BLO/1158/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER 3876958

BY INVER HOUSE DISTILLERS LIMITED

TO REGISTER THE FOLLOWING MARK IN CLASS 33

Background

1. On 10 February 2023, Inver House Distillers Limited ("the applicant") applied to register the above 3D mark for the following goods in Class 33:

Class 33: Spirits (beverages); whisky.

2. On 3 March 2023 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 Class 33. 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 appears to comprise a shape of a product or its packaging, a bottle. Consumers do not generally regard shapes as comprising trademarks and the shape concerned does not appear to differ significantly from the norms of the trade in such a way that enables it to function as a trademark.

I have noted the embellishment shown on the base of the bottle, however this would be viewed by the average consumer as merely decorative, and is not sufficient to add any distinctiveness to the mark.

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

4. On 2 May 2023 Sipara Limited, the attorney acting on behalf of the applicant, requested a hearing. The hearing took place on 23 May 2023 between me and Mr Robert Furneaux of Sipara Limited representing the applicant.

5. Mr Furneaux's submissions at the hearing were as follows:

- Distinctive character of a mark must be assessed, firstly, in relation to the goods and secondly, by reference to the perception of the relevant public.
- In the whisky market consumers have been educated to perceive bottles as designations of origin.
- The bottle shape differs from the norms and customs of the sector given its distinctive double bulbous neck.
- The bottle has a distinctive image of a compass at its base.

6. Prior to the hearing I had conducted a search of the internet in order to establish the norms and customs of the trade and whether the shape of the bottle would be perceived as designating single trade origin by the relevant consumer when used in respect of the goods, namely, spirits and whisky. I found that the goods are typically sold in glass bottles of similar height, consisting predominantly of a larger cylindrical section which then narrows towards the top to form the neck of the bottle and which is then closed at the top with a cap. It is clear that the 'neck' of the applicant's bottle includes what Mr Furneaux described as a double bulbous segment within its neck and that this feature is absent from other similar shaped bottles. I did not consider that feature to be enough to conclude that the shape of the bottle 'in its totality' possesses distinctive character such that it is capable of guaranteeing the identity of the origin of the goods and to distinguish the goods from others which have another origin. I have not found any evidence to suggest that consumers have been educated to perceive bottle shapes as designating the origin of the goods. Furthermore, I did not agree with Mr Furneaux that the shape of the bottle departs significantly from the norms and customs of the trade but regarded it simply as a mere variant of existing bottle shapes.

7. In respect of the compass shape at the base of the bottle I considered that to be a non-distinctive decoration that was likely to go unnoticed by the relevant consumer, and even if they were to pick up the bottle and turn it over, or that the device were visible through the up standing bottle, I do not believe they would take the decoration as a trade mark designating the goods of a single undertaking. I was not persuaded by Mr Furneaux's submissions that the mark was inherently distinctive so I maintained the objection at the hearing.

8. The hearing report was issued on 24 May 2023 and a period of two months allowed for Mr Furneaux to file evidence with a view to demonstrating that the mark had acquired distinctive character through use.

9. A request to extend the response period was received on 20 July 2023. This was agreed and a new response date was set at 25 September 2023. A second request to extend the response date by one week was received on 22 September 2023 and the period duly extended to 2 October 2023.

10. On 28 September 2023 the attorney filed evidence to demonstrate that the mark had acquired distinctive character through use. The evidence constituted a witness statement of Mr Peter Powell, the commercial director of Inver House Distillers Limited (the applicant), together with Exhibits PP1 to PP10.

11. Having thoroughly considered the evidence I did not consider it sufficient to conclude that the mark had acquired distinctive character through use. It was clear that the applicant had significant presence in the marketplace but the evidence did not show the mark was being used as a means of identifying the goods as being those of a single undertaking, in other words, it was not being used as a 'trade mark'.

12. I maintained the objection and informed Mr Furneaux of my decision in my letter of 5 October 2023. I did not consider it appropriate to invite more evidence because in my view 'more of the same' would not suffice in demonstrating acquired distinctiveness through use. I allowed two months, to 5 December 2023, for Mr Furneaux to consider my decision and informed him that in the absence of any response the application would be refused under the provisions of section 37(4) of the Trade Marks Act 1994.

13. Although the application had not been formally refused since the response date had not expired, a form TM5 was received on 12 October 2023. As I had made it clear in my letter of 5 October 2023 that I was maintaining the objection, to all intents and purposes this drew to a close any further discussion on the issue.

14. 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.

