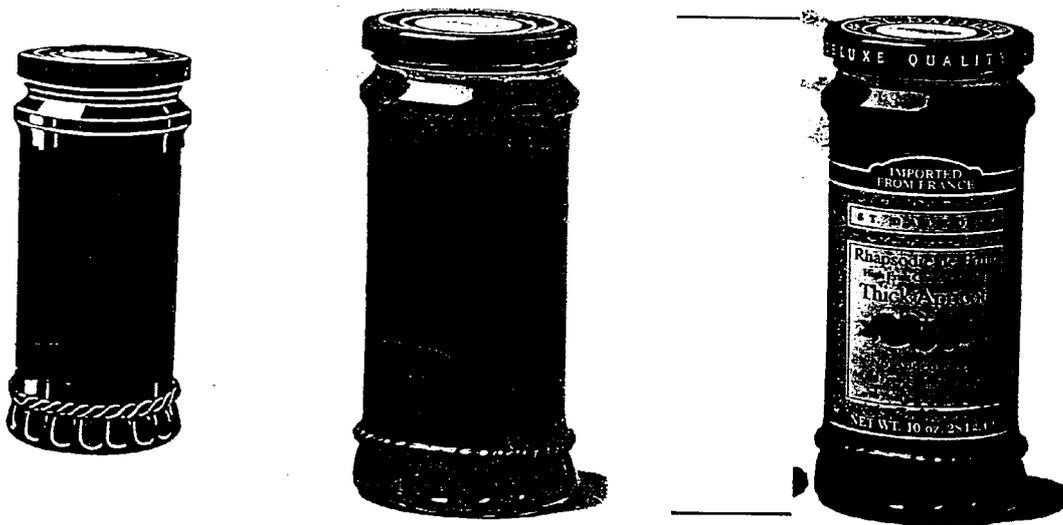


## TRADE MARKS ACT 1994

**IN THE MATTER OF  
APPLICATION NO.2103377  
BY CHATHAM INTERNATIONAL INCORPORATED  
TO REGISTER A TRADE MARK  
IN CLASS 29**

### DECISION AND GROUNDS OF DECISION

On 21 June 1996 Chatham International Incorporated of 103 Springer Building, 3411 Silverside Road, Wilmington, Delaware 19810, U.S.A. applied under the Trade Marks Act 1994 to register the trade mark shown below in Class 29 of the register in respect of "Jams, conserves, marmalades, spreads and curds".



The shape of the jar as shown in the representations

Although the third representation of the mark shows it with a label etc., it is clear from the form of application that this forms no part of the mark applied for. The mark applied for is the three-dimensional shape of the jar as represented above.

Prior to the application being examined the applicants filed evidence to persuade the registry that the application should be allowed to proceed to registration as a result of the use made of the mark. However, when the application came to be examined, the evidence was not considered sufficient to demonstrate that the mark had acquired distinctiveness and objection was taken under Section 3(1)(b) of the Act.

At the hearing, at which the applicants were represented by Mr Matthews of Page Hargrave, their trade mark agents, the objection under Section 3(1)(b) of the Act was maintained. The applicants subsequently filed additional evidence but the objection was again maintained. Consequently the applicant was allowed a further period of three months until 14 January 1998 in which to respond. However, by 19 February 1998 no response had been received and the application was therefore refused in accordance with Section 37(4) of the Act.

Following refusal of the application under Section 37(4) of the Act I am now asked under Section 76 of the Act and Rule 56(2) of the Trade Marks Rules 1994 to state in writing the grounds of my decision and the materials used in arriving at it.

Firstly, I must consider the prima facie case for acceptance.

Section 3(1)(b) of the Act read as follows:-

"The following shall not be registered.

(b) trade marks which are devoid of any distinctive character

The shape of the applicants' jar reveals a protruding lip towards the top of the jar, that will enable a purchaser to hold the jar firmly to facilitate the removal of its cap. There also appears to be a pattern incorporated into the surface of the jar towards its base. The only other feature of the jar is that its sides seem uniform in dimension.

