispy while the centre is still draining. I believe this would apply to smaller cheeses as well as larger ones.

15. In addition, a round mould provides a more even surface for ripening the cheese meaning that rounded cheeses are less likely to be over-ripened than square or rectangular cheeses. See more detail on why cheese is often round at [internet reference provided], an extract of which is at page 18 of Exhibit KL1.

Waxed cheeses

16. Wax is a traditional method of preserving cheese. A wax coating forms a good barrier to keep air and moisture off the cheese so that it does not go mouldy. In the Unwrapped Video, Shantel Moses, Senior Brand Manager for Mini Babybel in the US, states (at 3:55) that the wax forms a protective layer on the Mini Babybel product which seals in the freshness. While this could also be achieved by using a plastic shrink-wrap covering, I am not aware of any alternative that could be used which would coat the cheese in the same way as the wax does.

17. A rounded shape is best for cheeses that are going to be covered in wax, as the homogenous shape allows the wax to cling evenly all around the cheese. If square or rectangular cheeses are covered in wax, the wax may be thinner around the corners which can cause the wax to crack along these points. A shape with corners would also increase the likelihood of the wax cracking or becoming damaged during mass production when the cheeses are transported along conveyor belts.

18. Because there is no realistic alternative way of coating Mini Babybel, the need to use wax effectively means that a round shape must be used for Mini Babybel to minimise the risk of damage to the wax.

19. Another example of cheese which is traditionally produced and sold in a round shape with a red wax coating, similar to that of Mini Babybel, is Edam cheese. Various sources indicate that Edam has been sold in this way since at least the 14th century (see for example the extracts at pages 19 and 20 of Exhibit KL1). See also example images of Edam cheese at pages 21 and 22 of Exhibit KL1. Aside from the pull-tag which serves a functional purpose, as set out at paragraph 12 above, I do not believe that the wax coating applied to Mini Babybel goes beyond what has been done with Edam cheeses for centuries.

20. I have seen videos of cheese being waxed by being dipped into liquid wax [Youtube references provided]. Screenshots of these videos are at pages 23 and 24 of Exhibit KL1 and copies of the videos are on the USB stick at Exhibit KL2. It can be seen from these videos that the wax covering follows the form of the underlying cheese and adopts the same shape as the cheese.

Portion size

21. On its website at [internet reference provided], Babybel states that one Mini Babybel equates to one dairy portion out of the three daily recommended (see page 25 of Exhibit KL 1). There are 61 kilocalories in each portion (see page 25 of Exhibit KL 1) which makes it a good size for a snack.

22. My experience at Sainsbury's indicates that consumers place value on having products already formed into exact portion sizes so that they know exactly how much of a product they or their children are eating and so that the portion size is already worked out for them. Consumers also value convenience and products that allow them to snack "on the go". This is supported by data I have seen in a document put together by one of

Sainsbury's buyers that indicates that the total snacking market is currently worth £220 million and is expected to grow to £300 million by 2020.

23. I believe that parents also value products which are easy for children to manage, without complicated packaging to remove, and products which reduce wastage. This is shown by the following statement which appears on the Babybel website: "Our individual cheese portions require no cutlery and give children independence when unwrapping and eating, while the uneaten portions are protected and preserved until their "best before" date." (see page 25 of Exhibit KL1)."

17. Mr Walker's witness statement is mainly submissions. I return to the legal arguments below. It is sufficient to record the following points from his evidence.

18. Mr Walker says that, as far as he is aware, the purchasing public never see just the waxed cheese in the form shown in the trade mark registration. This is because the cheese is always covered by two, sometimes three, layers of "*branding*." These are (a) a branded wrapper for the cheese, (b) a net bag with a swing tag, and (c) a branded box within which the wrapped and netted cheeses appear on shop shelves. In support of his claim, Mr Walker exhibits a picture showing that this is how the proprietor's Mini Babybel product (the appearance of which is said to be represented by the contested mark) appears in a retail environment.¹

19. According to Mr Walker, the cheese product sold under the word mark Mini Babybel is 4.2cm in diameter and 1.5cm deep.² This contrasts with the dimensions shown in the representation of the contested mark of 4cm by 2 cm. Mr Walker claims that this supports the applicant's claim that it is not clear from the representation what these dimensions relate to.

20. Pages 4 and 5 of exhibit NW1 to Mr Walker's statement consist of copies of pages from the Pantone website returned by a search on the term 'red'. The

¹ See page 1 of exhibit NW1

² See pages 2 and 3 of exhibit NW1

applicant relies on this to show that there is a spectrum of shades of colour covered by the description 'red'.

21. Mr Walker also exhibits a copy of an article explaining why the same colour looks different on different computer monitors.³

22. The proprietor's evidence consists of three witness statements by Michelle Bamford, the Regulatory and Technical Affairs Manager of Bel UK Ltd, Elise Merlet, who is a patent engineer employed by the proprietor, and Rebeca Field, who is a trade mark attorney with HGF Limited.

23. The main points from M. Bamford's statement of 12th July 2018 are that:

- The Mini Babybel cheese product was introduced in the UK in 1981 and has been sold throughout the UK for 37 years;
- The shape, colour, size and pull-tab, as per the contested mark, has been used to promote the product in the UK;
- In 2017, over a billion Mini Babybel products were consumed in the UK;
- The pull-tag is part of an "*opening ritual*" of the product for the consumer;
- Market research from June 2012 found that 29% of parents in the UK described Mini Babybel as their child's favourite cheese snack, more than any other brand;⁴
- Between 2015 and 2017, the proprietor spent between €2.3m and €4.1m promoting the product, including TV adverts, displays on billboards, bus stops, etc.;⁵
- In 2016, the Mini Babybel product had 23.6% of the UK market for snacking cheeses.⁶

³ See pages 6 – 9 of exhibit NW1

⁴ See exhibit MB1

⁵ Some of the promotions in evidence show that the proprietor has sculpted and/or stylised versions of its wax coated cheese product into various motifs or anthropomorphic characters for use in its promotional material: See exhibits MB4 – MB6.