The Law

15. 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 – Section 3(1)(b)

16. The Court of Justice of the European Union ('CJEU') has emphasised the need to interpret the grounds of refusal of registration listed in Article 3(1) and Article 7(1), the equivalent provision in Council Regulation 40/94 of 20 December 1993 on the Community Trade Mark, in the light of the general interest underlying each of them (*Bio ID v OHIM*, C-37/03P paragraph 59 and the case law cited there and, more recently, *Celltech R&D Ltd v OHIM,* C-273/05P).

17. The general interest to be taken into account in each case must reflect different considerations according to the ground for refusal in question. In relation to section 3(1)(b) (and the equivalent provision referred to above) the Court has held that *"…the public interest… is, manifestly, indissociable from the essential function of a trade mark"*, *SAT.1 SatellitenFernsehen GmbH v OHIM, C-329/02P.* The essential function thus referred to is that of guaranteeing the identity of the origin of the goods or services offered under the mark to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin. Marks which are devoid of distinctive character are incapable of fulfilling that essential function.

18. Section 3(1)(b) must include within its scope those marks which, whilst not designating a characteristic of the relevant goods and services (i.e. not being necessarily descriptive), will nonetheless fail to serve the essential function of a trade mark in that they will be incapable of designating origin. In terms of assessing distinctiveness under section 3(1)(b), the ECJ provided guidance in Koninklijke KPN Nederland NV v Benelux-Merkenbureau (Postkantoor) C-363/99) where, at paragraph 34, it stated:

> *A trade mark's distinctiveness within the meaning of Article 3(1)(b) of the Directive must be assessed, first, by reference to those goods or services and, second, by reference to the perception of the relevant public, which consists of average consumers of the goods or services in question, who are reasonably well informed and reasonably observant and circumspect (see inter alia Joined Cases C-53/01 to 55/01 Linde and Others [2003] ECR I- 3161, paragraph 41, and C-104/01 Libertel [2003] ECR I-3793, paragraphs 46 and 75)*

19. The mark that is the subject of this application is a 3D shape of a bottle. It is important to recognise that the position in the UK as regards marks which constitute the appearance of a product or its packaging is uncertain. For the reasons set out in BL O/555/22 (Device of a lawnmower) at paras 31-48, the UK courts do not regard the jurisprudence of the CJEU as being 'acte claire'. That is to say whether the test of 'departing significantly from the norms and customs of the trade' is both a necessary and sufficient test for Trade Mark distinctiveness and registration. I refer also to *Henkel KGaA v OHIM (Case C-144/06 P)* which refers to the criteria for assessing the distinctive character of three-dimensional trade marks as being no different to other category of marks, and consumers are not in the habit of making assumptions about the origin of products on the basis of their shape or their packaging:

36 According to equally consistent case-law, the criteria for assessing the distinctive character of three-dimensional trade marks consisting of the appearance of the product itself are no different from those applicable to other categories of trade mark. However, when those criteria are applied, account must be taken of the fact that the perception of the average consumer is not necessarily the same in relation to a three-dimensional mark consisting of the appearance of the product itself as it is in relation to a word or figurative mark consisting of a sign which is independent of the appearance of the products it denotes. Average consumers are not in the habit of making assumptions about the origin of products on the basis of their shape or the shape of their packaging in the absence of any graphic or word element, and it could therefore prove more difficult to establish distinctiveness in relation to such a three-dimensional mark than in relation to a word or figurative mark (Case C-136/02 P Mag Instrument v OHIM [2004] ECR I-9165, paragraph 30, and Storck v OHIM, paragraphs 26 and 27)

37 In those circumstances, only a mark which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin is not devoid of any distinctive character for the purposes of Article 7(1)(b) of Regulation No 40/94 (Case C-173/04 P Deutsche SiSi-Werke v OHIM [2006] ECR I-551, paragraph 31, and Storck v OHIM, paragraph 28)

20. This was further reiterated in joined cases C-344/10 P and C-345/10 P *Freixenet SA:*

45. It is also settled case-law that, the criteria for assessing the distinctive character of three-dimensional trade marks consisting of the appearance of the product itself are no different from those applicable to other categories of trade mark (see, in particular, Mag Instrument v OHIM, paragraph 30; Case C-173/04 P Deutsche SiSi-Werke v OHIM [2006] ECR I-551, paragraph 27; Storck v OHIM,paragraph 26, and Case C-144/06 P Henkel v OHIM [2007] ECR I-8109, paragraph 36).