Goods such as jams and spreads etc. are usually sold in jars and such jars are very similar in appearance to the shape of the jar applied for. The only real difference between this jar and the "average" jar shape is that the shape of the applicants' jar is slightly taller in relation to its diameter than usual but apart from that it is unexceptional. I do not see that there is anything in the shape of this jar that would serve to distinguish the goods of the applicant from those of other traders.

In the TREAT trade mark case (1996 RPC 296), Jacob J remarked:-

"What does *devoid of any distinctive character* mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark? A meaningless word or a word inappropriate for the goods concerned ("North Pole" for bananas) can clearly do. But a common laudatory word such as "Treat" is, absent of use and recognition as a trade mark, in itself (I hesitate to borrow the word from the old Act *inherently* but the idea is much the same) devoid of distinctive character. I also think "Treat" falls within section 3(1)(c) because it is a trade mark which consists exclusively of a sign or indication which may serve in trade to perform a number of the purposes there specified, particularly, to designate the kind, quality and intended purpose of the product."

It is my view that the shape applied for will not be taken as a trade mark without first educating the public that it is a trade mark. It follows that this application is debarred from prima facie acceptance registration by Section 3(1)(b) of the Act.

However, that is not the end of the matter since I have to consider the evidence filed which the applicants contend shows that the mark has acquired a distinctive character as a result of the use made of it.

The proviso to Section 3(1) is in the following terms:-

“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 evidence submitted prior to examination consists of a Statutory Declaration dated 3 August 1996 by Mark J Tate of Canners and Packers International Limited who, is the importer and distributor for all "St Dalfour" goods sold in the United Kingdom. It is not entirely clear from Mr Tate's evidence, but it would appear that "St Dalfour" is the word mark used by the applicants in conjunction with the jar shape applied for. It is clear from this evidence that the applicants have sold a very considerable number of jars through very well known retail outlets. Mr Tate does not state what goods have been sold in the jar shape applied for, although I note from the exhibits to his declaration that the only goods shown are "jams".

The turnover in number of jars sold is as follows:

DATE	NUMBER OF JARS
1993	82,944
1994	616,338
1995	2,320,704
1996	1,869,696 (six months only)

NB: Total number of jars sold in 1996 were estimated to be 3,700,000.

These sales account for annual retail-based turnover as follows:

DATE	£ - RETAIL
1993	82,114
1994	610,174
1995	2,529,567
1996	4,514,000 (estimated)

Mr Tate goes on to provide details of advertising associated with the jar for the years 1994 to August 1996. Details of the advertising expenditure for this period are as follows:

DATE	£ - ADVERTISING
1994	114,530
1995	165,000
1996	27,000 (to August)

During this period advertisements were placed in appropriate magazines and exhibition stands were taken at the BBC Good Food Show, the Festival of Fine Wine and Food and at the Ideal Home Exhibition. Mr Tate goes on to state that the St Dalfour jar received the Prix Verre Avenir award in France.

At exhibit MT1 Mr Tate also produces various references to the jar, in the way of extracts from magazines, photographs of the jar on display at two retail outlets, photographs of the jar at two exhibitions and two examples of leaflets used by the applicant. All this material shows that, in use, additional distinguishing material appears on the jar shape applied for.

It is my conclusion that this evidence is unsatisfactory. Although it appears that a large number of jars have been sold through well known outlets, nowhere is it stated that “St Dalfour” goods are always sold in jars of the shape applied for; it is not, therefore, possible to be sure that sales of “St Dalfour” products equate with sales of goods under the shape mark applied for.

Leaving that aside, use of a mark does not, in itself, equate to distinctiveness.

In the TREAT trade mark case (1996 RPC 296), Jacob J remarked:-

“Mere evidence of use of a highly descriptive or laudatory word will not suffice, without more, to prove that it is distinctive of one particular trader - is taken by the public as a badge of trade origin. This is all the more so when the use has been accompanied by what is undoubtedly a distinctive and well recognised trade mark.”