⁶ See exhibit MB7

24. Elise Merlet says that her role is to protect the proprietor's innovations and know-how. She is therefore aware of the technical aspects of her company and the cheese products it produces. The most important aspects of Madame Merlet are as follows:

- She says that there are errors in Katherine Lynch's statement; for example, the final shape of the Mini Babybel product does not result from the shape of the moulds as she claims, as can be seen from the videos exhibited to her statement and the images in exhibit EM1;
- The final torus shape of the product has two flat surfaces on either side of the torus and this is not simply the result of the manufacturing or moulding process;
- Competing cheese snacks come in a wide variety of shapes;⁷
- The traditional shape of the Edam cheese is a ball shaped, whereas the Mini Babybel product has flat surfaces on the top and bottom of the cheese;⁸
- Edam is traditionally sold in a variety of colours; black, orange, red, brown and green, some of which are used to denote cheeses with particular flavours or level of ageing;
- The colour red has no functional purpose;
- Commercial scale waxing of cheese involves dipping the cheese by hand or machine into wax or immersing the cheese entirely in wax via a conveyor belt;
- These methods of waxing cheese do not align with Mr Lynch's claim that the pull tag shown in the contested mark is used to assist the waxing process;
- Traditional cheeses are not the size or dimensions of the Mini Babybel product, therefore the dimensions of the contested mark do not indicate portion size.

25. Ms Field's statement exhibits the application file obtained from the IPO.⁹ It shows that the application to register the contested mark was originally objected to as contrary to ss.3(1)(a) and (b) of the Act. The applicant then agreed to substitute the original representation of the trade mark with the version of the mark registered in

⁷ As illustrated in exhibit EM2

⁸ See exhibit EM3

⁹ See exhibit RF1

France and from which the UK application claimed priority under the Paris Convention. This appears to have been in colour. At the same time, the applicant entered the limitation that the mark is limited to the colour red, as shown in the register. These changes appear to have led to the acceptance of the application to register the mark.

26. Ms Field deduces from these events that at the time of filing the application in 1996 the IPO did not require (a) colours to be defined by Pantone colour codes, or (b) additional representations or views of trade marks with three dimensions.

The hearing

27. A hearing took place on Friday 30th November 2018. Simon Malynicz QC appeared as counsel for the applicant. Michael Edenborough QC appeared as counsel for the proprietor.

Application to re-introduce a ground for invalidation based on s.3(1)(b) of the Act

28. On Thursday 22nd November 2018, just over a week before the scheduled hearing, the applicant applied for permission to re-introduce a ground for invalidation based on s.3(1)(b) of the Act, i.e. that the contested trade mark is devoid of any distinctive character. This was considered as a preliminary matter at the hearing described above.

29. Whilst accepting that it was unfortunate to have to apply to reintroduce a ground it had previously dropped, Mr Malynicz submitted that:

- The proprietor had not been taken by surprise by a new issue because the s.3(1)(b) ground had originally been pleaded prior to being dropped earlier in the year;

- The proprietor had filed evidence, in the form of the witness statement of Michelle Bamford, which engaged (only) with the issue of the contested trade mark having acquired distinctiveness through use;
- The claim under s.3(1)(b) was arguable and should be heard;
- Dealing with the claim now would avoid the possibility of a further application for invalidation later;
- The proprietor would not be prejudiced by allowing the application.

30. Mr Edenborough made the following points in his skeleton argument:

- The applicant's pleadings had already been considered on numerous occasions and the applicant had made a conscious decision to drop the s.3(1)(b) ground;
- Allowing the applicant to reintroduce the ground at this stage of the proceedings would be unfair to the proprietor, who had already been inconvenienced by the shambolic way the application had been pleaded and pursued;
- The applicant had legal representation throughout and should know how to plead its case;
- No explanation had been offered as to why the applicant had changed its position again, other than the simple assertion that it had changed its mind about the s.3(1)(b) ground after discussing its case with its counsel;
- If the application was allowed, the hearing would have to be adjourned so that the proprietor could have the opportunity to file additional evidence going to the inherent and acquired distinctiveness of the contested trade mark.

31. When I asked him about it, Mr Malynicz accepted that if the amendment was allowed the proprietor should be given an opportunity to file additional evidence. However, he indicated that the applicant would be content to proceed based on submissions about the law and its existing evidence.

32. I refused the applicant's application to amend its pleadings (again). My reasons for doing so are that:

- Parties to proceedings should be entitled to rely on statements from the other side that a specific issue is no longer being pursued;
- A party which has raised, but then specifically dropped, a claim of non-distinctiveness should not be allowed to re-introduce legal grounds going to that same issue without a compelling reason;
- No compelling reason was given for allowing the applicant to back-track on its decision to drop the legal grounds attacking the contested mark on grounds of non-distinctiveness;
- It is not sufficient to simply say that the applicant has changed its mind;
- Although the issue of acquired distinctiveness was addressed in some of the proprietor's evidence, the inherent distinctiveness of the contested mark was not addressed in either side's evidence;
- The matter of acquired distinctiveness only arises once it is established that the contested mark is *prima facie* devoid of any distinctive character;
- In this case that would mainly depend on the extent to which the shape, size and colour of the contested mark stood out from the norms and customs of the sector at the relevant date in 1996;
- That may not be a matter which can be decided fairly in 2018 based on legal arguments alone, without any evidence to assist the decision maker to assess the factual position at the relevant date;
- The applicant had been directed to address its evidence of non-distinctiveness to the relevant date in 1996 following a CMC on 24th January 2018, i.e. prior to the ground being formally dropped in May 2018;
- Adjourning the hearing at short notice to permit the parties to file evidence going to the matter at issue would involve a significant delay and waste costs;
- These consequences are, of themselves, a form of prejudice to the proprietor.

33. The applicant's pleading of its case, which I consider the proprietor is justified in labelling as 'shambolic', and the delay and additional cost it had already caused the

proprietor, was a further aggravating factor. However, my decision did not depend on this.

What are the essential characteristics of the contested trade mark?

34. Before turning to the remaining legal grounds for invalidation, I find it convenient to decide what are the essential characteristics of the contested mark. Mr Malynicz's primary submission was that the essential characteristics of the mark were its "puck-like" shape together with the protrusions making up the pull tag. According to Mr Malynicz, the colour red is an incidental element of the mark, as in *Lego Juris A/S v OHIM*.¹⁰ He submitted that the dimensions included in the representation of the mark are unclear and, in any event, incapable of turning the mark into anything other than a shape mark.