46. However, when those criteria are applied, account must be taken of the fact that the perception of the average consumer is not necessarily the same in relation to a three-dimensional mark consisting of the appearance of the product itself as it is in relation to a word or figurative mark consisting of a sign which is independent of the appearance of the products it designates. Average consumers are not in the habit of making assumptions about the origin of products on the basis of their shape or the shape of their packaging in the absence of any graphic or word element, and it could therefore prove more difficult to establish distinctive character in relation to such a three-dimensional mark than in relation to a word or figurative mark (see, in particular, Mag Instrument v OHIM, paragraph 30; Deutsche SiSi-Werke v OHIM, paragraph 28, and Storck v OHIM, paragraph 27).

47. In those circumstances, only a mark which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin is not devoid of any distinctive character for the purposes of Article 7(1)(b) of Regulation No 40/94 (see, in particular, Mag Instrument v

OHIM, para 31; Deutsche SiSi-Werke v OHIM, para 31, and Storck v OHIM, para 28).

21. When considering whether a mark departs significantly from the norms and customs of the trade, I refer to the three steps identified by Lord Justice Kitchen in [2017] EWCA Civ 1729, *London Taxi* and paragraph 45:

> *45. The first step in the exercise is to determine what the sector is. Then it is necessary to identify common norms and customs, if any, of that sector. Thirdly it is necessary to decide whether the mark departs significantly from those norms and customs.*

22. It would appear that when determining if a shape mark is inherently distinctive the CJEU may be (but as I have said, it is not acte claire), saying that the only necessary and sufficient test is whether the shape departs significantly from the norms and customs of the sector. However, whilst the UK Courts seem to acknowledge that the question of 'departing significantly from the norms and customs' may be a necessary test, they do not appear to agree that it is also a 'sufficient' test. In other words, it is only the statutory test of being 'devoid of distinctive character' (from a trade mark perspective) that matters rather than any Court substituted test of 'differing significantly'. The UK Courts' perspective also appears to differentiate between the concept of distinctiveness per se (i.e. the ability to stand out in a general sense), and distinctiveness in the trade mark sense (i.e. denoting trade origin). In this regard, it is worth noting the following comments from Kerly's, 16th Edition, Chapter 10:

> *10-035 The essential function of a trade mark is to distinguish the goods and/or services of one undertaking from those of other undertakings and the term "distinguish" must be understood in that way. The attribute of a trade mark which gives it the necessary ability to "distinguish" is its distinctive character, but the assessment of distinctive character is really an assessment of whether the sign/trade mark can distinguish in the sense just mentioned.*
>
> *10-036 Problems arise if the term "distinguish" is used or understood more loosely. The examples given below demonstrate that "distinguish" can and has been used to mean different things. First, there is the correct meaning: see the citations from the Court of Justice judgments set out above.*
>
> *10-037 Secondly, the term "distinguish" can be used in the sense of "different". In the past, this meaning tended to be used (especially in CFI judgments) in cases involving the shapes of goods or their packaging, where the applicant frequently argues to this effect: "my mark has (the minimum degree of) distinctive character because it can clearly be distinguished from others in the market." This type of argument is utterly bogus. It amounts to nothing more than saying that "my mark is different". Deployment of this type of argument is a clear sign that the mark does not have distinctive character.*
>
> *10-038 Thirdly, "distinguish" or "distinctive" is used in the sense of "standing out", likely to attract the attention of the consumer. This is a slight variation on "different", in that the mark is now adjudged to be sufficiently different such that it attracts the attention of the consumer. However, there are many things which*

will attract the attention of the consumer (bright or garish colours, snazzy graphics, bold claims) which have nothing to do with distinctive character. The usefulness of this concept depends entirely on whether the consumer's attention is attracted in the right "trade-origin message" manner.

10-039 Fourthly, the term "distinguish" is used in the "recognition" sense. Again, this may be only a slight variant on the above, but it has a greater aura of respectability because it involves the average consumer. Thus, the applicant argues to this effect: "my mark has distinctive character because the average consumer would recognise it, thereby enabling him or her to repeat the purchasing experience if positive or avoid it if negative." The CFI has correctly rejected recognition as being sufficient in some cases, e.g.: 49 The fact that consumers may get into the habit of recognising such a product from its get up is not enough to preclude the ground for refusal based on Article 7(1)(b) of the Regulation – Unilever v OHIM (T-194/01).

23. It seems therefore to be clear from these comments that from the UK's perspective, simply being different, novel, eye-catching or standing out is not, of itself, sufficient for establishing distinctiveness in a trade mark sense.

