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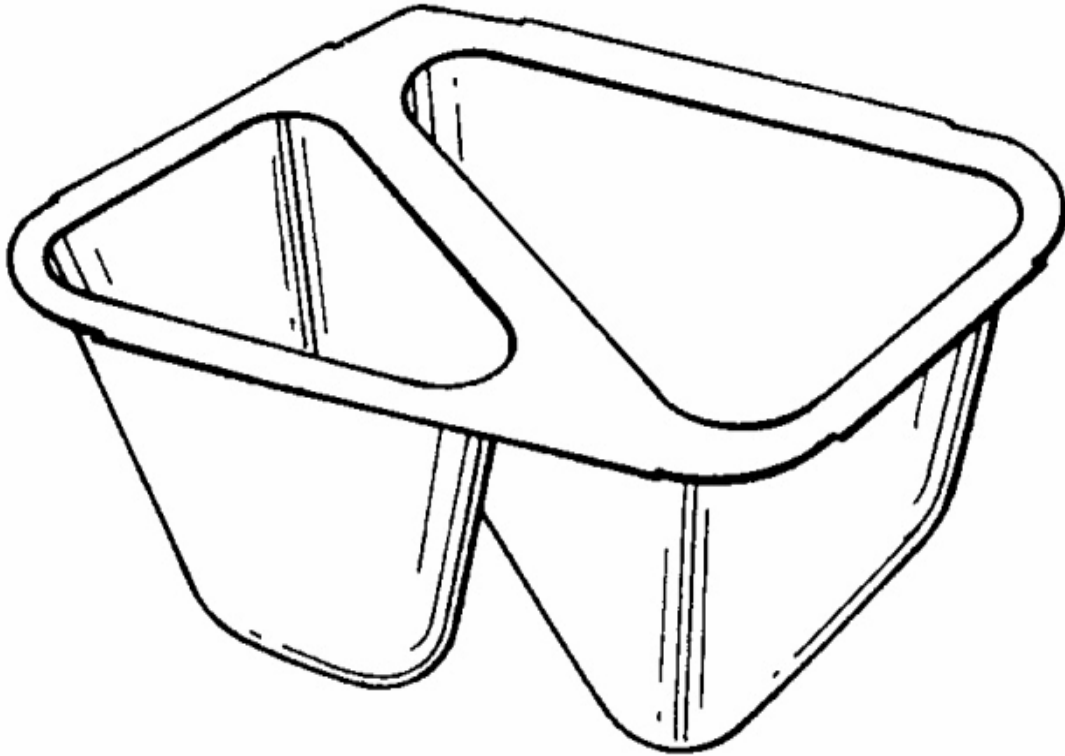
**TRADE MARK APPLICATION No 2000653**

**BY MOLKEREI ALOIS MULLER GMBH & CO**

**FOR REGISTRATION OF A THREE DIMENSIONAL SHAPE OF  
PACKAGING IN CLASSES 29 AND 30**

## Background

1. On 31 October 1994, Molkerei Alois Muller GmbH & Co. applied to register the trade mark shown below.



2. The goods for which protection is sought are “yogurts: desserts and puddings” in Class 29, and “desserts: rice desserts” in Class 30.

3. The application met with a number of objections from the Registrar, some of which have subsequently been waived. For the purposes of this decision it is sufficient to record that the trade mark was objected to because it is devoid of any distinctive character and consists exclusively of the shape of goods which is necessary to achieve a technical result, and is consequently excluded from registration under sections 3(1)(b) and 3(2)(b) of the Trade Marks Act 1994.

4. In an attempt to overcome the objections the applicant submitted evidence in the form of two statutory declarations by Kenneth Leslie Wood. Mr Wood is the Managing Director of Muller Dairy (UK) Limited, which markets the applicant’s products in the UK. Exhibited to Mr Wood’s second declaration is a further statutory declaration of Julie Ogley, who is Managing Director of a market research company called Pathfinder. Ms Ogley provides the results of a public survey undertaken in

1998 to test the UK public's recognition of the applicant's trade mark. The evidence is primarily intended to support the case that the applicant's mark had acquired distinctive character through use prior to the date of the application. I will return to this evidence in more detail later. At this stage it is sufficient to set out the primary facts.

