

O-169-04

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 2109193  
BY COOPER ROLLER BEARINGS COMPANY LIMITED  
TO REGISTER A TRADE MARK  
IN CLASS 7**

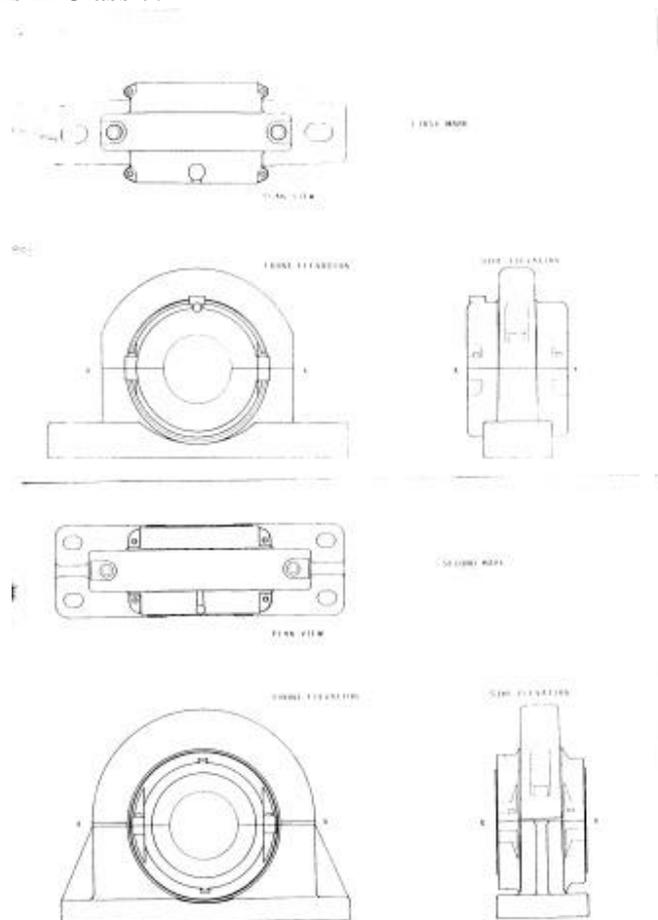
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**DECISION AND GROUNDS OF DECISION**

**Background**

1. On 4 September 1996 Cooper Roller Bearings Company Limited of Wisbech Road, King's Lynn, Norfolk, PE30 5JX applied to register the following series of two three-dimensional marks in Class 7.



2. On the application form the representation of the mark is accompanied by the statement:

“The mark consists of the three-dimensional shape of a bearing, cartridge and pedestal assembly split along the line X – X”.

3. The application was made in respect of the following goods:

“Bearings; bearing, cartridge and pedestal assemblies; parts and fittings for the aforesaid goods”.

4. Objections were taken under Section 3(1)(b) and (c) of the Act because the marks consist exclusively of the device of a bearing assembly being a sign which may serve in trade to designate eg bearings, and under Section 3(2)(a) of the Act because the marks appear to be the shape which results from the nature of the goods themselves.

5. In response on 4 April 1997 Brookes & Martin, the Applicant’s trade mark attorneys, submitted evidence of use and trade evidence in support of the mark.

6. The examiner did not consider the evidence to be sufficient to overcome the objections and the objections were maintained.

7. At a hearing which took place on 16 September 1997, at which the Applicant was represented by Mr Symonds of Brookes & Martin, three further declarations were submitted from persons in the trade.

8. The hearing officer asked for clarification of what the trade mark consists of. In his letter dated 3 December 1997 Mr Symonds referred to the statement which accompanies the representation of the mark on the application form and said it was intended to emphasise that the trade mark is the entire overall shape. After consideration by the hearing officer of this point and of the further declarations the objections were maintained.

9. Following refusal of the application, under Section 76 of the Act and Rule 56(2) of the Trade Marks Rules 1994 (now Rule 62(2) of the Trade Marks Rules 2000), Brookes & Martin on behalf of the Applicant requested the registrar on form TM5 to state in writing the grounds of the decision to refuse the application. Receipt of the form TM5 was recorded on the registry’s database on 14 September 1998. On 20 January 2004 the Applicant’s attorneys, now called Brookes Batchellor LLP, wrote to the registry chasing up the statement of grounds. At this stage in the proceedings, it became apparent that the file containing all the papers relating to the application had been lost in the registry. Brookes Batchellor LLP kindly provided copies of the papers from their file, which appear to be complete with the exception of the exhibits which were attached to the Statutory Declaration of Mr Peter Ely.