24. I refer also to the comments of Laddie J in *Yakult* [2001] RPC 39, when he upheld the refusal on appeal to register the shape of a bottle for goods in Classes 29 and 30. At paragraphs 8 and 10 he said (emphasis added):

8. There was little dispute between the parties as to the correct approach to the application of section 3(1)(b). The onus is on the applicant to show that the proposed mark is inherently distinctive. Mr Thorley agreed that Mr James was entitled to rely upon first impressions, as long as in doing so he directed his attention to the correct issue. According to Mr Thorley, that issue, in a case where a container is the subject of the application, ***is whether the design is eye catching in a relevant trade mark sense. The fact that a particular design is eye-catching because it is unusual or decorative is not enough by itself. At all times the Registry has to ask whether the design is distinctive as a badge of origin…***

10. Where inherent distinctiveness is concerned, the Registry has to find that the mark performs the function of identifying origin even before the public is educated that it is so used for that purpose. Where invented, non-descriptive word marks are concerned, it may be easy to come to such a finding. But where a container is in issue it may well be much more difficult. ***As Mr Thorley rightly conceded, the fact that a container is unusual or attractive does not, per se, mean that it will be taken by the public as an indication of origin. The relevant question is not whether the container would be recognised on being seen a second time, that is to say, whether it is of memorable appearance, but whether by itself its appearance would convey trade mark significance to the average customer.*** *For the purpose of this appeal, I am prepared to accept that the bottle shape which is the subject of these applications is both new and visually distinctive, meaning that it would be recognised as different to other bottles on the market. That does not mean that it is inherently distinctive in a trade mark sense.*

25. When applying apparent tension to the present case, my starting point is the presumption, based on *Henkel* and others, that consumers are not in the habit of regarding marks comprising the appearance of products or their packaging as trade marks in their inherent characteristics. From that starting presumption, I need to make a finding as to whether I consider the features of shape and configuration drawn to my attention by the applicant as, 'significantly differing from the norms and customs of the trade' (which may displace the presumption), or simply normal variants and/or decorative only. Even if I am wrong however, that the bottle is simply, a 'normal variant', then, based on UK authority, the fact a double bulbous feature of the bottle neck and compass bottom may be novel, original or even eye catching would not be sufficient to show that the mark is distinctive in a trade mark sense and in its inherent characteristics. The mark would require something more for it to convey trade mark significance in its inherent characteristics. In my mind, the mark does not possess any characteristic that would enable the relevant consumer to immediately perceive the mark in its totality as a distinctive trade mark in the prima facie, but I will elaborate my finding below.

Application of the law

Inherent distinctiveness

26. The mark consists of a three dimensional shape of a bottle which includes a figurative element at the base of the bottle in the form of a navigational compass. The goods in respect of which the mark is to be used are *"Spirits (beverages); whisky."* in Class 33. I consider the relevant consumer of these goods to be the adult general public seeking to purchase the goods for their own consumption or to gift to others; and also retail establishments and businesses operating in the hospitality sector, both of which would purchase the product to offer for sale to their customers, be that in a retail establishment, or a bar, hotel or restaurant. In terms of the general public, I do not consider spirits and whisky to be an everyday consumable but are more likely to be considered more a luxury item that they would purchase relatively infrequently as a treat for themselves or as a gift for others. Businesses would be purchasing the goods to sell on to their customers so they would want to be sure that the goods are those that they know will be in demand by their customers. In each case, I believe the relevant consumer would apply at least a moderate level of attention and circumspection when considering whether or not to purchase.

27. The mark has been applied for as a 3D shape of a bottle and which consists predominantly of a larger lower section of cylindrical shape within which the majority of the beverage is held. This narrows and extends towards the top of the bottle to form its neck which is then closed off with a cap. I would regard the shape of the bottle as being pretty much what one would expect an alcoholic beverage bottle to look like. As mentioned in paragraph 6 above, the bottle shape is typical of the bottles used in respect of spirits and whisky in that the majority all incorporate a wider lower section with a narrower neck and are all of similar height. The examples of third party spirit and whisky bottles provided with the hearing report can also be found at Annex A below. I acknowledge that the applicant's bottle includes what Mr Furneaux described as being a 'double bulbous' segment within its neck, but this is not too dissimilar to other bottles on the market which also have curved sides giving them a bulbous

appearance. I do not consider this minor difference will make a significantly different impression on the relevant consumer.