5. The mark consists of the shape of the packaging for a dessert product. The package is known as a "twin-pot". The applicant was the first undertaking to introduce such a twin-pot format in 1987. The applicant sells ready-to-eat desserts comprising of yogurt and a contrasting filling to be added to the yogurt for consumption. The most popular combination is sold under the name FRUIT CORNER. In 1991 the applicant introduced a similar product under another brand - CRUNCH CORNER. By 1992, the applicant had a 12% share of the total yogurt market which it satisfied through the supply of twin-pot yogurts in the shape of the mark applied for, and this was still roughly the position at the relevant date of 31 October 1994.

6. The applicant also introduced a twin-pot rice dessert with fruit puree addition, which has been sold under the name LUXURY MULLERICE. It is not clear whether the mark applied for was used in respect of this product prior to the relevant date.

7. The applicant has promoted its twin-pot products primarily through television advertising.

8. Since 1990 competitors have also used twin-pot and multi-part packaging for yogurt products. According to an article in CHECKOUT magazine (exhibit 3D2) by mid 1994 the applicant had 73% market share by value in the trade in twin-pot yogurts.

### **The Hearing**

9. The matter came to be heard on 26 September 2003 when the applicant was represented by Mr Iain Purvis of Counsel, instructed by Swindell & Pearson, trade mark attorneys. Following the hearing, I wrote to Swindell & Pearson maintaining the objections raised by the Examiner under s3(1)(b) and 3(2)(b) of the Act. Following a further exchange of correspondence the application was refused on 26 February 2004. I have since been asked for, and now provide, a statement of the grounds for my decision.

### **Section 3(2)(b)**

10. Section 3(2)(b) of the Act is as follows:

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

(a) –

(b) the shape of goods which is necessary to obtain a technical result

(c) - .”

11. The provision has its origins in Article 3(1)(e), second indent, of EC Directive 104/89.

12. The European Court of Justice (ECJ) considered the meaning and scope of this provision in cases C-299/99 and C-218/01, *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* and *Henkel KGaA v Deutsches Patent- und Markenamt*. The former is reported at [2003] RPC 2.

13. In *Philips*, the court was asked, inter alia, whether a shape is unregistrable if its essential features are shown to be attributable only to a technical result and whether such an objection can be overcome by showing that there are other shapes which could obtain the same technical result. The court answered this question as follows:

“ Article 3(1)(e), second indent, of Directive 104/89 must be interpreted to mean 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. Moreover, the ground for refusal or invalidity of registration imposed by that provision cannot be overcome by establishing that there are other shapes which allow the same technical result to be obtained.”

14. In *Henkel*, the court was asked whether, in the case of three dimensional trade marks consisting of the packaging of goods which are normally traded in packaged form, the shape of the packaging was to be equated with the shape of the goods for the purposes of applying Article 3(1)(b), (c) and (e) of Directive 104/89. The court answered this question as follows:

“For three-dimensional trade marks consisting of the packaging of goods which are packaged in trade for reasons linked to the very nature of the goods, the packing thereof must be assimilated to the shape of the goods, so that the packing may constitute the shape of the goods within the meaning of Article 3(1)(e) of the First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks and may, where appropriate, serve to designate characteristics of the packaged goods, including their quality, within the meaning of Article 3(1)(c) of that directive.”

15. At the time of the hearing the ECJ had not given its answers in *Henkel*. I therefore heard submissions from the applicant’s counsel as to the correctness of Advocate General Ruiz-Harabo Colomer’s Opinion in that case (which was essentially the same as the court’s subsequent answer). No purpose would now be served by my rehearsing the applicant’s argument on this point of law. In the light of the court’s subsequent answers it is now absolutely clear that an objection under Section 3(2)(b) can apply where the sign in question consists of the shape of packaging for goods which are packaged in trade for reasons linked to their very nature.

16. I do not believe that it is in dispute that the goods listed in the application, or at least those for which it is claimed that the mark has acquired a distinctive character, fall into this category.

17. The Registrar's objection to this particular packaging shape is that its essential features are functional. It is a two-part container for a non-solid dessert consisting of a base dessert and an additional topping or flavouring. The shape serves both as packaging for the dessert and (once a plastic lid has been peeled off) also as an eating tray from which the consumer can conveniently mix and consume the product. This obviates the need for the consumer to buy and store the dessert and topping separately, and also the need for a traditional eating bowl or dish, thus making the product particularly convenient for consumption when out of the home.

18. When the constituent products are sold together the packaging must include a means of keeping the base dessert separate from the topping prior to consumption. The use of two chambers is a technical solution to this problem. The use of larger and smaller chambers is determined by the intended proportions of the constituents. The flat top surface of the shape is necessary for it to work as an eating tray and therefore also obtains a technical result.