10. As the hearing officer who heard the Applicant’s case is no longer available, Brookes Batchellor LLP were asked if they were content for the statement of grounds to be written by a different hearing officer, and they agreed. It falls to me therefore to write this decision from the papers on file.

## **Summary of the Evidence filed in response to the Examination Report**

11. The evidence of use consists of the Statutory Declaration dated 27 March 1997 of Mr Peter Ely, Technical Director of the Applicant, who states that “The trade mark for which registration is sought consists of the three-dimensional shape of a bearing, cartridge and pedestal assembly, as shown in the representations included in the application, the characteristic of which is that the assembly is split to the shaft along a radial plane through the bearing” and “This bearing assembly shape is unique to the Applicant and has become identified with it as the result of long and extensive usage”. He states that roller bearing assemblies represented in the application have been sold throughout the United Kingdom and exported since at least 1961. He gives figures for sales quantities and turnover in respect of bearings having the said shape in the five years preceding the date of application as follows:

YEAR	SALES QUANTITY	TURNOVER £ million
1991	-	11.51
1992	-	10.68
1993	-	12.10
1994	39,589	12.44
1995	41,808	13.07
1996	47,061	15.46

12. The trade evidence consists of the Statutory Declaration dated 25 February 1997 of Mr Brian Raymond Stoppani, who states that he is Technical Director of J Thompson Engineering Ltd, a position he has held since 1990, and has approximately 39 years experience of general engineering. He says he makes the declaration from his own knowledge in support of an application by Cooper Roller Bearings Co Ltd (the Applicant) to register the shape of its split roller bearing as a trade mark. He states that since about 1961 he has been concerned in the installation of bearings in various types of machinery and has become aware of many different types of bearing by a number of different manufacturers, that since 1961 he has been aware of split roller bearing assemblies by the Applicant and that he recognises the drawing shown to him as depicting bearing assemblies of this type. He goes on to state that these bearing assemblies are split along a plane passing through the bearing axis and are instantly recognisable by their overall shape coupled with this split construction, and that such bearing assemblies would be taken to be the Applicant’s bearing assemblies by anyone employed in engineering who has the task of specifying bearings to be used in machinery, and that the overall shape coupled with this split construction is a characteristic of the Applicant’s bearings and theirs alone.

## **Summary of the Evidence filed at the Hearing**

13. The first statutory declaration is that of Mr Keith Wheelhouse dated 19 September 1997. Mr Wheelhouse states that he is a consulting engineer, he was employed by British

Coal for 34 years and has wide experience of general engineering. Mr Wheelhouse states that Exhibit KW1 to his declaration (a copy of the marks applied for, reproduced at Annex 1) consists of two versions of bearing assemblies manufactured and sold by Cooper Roller Bearings Company Limited, and he understands that Cooper regards the shapes of these assemblies as three-dimensional trade marks. He further states that a typical engineer who has the task of specifying and ordering bearings for particular applications will regard the bearing assemblies shown in Exhibit KW1 as being unique and easily recognised, and will not confuse these assemblies with other bearings available on the international market. He goes on to state that, leaving aside the split construction of the bearing assemblies shown in KW1, the characteristics which in combination are common to both assemblies and serve to make their shapes unique are:

- a) the cap is retained by a single pair of bolts, the heads of which are received in recesses,
- b) the sides of the main body are parallel,
- c) the sides of the body meet the base in square corners, reinforced by tapered webs in one version,
- d) the body shape has a central flange-like protrusion which gives a distinctive profile to the plan and end elevations,
- e) a circular lubricator boss is set at one end of the housing,
- f) the upper surface of the body is formed by a smooth curve.

These features are indicated by lettering “a” to “e” on the first mark and “a” to “f” on the second mark, in exhibit KW1.

