

O-178-04

**TRADE MARKS ACT 1994
AND
THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996**

**IN THE MATTER OF INTERNATIONAL REGISTRATION NO. 767786
AND THE REQUEST BY STOKKE GRUPPEN AS
TO PROTECT A TRADE MARK IN CLASS 20**

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Background

1. On 15 November 2001, Stokke Gruppen AS of Hahjen, N-6260 Skodje (Norway) on the basis of International Registration No. 767786, requested protection in the United Kingdom under the provisions of the Madrid Protocol for the protection of the following mark:



The following words appear beneath the mark on the form of notification:

Indication relating to the nature or kind of mark: three dimensional mark.

Protection is sought in class 20 in respect of:

Children's chairs.

2. It was considered that the request failed to satisfy the requirements for registration in accordance with article 3 of the Trade Marks (International Registration) Order 1996 and Notice of Refusal under 9(3) was given because the mark is excluded from registration by Sections 3(1)(a) (and (b) and Section 3(2)(a) of the Trade Marks Act 1994. This is because the mark consists of a representation of the goods and is considered to be devoid of any distinctive character and is not capable of

distinguishing goods exclusively of the shape of the goods which results from the nature of the goods themselves.

3. Evidence of use of the mark was filed on 18 June 2002 with the purpose of showing that the mark had acquired a distinctive character as a result of that use. However, the evidence was not considered sufficient to overcome the objections which were maintained.

4. At a Hearing at which the applicant was represented by Mr Patrick Ellis-Jones of J A Kemp & Co their Trade Mark Attorneys the objection under Section 3(1)(b) of the Act was maintained. Notice of Refusal was issued under Article 9(3) and I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Mark Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it. The objections raised under Sections 3(1)(a) and 3(2)(a) were waived and I need make no further mention of them.

The Law

5. The relevant part of Section 3(1) of the Act are as follows:

“The following shall not be registered-

- (a)
- (b) trade marks which are devoid of 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 Prima Facie Case for Registration

6. The approach to be adopted when considering the issue of distinctiveness under Section 3(1)(b) of the Act has recently been summarised by the European Court of Justice in paragraphs 37 and 39 to 41 of its Judgment in Joined Cases C-53/01 to C-55/01 *Linde AG, Windward Industries Inc and Rado Uhren AG* (8th April 2003) 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.

.....

39. Next, pursuant to the rule 1 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).

7. The sign applied for is the shape of a chair and in order to be acceptable for prima facie registration as a trade mark it must convey trade source significance to the relevant public. It is not sufficient for it to consist of a shape which is different to other shapes for the product on the market, that appearance by itself must convey trade mark significance. In the application by *Kabushiki Kaisha Honsha* [2001] RPC 39 to register the shape of a bottle Mr Justice Laddie said:

“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.”

8. In my view, based upon my own experience as a consumer, I am aware that children's chairs are available in a wide variety of shapes, sometimes for functional reasons or sometimes for aesthetic reasons. I do not consider that the shape of a child's chair would usually indicate the trade source of the goods to the consumer. Children's chairs come, not in a standard form, but in a wide range of variations and most manufacturers make a number of different styles. This proposition is supported by pages from Exhibit C of the applicant's evidence dated 17 June 2002 and included at Annex A of this decision.

9. Therefore, to be significantly different a child's chair has to be quite unusual to stand out from the shapes which are the norm for the sector.

10. Even if the applicant's chair had been strikingly different at the date of its design it had by the applicant's own evidence, been widely copied by the relevant date; (ref Exhibit A dated 17 June 2002 and included at Annex B of this decision).

11. The DAN CHAIR is, in my opinion, similar to the applicant's chair and may or may not be an example of this; (ref Exhibit C dated 17 June 2002 and included Annex C of this decision).

12. The application is excluded from acceptance, prima facie, because, in my view at the relevant date, the average consumer of these goods would not conclude that the sign was an indication of the origin of the goods. It follows that this application is debarred from prima facie acceptance under Section 3(1)(b) of the Act.

The Case for Registration based on Acquired Distinctiveness

The Law

13. In the *Windsurfing Chiemsee* case (C-108/97 and C-109/97), the ECJ ruled on the nature of the enquiry as to whether a mark has acquired a distinctive character under Article 3(3) Section 3(1) proviso). 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:

“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” (paragraph 51).