19. The applicant does not appear to dispute the validity of this objection insofar as it applies to the basic construct of a twin pot container as such, but it argues that this analysis overlooks the fact that this particular twin pot has a number of arbitrary features so that its essential features cannot all be said to be functional. In this connection, the applicant points to the overall square shape of the pot, to the rounded corners and, particularly, to the off-set diagonal split between the larger and smaller chambers of the pot.

20. In support of these arguments the applicant filed evidence of the shapes of twin pot containers used by third parties trading in similar desserts. Exhibit K LW7 to Mr Wood's second declaration shows a range of such twin-pots for yoghurt type desserts with additional toppings. All of these shapes have a flat top. Most of these containers have a larger chamber at one end and a smaller chamber (for the topping) at the other. Two of the designs shown in use by supermarkets for own-label products feature a diagonal split between the larger and smaller chambers. In one case the angle of the diagonal split is less severe than that shown in the applicant's mark, with the result that the overall shape of the container is more rectangular than squarish. In the other case, the supermarket container has two diagonal splits along roughly similar angles to that shown in the applicant's shape. These divisions serve to separate two smaller triangular chambers for toppings (one at each end) from a third centrally positioned larger triangular chamber where the base dessert is stored, the three triangular chambers are set within an overall rectangular shape.

21. Although I have called these shapes "rectangular" with "triangular" chambers, that is not strictly correct because all of these containers feature rounded corners. I put it to Mr Purvis at the hearing that this appears to represent a manufacturing preference, no doubt because rounded corners are stronger and less likely to split open than sharp corners. He appeared to accept this, but in any event I do not think that anything turns on this point. This is because the rounded corners of the applicant's shape are unlikely to make any significant impact on an average consumer. I do not therefore believe that this aspect of the design can be regarded as an essential feature of the shape, whether functional or not.

22. The applicant's main argument rests on the off-set diagonal split of the chambers within its squarish twin-pot shape. I accept that there are a number of ways of designing a twin-pot dessert container with a flat top, most of which are shown in the examples in exhibit KLW7 mentioned above. The designer may choose to have semi-circular or squared-off ends to the pot (or one of both). When it comes to the division between the chambers, there appears to be two options, a straight or diagonal division.

23. It is clear from the ECJ's judgement in *Philips* that an objection under Section 3(2)(b) cannot be overcome simply by showing that there are other shapes which can obtain the same technical result. It is therefore necessary to determine whether the choice of a diagonal division is, as the applicant contends, arbitrary, or whether it contributes to the technical result obtained by the overall shape.

24. The material between the two chambers of the twin-pot is not rigid. It contains a pliable strip which acts as a sort of hinge allowing the smaller chamber to be raised so that the contents can be emptied into the larger chamber prior to consumption. Some of the applicant's television advertisements (exhibit KLW3 to Mr Wood's second declaration) show a consumer using this method to add a fruit preserve topping onto the yoghurt in the larger chamber. Following the hearing, I wrote to the applicant's attorneys expressing my provisional view, which was that the diagonal split of the design was not an arbitrary feature but a functional means of effectively adding the topping to the dessert. The diagonally split design of pot appeared to be designed so as to result in the topping being distributed in a roughly central position on the base dessert when the tipping mechanism was used, whereas a twin-pot with a straight division between the chambers would, if used in the same way, result in the topping being deposited at one end or other of the base dessert, which appears to be a less effective means of adding the topping.

25. I received in reply a written submission from the applicant's attorneys in which it is:

- i) argued that there are a number of ways of eating the dessert product which do not involve tipping the contents of the smaller chamber onto the contents of the larger chamber;
- ii) accepted that if the tipping mechanism is used the contents of the smaller chamber will slide or pour down the longest side wall of the small chamber and enter the large chamber adjacent to the centre part of the longest side wall thereof;
- iii) noted that, in the applicant's pot, the side wall of the large chamber is longer than the adjacent side wall of the smaller chamber;
- iv) pointed out that if this were not the case, there would be a danger of the contents of the smaller chamber pouring over the sides of the pot when tipped up – which would be poor design;
- v) therefore acknowledged that good design requires the side wall of the largest chamber of a twin-pot container to be longer than the adjacent side wall of the smaller chamber.