14. He states that this combination of characteristics is not dictated by the function which a bearing has to perform, and that the distinctiveness of the bearing assembly shown in KW1 can be appreciated by comparing it with representative designs of other manufacturers, examples of which are produced in exhibit KW2 (reproduced at Annex 2). These examples are marked with the letters “A” to “F” to draw attention to the differences from the features of the Applicant’s assembly correspondingly marked “a” to “f”. He then goes on to compare each of the features in turn, and concludes by stating that the examples illustrated of bearing assemblies made by competitors demonstrate that the Applicant’s bearing assemblies illustrated in KW1 have a shape which does not result from the nature of the bearing housing itself, is not the shape necessary to obtain a technical result, and because of the long use made of it has acquired a distinctive character.

15. The second statutory declaration is that of Mr Graeme Robertson and is dated 1 September 1997. Mr Robertson states that he is General Manager of Lee Beesly Deritond, he has approximately 19 years experience of general engineering and his work involves the purchase and installation of bearings which his company obtains from various manufacturers including Cooper Roller Bearings Company Limited. He refers to exhibit GR1 (a copy of the marks applied for, reproduced at Annex 3), and states that the bearings illustrated are readily distinguishable from other bearing assemblies and identifiable from their overall shapes as being of the Applicant’s manufacture. He further

states that, although function does determine certain characteristics of the shape of a bearing assembly, other aspects of the overall shape of the Applicant's bearing assembly appear to have been determined by the designer for reasons unconnected with function, such as the plain, uninterrupted semi-circular shape of the peripheral surface of the pedestal marked "1" in GR1. He states that his company installs bearing assemblies made by manufacturers other than the Applicant and that in general these have external shapes which cannot be confused with the bearings shown in GR1, and concludes by stating that the overall shapes of the Applicant's bearing assemblies constitute a trade mark in the sense that they are unique to these assemblies and can distinguish them from other assemblies available on the market.

16. The final statutory declaration is that of Mr Michael Yates and is dated 8 September 1997. Mr Yates states that he is Purchasing Manager of BSL Limited, BSL Limited is one of the largest distributors of bearings and power transmission products in Europe, he has approximately 32 years experience of general engineering and in his work he deals with bearings of many different types, bought from many different manufacturers. Exhibit "MY1" to his declaration is a copy of the marks applied for (reproduced at Annex 4). He states that, as a person working in the field of bearings, he finds these bearing assemblies to be instantly recognisable as the Applicant's goods by virtue of their overall shape and that by September 1996 this overall shape was a characteristic of the Applicant's bearings. He goes on to state that although many bearing assemblies have certain features in common, each has certain unique characteristics which exemplify the designer's preferences but are in no way determined by the function of the bearing, and that these characteristics serve to distinguish any particular bearing assembly from others. As an example, he states that it is common for split bearings of the type shown in "MY1" to have distinct vertical posts to receive the bolts (marked "B" in "MY1") and for the heads of the bolts to be exposed to receive a spanner, whereas the assembly shown in "MY1" does not have posts of this sort and the heads of the bolts are concealed. He states that these are simply different approaches to the question of accommodating the bolts, that neither approach is dictated by technical requirements, but the appearance of the assemblies shown in "MY1" is provided with a distinct characteristic because of the absence of posts and the concealment of the bolt heads. He concludes by stating that his Company buys and distributes bearing assemblies made by other manufacturers for the same end uses as those shown in "MY1" but all of these are quite different in overall shape to those shown in "MY1" and cannot be confused with the assemblies shown in "MY1".

## **The Decision**

### **Section 3(2)(a)**

#### **The Law**

17. Section 3(2)(a) of the Act is set out below:

"(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.”.

18. The proviso that a mark shall not be refused registration if it has in fact acquired a distinctive character as a result of the use made of it does not apply to Section 3(2) of the Act. However, in his response to the examination report Mr Symonds urged the examiner to give considerable weight to the specialised knowledge of Mr Stoppani. The other three declarants also state that they have wide experience in the engineering field. I am not aware how the declarants were chosen and thus how independent of the Applicant they are. They all appear to have been aware that it was the bearing assembly of the Applicant that they were being asked to identify, in fact all except Mr Wheelhouse even go so far as to say that they are making their declarations in support of the Applicant’s application to register the shape of its split roller bearing as a trade mark. Nevertheless, I have borne their evidence in mind when assessing whether there are grounds for refusal of the mark under Section 3(2)(a).