I consider that this applies equally where the sign in question is something as inherently lacking in trade mark character as this jar shape. It is important to note that the evidence shows that the jar is always used with other distinguishing matter, notably the “St Dalfour” mark, and there is no reason to conclude that it is capable of distinguishing alone.

In this case the applicants do not only rely upon evidence of use. They also rely upon the evidence from persons in the trade that the shape is unique for such goods.

As I have already indicated, the evidence of use filed prior to the date of examination was unacceptable because it demonstrated only that the jar had been used with additional distinctive matter contained in a label attached to the jar. The subsequent evidence sought to demonstrate that when presented with an outline shape of the jar most customers, competitors and a trade association associated the shape of the jar with the applicants.

This evidence consists of a survey conducted by Page Hargrave on behalf of the applicants.

In his Statutory Declaration, Mr Matthews, of Page Hargrave, states that he was provided with the names and addresses of three customers and four competitors. Although there is no specific trade association for jam or preserve manufacturers in the United Kingdom he was also provided with the name and address of an independent trade association. On 13 and 17 January Mr Matthews sent identical letters and questionnaires, together with two representations of the shape of the jar, to the above-mentioned customers, competitors and the trade association. Copies of the letters and enclosures sent to the respondents together with their replies are attached at Annex A. No responses were received in respect of questionnaires sent to Thursday Cottage Limited and Trustin the Foodfinders Limited.

I note from the questionnaire completed by the British Association of Canned and Preserved foods Importers and Distributors that when asked:

**“Do you recognise the jar shape shown on the attached Exhibit A?”**

their reply was:

**“No”**

and when asked:

**“With what goods do you associate the jar shape?”**

their reply was:

**“Could be anything from veg fruits to jams/chutneys”.**

I further note from the questionnaire completed by Whole Earth Foods Limited that when asked:

**“With which firm or company do you associate said jar shape?”**

they replied:

**“Bick’s, Sorrel Ridge, Polaner, St Dalfour”.**

The other respondents state that they recognise the jar shape and that they “associate “ the jar shape with the applicants.

In the TREAT case (referred to above) Jacob J noted:

“Overall there is a further point, namely that recognition is not the same thing as perception as a trade mark - as not only recognising the word but as regarding it, in itself, as denoting goods of one particular trader.”

In my opinion this evidence is flawed in that although it demonstrates a measure of association of the shape of the jar with the applicants it falls far short of establishing that the relevant public regard the sign applied for as a badge of origin - ie as a trade mark.

In any event the respondents only represent a small selection of the relevant public. There is no evidence that the general public regard the jar shape as distinctive of the applicant. Trade buyers are not, in my opinion, representative of the general public, as they are likely to be aware of small differences in packaging shapes that the general public will fail to notice.

Even if I am wrong about this the survey only establishes that a small proportion of the relevant public regard the jar shape as distinctive.

In the TREAT case Jacob J said:

“Suppose the proprietor can educate 10% of the public into recognising the word as his trade mark. Can it really be enough to say it has a distinctive character and so enough to let the proprietor lay claim to the word as a trade mark altogether? The character at this stage is partly distinctive but mainly not. .... This all suggests that the question of factual distinctive character is one of degree. The proviso really means ‘has the mark acquired a sufficiently distinctive character that the mark has really become a trade mark’.”

It is my conclusion that the mark is not incapable of distinguishing within the meaning of Section 1(1) of the Act: but the evidence has not shown that it has acquired a distinctive character for the goods claimed or the goods shown in the evidence ie “jams”. The mark is therefore devoid of distinctive character.

In this decision I have considered all the documents filed by the applicant and all the arguments submitted to me in relation to this application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Section 3(1)(b) of the Act.