26. The applicant's attorneys also provide comments on the shapes used by competitors (exhibit K LW7) in which it is noted that a number of these designs would be equally effective at preventing spillage of the topping when the "hinge" is used. These designs include the rectangular shapes with a diagonal split (or splits) between the chambers referred to at paragraph 20 above. This observation does not appear to me to detract from the suggested advantages of a diagonal split between the chambers of a twin-pot design.

27. The applicant also points to another basically rectangular design (but with a semi-circular end on the side of the pot in which the larger chamber is housed) which has a straight split between the large and small chambers. In this design the side wall of the larger chamber occupies most of the width of the container whereas the adjacent side wall of the smaller chamber occupies only about half the width of the container. The applicant notes that this design should be equally effective at preventing spillage on tipping, which I accept. However, it appears to me that this arrangement of small and large chambers would result in the topping being deposited largely over one side of the base dessert when the "hinge" mechanism is used to add the topping, which is not optimum from a design perspective.

28. Although the applicant did not comment on it, I note myself that exhibit K LW7 includes a third design which should be equally effective at preventing spillage when the contents of the smaller chamber are tipped up and over those in the larger chamber. This is a basically circular shape pot used by St Ivel for its "Shape" product wherein the larger chamber occupies most of one side of the pot and the smaller chamber occupies about half of the other side. Further, this design would not appear to suffer from the one-sided distribution effect noted above.

29. I therefore accept that there are other designs of twin-pot containers which would be equally effective at preventing spillage if (as these pots seem to be designed for) the pliable hinge is used to tip up the content of the smaller chamber and add it as a topping to the content of the larger chamber. And there is at least one other design (and probably more) which would be equally effective at distributing the topping relatively evenly over the base dessert. However, in my view, these findings do not mean that the diagonally split design of the applicant's twin-pot shape is not only attributable to a technical result. For the reasons given above, I find that this feature of the design contributes to the efficient achievement of a technical result.

30. The overall square(ish) shape of the applicant's twin-pot is largely the result of the choice of the diagonal division between the larger and smaller chambers. The result is a compact pot, which I would expect to represent an efficient use of material. In any event, there is plainly a limited design choice as to overall shape.

31. I note that none of the third party twin-pot products in evidence present quite the same square appearance as that of the applicant's product. The fact that the designers of the competitors products have not adopted the same design may appear to contradict the above findings. However, there is no evidence before me from the designers of any of these products explaining the thinking or limitations behind the choices of design. These choices may therefore have been constrained by intellectual

property rights (real or perceived), including the fact that this trade mark application has been pending since 1994.

32. I conclude that all the essential features of the applicant's shape are functional, and that these features are attributable only to a technical result.

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

33. According to the ECJ in *Philips* (see paragraphs 75 and 76 of the judgement), a sign excluded by any of the provisions corresponding to Article 3(1)(e) of the Directive can never be registered as a trade mark. Consequently, if I am right in concluding that the applicant's shape is excluded by Section 3(2)(b) of the Act, there is no need to go into the reasons why Section 3(1)(b) may otherwise have applied. However, for the sake of completeness I will do so, assuming against myself that the mark is not otherwise excluded by Section 3(2)(b).

34. The relevant parts of Section 3(1) are 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 paragraphs (b), (c) or (d) 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.”

35. Section 3(1)(b) is based on (and is identical to) Article 3(1)(b) of the Directive. In *Henkel* the ECJ set out the test to be applied under Article 3(1)(b) in the case of a three dimensional trade mark consisting of the shape of packaging for goods of this nature. The court stated:

“For three-dimensional trade marks consisting of the packaging of goods which are packaged in trade for reasons linked to the very nature of their product, their distinctive character within the meaning of Article 3(1)(b) of Directive 89/104 must be assessed by reference to the perception of the average consumer of such goods, who is reasonably well informed and reasonably observant and circumspect . Such a trade mark must enable such a consumer to distinguish the product concerned from those of other undertakings without conducting an analytical or comparative examination and without paying particular attention.”

36. The applicant has not seriously challenged the Examiner's assessment that, considered as an unused trade mark, it is devoid of any distinctive character. I think that this must be right. Setting aside the results of the applicant's use of the mark for the moment and comparing the applicant's shape with the shapes that a two part container for desserts might naturally take, the differences are not such that the applicant's shape would stand out in the eyes of an average consumer of such



relatively low cost goods, enabling such a consumer to distinguish the goods of one undertaking from those of other undertakings without the consumer having to pay particular attention or conducting a comparative examination of the competing products.

37. The applicant's primary case is that the mark had acquired a distinctive character as a result of the use made of it prior to 31 October 1994.