35. Mr Edenborough submitted that the shape, the protrusions, the dimensions and the colour red were all essential characteristics of the mark. As regards the colour element, he submitted that the presence of a limitation to the colour red indicated that colour was indispensable to the identity of the trade mark.¹¹

36. The limitation of the mark to the dimensions shown in the representation and to the colour red, are 'limitations' within the meaning of s.13 of the Act. The effect of these limitations is to restrict the proprietor's right of enforcement to signs which fall within them. I accept that the presence of such limitations is a strong indication that the applicant regarded the dimensions and colour red as indispensable to the identity of the contested trade mark. I take that into account. However, it would be wrong to take the mere presence of such limitations as necessarily requiring that the dimensions and colour red are considered as essential characteristics of the mark. Rather, this must be based on my objective assessment of the matter. In making this assessment I can take account of whether the presence or absence of the

¹⁰ The Court of Justice of the European Union (hereafter "the CJEU"), Case C-48/09P

¹¹ In this connection, my attention was drawn to paragraph 8 of the decision of Mr Geoffrey Hobbs QC, as the Appointed Person, in *Robert McBride Ltd's Application*, [2003] RPC 19.

characteristics in question would make an important difference to the impression that the trade mark creates on an average consumer of cheese products.¹²

37. In my view, an average consumer would regard the dimensions of the trade mark as an important aspect of the sign. A shape of goods that could be (say) 40cm in diameter would clearly make a very different impression to one that is only 4cm and can therefore be held in the palm of the hand.

38. As regards the importance of the colour red, it is common knowledge that building bricks, such as the Lego brick, usually come in a variety of purely decorative colours. Consequently, no individual colour has any real importance. It is the shape of the brick which matters. In those circumstances, a tribunal would be entitled to find that the colour in which the shape of a building brick is portrayed in a representation of a trade mark is a minor arbitrary feature of the three dimensional mark, and of no importance, i.e. is not an essential characteristic of such a mark.

39. My own experience tells me that the majority of cheeses are not marketed in protective coatings, coloured or otherwise. Further, there is no evidence that the colours applied to such protective coatings are incidental, as in the case of the colour of building bricks. On the contrary, Katherine Lynch's evidence, on behalf of the applicant, is that a red protective coating is particularly associated with Edam cheese. It is true that Elise Merlet's evidence, on behalf of the proprietor, is that Edam cheese comes in a variety of colours, but she says that at least some of these colours are used to convey information to the consumer about the flavour or age of the cheese. If that is so, these colours are not incidental either. Further, the evidence appears to be addressed to the position in 2018, whereas my assessment must logically be directed to the position at the time of the application in 1996.

40. I find that the essential characteristics of the contested trade mark are the shape of the goods in the dimensions indicated in the representation of the mark, the protrusions making up the pull tag, and the colour red.

¹² See paragraphs 70, 71 and 76 of the judgment of the CJEU in *Lego Juris A/S v OHIM*.

The grounds for invalidation based on section 3(2) of the Act

41. On the date these proceedings commenced, s.3(2) of the Act was as follows:

“(2) A sign shall not be registered as a trade mark if it consists exclusively of-

- (a) the shape which results from the nature of the goods themselves,
- (b) the shape of goods which is necessary to obtain a technical result, or
- (c) the shape which gives substantial value to the goods.”

42. Each of these exclusions depends on the trade mark consisting exclusively of the shape of the goods. As is clear from *Lego Juris A/S v OHIM*, this is the case where the essential characteristics of the sign relate to a shape. Shapes of a particular size are still shapes. Therefore, the dimensions of the trade mark at issue do not take the mark outside the potential scope of s.3(2). However, my finding that the colour red is an essential characteristic of the contested trade mark does. This is sufficient reason, by itself, to reject the grounds for invalidation based on s.3(2).

43. In case I am wrong to regard the colour red as an essential characteristic of the contested trade mark, I shall examine the grounds under s.3(2) on the basis that the essential characteristics of the mark are the shape in the dimensions shown on the register.

44. In its judgment in *Hauck GmbH & Co. KG v Stokke*,¹³ the CJEU clarified the scope of the first indent of article 3(1)(e) of Directive 89/104/EEC (corresponding to s.3(2)(a) of the Act) as follows:

“23. Thus, an interpretation of the first indent of that provision whereby that indent is to apply only to signs which consist exclusively of shapes which are indispensable to the function of the goods in question, leaving the producer of those goods no leeway to make a personal essential contribution, would not allow the objective of the ground for refusal set out therein to be fully realised.

¹³ CJEU, Case C-205/13

24. Indeed an interpretation to that effect would result in limiting the products to which that ground for refusal could apply to (i) 'natural' products (which have no substitute) and (ii) 'regulated' products (the shape of which is prescribed by legal standards), even though signs consisting of the shapes formed by such products could not be registered in any event because of their lack of distinctive character.

25. Instead, when applying the ground for refusal set out in the first indent of Article 3(1)(e) of the trade marks directive, account should be taken of the fact that the concept of a 'shape which results from the nature of the goods themselves' means that shapes with essential characteristics which are inherent to the generic function or functions of such goods must, in principle, also be denied registration.

26. As the Advocate General indicated in point 58 of his Opinion, reserving such characteristics to a single economic operator would make it difficult for competing undertakings to give their goods a shape which would be suited to the use for which those goods are intended. Moreover, it is clear that those are essential characteristics which consumers will be looking for in the products of competitors, given that they are intended to perform an identical or similar function.

27. Consequently, the answer to the first question is that the first indent of Article 3(1)(e) of the trade marks directive must be interpreted as meaning that the ground for refusal of registration set out in that provision may apply to a sign which consists exclusively of the shape of a product with one or more essential characteristics which are inherent to the generic function or functions of that product and which consumers may be looking for in the products of competitors."

45. Mr Malynicz submitted that the contested mark fell within the scope of s.3(2)(a) of the Act (i.e. the first indent of article 3(1)(e) of the Directive) because:

- Although cheeses come in many shapes, one of the most common shapes is a generally round or 'puck' shape, e.g. Camembert or Brie;
- This shape is inherent to the generic function of the goods in that it allows slicing and portioning into wedges, as well as convenient transportation, storage and display;
- The protrusions which form part of the mark are functional, to permit peeling;
- The mere fact that other shapes could achieve the same result is irrelevant;¹⁴
- The small size does not alter the generic function of the shape.

46. Whilst accepting that aspects of shape which result from the manufacturing process are not relevant to s.3(2)(b) of the Act, Mr Malynicz relied on essentially the same points to support the s.3(2)(b) ground.