“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 the 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” (paragraph 52).

14. Evidence of acquired distinctiveness was filed on 18 June 2002. This consisted of a Statutory Declaration dated 17 June 2002 by Jon Alstad who is the UK Director of Stokke UK Limited and several exhibits. Mr Alstad states that the chair was designed in 1972 by a Norwegian, Peter Opsvik, and sales in the United Kingdom began in 1974.

15. The number of chairs sold in the UK at a retail value of between £100 and £150 each is as follows:-

Between 1974 and 1998	3000-3800 p.a.
1999	7,1000
2000	9,500
2001	13,000

No information relating to market share has been provided but it seems likely that these sales represent a very small share of the total UK market.

16. Mr Alstad also states that approximately £100k was spent on promotional activities in each of the three years to 2002. There are no details of promotional spend prior to 1999 and little information about the nature of the promotion undertaken. From exhibit B it appears to have been in magazines for mothers and fathers with babies. Although these promotions show the shape of the chair they do not identify the shape as a designation of source but as having functional benefits. The name TRIPP TRAPP is used to designate the source.

17. Mr Alstad also submitted in his Statutory Declaration that as the design of the chair represented a radical departure from the traditional baby chair design and its appearance was highly unusual, chairs produced by the applicant were easy to distinguish from chairs of other manufacturers.

18. However, even if this was true at the date of the application, product recognition appears to be insufficient and 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; (Philips v. Remington [2001] RPC 38 paras 64 and 65).

19. At the Hearing I rejected the evidence and maintained the objection. However, I agreed to allow further time for additional evidence to be submitted.

20. Following the Hearing further written submissions were made by the agent on 19 May 2003, 14 August 2003 and 24 November 2003.

21. The submission of 19 May 2003 included at Appendix A a Design Museum brochure featuring the Tripp Trapp chair. This feature referred to the design in terms of the “sustainability” of the chair, that it is adjustable and designed to grow with the child, but not to its appearance.

22. The submission of 14 August 2003 included two exhibits. Exhibit A is a review of the chair taken from a website. The review purports to show that the design is attractive to mothers and is described as “groovy” and “definitely the nicest looking high chair on the market”. No background information has been supplied about the review and it does not show that the shape of chairs are generally indicative of origin or that this design is substantially different from other child seats to the extent that it has trade mark character.

23. Exhibit B is another design review from 1975. This showed that the design was innovative when new but not that it had trade mark character at the relevant date of filing.

24. The final submission on 24 November 2003 included three exhibits. Exhibit A is a USA publication aimed at designers. This refers to, but does not show, a chair called “TRIPP TRAPP” and refers to it as famous but also “much copied”. Exhibits B and C are from Scandinavia and aimed at designers.

25. These submissions did not, in my view, assist in demonstrating acquired distinctiveness as an indication of trade source to a significant proportion of UK consumers of children's chairs and the objection was maintained.

26. Clearly the exhibits to the Statutory Declaration by Mr Alstad and the additional submissions incorporate references to the shape and design of the chair. The unique design is referred to in several exhibits but the evidence does not go as far as to indicate that the applicant has been successful in educating the relevant public that the shape of the goods in question designate the applicant's products. It is also clear from the exhibits that the brochures and advertising material all contain other distinctive matter and the Chair is promoted by the applicant under the signs STOKKE and TRIPP TRAPP and not the mark applied for.

27. In my view the evidence filed has not established that the mark applied for has acquired a distinctive character as a trade mark in its own right. The exhibits do not show trade mark use of the mark. They show the shape applied for use in conjunction with the words STOKKE and/or TRIPP TRAPP.

28. In particular, I do not consider the relevant public would attach trade origin significance to the mark applied for when used in this way.

29. I do not consider the evidence proves the mark applied for has acquired a distinctive character as a result of the use made of it and I conclude that the applicant has failed to satisfy the proviso of Section 3(1) of the Act.

Conclusions

30. The mark is not acceptable prima facie because it is debarred from registration under Section 3(1)(b) of the Act.

31. The evidence filed to substantiate the claim that the mark has acquired a distinctive character is not sufficient to satisfy the proviso to Sections 3(1)(b)(c) and (d) of the Act.

32. 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 above it is refused under Section 37(4) of the Act.

Dated this 22nd day of June 2004.

Ian Peggie
For the Registrar
The Comptroller-General