38. In the *Windsurfing Chiemsee* case [1999] ETMR 585, the ECJ set out the test to be applied in order to determine whether a trade mark has acquired a distinctive character under Article 3(3) of the Directive (Section 3(1) proviso). It held that the national courts 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 that:

“In determining whether a mark has acquired distinctive character following the use made of it, the competent authority must make an overall assessment of the evidence that the mark has come to identify the product concerned as originating from a particular undertaking, and thus to distinguish that product from goods of other undertakings.” (paragraph 49)

“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).

AIf, 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. 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.” (paragraph 52).

39. It is not clear whether, at the relevant date, the applicant had just launched, or was just about to launch, a rice dessert product. In my view there is plainly insufficient evidence to support the case for finding that the mark had acquired a distinctive character for the goods listed in Class 30.

40. It appears from the evidence that, by 1994, the shape the subject of the application enjoyed around 12% by value of the total yoghurt market in the UK. And it appears that the shape in question was the clear market leader as far as the more specific market for twin-pot yoghurts was concerned.

41. As I mentioned earlier, the applicant arranged for a public survey to be conducted in December 1998 in order to establish the level of consumer recognition of the shape applied for and the degree of association between the shape and the word marks used by the applicant in relation to products sold in packaging of the shape applied for.

42. Ms Ogley of Pathfinders gives evidence as to the conduct and outcome of the survey. Although Ms Ogley designed the survey herself, the fieldwork was sub-contracted to another specialist market research company called QRS Market Research Limited. They interviewed a “statistically robust” sample of 213 people face-to-face outside various supermarkets across the UK. For reasons which are not entirely clear to me, all the respondents were shown an empty unbranded example of the twin pot which is the subject of this application **and** an empty unbranded example of a jar used for petroleum jelly sold under the trade mark Vaseline. About half were shown the Vaseline jar first and the applicant’s twin pot second. The other half were shown the containers in the reverse order.

43. Ms Ogley describes the questions put to the respondents like this.

“8. A first question “Do you recognise this?” was asked. If the answer to this was “yes” or “not sure”, a second question “What is it?” was asked. A third question “Do you have any idea what comes in this container?” was then asked, and also asked to the respondents who answered “no” to the first question.

9. For the respondents who had been shown the Muller Corner carton, those who had not mentioned both the trade marks “MULLER” and “CORNER” in response to either the second or third questions, were asked a fourth question “What brand or make comes in this container?”

10. Any respondents who had mentioned the mark “CORNER” in response to any of the second to fourth questions, but not the mark “MULLER”, were then asked “Who makes CORNER/FRUIT CORNER?”

44. And she summarises the results of the survey as follows:

“20. The following is a summary of the findings from the survey:

- In response to the first question, over 9 out of 10 (92%) of all respondents claimed to recognise the Muller Corner pot, with a further 2% indicating they were “not sure”.
- In response to the second question 47% mentioned a Muller brand, namely either MULLER or CORNER.
- After the third question had been asked, 51% of respondents had mentioned a Muller brand.
- Once questions 4 and 5 had been asked where appropriate (see paragraphs 9 and 10 above) 71% of respondents had mentioned a Muller brand.

In summary, in response to questions 1-3, asked as appropriate (see above paragraphs) the following proportions were achieved. The figures in brackets relate to yogurt buyers as determined by question 6.

- 29% mentioned the trade mark MULLER (32%)
- 34% mentioned the trade mark CORNER (38%)
- 51% mentioned either of the trade marks MULLER or CORNER (56%)

In summary combining the responses to questions 1-5:

- 61% mentioned MULLER at some point (73%)
- 37% mentioned CORNER (47%)
- 71% mentioned either MULLER or CORNER (84%)

Mentions of non-Muller brands such as Ski and Shape, were at a very low level, indicating I suggest a very low level of thinking of the pot with these brands, or yogurt in general.”

45. The summary reveals a defect in the interpretation of the result of the survey in that it appears to assume that whenever the shape in question prompted a respondent to “mention” one or more of the applicant’s word marks the shape was acting as a guarantee of trade origin. This does not follow. Further, the problem is compounded by the fact that the researchers regarded CORNER as one of the applicant’s brands when on the evidence it is not a brand as such but simply a part of other brands such as FRUIT CORNER and CRUNCH CORNER. The word “corner” plainly describes the position of one of the chambers within the applicant’s twin-pot. It cannot therefore be assumed that any mention of that word is necessarily a reference to one of the applicant’s word marks.