47. Mr Edenborough made a wide-ranging attack on the applicant's case under s.3(2). He submitted that it was (a) based on assertions unsupported by evidence, (b) so wide and all-encompassing in scope as to be obviously wrong, (c) was based partly on speculation as to the what the mark represented, (d) made criticisms that were of general application to the shape of any cheese, rather than specific to the particular shape at issue.

48. On the point about cheeses coming in generally round shapes, Mr Edenborough pointed out that cheeses come in many different shapes. Although he accepted that the existence of alternative shapes was insufficient to defeat an objection under s.3(2)(a) or 3(2)(b) of the Act, he submitted that there must be some limit to the potential number of shapes that a product can take before the 'anti-monopoly of forms' policy which underlies s.3(2)(a) and (b) is engaged.

49. As to generally round shapes being a result of the manufacturing process, Mr Edenborough pointed to Elise Merlet's statement that the moulds shown in the evidence have straight sides. The shape shown in the trade mark does not have

¹⁴ Per the judgment of the CJEU in *Lego Juris v OHIM*

straight sides. Therefore, the goods do not reflect the shape of the mould. Further, the evidence does not establish that round cheeses drain any better than cheeses of other shapes.

50. As to the claim that the trade mark reflected a traditional shape for cheese, Mr Edenborough relied on, amongst other things, the fact that the trade mark was a shape in particular dimensions. Further, no evidence had been filed to show that the protrusions shown in the mark were a traditional part of the shape of cheeses.

51. According to Mr Edenborough, the allegation that red surface of the cheese shown in the trade mark represented a wax or plastic protective coating, and therefore functional, was speculation. The trade mark did not include a claim to a wax or plastic coating. In any event, other means of protecting the cheese were available, e.g. hardened rind or waxed paper.

52. The claim that round cheeses are easier to handle, and less likely to fail because they do not have corners, was also wrong. Mr Edenborough submitted that the first point related to large cheeses which were sometimes cylindrical to assist in movement around the dairy. That did not apply to a cheese of 4 x 2cms. The second point was also wrong because the evidence showed that cheeses with more obviously acute corners can still be waxed.¹⁵

53. The allegations that the shape relates to the goods being (i) snack-sized portions, (ii) easily transportable, or (iii) opened and consumed without implements, were irrelevant because those attributes did not relate to the shape of the goods.

54. I would have rejected the applicant's grounds for invalidation based on ss.3(2)(a) and (b) (even if the colour red is not an essential characteristic of the mark) because:

- I accept Mr Edenborough's submission that the partly rounded sides of the cheese depicted in the contested mark do not result from a generic moulding process, i.e. from the nature of the goods themselves;

¹⁵ See KL1, page 23

- I reject Mr Malynicz’s submission that the dimensions in which the trade mark is registered should not form part of my assessment of whether the trade mark consists exclusively of a shape which results from the nature of the goods themselves, or is necessary to achieve a technical result;
- I accept Mr Edenborough’s submission that the claimed advantages of round cheeses do not apply to the basic shape depicted in the contested mark, at least in the dimensions covered by the trade mark;
- I agree with Mr Edenborough that the specific shape of the trade mark does not determine the volume of cheese provided (which could equally be provided in any shape) and is therefore important to the provision of a portion-size cheese;
- Although I accept that the protrusions shown in the mark are purely functional, to assist peeling, this is but one aspect of the shape;
- Although I accept that the covering of the cheese depicted in the contested mark represents a protective coating of some kind, and that it is appropriate to consider this characteristic as a generic function, this is not enough to make good the grounds under ss.3(2)(a) or (b) in the light of my findings about the non-generic/non-functional aspects of the trade mark.

55. In *Hauck* the CJEU clarified the scope of the third indent of article 3(1)(e) of the Directive (s.3(2)(c) of the Act) as follows:

“28. By its second question, the referring court asks, in essence, whether the third indent of Article 3(1)(e) of the trade marks directive is to be interpreted as meaning that the ground for refusal of registration set out in that provision may apply to a sign which consists exclusively of the shape of a product with several characteristics each of which may give that product substantial value and if it is necessary to take the target public’s perception of the shape of that product into account during that assessment.

29. It can be seen from the order for reference that the doubts expressed by the referring court regarding the interpretation of that provision stem from the fact that, according to that court, although the shape of the ‘Tripp Trapp’ chair

gives it significant aesthetic value, at the same time it has other characteristics (safety, comfort and reliability) which give it essential functional value.

30. In that regard, the fact that the shape of a product is regarded as giving substantial value to that product does not mean that other characteristics may not also give the product significant value.

31. Thus, the aim of preventing the exclusive and permanent right which a trade mark confers from serving to extend indefinitely the life of other rights which the EU legislature has sought to make subject to limited periods requires — as the Advocate General observed in point 85 of his Opinion — that the possibility of applying the third indent of Article 3(1)(e) of the trade marks directive not be automatically ruled out when, in addition to its aesthetic function, the product concerned also performs other essential functions.

32. Indeed, the concept of a ‘shape which gives substantial value to the goods’ cannot be limited purely to the shape of products having only artistic or ornamental value, as there is otherwise a risk that products which have essential functional characteristics as well as a significant aesthetic element will not be covered. In that case, the right conferred by the trade mark on its proprietor would grant that proprietor a monopoly on the essential characteristics of such products, which would not allow the objective of that ground for refusal to be fully realised.

33. Moreover, regarding the impact of the target public, the Court has observed that, in contrast to the situation referred to in Article 3(1)(b) of the trade marks directive, where the perception of the target public must be taken into account since it is essential for the purposes of determining whether the sign filed for registration as a trade mark enables the goods or services concerned to be recognised as originating from a particular undertaking, such an obligation cannot be imposed in the context of paragraph 1(e) of that article (see, to that effect, judgment in *Lego Juris v OHIM*, EU:C:2010:516, paragraph 75).

34. The presumed perception of the sign by the average consumer is not a decisive element when applying the ground for refusal set out in the third indent of the latter provision, but may, at most, be a relevant criterion of assessment for the competent authority in identifying the essential characteristics of that sign (see, to that effect, judgment in *Lego Juris v OHIM*, EU:C:2010:516, paragraph 76).