19. Each of the declarants states that they recognise the Applicant’s bearing assemblies by their unique overall shape, but they each identify different specific features as being different from those of other manufacturers

20. Although Mr Stoppani states that bearings of this overall shape coupled with the split construction are characteristic of the Applicant’s bearings and theirs alone, apart from the overall shape the only feature he specifically mentions is the split; he provides no evidence that the split is a feature unique to the Applicant, nor does he identify any particular feature of the bearing that is anything other than the shape resulting from the nature of the goods themselves.

21. Mr Wheelhouse identifies several features of the Applicant’s bearings which are different from those of other manufacturers. However I note that there are also several differences between the bearings of each of the other manufacturers shown in exhibit “KW2”, and this is borne out by Mr Yates who points to the fact that each bearing assembly has certain unique characteristics, and it is these characteristics which serve to distinguish any particular assembly from others.

22. Both Mr Wheelhouse and Mr Yates mention the recessed bolts of the Applicant’s bearing assembly and compare them with the exposed bolts which they say are more usual. Mr Yates states that these are simply different approaches to the question of accommodating bolts, which are not dictated by technical requirements. It seems to me that the recessed bolts of the Applicant’s bearings are likely to be the result of a design consideration intended to give a smoother outline to the assembly, whether for aesthetic or functional reasons. It does not seem to me that they would have been intended to identify the trade origin of the goods and there is no evidence that they are promoted as such or perceived as such by the average consumer.

23. Mr Robertson on the other hand identifies the plain, uninterrupted semi-circular shape of the peripheral surface of the pedestal marked “1” in exhibit GR1 as an example

of an aspect of the Applicant's bearing assembly which appears to have been determined by the designer for reasons unconnected with function. Again, this feature appears to me more likely to have been arrived at as a result of a design consideration, and again there is no evidence that it is perceived as an indication of trade origin by the average consumer.

24. Comparing the marks applied for and the particular features identified by the declarants, with the examples of the bearing assemblies of other manufacturers shown in exhibit "KW2" of Mr Wheelhouse's declaration, I can see certain similarities and certain differences between each of them, but I see nothing that is likely to be perceived by the average consumer as an indication of trade origin, rather than as the shape which results from the nature of the goods themselves. I acknowledge that there are differences between them, but I do not think that the fact that there are different ways of achieving the same result means that any one of those ways can be protected as a trade mark.

25. At the time of the hearing there was no guidance from the Courts regarding Section 3(2) of the Act. Since that date the case of *Philips Electronics NV v Remington Consumer Products Limited* has been heard in the English Court of Appeal [1999] E.T.M.R. 816 and referred to the European Court of Justice (ECJ) [2002] E.T.M.R. 81. The meaning of the phrase "the shape which results from the nature of the goods themselves" has not been defined, but before the Court of Appeal, Aldous L.J. observed in relation to Section 3(2)(a) "The purpose of the subsection is to prevent traders monopolising shapes of particular goods" and "Subsection 2(a) has to be construed in the context of subsections (b)&(c). It is intended to exclude from registration basic shapes that should be available for use by the public at large".

26. The ECJ were not asked to consider Section 3(2)(a), but in relation to Section 3(2) (Article 3(1)(e) of the Directive) in general at paragraphs 73 to 78 they observed that:

"73. It must first be observed in this regard that, under Article 2 of the Directive, a trade mark may, as a rule, consist of any sign capable both of being represented graphically and of distinguishing the goods or services of one undertaking from those of other undertakings.

74. Second, it must also be borne in mind that the grounds for refusal to register signs consisting of the shape of a product are expressly listed in Article 3(1)(e) of the Directive. Under that provision, signs which consist exclusively of the shape which results from the nature of the goods themselves, or the shape of the goods which is necessary to obtain a technical result, or the shape which gives substantial value to the goods cannot be registered or if registered are liable to be declared invalid. According to the seventh recital in the preamble to the Directive, those grounds for refusal have been listed in an exhaustive manner.

75. Finally, the marks which may be refused registration on the grounds listed in Article 3(1)(b), (c) or (d) of the Directive may under Article 3(3) acquire a distinctive character through the use made of them. However, a sign which is

refused registration under Article 3(1)(e) of the Directive can never acquire a distinctive character for the purposes of Article 3(3) by the use made of it.