46. The applicant has supplied the original questionnaires completed by the market researchers who did the field work. In questionnaire 3, the respondent is recorded as having answered question 2 by saying “A yoghurt pot with a corner additive.”(thus mentioning “corner”). But when asked which brand or make comes in a container of the type shown to the respondent he or she is recorded as answering “pretty much everything these days”.

47. It is plainly of no value simply to record the number of “mentions” of a word mark or brand without taking into account the context in which the association is made and the overall significance of the respondents answers.

48. The appropriate method for conducting a public survey has been the subject of much judicial comment. Perhaps the best known case is that of *Imperial Group v Philip Morris* [1984] RPC 293 in which Whitford J. set out certain guidance which should be followed if survey evidence is to be given weight in legal proceedings. This guidance makes it clear that questions must not be leading and should not lead the respondent into speculating about matters about which he or she would not have concerned him or her in an ordinary commercial situation.

49. The first two questions put to respondents in this survey are not leading. The third question – “Do you have any idea what comes in this container?” is not leading either, but it is more open to the charge that it invites artificial guesswork. I recognise that it is almost impossible to devise a survey of this type which is above criticism, and I do not therefore believe that any defect in a survey should be regarded as being

necessarily fatal. The fourth question – “What brand or make comes in this container?” – is, however, more significantly flawed because it invites respondents to name the word brand associated with the shape whilst implying that there is only one such brand or make. In circumstances where the shape concerned is used in connection with a market leading product, this approach makes it impossible to distinguish between those who were genuinely of the belief that the shape designated a Muller product and those who weren’t going on the shape but were instead going on the type of product and guessing that the market leader was most likely to be the “correct” answer to the question. The point can be illustrated by considering some of the more obvious examples of guesswork. For example, the respondent whose answers are recorded in questionnaire 18 responded to question 4 by saying “Muller, **is it?**” (emphasis added) Similarly, the respondent the subject of questionnaire 124 said “**Probably** Muller” (emphasis added). Four other respondents identified third party brands whose products are not sold in twin-pots corresponding to the shape applied for. Despite the singularity of the answer suggested by the question, 2 further respondents identified Muller and a competitor product as coming in a pot of the shape applied for.

50. The answers to the fifth question appear to be largely irrelevant.

51. I have been through each of the completed questionnaires and have concluded that 92 of the 217 gave answers which indicate that the respondent recognised the pot shown to him/her as the one used in a number of Muller products. All of these respondents referred to the Muller name, or to a word brand used by Muller, in their answers to questions two and three (mostly in their answers to question 2 – “What is it?”). I have taken account of the answers given to question 4 insofar as they serve to clarify answers given to questions 2 and 3. Otherwise, for the reason given above, I have not given weight to the answers of a further 44 respondents, who did not mention the applicant’s name or word brands in their response to questions 2 and 3, but who named one of them in their response to question 4.

52. Even taking the minimum level of recognition revealed by the survey as my starting point, it appears to me to represent a significant proportion of the relevant public. It is possible that even among the 92 who answered questions 2 and 3 in a way that favoured the applicant, some were associating twin-pots per se with the applicant rather than the specific shape of the twin-pot container for which registration is sought. In most cases of this type it would be wise for an applicant commissioning a survey in support of a trade mark application to simultaneously test respondents reaction to a different shaped product of the same type. This approach helps to distinguish between respondents who recognise the specific shape applied as one used by the applicant and those who merely associate the type of product with its only or best known producer.

53. I do not believe that this particular shortcoming seriously undermines my conclusions about the level of recognition of the shape revealed by this particular survey. My reasons for this are as follows. Firstly, none of the respondents who mentioned a brand in response to questions 2 and 3 identified a producer other than the applicant. Secondly, in response to subsequent questions, a significant proportion of respondents indicated that they were aware of other twin-pot yoghurt products on the market. Thirdly, even in relation to question 4, which plainly generated more

guesswork, the level of mis-attribution of the shape to other producers was still very low. I therefore find that the survey shows that a significant proportion of the relevant public recognised the shape shown to them as being one used by the applicant.

54. The survey was conducted some 4 years after the relevant date, by which time the applicant's sales had grown by 60% per annum and the amount spent per annum on advertising had more than doubled. Nevertheless, the applicant's share of the yoghurt market was already quite large by 1994 (12%) and its share of the twin-pot market was not greatly different in 1994 as compared to 1998 (suggesting that, probably because of their convenience, twin-pot products were capturing a progressively larger share of the total yoghurt market). Consequently, even if I apply a discount to the recognition shown of the shape in 1998, the proportion of the relevant public for yoghurt which would have recognised the shape as one used by the applicant in 1994 would probably still be significant.