35. In that regard, as the Advocate General indicated in point 93 of his Opinion, other assessment criteria may also be taken into account, such as the nature of the category of goods concerned, the artistic value of the shape in question, its dissimilarity from other shapes in common use on the market concerned, a substantial price difference in relation to similar products, and the development of a promotion strategy which focuses on accentuating the aesthetic characteristics of the product in question.

36. In the light of the foregoing, the answer to the second question is that the third indent of Article 3(1)(e) of the trade marks directive must be interpreted as meaning that the ground for refusal of registration set out in that provision may apply to a sign which consists exclusively of the shape of a product with several characteristics each of which may give that product substantial value. The target public's perception of the shape of that product is only one of the assessment criteria which may be used to determine whether that ground for refusal is applicable.”

56. Mr Malynicz submitted that this exclusion applied because:

- The essential characteristics of the contested trade mark serve functional (described above) and aesthetic purposes;
- The proprietor has sought to play on the attractive appearance of the mark by sculpting or stylising the wax coating into various motifs or anthropomorphic characters in its promotional material;

- The product clearly has commercial value as a bite-size cheese portioned product.

57. Mr Edenborough pointed out that it is not enough for the shape to give value to the goods: the exclusion only applies where the shape gives substantial value to the goods. According to Mr Edenborough, there was no evidence that it did. Insofar as the applicant relies on a bite-size portion as giving substantial value to the goods, Mr Edenborough pointed out that there were an infinite number of shapes which could be used to provide a bite-sized portion. Consequently, the shape (and dimensions) at issue are not important to the provision of cheeses of a specific volume.

58. I accept Mr Edenborough's submission on this point.

59. I reject Mr Malynicz's submission that the evidence showing that the proprietor has sculpted or stylised its coated cheese product into various motifs or anthropomorphic characters in its promotional material shows that it has promoted the shape and appearance of the contested mark as an attractive shape, let alone one that gives substantial value to the goods. On the contrary, if it indicates anything, it indicates that the proprietor has felt it necessary to use very fanciful versions of its product for promotional purposes. This points to the relative lack of appeal of the basic shape and appearance of the goods at issue, as represented in the contested mark.

60. In any event, I note that this aspect of the applicant's case was not pleaded and appears to have emerged for the first time at the hearing. Consequently, it would not have been fair to the proprietor to find against it on this basis. However, as I have found that the argument has no merit, it is not necessary to say any more about this.

61. In the absence of any other evidence showing that the shape and dimensions of the goods shown in the contested mark give substantial value to the goods, such as those mentioned in paragraph 35 of the CJEU's judgment in *Hauck*, I reject the ground for invalidation based on s.3(2)(c) of the Act.

The ground for invalidation based on section 3(1)(a) of the Act

62. At the date these proceedings commenced, s.1(1)(a) of the Act was as follows:

“(1) 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. “

63. Section 3(1)(a) states that:

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

(a) signs which do not satisfy the requirements of section 1(1),”

64. Section 47(1) of the Act is as follows:

“47. - (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).”

65. The applicant claims that the contested mark is not represented graphically as required by the case law of the CJEU. In that connection, Mr Malynicz drew my attention to the judgment of the court in *Libertel Groep BV v Benelux-Merkenbureau*.¹⁶ The court was asked about the requirements for graphically representing colour in the abstract as a trade mark. The court said:

“28. Furthermore, as the court has held, a graphic representation within the meaning of article 2 of the Directive must enable the sign to be represented visually, particularly by means of images, lines or characters, so that it can be

¹⁶ Case C-104/01

precisely identified: Sieckmann v Deutsches Patent-und Markenamt (Case C-273/00) [2003] Ch 487, 509, para 46.

29. In order to fulfil its function, the graphic representation within the meaning of article 2 of the Directive must be clear, precise, self-contained, easily accessible, intelligible, durable and objective: Sieckmann , paras 47-55.

30. In this case, the query referred to the court relates to an application to register a colour per se, represented by a sample of the colour on a flat surface, a description in words of the colour and/or an internationally recognised colour identification code.

31. A mere sample of a colour does not satisfy the requirements set out in paras 28 and 29 of this judgment.

32. In particular, a sample of a colour may deteriorate with time. There may be certain media on which it is possible to reproduce a colour in permanent form. However with other media, including paper, the exact shade of the colour cannot be protected from the effects of the passage of time. In those cases, the filing of a sample of a colour does not possess the durability required by article 2 of the Directive: see Sieckmann , para 53.

33. It follows that filing a sample of a colour does not per se constitute a graphic representation within the meaning of article 2 of the Directive.

34. On the other hand, a verbal description of a colour, in so far as it is composed of words which themselves are made up of letters, does constitute a graphic representation of the colour: see Sieckmann, p 511, para 70.

35. A description in words of the colour will not necessarily satisfy the conditions set out in paras 28 and 29 of this judgment in every instance. That is a question which must be evaluated in the light of the circumstances of each individual case.

36. A sample of a colour, combined with a description in words of that colour, may therefore constitute a graphic representation within the meaning of article 2 of the Directive, provided that the description is clear, precise, self-contained, easily accessible, intelligible, and objective.

37. For the same reasons as those set out at para 34 of this judgment, the designation of a colour using an internationally recognised identification code may be considered to constitute a graphic representation. Such codes are deemed to be precise and stable.

38. Where a sample of a colour, together with a description in words, does not satisfy the conditions laid down in article 2 of the Directive in order for it to constitute a graphic representation because, inter alia, it lacks precision or durability, that deficiency may, depending on the facts, be remedied by adding a colour designation from an internationally recognised identification code."

66. The Court therefore answered the first of the referred questions in these terms:

"68. The reply to the first question referred must therefore be that a colour per se, not spatially delimited, may, in respect of certain goods and services, have a distinctive character within the meaning of article 3(1)(b) and article 3(3) of the Directive, provided that, inter alia, it may be represented graphically in a way that is clear, precise, self-contained, easily accessible, intelligible, durable and objective. The latter condition cannot be satisfied merely by reproducing on paper the colour in question, but may be satisfied by designating that colour using an internationally recognised identification code."