Dated this 31 day of July 1998

A J PIKE  
For the Registrar  
The Comptroller General

nts Trade Marks Designs Copyright

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HNNP  
**PAGE HARGRAVE**

CHARTERED PATENT ATTORNEYS  
EUROPEAN PATENT ATTORNEYS  
REGISTERED TRADE MARK AGENTS

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Ms Joanne Stewart  
J Sainsbury plc  
Stamford House  
Stamford Street  
London SE1 9LL

Date: 9th June 1997

Your Ref: -

Our Ref: HNM/CH/63000/001

Dear Ms Stewart

Re: Trade Marks

I am working on behalf of one of my clients in order to protect their trade mark rights in the United Kingdom and in order to do so, I have to provide the Trade Marks Registry with factual evidence.

I enclose a Questionnaire and would be much obliged if you would have it completed and returned to me in the enclosed stamped addressed envelope.

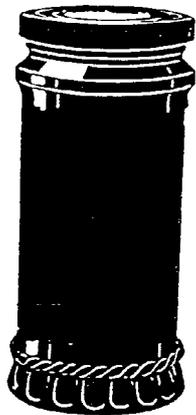
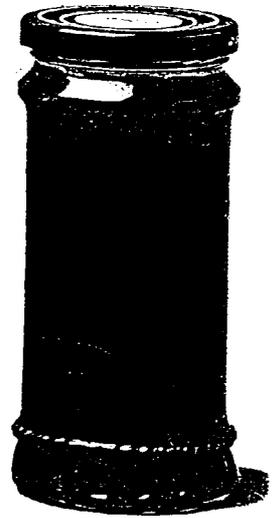
It is preferable that I do not mention the name of my clients in this matter at present in case your replies might be thought to be prejudiced one way or the other. Please note that I am not asking you for a biased opinion but are merely asking for a statement of the facts as they appear to you. If the answers are detrimental to my clients' case then so be it.

Yours sincerely

H Nicholas Matthews  
Page Hargrave

enclosures

EXHIBIT "A"



QUESTIONNAIRE

QUESTION	ANSWER
1. What is your full name? .....	Joanne Stewart.....
2. What is the name and address of your company or employer? .....	J Sainsbury plc Stamford House Stamford Street London SE19 4L.....
3. What is the business of your company or employer? .....	Food Retailer.....
4. What position do you hold in your company or with your employer and for how long have you held it? .....	1 year Buying Support Manager.....
5. For how long have you been concerned with the trade carried on by your company or employer? .....	13 years.....
6. Do you recognise the jar shape shown on the attached Exhibit A1? .....	Yes.....
7. If so, for how long have you known said jar shape? .....	Two years approx.....
8. With what goods do you associate said jar shape? .....	St. Dalfour Fruit Spreads.....
9. With which firm or company do you associate said jar shape? .....	Canners & Packers.....
10. Would you be prepared to execute a Statutory Declaration in which you would confirm that the answers you have given are true? .....	Yes.....

SIGNED Joanne Stewart.....  
DATE 1/9/97.....

QUESTIONNAIRE

QUESTION	ANSWER
1. What is your full name? .....	MARTIN WATSON
2. What is the name and address of your company or employer? .....	BREWHEIST HEALTH FOOD SUPPLIES ASBUTCHURCH OYSTON LANE BYFLEET SURRY KT14 7JP
3. What is the business of your company or employer? .....	HEALTH FOODS WHOLESALE
4. What position do you hold in your company or with your employer and for how long have you held it? .....	BUYER 2 YEARS
5. For how long have you been concerned with the trade carried on by your company or employer? .....	2 1/2 YEARS
6. Do you recognise the jar shape shown on the attached Exhibit A1? .....	YES
7. If so, for how long have you known said jar shape? .....	2 YEARS
8. With what goods do you associate said jar shape? .....	ST DALFOUR JAM
9. With which firm or company do you associate said jar shape? .....	ST DALFOUR
10. Would you be prepared to execute a Statutory Declaration in which you would confirm that the answers you have given are true? .....	YES

SIGNED *M. Watson* .....

DATE ..... 13-1-97 .....