55. This leads me to consider whether evidence of product recognition is sufficient to establish acquired distinctiveness as a trade mark. In the *Philips* case (see above) the ECJ was asked:

“ Where a trader has been the only supplier of particular goods to the market, is extensive use of a sign, which consists of the shape (or part of the shape) of those goods and which does not include any capricious addition, sufficient to give the sign a distinctive character for the purposes of Article 3(3) in circumstances where as a result of that use a substantial proportion of the relevant trade and public

- a) associate the shape with that trader and no other undertaking;
- b) believe that goods of that shape come from that trader absent a statement to the contrary?”

56. The court's response indicated that it was possible for a shape to acquire a distinctive character in these circumstances but that:

- a) the requirement cannot be shown to be satisfied purely on the basis of general abstract data, such as predetermined percentages (paragraph 62);
- b) the distinctive character of a shape, even that acquired by the use made of it, must be assessed in the light of the presumed expectations of an average consumer of the product, who is deemed to be reasonably well informed and reasonably observant and circumspect (paragraph 63);
- c) the identification of the shape as originating from a given undertaking must be as a result 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 (paragraph 64);
- d) it is for the national court to verify that the requirements of the provision are satisfied on the basis of specific and reliable data (paragraph 65).

57. This applicant did not enjoy a de facto monopoly in twin-pot yoghurts at the date of the application. It was, however, the clear market leader with apparently around three quarters of the UK market for such twin-pot products. It appears to me that the difficulty which arises in distinguishing between recognition of a shape of a product

as a trade mark, and recognition of the **type** of product as one associated with a particular trader, does not only arise where the trader is the only supplier of the type of product in question, but can also arise (perhaps to a lesser degree) where one trader dominates the market in a particular type of product. Moreover, although the ECJ was asked about the recognition of a shape in a situation where one party is the only known supplier of the type of article characterised by that shape, the court's answer is general in nature.

58. I do not find this surprising. It is now well established that (Section 3(2) apart), shape marks are subject to the same legal requirements as apply to other categories of trade mark. If a trader were to use a descriptive word mark, such as, for example, BUDGET for car hire services, in a non-distinctive way, simply as a description of a class of his car hire service, he could not hope to register it as a trade mark simply by showing that he was most closely associated with budget class car hire in the minds of the public. He would have to show that he had used BUDGET distinctively, as a trade mark. The same would appear to apply to shape marks. It appears that it is not sufficient to have used a shape. It seems to be necessary to have used it as a trade mark: that is to have used it in ways that are apt to distinguish the commercial origin of the goods so that consumers can rely upon the mark, in the course of trade, to distinguish the goods of an undertaking.

59. This analysis is consistent with the ECJ's case law on the subject of the essential function of a trade mark. For example, in *Mag Instruments Inc. v OHIM* [2002] ECR II-467, the Court of First Instance (CFI) of the European Court noted that the settled case law of the Court was that:

“.....the essential function of a trade mark is to guarantee the origin of the marked goods or services to the consumer or end user. The mark must enable the public targeted to distinguish the goods or services from those of other undertakings, and to believe that all the goods or services identified by it are manufactured or provided under the control of the trade mark owner, who can be held responsible for their quality.”

60. The CFI further observed that:

“ Only in this way will a consumer who purchases the goods or services identified by the mark be in a position, on a subsequent purchase, to make the same choice, if his experience is a positive one, or to choose differently if it is not.”

61. The evidence shows that the shape applied for is generally obscured in use by a plastic lid which would make it more difficult for the consumer to see the diagonal split between the two chambers of the twin-pot when the product is selected during the course of trade. This does not appear to be consistent with the shape serving a trade mark function.

62. The applicant submits the following arguments in response to this point. Firstly, that the plastic lid does not obscure all the features of the shape, and does not completely obscure the diagonal split between the chambers, which can still be seen from below. Secondly, that attention is drawn to the presence of this feature by the

use of word marks including the word “Corner”. Thirdly, that the diagonal split is visible in use, and in advertisements showing the product in use.

63. In connection with this last argument, the applicant points out that in Case C-206/01, *Arsenal v Reed*, the ECJ appeared to accept (see paragraph 57 of the judgement) that mis-identification of the responsible undertaking occurring after the goods have been selected may still impair the functions of a trade mark.