67. Although expressed in terms of trade marks consisting exclusively of colour, there is no doubt that the court's requirement for trade marks to be graphically represented in a way that is clear, precise, self-contained, easily accessible, intelligible, durable and objective, applies to marks of all kinds.¹⁷

68. At the hearing, Mr Malynicz pursued four points. Firstly, he submitted that there was a mismatch between the verbal description of the mark and the colour(s) shown in the pictorial representation of it. This was because the description says that the mark is 'red' whereas the pictorial representation shows the protrusions from the basic 'puck' shape in white and fuchsia. Therefore, the overall representation of the mark is not clear, precise or intelligible. Secondly, he submitted that if, contrary to his submission under s.3(2), colour was held to be an important characteristic of the

¹⁷ See, for example, *Dyson Ltd v Registrar of Trade Marks*, Case C-321/03.

mark, the colour 'red' used in the description of the mark is not clear or objective because it could cover a range of colours, all of which could be described as 'red'. Thirdly, he submitted that the dimensions shown in the representation of the mark should be taken as part of the mark rather than an explanation of size. Further, even if this is wrong, he submitted that the dimensions do not relate to the 'puck' shape shown in the picture of the mark with sufficient clarity or precision. This is because the measurements are in two dimensions whereas the shape is in three. Fourthly, Mr Malynicz submitted that the representation of the shape is not clear or precise because only one view is presented depicting what may, or may not be, a symmetrical shape.

69. For his part, Mr Edenborough submitted that there was no mismatch between the colour stated in the description and the colour shown in the pictorial representation of the mark. This was because the description should be taken as referring to what can be seen in the representation. Therefore, the colour 'red' is the colour shown. Further, white is not a colour *per se* and that is why it is not mentioned in the description of the mark. As to the alleged lack of clarity or precision in the colour 'red', this falls away once one accepts that the 'red' referred to in the description is the colour red as shown in the pictorial representation of the mark. Regarding the requirement for durability, he argued that the colours shown in the picture will be constant as long as the digital file in which they are stored is maintained.

70. Mr Edenborough submitted that it was plain that the measurements shown in the representation of the mark related to the dimensions of the basic shape of the goods. Further, it would be clear to anyone that the 4cm measurement refers to the diameter of the shape along its major plane, and the 2cm measurement refers to its depth orthogonal to that plane.

71. Finally, addressing the complaint that only one view of the shape is provided, Mr Edenborough submitted that it should be inferred that nothing of interest is present when viewed from different angles, i.e. that the shape is symmetrical, except for the two protrusions shown.

72. I accept that the trade mark consists only of what is visible in the representation. Therefore, features which could be present when the goods are viewed from other angles, but which are not shown in the representation of the trade mark, are not covered. It follows that there is no need to represent them, or their absence. In my view, it is clear enough that the shape depicted in the representation is symmetrical, except for the two protrusions shown. I therefore reject the applicant's case insofar as it claims that one view of the shape is insufficient to clearly represent it.

73. I reject Mr Malynicz's submission that the measurements shown in the mark should be regarded as part of the mark itself, rather than information about the dimensions of the shape shown. That is not a natural, or even plausible, interpretation of this information. The suggestion that such information should have appeared in the written description of the mark, rather than in the pictorial representation, is an overly technical criticism. Following that approach would make it even harder to show which aspects of the shape the dimensions apply to. The correct approach is to consider the mark and the accompanying description as a whole. In this connection, I note that the description cross refers to the dimensions shown in the pictorial representation. It is therefore obvious that the dimensions are information about the shape of the goods and not part of the mark *per se*. Consequently, I see no merit in this point and I reject it.

74. As to the clarity of the dimensions, once one understands (as will be apparent from the representation and description of the mark) that it has three dimensions, it becomes clear that the dimensions refer to the diameter and depth of the shape at its widest points. Although I agree that this could have been made clearer still, in my view, it is clear enough to enable consumers, other traders and competent authorities to ascertain precisely what these measurements mean. I therefore reject this point too.

75. That brings me to the points about colour and the alleged mismatch between the description and the representation of the mark. I find it convenient to examine these points together starting with the alleged mismatch. It is true that the description says that the mark is 'red' whereas the representation of the mark shows the protrusions on the basic 'puck' shape in white and fuchsia. I reject Mr Edenborough's submission

that white is not a colour. Most consumers would regard it as a colour. However, I accept that there is a good argument that the use of a neutral shade like white is, in context, sufficient to make it clear to the reader that the colour limitation does not extend to the relatively small part of the shape shown in white. In my view, there is room for argument as to whether the part of the protrusions shown in a fuchsia-like colour fall within the description 'red'. However, for present purposes I accept that it does. I therefore reject the applicant's claim that the presence of the parts of the mark in fuchsia and white creates a mismatch between the pictorial representation of the mark and the description, which renders the mark unintelligible.

76. This brings me to the question of whether the colour 'red' is defined with sufficient precision and clarity.

How precisely must colour be defined in the representation of a trade mark consisting of more than colour *per se*?

77. In *Libertel Groep BV v Benelux-Merkenbureau*¹⁸ the CJEU considered various questions relating to the registrability of colours as trade marks. One of these was about the acceptable ways in which colour could be represented for the purposes of registration. The court stated that:

“30. In this case the query referred to the Court relates to an application to register a colour *per se*, represented by a sample of the colour on a flat surface, a description in words of the colour and/or an internationally recognised colour identification code.

31. A mere sample of a colour does not, however, satisfy the requirements set out in paragraphs 28 and 29 of this judgment.

32. In particular a sample of a colour may deteriorate with time. There may be certain media on which it is possible to reproduce a colour in permanent form. However with other media, including paper, the exact shade of the colour

¹⁸ Case C-104/01

cannot be protected from the effects of the passage of time. In these cases, the filing of a sample of a colour does not possess the durability required by Article 2 of the Directive (see Sieckmann, paragraph 53).

33. It follows that filing a sample of a colour does not per se constitute a graphic representation within the meaning of Article 2 of the Directive.

34. On the other hand, a verbal description of a colour, in so far as it is composed of words which themselves are made up of letters, does constitute a graphic representation of the colour (see Sieckmann, paragraph 70).

35. A description in words of the colour will not necessarily satisfy the conditions set out in paragraphs 28 and 29 of this judgment in every instance. That is a question which must be evaluated in the light of the circumstances of each individual case.

36. A sample of a colour, combined with a description in words of that colour, may therefore constitute a graphic representation within the meaning of Article 2 of the Directive, provided that the description is clear, precise, self-contained, easily accessible, intelligible, and objective.

37. For the same reasons as those set out at paragraph 34 of this judgment, the designation of a colour using an internationally recognised identification code may be considered to constitute a graphic representation. Such codes are deemed to be precise and stable.