28. When considering how the relevant consumer will perceive the mark I have taken into consideration the fact that consumer perception is not necessarily the same in relation to a three-dimensional mark consisting of the appearance of the product itself as it is in relation to a word or figurative mark, and furthermore, consumers are not in the habit of making assumptions about the origin of products on the basis of their shape or the shape of their packaging in the absence of any graphic or word element (*Henkel, Freixenet SA).*

29. Within the alcoholic beverage sector, the goods are generally sold in bottles of comparable size and shape to the applicants bottle (see Annex A). I do not regard the 'double' bulbous feature of the applicants bottle to be enough to conclude that the shape of the bottle 'in its totality' departs significantly from the norms and customs of the trade and thereby fulfils its essential function of indicating origin. Furthermore, it should not necessitate an analytical examination of the goods by the consumer in order for them to identify features that would enable the goods to be distinguished from those of other undertakings in the market place. I refer in this regard to C-136/02 *Mag Instrument v OHIM* and paragraph 32 where it reads:

> *"It must always be determined whether such a mark permits the average consumer of that product, who is reasonably well informed and reasonably observant and circumspect, to distinguish the product concerned from those of other undertakings without conducting an analytical examination and without paying particular attention."*

30. If the relevant consumer is required to take time in analysing the goods in order to notice what are considered to be their distinguishing features, then the mark cannot be said to immediately designate single trade origin. Moreover, I am of the view that the relevant consumer would not pay too much attention to the double bulbous feature of the bottle to the extent that it would lead them to conclude that the bottle shape was a distinctive sign designating the goods of a particular undertaking. I acknowledge that the bottle also bears a graphic element at the base of the bottle in the form of the following compass image:

However, its position on the underside of the bottle is likely to be overlooked by the relevant consumer and does not have the capacity to designate the goods of a single origin. Even if they were to turn the bottle over and see the image, or if the compass were to be otherwise visible at the point of sale, I do not believe they would regard it a trade mark but will take is as nothing more than as a non-distinctive decoration.

31. In assessing the inherent distinctiveness of the mark I have also taken into account the way in which the goods are presented to the consumer and note that the applicant's goods are pre-packaged within a rectangular cardboard carton (see Annex A below). The goods can be purchased either from a physical or online store. When sold via a physical store the goods will be displayed on the shelf within the carton. The carton does not bear an image of the bottle itself so when purchasing via a physical store the relevant consumer would not become aware of the bottle shape or the compass image until it had been removed from the carton. This supports my view that neither the bottle shape nor the compass image are being used as a means of identifying the goods of a single undertaking and distinguishing them from those of other undertakings. In other words, the mark is not being used as a trade mark but this I something I shall discuss further in relation to acquired distinctiveness.

32. When purchased via an online store, as can also be seen in Annex A, the actual bottle is shown alongside the carton so the consumer will have sight of it during their purchasing selection. Nonetheless, I am of the view that even in that context the bottle shape is not performing the function of a distinctive trade mark. The consumer will take OLD PULTENEY as the designation of origin and will not afford the bottle shape any trade mark significance.

33. I have mentioned above that the goods are presented to the consumer within a cardboard carton, however, I have also taken into consideration how the mark would be perceived if the goods were also offered for sale without the carton, (although I have not found evidence of that to be the case). It is settled case law (*Freixenet SA and others),* as I have said, that consumers are not in the habit of making assumptions about the origin of products on the basis of their shape or the shape of their packaging in the absence of any graphic or word element. I therefore remain of the view that when encountering the bottle without its carton, the relevant consumer would not regard its shape as a distinctive sign designating the goods of a single undertaking.

34. I therefore conclude that the mark is inherently non-distinctive as a normal variant of a bottle containing alcohol and that it does not significantly differ from the norms and customs of the trade. Further, that even if its features were to be objectively novel or eye catching, in accordance with UK authorities I would find that such features, collectively or individually, would not convey trade mark distinctiveness in the prima facie. Without education, the relevant consumer will not perceive it as a sign designating the goods as those originating from a single undertaking.

Acquired distinctiveness and the relevant legal principles.

35. As already mentioned in paragraph 15, section 3 of the Act states that a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) of the Trade Marks Act 1994 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.

36. The guiding principles when assessing evidence to demonstrate acquired distinctiveness are set out in *Windsurfing Chiemsee* (Joined cases C-108/97 and C-109/97):

51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: the market share held by the mark; how intensive, geographically widespread and longstanding use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from Chambers of Commerce and industry or other trade and professional associations.

52. If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied. However, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general abstract data such as predetermined percentages.