64. It is true that the diagonal division of the twin-pot is visible in some of the applicant’s television advertisements, which show the product being consumed. However, there is nothing in the advertisements which positively suggests to the viewer that the shape is a means of distinguishing the applicant’s goods. There is no evidence that the applicant has encouraged the public to, for example, “look for the one in the diagonally split pot”.

65. This would not be surprising if the shape is only fully visible after the product has been bought and the lid removed. In fact the arrangement of the chambers can, as the applicant points out, be seen from below and (if one looks carefully) from two of the sides. But this analysis assumes a tendency on the consumer’s part to conduct an examination of the product, which is hardly consistent with the shape having been used as a trade mark.

66. I have no difficulty in accepting that the functions of a trade mark may extend beyond the essential function, and that events occurring after the product has been selected in the course of trade could affect the capacity of the mark to perform its essential function during the course of the proprietor’s subsequent trade in the product. This may, as Mr Reed discovered, affect third party use of a trade mark, even if that use does not fall within the traditional view of trade mark use.

67. Mr Purvis suggested that this was the case here. He asked me to imagine a group of children being served with a twin-pot yoghurt in a pot corresponding to the shape applied for, but with the plastic lid (which bears the brand name) already removed. He suggested that the children would assume that the product was one for which the applicant was responsible and, if they were not satisfied with the quality, they may be less likely to purchase a Muller product in the future. However, this assumes that such consumers will avoid the applicant’s products by reference to the shape of the pot, which is not likely unless it is plainly visible at the point of selection.

68. In any event, even if this point was good, I do not believe that it relieves the requirement for the proprietor of the trade mark to have used the mark in order to distinguish his own goods in the course of his own trade, (which usually means at the point of selection), before it can be said to have acquired a distinctive character through use.

69. In this respect, I believe that the shape applied for can be distinguished from other shape-of-packaging marks, such as the shape of the JIF lemon and the COCA COLA bottle, which Mr Purvis suggested were on all fours with this mark. Both of those marks are used by their proprietors and the public as a means of distinguishing goods in the course of trading in the relevant products.

70. I therefore hold that the applicant's evidence shows product recognition by a significant proportion of the relevant public, but not use by the proprietor, with consequent reliance on the shape by consumers as a trade mark.

71. The applicant also applied for registration of the shape as a Community Trade Mark. The Office for the Harmonisation of the Internal Market (OHIM) rejected the application on the grounds that the mark is devoid of any distinctive character. The applicant appealed and the matter was considered by the First Board of Appeal, which issued a decision on 31 January 2001 upholding the refusal of registration. In the course of the decision the Board did, however, observe that the evidence filed by the applicant (which appears to be essentially the same as the evidence before me) that the mark had acquired distinctiveness in the United Kingdom. Not surprisingly, the applicant asks that this finding be taken into account in the assessment of its claim by the competent authority in the UK.

72. The decision on the First Board of Appeal is not binding on me (see the ECJ's answer to the third question asked of it in *Henkel*), but I can take it into account. I note that the decision was issued before the ECJ issued its judgement in *Philips*, which drew attention to the need for a shape mark to have been used as a trade mark. On my reading of the Board of Appeal's decision, it appears to have equated product recognition with use as a trade mark. In the light of later authority from the ECJ, such recognition may not always be sufficient. I am not therefore persuaded to follow the decision of the OHIM Board of Appeal on this occasion.

73. However, the question of whether trade mark use is required before a shape mark can be said to have acquired a distinctive character has again been placed before the ECJ as a result of reference from the High Court in *Dyson v Registrar of Trade Marks*, Case C-321/03. Despite what I have stated above, if it were not for my conclusions on the Section 3(2)(b) objection, I would have been inclined to suspend this application (with the applicant's agreement) to await the ECJ's answer in the *Dyson* case before finally refusing this application for registration for lack of distinctiveness. But in the light of the Section 3(2)(b) objection that is not appropriate.

## **Conclusion**

74. For the reasons given above, I refused this application because it is subject to objection under Section 3(2)(b) of the Act; the sign applied for consists exclusively of the shape of goods which is necessary to achieve a technical result.



75. I also record that there is a further objection under Section 3(1)(b) because the trade mark put forward for registration is devoid of any distinctive character, and as currently advised, the evidence filed does not show that the mark has acquired the necessary distinctive character as a result of the use made of it prior to the date of the application.

**Dated this 25th Day of June 2004**

**Allan James  
For the Registrar**