QUESTIONNAIRE

QUESTION	ANSWER
1. What is your full name?	CHANDRAN GNANAKURU
2. What is the name and address of your company or employer?	ROBINSKI & Co Ltd. 31-33 B. road Road LONDON W3 7XR
3. What is the business of your company or employer?	Food wholesalers & distributors
4. What position do you hold in your company or with your employer and for how long have you held it?	Managing Director 3 years
5. For how long have you been concerned with the trade carried on by your company or employer?	4 years
6. Do you recognise the jar shape shown on the attached Exhibit A1?	Yes.
7. If so, for how long have you known said jar shape?	2+ years
8. With what goods do you associate said jar shape?	St. Dalfour Jams
9. With which firm or company do you associate said jar shape?	Cannon & Puckers (U.K.)
10. Would you be prepared to execute a Statutory Declaration in which you would confirm that the answers you have given are true?	Yes.

SIGNED ..... *Chandran Anand* .....

DATE ..... 13<sup>th</sup> Jan -96 .....

QUESTIONNAIRE

QUESTION	ANSWER
1. What is your full name? .....	ANDREW MICHAEL JESWELL
2. What is the name and address of your company or employer? .....	MERIDIAN FOODS LTD CORNWEN LL21 9RT
3. What is the business of your company or employer? .....	FOOD MANUFACTURER
4. What position do you hold in your company or with your employer and for how long have you held it? .....	MANAGING DIRECTOR 10 YRS +
5. For how long have you been concerned with the trade carried on by your company or employer? .....	10 YRS +
6. Do you recognise the jar shape shown on the attached Exhibit A1? .....	YES
7. If so, for how long have you known said jar shape? .....	2 YRS +
8. With what goods do you associate said jar shape? .....	ST DALFOUR FRUIT SPREAD
9. With which firm or company do you associate said jar shape? .....	ST DALFOUR
10. Would you be prepared to execute a Statutory Declaration in which you would confirm that the answers you have given are true?	YES

SIGNED .....  .....

DATE ..... 21/1/97 .....

QUESTIONNAIRE

QUESTION	ANSWER
1. What is your full name?	CRAIG SAMS
2. What is the name and address of your company or employer?	WHOLE EARTH FOODS LTD 269 PORTOBELLO RD LONDON W11 1LR
3. What is the business of your company or employer?	FOOD + DRINK MFRS
4. What position do you hold in your company or with your employer and for how long have you held it?	CHAIRMAN 30 YEARS
5. For how long have you been concerned with the trade carried on by your company or employer?	30 YEARS
6. Do you recognise the jar shape shown on the attached Exhibit A1?	YES
7. If so, for how long have you known said jar shape?	20 YEARS
8. With what goods do you associate said jar shape?	PICKLES, RELISHES, DIPS, DRESSINGS, JAMS
9. With which firm or company do you associate said jar shape?	BICK'S, SORREL RIDGE POLANER, ST. DALFOUR
10. Would you be prepared to execute a Statutory Declaration in which you would confirm that the answers you have given are true?	YES

SIGNED Craig Sams

DATE January 25 97

QUESTIONNAIRE

QUESTION	ANSWER
1. What is your full name? .....	BRITISH ASSOCIATION OF CANNED AND PRESERVED FOOD IMPORTERS & DISTRIBUTORS LIMITED
2. What is the name and address of your company or employer? .....	SUITE 17, CASTLE HOUSE 25 CASTLE REACH STREET WINDYON, W.I.H. SYR.
3. What is the business of your company or employer? .....	TRADE ASSOCIATION
4. What position do you hold in your company or with your employer and for how long have you held it? .....	SECRETARY GENERAL
5. For how long have you been concerned with the trade carried on by your company or employer? .....	INCORPORATED SINCE 1984
6. Do you recognise the jar shape shown on the attached Exhibit A1? .....	NO
7. If so, for how long have you known said jar shape? .....	N.A.
8. With what goods do you associate said jar shape? .....	WOULD BE ANYTHING FROM VEG FRUITS TO JAMS / BUTTER
9. With which firm or company do you associate said jar shape? .....	DON'T KNOW
10. Would you be prepared to execute a Statutory Declaration in which you would confirm that the answers you have given are true? .....	YES

SIGNED .....

DATE .....

  
 21 February 1997