38. Where a sample of a colour, together with a description in words, does not satisfy the conditions laid down in Article 2 of the Directive in order for it to constitute a graphic representation because, inter alia, it lacks precision or durability, that deficiency may, depending on the facts, be remedied by adding a colour designation from an internationally recognised identification code.”

78. The *Libertel* judgment has been generally understood as meaning that neither a sample of the colour(s), nor mere descriptions of colour in words, such as ‘red’, are

sufficiently clear, precise and/or durable to satisfy the requirement for a graphical representation of colour marks. Instead, the practice of using internationally recognised colour identification codes has become the usual way of representing such marks.

79. The requirements for representing trade marks consisting of colour *per se* has been extended to other types of colour marks. For example, in *Robert McBride's Application*¹⁹ the requirement was applied to the representation of two colours applied to the upper and lower halves of a rectangular dishwasher tablet. The mark in that case consisted of a combination of colours and their respective position on the goods.²⁰ Similarly, the *Libertel* requirements have been applied to marks consisting of colour applied to the whole surface of the containers of the goods for which registration is sought: see, for example, *Calor Gas (Northern Ireland) Limited's Application*.²¹

80. On the other hand, Mr Edenborough is correct when he says that it is not always necessary to precisely define the colour(s) shown in marks. This is not a necessary requirement for many figurative marks in which colour is included, but is not an important characteristic of the mark, e.g. a cartoon of a black and white sheep shown in a green field. In this example, the fact that the sheep is black and white is relevant to the assessment of the identity of the trade mark, but the precise hue of black or white (or green for grass) is unlikely to make more than a negligible contribution (if any) to the identity of the mark. Consequently, there is no need to define the colours more precisely. The *Lego Juris* case mentioned above provides another example of a mark in which colour was present but unimportant because it was incidental to the essential subject matter of the mark, which was the shape of the goods. I can imagine other circumstances in which colours could be present, but the precise shade of the colours would be unimportant, e.g. a rainbow device or a word mark with the individual letters shown in varying primary colours. It is not therefore possible or necessary to extend the *Libertel* requirements for representing colours to every trade mark in which colour is present.

¹⁹ A decision of Mr Geoffrey Hobbs QC as the Appointed Person [2003] RPC 19

²⁰ A similar type of mark was the subject of the judgment of the CJEU in *Louboutin AS v Van Haren Schoenen BV*, Case C-163/16 (see paragraph 9 of the judgment).

²¹ BL O/340/06

81. However, in my view, the *Libertel* requirements apply to every trade mark in which colour is an essential characteristic of the mark. If it were otherwise, the task of deciding whether two such marks were identical, or even similar, could be made impossible. And this would lead to the kind of uncertainty that the *Libertel* requirements are intended to avoid.

Is the colour 'red' defined with sufficient clarity and precision in this case?

82. It follows from my finding at paragraph 40 above that I consider the colour red to be an essential characteristic of the contested mark. The question of whether the colour red is defined with sufficient precision is therefore of decisive significance.

83. In *Calor Gas (Northern Ireland) Limited's Application*, Mr Geoffrey Hobbs QC (again sitting as the Appointed Person) considered an appeal against the decision of the registrar to refuse to allocate a filing date to an application to register a mark consisting of a yellow colour applied to the surface of an ordinary gas container until a colour identification code was provided. Referring to the CJEU's judgment in *Sieckmann*,²² Mr Hobbs stated that:

"The Sieckmann criteria are clearly not satisfied by a graphic representation which lacks precision as to the particular colour or colours in which the identity of a colour specific sign resides. That is especially true when the lack of precision is attributable to the inclusion of general designations such as 'red', 'green' or 'blue' in the graphic representation of the sign. Such designations are, in the absence of further clarification, apt to render the representation unacceptable for ambiguity as noted in Robert McBride Ltd's Trade Mark Application [2003] RPC 19, page 343 at paragraph 9:

"...The identity of a colour resides in the hue that it presents to the eye of the observer. A verbal description which fails to identify the hue of the colour it seeks to define is a recipe for uncertainty: it would leave room for differing perceptions of different individuals to be equally applicable

²² Case C-273/00 *Sieckmann*. This case pre-dated *Libertel* and first set out the court's requirements for graphical representation in the context of sound marks.

benchmarks by which to judge whether a particular hue falls within the relevant wording, with each individual also being liable to regard the wording of the description as applicable to a multiplicity of different colour shades, c.f. Orange Personal Communications Ltd.'s Application."

84. It therefore seems clear that in the case of a mark in which colour is important, such as this one, defining the colour with the broad description 'red' is insufficiently precise to satisfy the requirement for a graphical representation of the trade mark.

85. I do not accept that this deficiency is cured by the presence of the cherry and fuchsia-like colours shown in the pictorial representation of the trade mark. I find that the colours shown in the picture of the mark do not limit the mark to the shades of red shown. This is because (i) the description of the mark does not say so, and (ii) there is no rule that the pictorial representation of the mark takes precedence over the description so that it would be appropriate to infer that the claim to the colour 'red' is limited to the shades of red shown in the picture.

86. In this connection, I note that in *Glaxo v Sandoz*,²³ the Court of Appeal considered an appeal against a judgment of the High Court that the graphical representation of a trade mark consisting of an inhaler device in two shades of purple was insufficiently clear, precise and intelligible. The problem in that case was that the arrangement of the colours depended entirely on the pictorial representation of the mark, but the written description of the mark appeared to go wider and cover multiple possible arrangements of the two colours applied to inhaler devices of any shape. The appellant argued that the mark should necessarily be taken as limited to what was shown in the picture. However, Kitchen L.J. (with whom Floyd L.J. and Sir Geoffrey Vos, Chancellor of the High Court, agreed) said that:

"63 Secondly and as I have explained, the graphical representation encompasses not just the pictorial representation of the sign but also any description which accompanies it. In the case of a sign consisting of one or more colours per se, the description is very important. Thus in *Libertel*, in the

²³ [2017] EWCA Civ 335

context of the application to register the colour orange per se as a trade mark, the CJEU said that the filing of a sample of the colour sought to be protected did not of itself constitute a graphical representation within the meaning of Article 2 of the Directive but a description of the colour might do, as might a sample of the colour combined with a description of it. In *Heidelberger*, in the context of an application to register the colours blue and yellow per se as a trade mark, the CJEU explained that a graphical representation consisting of two or more colours and designated in the abstract and without contours must be systematically arranged by associating the colours in a predetermined and uniform way. Not surprisingly, the Court was of the view that the accompanying description that the mark applied for consisted of the applicant's corporate colours "which are used in every conceivable form" did not satisfy that requirement.