76. Article 3(1)(e) thus concerns certain signs which are not such as to constitute trade marks and is a preliminary obstacle liable to prevent a sign consisting exclusively of the shape of a product from being registrable. If any one of the criteria listed in Article 3(1)(e) is satisfied, a sign consisting exclusively of the shape of the product or of a graphic representation of that shape cannot be registered as a trade mark.

77. The various grounds for refusal of registration listed in Article 3 of the Directive must be interpreted in the light of the public interest underlying each of them (see, to that effect, *Windsurfing Chiemsee*, paragraphs 25 to 27).

78. The rationale of the grounds for refusal of registration laid down in Article 3(1)(e) of the Directive is to prevent trade mark protection from granting its proprietor a monopoly on technical solutions or functional characteristics of a product which a user is likely to seek in the products of competitors. Article 3(1)(e) is thus intended to prevent the protection conferred by the trade mark right from being extended, beyond signs which serve to distinguish a product or service from those offered by competitors, so as to form an obstacle preventing competitors from freely offering for sale products incorporating such technical solutions or functional characteristics in competition with the proprietor of the trade mark.”

27. The declarants have stated variously that the combination of features of the Applicant’s bearing assemblies is not dictated by function, and that whereas function determines certain characteristics others appear to have been determined for reasons unconnected with function, or by the designer’s preferences.

28. Taking the best view I can of the matter, I have reached the conclusion that the shapes applied for are no more than two possible shapes resulting from the nature of the goods themselves and should be available for any trader to use. Each of the bearing assemblies illustrated in the evidence, including the Applicant’s own, appears to have the same basic shape consisting of a flat base protruding at either side of a central rounded section. In *Philips* the ECJ also said that “a sign consisting exclusively of the shape of a product is unregistrable by virtue thereof if it is established that the essential functional features of that shape are attributable only to the technical result”. The declarants have stated that they recognise the Applicant’s bearing assemblies by their overall shapes and each declarant has identified features of the bearing assemblies which they say are different to the bearing assemblies of other manufacturers. None of these individual features appears to be unconnected with the function or design of the bearing assemblies, as illustrated by the other manufacturers’ bearings shown in exhibit “KW2” of Mr Wheelhouse’s declaration, and the degree of arbitrariness involved in the combination of features in the overall shapes appears to be no more than the difference between the

shapes of the bearing assemblies of other manufacturers. I find that the shapes applied for are excluded from registration by Section 3(2)(a) of the Act.

29. Objections taken under Section 3(2) cannot be overcome by the Applicant showing that the mark has in fact acquired a distinctive character as a result of the use made of it. However, in case I am found to be wrong in my conclusion and for the sake of completeness I will go on to consider the objection under Section 3(1) of the Act.

### **Section 3(1)(b)&(c)**

#### **The Law**

30. Sections 3(1)(b)&(c) of the Act are as follows:

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

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

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,”

The proviso to Section 3(1) is as follows:

“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 prima facie case for registration**

### **Section 3(1)(c)**

31. Having found that the mark is a shape which results from the nature of the goods themselves I find that it is also a shape which may serve in trade to designate the kind of goods. I am supported in this view by the ECJ in paragraph 77 of its Judgment in Joined Cases C-53/01 to C-55/01 *Linde AG, Windward Industries Inc and Rado Uhren AG* (8<sup>th</sup> April 2003):

“77. Having regard to the foregoing, the reply to the second limb of the second question must be that, when examining the ground for refusing registration in Article 3(1)(c) of the Directive in a concrete case, regard must be had to the public interest underlying that provision, which is that all three-dimensional shape of product trade marks which consist exclusively of signs or indications which may serve to designate the characteristics of the goods or service within the

meaning of that provision should be freely available to all and, subject always to Article 3(3) of the Directive, cannot be registered.”

I find that this application is debarred from prima facie acceptance under Section 3(1)(c) of the Act.

### **Section 3(1)(b)**

32. The test for distinctiveness was laid down by Mr Justice Jacob in the *Treat* case [1996] RPC 281 page 306 line 1 when he said:

“What does *devoid of 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?”