53. As regards the method to be used to assess the distinctive character of a mark in respect of which registration is applied for, Community law does not preclude the competent authority, where it has particular difficulty in that connection, from having recourse, under the conditions laid down by its own national law, to an opinion poll as guidance for its judgments (see, to that effect, Case C-210/96 Gut Springenheide and Tusky [1998] ECR I-4657, paragraph 37)"

37. It is of course understood that the principles set out in *Windsurfing Chiemsee* do not represent a simple 'tick box' exercise but that a full evaluation of the totality of the evidence must be undertaken.

38. The way in which an inherently non-distinctive mark may acquire a distinctive character was elaborated upon by the CJEU in Case C-299/99 *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* [2002] ECR I-5475 at paragraph 64:

"…the identification, by the relevant class of persons, of the product as originating from a given undertaking must be as a result of the ***use of the mark as a trade mark*** *and thus as a result of the nature and effect of it, which make it capable of distinguishing the product concerned from those of other undertakings."* (Emphasis added)

39. In other words, an inherently non-distinctive mark can only acquire a distinctive character if the maker or supplier of the goods and services concerned uses the mark in such a way that it comes to guarantee to consumers that the product originates from a particular undertaking. I must therefore assess the evidence and determine whether a significant proportion of the relevant consumer has come to perceive the mark as designating the goods of a single undertaking and that it serves to distinguish those goods from those of other undertakings as a result of the use made of it. In that respect, such use must be use as a trade mark.

40. Furthermore, in Case C-353/03 *Société des Produits Nestlé SA v Mars UK Ltd* [2005] ECR I-6135 the CJEU has also held that a non-distinctive mark may have acquired distinctive character if it has been used as part of or in conjunction with a registered trade mark.

> *26. In regard to acquisition of distinctive character through use, the identification, by the relevant class of persons, of the product or service as originating from a given undertaking must be as a result of the use of the mark as a trade mark (judgment in Philips, paragraph 64).*
>
> *27. In order for the latter condition, which is at issue in the dispute in the main proceedings, to be satisfied, the mark in respect of which registration is sought need not necessarily have been used independently.*
>
> *28. In fact Article 3(3) of the directive contains no restriction in that regard, referring solely to the 'use which has been made' of the mark.*
>
> *29. The expression 'use of the mark as a trade mark' must therefore be understood as referring solely to use of the mark for the purposes of the identification, by the relevant class of persons, of the product or service as originating from a given undertaking.*
>
> *30. Yet, such identification, and thus acquisition of distinctive character, may be as a result both of the use, as part of a registered trade mark, of a component thereof and of the use of a separate mark in conjunction with a registered trade mark. In both cases it is sufficient that, in consequence of such use, the relevant class of persons actually perceive the product or service, designated exclusively by the mark applied for, as originating from a given undertaking."*

41. I refer also to the comment in Bach and Bach Flower Remedies Trade Marks [2000] RPC 513 at paragraph [49] (per Morritt LJ with whom Thorpe and Chadwick L.JJ agreed):

> *"… use of a mark does not prove that the mark is distinctive. Increased use does not do so either. The use and increased use must be in a distinctive sense to have any materiality.*"

Application of the case law

42. The evidence consisted of a witness statement of Mr Peter Powell, the commercial director of Inver House Distillers Limited (the applicant), together with Exhibits PPA to PP10.

43. Mr Powell stated in his witness statement that the mark was first used in 1997 in respect of their OLD PULTENEY 12 year old single malt whisky. Turnover was recorded as being just in excess of £2.7million during the financial year 2018 rising to just over £2.9million in 2022. The applicant had spent a considerable amount marketing the product spending around £330,000 in 2018 rising year on year to around £942,000 in 2022. While these figures are not insignificant, it is clear from the evidence that the goods have been marketed under the brand name OLD PULTENEY

with no evidence to suggest that the bottle shape itself was being used as a brand indictor or that it had been brought to the attention of the consumer.

44. Exhibit PP1 included screenshots taken from the applicant's website setting out the history of the Pulteney Distillery since it was founded in 1826. Representations of the bottle appeared on pages 12 and 13 but the mark was not being used as a trade mark nor was the reader drawn attention to it.

45. Exhibit PP2 included screenshots of various other whisky bottles and had been provided to show that none have a similar shape or features as those found in the applicant's bottle. I would agree that none of the other branded bottles are exactly the same as the applicants in terms of shape and features, but their overall shape is very similar with only minor differences in the shape and size of the neck. As mentioned at paragraph 29, I do not regard the shape of the applicants bottle as being one that can be said to depart significantly from the norms and customs of the trade such that it would immediately be perceived as a designation of single brand origin.