64. Thirdly, I do not detect in the guidance given by the CJEU any suggestion that, in the case of applications to register marks consisting of one or more colours per se, the pictorial representation is paramount and the verbal description is secondary. To the contrary, the Court has focused on the graphical representation as a whole and emphasised that its function is to define the mark in the public register in such a way as to make it accessible to the authorities and to the public and to ensure that its scope is clear and precise. Indeed and as I have explained, the Court said expressly in its judgment in *Heidelberger* that the mere juxtaposition of two colours, without shape or contours, or a reference to two or more colours "in every conceivable form" does not meet the requirements of precision and uniformity required by Article 2 of the Directive."

87. It is true that the difficulty in the *Glaxo* case related to the specificity of the arrangement of the colours shown in the pictorial representation of the mark, rather than the specificity of the colours (which were defined by colour identification codes). However, the difficulty in relying on the picture to limit the meaning conveyed by the description of the mark applies equally where the lack of specificity relates to the colour(s) identified in the mark description.

88. If that is right, and the written description of the mark is taken as the primary indication of the subject matter of the trade mark, then the claim to goods of the shape and size depicted in the colour 'red' is not sufficiently clear and precise to satisfy the *Libertel* requirements. This conclusion is illustrated by the proprietor's claim that 'red' covers (at least) goods of the shape and size shown in shades of red as different as cherry red and fuchsia.

89. If I am wrong about that and the limitation to 'red' should properly be taken as being limited to the colours shown in the picture, then the absence of colour identification codes means that the colours are not represented in an objective and durable manner. This is because the pictorial representation of the colours on the register is only as accurate as the process used to capture the colours when they were scanned from the application into the electronic register. The original representation is liable to change over time in the same way as a physical sample of the goods.

90. I should also address the possibility that neither the pictorial representation nor the written description of the mark should be considered as secondary to each other. In that event, I find that they do not correspond. As Kitchen L.J. stated in the *Glaxo* case:

“35. the function of the graphic representation is, in particular, to define the sign so that the subject matter for which protection is sought or has been secured can be clearly and precisely identified by the competent authorities and the public. Moreover and importantly, in order to fulfil its role as a trade mark and meet the requirements of precision and clarity, the sign must always be perceived unambiguously and uniformly. In my judgment it follows that if the authorities and the public are left in a state of confusion as to the nature of the sign then these requirements will not be satisfied.”

91. Consequently, if the true position is that the pictorial representation and description of the mark do not correspond with respect to the identification of the colour 'red', then this would cause some people to regard the mark as covering any shade of red and others to regard it as covering only cherry red and fuchsia, as

shown in the picture. In that event, the ambiguity means that mark is not graphically represented as required by s.1(1) of the Act.

Amendments to ss.1(1) and 3(2) of the Act made on 14th January 2019

92. I am aware that ss.1(1) and 3(2) of the Act were amended on 14th January 2019 by The Trade Marks Regulations 2018.²⁴ The widening of the scope of s.3(2) of the Act to cover more than shapes appears to have been intended to reflect the wider range of signs that may be capable of being registered because of the removal of the requirement for a graphical representation. If that is right, the amended s.3(2) is likely to be wider in scope than the version in force at the date of commencement of these proceedings. The amendment is therefore more than just a clarification of the existing law.²⁵ I do not consider that the amendments to ss.1(1) and 3(2) apply to proceedings which started prior to the new law coming into effect. The amendments were made to comply with EU Directive 2015/2436. It is an established principle of EU law that changes are not retrospective unless clearly indicated to be so in the legislation. It is true that there are no transitional provisions. However, I do not consider that this means that the changes to ss.1(1) and 3(2) apply to trade marks registered, or to any proceedings started, before the changes came into effect.

93. Further, even if I am wrong about this, the requirement to represent trade marks in a way that is clear, precise, self-contained, easily accessible, intelligible, durable and objective, continues to apply.²⁶ The contested mark does not meet this requirement. Therefore, the removal of the requirement for a graphical representation of the mark if of no assistance to the proprietor with regard to the ground for invalidation based on s.1(1) of the Act.

94. The requirement for the mark to be represented in a manner that is clear, precise, self-contained, easily accessible, intelligible, durable and objective existed at the date of the application to register the contested mark. This is because this is

²⁴ SI 2018/825

²⁵ See paragraph 9 of the judgment of the CJEU in *Louboutin*, Case C-163/16, which confirmed that a mark consisting of colour applied to the part of shape of the goods was not to be considered a shape mark within the meaning of Article 3(1)(e)(iii) of Directive 2008/95.

²⁶ See recital 13 to Directive EU 2015/2436

what the CJEU has subsequently told us is required for a trade mark to fall within the provision of the Directive corresponding to s.1(1) of the Act. It therefore makes no difference that the registrar's practice did not require the use of international colour identification codes until the case law of the CJEU clarified that this is what is necessary to comply with EU law.

Outcome

95. The application for invalidation under s.47(1) of the Act based on grounds under s.3(2) fails.

96. The application for invalidation under s.47(1) based on grounds under ss.1(1) and 3(1)(a) succeeds. This means that the trade mark registration is invalid and will be cancelled.

Costs

97. The application has succeeded and the applicant is therefore entitled to a contribution towards its costs.

98. Mr Edenborough submitted that in the event of his client losing, the usual contribution towards the applicant's costs should be reduced. This is because of the chaotic way in which the application was pleaded and pursued, which caused the proprietor to incur additional and unnecessary costs.

99. Mr Malynicz asked for the usual scale costs.

100. In my view, the way that the applicant has pleaded and pursued its application amounts to unreasonable behaviour. It has wasted a great deal of everyone's time, including that of the proprietor, which has incurred wasted costs as a result. Taking this into account, I order Fromageries Bel S.A. to pay J Sainsbury plc the sum of £200, being the official filing fee for the application for invalidation. In the circumstances, it would, in my view, be unjust to require the proprietor to pay the applicant any more than that.

13th of February 2019

Allan James
For the Registrar