33. On the form of application, the representation shown consists of two outline drawings of bearing assemblies accompanied by the statement:

“The mark consists of the three-dimensional shape of a bearing, cartridge and pedestal assembly split along the line X – X”.

34. When asked by the hearing officer to clarify the actual mark, Mr Symonds replied that “it is the entire overall shape” and added that the split “is one of a number of important characteristics”, but he did not identify any other important characteristics or explain how they gave the shape any distinctive character.

35. Whilst it is clear that a combination of non-distinctive elements can create a distinctive whole I do not accept that is the case with this mark. I do not see that there is anything in the shape of these bearing assemblies that would serve to distinguish the goods of the Applicant from those of other traders.

36. Since the date of the hearing further guidance has been given in several cases before the English and European Courts regarding the criteria for assessing the capacity of the shape of goods to function as a trade mark. The cases confirm that there is no distinction in law between different types of marks with regard to the test for distinctiveness. Shape marks must therefore be assessed against the criteria for acceptance under Section 3(1), in that they must be capable of distinguishing the goods of one undertaking from those of other undertakings. This was confirmed by the European Court of Justice in *Linde*, joined cases C-53/01 to 55/01 [2003] E.T.M.R. 78, paragraphs 37 to 41 and 47, in the following terms:

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

38. It follows that a three-dimensional shape of product sign may in principle constitute a trade mark provided those two conditions are met (Case C-299/99 *Philips* [2002] ECR I-5475, paragraph 73).

39. Next, pursuant to the rule in Article 3(1)(b) of the Directive, trade marks which are devoid of distinctive character are not to be registered or if registered are liable to be declared invalid.

40. For a mark to possess distinctive character within the meaning of that provision it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from products of other undertakings (see *Philips* [2002] ECR I-5475, paragraph 35).

41. In addition, a trade mark's distinctiveness must be assessed by reference to, first, the goods or services in respect of which registration is sought and, second, the perception of the relevant persons, namely the consumers of the goods or services. According to the Court's case-law, that means the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and circumspect (see Case C-210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 31, and *Philips*, paragraph 63).

.....

47. As paragraph 40 of this judgement makes clear, distinctive character means, for all trade marks, that the mark must be capable of identifying the product as originating from a particular undertaking, and thus distinguishing it from those of other undertakings.”

37. Further guidance is available in *Henkel KGaA v OHIM* which is reported at [2002] ETMR 25, in which The Court of First Instance said at paragraphs 48 - 49:

“48. Article 7(1)(b) of Regulation No 40/94 does not distinguish between different categories of trade marks. The criteria for assessing the distinctive character of figurative marks consisting of the representation of the product itself are therefore no different from those applicable to other categories of trade marks.

49. Nevertheless, when those criteria are applied, account must be taken of the fact that the perception of the relevant section of the public is not necessarily the same in relation to a three-dimensional mark consisting of the shape and the colours of the product itself as it is in relation to a word mark, a figurative mark or a three-dimensional mark not consisting of the shape of the product. Whilst the public is used to recognising the latter marks instantly as signs identifying the product, this is not necessarily so where the sign is indistinguishable from the appearance of the product itself.”

38. I bear in mind also the comments by Laddie J in *Yakult Honsha KK's Trade Mark Application* [2001] RPC 39 (Page 756) at paragraph 11:

"..... Like Mr James, I can see nothing which would convey to someone who was not a trade mark specialist that this bottle was intended to be an indication of origin or that it performed that function. Even were it to be recognised as of different shape to other bottles on the market, there is nothing inherent in it which proclaims it as having trade mark significance."

39. In my view the relevant public would not consider this mark to denote trade origin. There is nothing to suggest that the average consumer of bearing assemblies regards the shape of the goods per se as identifying the origin of the product. The overall impression does not convey trade mark significance. In my view the mark applied for will not be taken as a trade mark without first educating the public. It is devoid of any distinctive trade mark character, and therefore it follows that this application is debarred from prima facie acceptance under Section 3(1)(b) of the Act.