46. Exhibit PP3 included extracts from a market research project conducted by an external agency on behalf of the applicant for a new product within their OLD PULTENEY range. While the focus of the research was on the new product, the results highlighted the importance of the bottle shape to the brand, for example, it revealed that the bottle shape was considered to be the applicant's strongest asset in that it stands out from the 'standard bottles'. The research also suggested that the applicant no longer use the carton because the distinctive shape of the bottle would enable it to stand out more on the shelf. While it was interesting to note that the consumer considered the bottle shape to be distinctive in a broad sense, that is not to say that they would perceive it immediately as a trade mark. The evidence must demonstrate that the mark has acquired distinctive character through use, however, as already mentioned above, the goods are sold within a carton so the consumer would not have sight of the bottle shape until after they had purchased it. While this exhibit shows that the consumer has come to recognise the bottle shape as being distinctive in design and in a broad sense, it did not show that they considered it distinctive in a trade mark sense.

47. Exhibit PP4 included marketing campaigns and press releases which included an article on the website www.derbytelegraph.co.uk featuring a Father's Day gift set comprising a bottle of the OLD PULTENEY whisky and a box of *Guylian* chocolates. The article shows a bottle of the whisky but there was no reference to it being used as a trade mark. The exhibit also included an article on the website www.dramface.com announcing the introduction of Old Pulteney's new collection of whiskies 'The Coastal Series'. The bottle appears in the article but no mention is made of the bottle shape or that it is being used as a trade mark. Another article on the website www.London-post.co.uk is an advert for a London Chip Shop who is selling fish and chips with a dram of Old Pulteney. There is an image of the bottle in the article but no specific reference to it or that it is being used as a trade mark. The exhibit also includes various advertising materials including those appearing on outdoor ads, on the online Tesco website, and materials from other Ad campaigns. These include images of the bottle but again none make any specific reference to its shape or that the shape is being used as a trade mark.

48. Exhibit PP5 included press clippings appearing on various websites upon which images of the bottle appeared. As was common throughout the evidence, this exhibit also did not show the bottle shape being used as a trade mark and no attempt was made to draw the consumers attention to it as a designation of origin. The websites included the following:

www.womenshealthmag.com
www.foodieexplorers.co.uk
www.abouttimemagazine.co.uk
www.whiskeyraiders.com
www.bbcgoodfood.com
www.thewhiskeywash.com
www.dranscotland.co.uk

49. Exhibit PP6 included further extracts taken from various websites including www.bbr.com which refers to the 'still shaped bottle'; www.topwhiskies.com refers to the bottle shape being inspired by the shape of the pot stills. On www.scotchwhisky.com it mentions that Old Pulteney sports a new bottle design which 'freshens up the overall look' yet retains the brand's distinctive bottle shape. www.jacsbothy.wordpress.com refers to the design of the bottle and describes it as having a small double neck reminiscent of a classic pot still shape. www.coolhinting.com the text is faint so was illegible. The screenshot taken from www.facebook.com showed images of the bottle but this was not trade mark use. While these articles all mention the shape of the bottle none refer to it in a trade mark sense nor do they include anything that would suggest that the applicant is attempting to educate the consumer that the shape of the bottle is their trade mark.

50. Exhibit PP7 includes a selection of sample invoices relating to sales of the 'Old Pulteney' products. These invoices serve only to show that the goods are sold throughout the UK under the brand name Pulteney. They do not indicate that the mark applied for is used to identify the goods of a single undertaking.

51. Exhibit PP8 included details of retailers in the UK who sell the applicant's products including:
www.thewhiskeyexchange.com;
www.whisky-online.com;
www.amathusdrinks.com;
www.tyndrumwhisky.com;
www.waitrose.com;
www.maserofmalt.com;
www.onbuy.com.

52. It is evident that the goods are sold via various online websites but the goods are sold under the trade mark Old Pulteney with no mention of the bottle shape or that the shape is also being used as a trade mark.

53. Exhibit PP9 provided details of the applicants advertising via their Facebook pages. While the screenshots show images of the bottle none are referring to it as the trade mark so it is Old Pulteney that consumers will take as the brand.

54. Exhibit PP10 provided details of advertising via sponsorship which included extracts from various websites including their own:

www.oldpulteney.com
www.tradeonlytoday.com
www.clipperroundtheworld.com
www.wickgolfclub.org
www.clipperroundtheworld.com
www.whiskycast.com
www.scotchmaltwhisky.co.uk
www.fieldandfawcett.co.uk
www.sailingtoday.telegraph.co.uk
www.oldpulteney.com

55. Most of these articles did not show the mark applied for, that is, the image of the bottle. Of those upon which the bottle did appear it was my view that it was not being used as a trade mark and would simply be seen as a representation of the goods with consumers taking 'Old Pulteney' to be the brand.

56. Having considered the evidence as a totality it was my view that none of the exhibits showed the mark being used as a means of identifying the goods of a single undertaking, that is, it was not being used as a trade mark. It is not for me to set out prescriptively what such evidence would look like in all cases. I will just draw attention to the case of BL O/072/18 (Device of a shoe sole) at para 31 which talks about a proprietor having 'confidence' in its sub-brand to convey a message of origin in its marketing. I do not see this 'confidence' in the applicant's marketing, shown in the evidence in this case. It is true for example that the compass device on the base of the bottle is sometimes replicated in a figurative image in connection with the marketing of the product but this, of itself and in my opinion, is not enough from which to draw the conclusion that the applicant uses a compass device, either separately from the bottle in a figurative sense or as part and parcel of the bottle itself.

57. Furthermore, in *Societe de Produits Nestle v Cadbury UK Ltd* [2017] EWCA Civ 358 (the 'Kit Kat' case), it states at paragraph 78:

> *"…..We are concerned here with a mark, the three-dimensional shape of a chocolate product, that has no inherent distinctiveness. A shape of this kind is not inherently such that members of the public are likely to take it as a badge of origin in the way they would a newly coined word or fancy name. Now assume that products in that shape have been sold on a very large scale under and by reference to a brand name which is inherently highly distinctive. Assume too that the shape has in that way become well-known. That does not necessarily mean that the public have come to perceive the shape as a badge of origin such that they would rely upon it alone to identify the product as coming from a particular source. They might simply regard the shape as a characteristic of products of that kind or they might find it brings to mind the product and brand name with which they have become familiar. These kinds of recognition and association do not amount to distinctiveness for trade mark purposes, as the CJEU has now confirmed in its decision in this case*"

58. With this in mind, even if the goods of the applicant have been sold on a very large scale under the trade mark OLD PULTENEY and the bottle shape has come to be very well known, the evidence must show that the relevant consumer perceives the bottle shape as a badge of origin. Even if the consumer recognised the bottle shape and associated it with the applicant, that is not enough to demonstrate acquired distinctiveness through use. The bottle shape may serve to allow the consumer to recognise and associate the mark with the OLD PULTENEY trade mark but it must be proved that the consumers regard the bottle shape itself as a badge of trade origin, which means that the consumers would rely on the bottle shape alone to purchase the products, if it were used on its own without any of the OLD PULTENEY trade marks. The evidence did not demonstrate that to be the case.

59. With regard to the case law quoted above in respect of *Nestle*, the evidence showed that OLD PULTENEY is a well-known brand of whisky and that the trade mark OLD PULTENEY appeared on the label affixed to the bottle as well as the carton within which the bottle is sold. In my mind, the bottle shape is not being used '*as part of a registered trade mark*', nor is it '*a component thereof*'. While the consumer will encounter the bottle shape once they have purchased the goods, or when viewing the goods online, I do not consider that to constitute '*use as a separate mark in conjunction with a registered trade mark'.* I am therefore of the view that the applied for mark has not acquired distinctive character through use as part of a registered trade mark, of a component thereof, or use of a separate mark in conjunction with a registered trade mark.

60. I did not consider it appropriate to invite more evidence as in my view 'more of the same' would not suffice in demonstrating acquired distinctiveness through use. I refer to the comment in Bach and Bach Flower Remedies Trade Marks [2000] RPC 513 at paragraph [49] (per Morritt LJ with whom Thorpe and Chadwick L.JJ agreed).

> *"… use of a mark does not prove that the mark is distinctive. Increased use does not do so either. The use and increased use must be in a distinctive sense to have any materiality.*"

61. In the present case the applicant had provided evidence which in my assessment did not come close to demonstrating that the bottle shape itself had acquired distinctiveness through use. I therefore did not consider it appropriate to invite more. My main concern was that the evidence did not show the mark being used as a trade mark, that is to say for the purposes of identifying the goods of a single undertaking. The evidence had failed to demonstrate that a significant proportion of the relevant consumer had come to regard the sign as a trade mark guaranteeing the origin of the goods.

Conclusion

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

Dated this 5th day of December 2023

Helen Davies
For the Registrar
The Comptroller-General

Annex A

<u>Examples of other bottled spirits and whisky on the market.</u>

Example of how the applicants goods are sold via online retail store.

https://groceries.asda.com/product/scotch-malt-whisky/old-pulteney-single-malt-scotch-whisky-12-years-old/1975767