#### **The Case for Registration based upon Acquired Distinctiveness**

40. The Statutory Declaration of Mr Peter Ely gives details of the amount of use of the mark, in the form of sales quantities and turnover, for each of the five years preceding the date of application. These figures demonstrate that the mark has been used extensively, but they do not show that it has been used as a trade mark. Mr Justice Jacob in the *Treat* case at page 3 lines 17-20 said:

"I think the Registrar was wrong to accept this evidence as demonstrating that the mark was "capable of distinguishing" for the purposes of s.10 of the 1938 Act. 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 as a badge of trade origin."

41. Since the hearing the view that, in order to show that a mark has acquired distinctiveness it is necessary to show that it has been used as a trade mark, has been given further support by the comments of Morritt L J in *Bach Flower Remedies* [2000] RPC 513 at page 530 lines 19 - 21 where he said:

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

and by the ECJ in the *Philips* case:

"65. .... However, it is for the national court to verify that the circumstances in which the requirement under that provision is satisfied are shown to exist on the basis of specific and reliable data, that the presumed

expectations of an average consumer of the category of goods or services in question, who is reasonably well-informed and reasonably observant and circumspect, are taken into account and that the identification, by the relevant class of persons, of the product as originating from a given undertaking is as a result of the use of the mark *as a trade mark*" (*my emphasis*).

42. I do not know how the Applicant's goods are sold because the two exhibits to Mr Ely's declaration have been lost with the original papers and Brookes Batchellor LLP were unable to provide the registry with copies. Exhibit "PE1" was a leaflet illustrating the bearing assembly and exhibit "PE2" a bundle of copy advertisements in which the said shape was depicted. Mr Ely states that the Applicant's annual advertising expenses during the five years prior to the date of application amounted to approximately £50,000, but I have no evidence that the shape of the Applicant's bearing assembly has been promoted as a trade mark. There is nothing in the Statutory Declaration to suggest that this is so, Mr Ely simply states "This bearing assembly shape is unique to the Applicant and has become identified with it as the result of long and extensive usage". I am not satisfied therefore that the mark applied for ie the shape of the Applicant's bearing assemblies, has been used or promoted as a trade mark.

43. Further supporting evidence was submitted in the form of declarations from persons in the trade. These declarants all appear to be the relevant consumers for the goods and to be reasonably well informed and reasonably observant and circumspect. However I do not know how independent of the Applicant they are. I am not told how they were chosen. It is apparent from their statements that they have been asked to support an application to register the shape of the Applicant's bearing assembly as a trade mark.

44. In the *Windsurfing Chiemsee* case, the ECJ ruled on the nature of the enquiry as to whether a mark has acquired a distinctive character under Article 3(3) of the Directive (proviso to Section 3(1) of the Act). It held that the national authorities may take into account evidence from a variety of sources, but a finding that the mark has come to denote the goods as coming from a particular undertaking must necessarily mean that the provisions of Article 3(3) are met. The Court held:

"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 long-standing 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."

45. I am not satisfied, first of all, that the four persons in the trade who provided evidence are truly independent of the Applicant. Even if they were, although all the trade witnesses claim to be able to recognise the shape characteristics of the bearing assemblies as the Applicant's bearing assemblies and to readily distinguish them from the bearing

assemblies of other manufacturers, there is no evidence that they rely upon the shape of the product to distinguish it in the course of trade. For example, there is no evidence of the role that the shape plays in the selection of these goods, and it appears far more likely that they are selected by reference to brand names and model numbers rather than by reference to the shape of the product. In these circumstances it is difficult to see how the use of the shape fulfils the condition described in paragraph 64 of *Philips*:

“64. Finally, 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.”

46. It would be difficult to see how any association that has built up between the Applicant and the shape would enable customers to repeat purchases by reference to the shape if they are satisfied, or to avoid them if they are not.

47. I conclude that the shape of the Applicant’s bearing assembly is incapable of distinguishing the goods of one undertaking and devoid of any distinctive character. I further find that, at the date of application, the shape had not acquired a distinctive character as a trade mark as a result of the use made of it. The trade mark is therefore excluded from registration by Sections 3(1)(b) of the Act.

### **Conclusion**

48. 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(2)(a) and Section 3(1)(b)&(c) of the Act.

**Dated this 10<sup>th</sup> day of June 2004.**

**Anne Pritchard**

**For the Registrar  
The Comptroller-General**

## **Annex 1**

## **Annex 2**

### **Annex 3**

## **Annex 4**