

O-263-18

In the matter of UK Trade Mark Application No. 3121849 filed by Robinsons Soft Drinks Limited (the Applicant) in class 32

and

In the matter of an Appeal to the Appointed Person by the Applicant against the Decision of the Hearing Officer O-356-17 for the Registrar, The Comptroller General dated 27th July 2017

DECISION OF THE APPOINTED PERSON

1. The application in issue was originally filed as an application for a European Union Trade Mark at the EUIPO with a filing date of 10 January 2014. In due course, an objection under Article 7(1)(b) was upheld, whereupon the Applicant made a request to convert the application into a UK trade mark application. The application was then assigned No. 3121849. The application is to register the three-dimensional mark depicted as follows:



2. The specification of goods is in class 32 and for:

'Non-alcoholic beverages; cordials (non-alcoholic beverages); squashes (non-alcoholic beverages); concentrates and dilutes; carbonated non-alcoholic drinks; mineral and aerated waters; fruit drinks and fruit juices; slush drinks; tablets or preparations for making effervescent non-alcoholic drinks; syrups, concentrates, powders, tablets, essences and/or other preparations for making beverages.'

3. The UK IPO maintained an objection under section 3(1)(b) of the Trade Marks Act 1994 (the Act). In its revised form, the objection was stated as follows:

O-263-18

“The application is not acceptable in Class 32. There is an objection under Section 3(1)(b) of the Act as the mark is devoid of any distinctive character. This is because the mark consists of a 3D representation of a non-distinctive receptacle or container for the goods listed. As such the average consumer is unlikely to pay any trade mark significance to the mark when encountered in the context of the goods in question.”

4. The Applicant responded to that objection by filing two witness statements. These witness statements did not attempt to prove that the mark had acquired distinctiveness under the proviso to section 3(1). Instead, they were filed to support the Applicant’s position that the mark possessed inherent distinctive character and was therefore registrable.
5. A hearing took place on 3rd October 2016. This resulted in a formal refusal of the Application on 4th January 2017, whereupon the Applicant requested a statement of reasons for the decision. The Hearing Officer then issued her Decision, the subject of this Appeal, on 27th July 2017, in which she gave her reasons why the Application failed as being contrary to section 3(1)(b) of the Act.
6. The Applicant appeals.
7. This appeal operates by way of review. Before I can intervene, it is necessary for me to be satisfied that there was a distinct and material error of principle in the decision in question or that the Hearing Officer was wrong. See *Reef Trade Mark* [2003] RPC 5; *BUD Trade Mark* [2003] RPC 25; and more recently the decision of Geoffrey Hobbs Q.C. sitting as the Appointed Person in *ALTI Trade Mark* (O-169-16) at paragraphs [19] to [20]; the decision of Daniel Alexander Q.C. sitting as the Appointed Person in *Talk for Learning Trade Mark* (O-017-17) referred to by Arnold J. in *Apple Inc. v. Arcadia Trading Ltd* [2017] EWHC 440 (Ch); and the judgment of Daniel Alexander Q.C. sitting as a Deputy Judge in the High Court in *Abanka D.D. v. Abanca Corporación Bancaria S.A.* [2017] EWHC 2428 (Ch).
8. Due to a change of personnel at the Applicant’s representatives and oversight, the TM55 and Grounds of Appeal were filed one day late, but the Hearing Officer granted a retrospective extension of time. It is perhaps because of the circumstances in which the TM55 had to be prepared that the Reasons for Appeal are brief:

O-263-18

'The Applicant has filed a substantial volume of evidence which it feels the Office did not give sufficient consideration to. The Applicant believes that the mark is acceptable for registration and would like the issue of registrability to be considered by the Appointed Person.'

9. In these circumstances, I was looking forward with interest to the Applicant's Skeleton Argument in support of its Appeal to see what errors of principle were alleged or why the Hearing Officer's decision should be considered to be wrong.
10. In advance of the hearing before me, I received reasonably full skeleton arguments from Mr Steven Jennings of Lewis Silkin LLP, representing the Applicant/Appellant and from Mrs Bridget Rees of the UK IPO for the Registrar. In its Skeleton Argument, the Appellant drew particular attention to and relied upon two decisions of the then Court of First Instance of the CJEU: T-393/02 *Henkel KGaA v OHIM (Shape of a white and transparent bottle)* and T-305/02 *Nestle Waters France v OHIM (Shape of a bottle)*. Since both these decisions have been the subject of adverse comment in *Kerly* (see e.g. the 16th Edition at 10-035 to 10-045, but especially 10-042 to 10-043, which also featured in earlier editions), I passed a message to the parties inviting them to consider these paragraphs so they could address them as necessary at the hearing.
11. In advance of the hearing I had the opportunity to read and consider the Appellant's evidence. The content of this evidence was summarised by the Hearing Officer in his decision at paragraphs 5 and 6.
12. The most substantial witness statement was that of Ms Louise Thompson dated 28th June 2016, comprising 17 pages of witness statement with two full ring binders of exhibits. As Mr Jennings submitted, the purpose of this evidence was to demonstrate that the container the subject of this application was novel, different to any container in this market sector (i.e. unique) and was designed to stand out from other containers in this market sector. Furthermore, the container in question is said to have initiated a new product sector – that of the super-concentrated drink product.
13. In order to illustrate these points, at the hearing, Mr Jennings referred me in particular to Ms Thompson's exhibit 2, which includes a number of photographs of supermarket shelves of ready to drink and dilutable drink products. Although these photographs appear to have been taken in June 2016, some time after the date of

O-263-18

application (10 January 2014) and some include images of the Applicant's product which feature the container in question, I am quite prepared to proceed on the basis that these photographs are representative of the range of bottles and containers used in the market sector concerned with ready to drink and dilutable drink products as at the date of application.

14. It struck me that the photographs in exhibit 2 demonstrated two points:

14.1. First, they illustrated the points which Mr Jennings was seeking to establish – I have summarised these in paragraph 12 above. In any event, having read the Appellant's evidence in advance, I indicated at the hearing that I was quite prepared to proceed on the basis that the container in question was new, different and stood out from others in the market sector.

14.2. Second, they confirmed an important point made in the Hearing Officer's decision. In her paragraph 22, the Hearing Officer stated:

'...the average consumer is not used to making decisions relating to the origin of goods based on the appearance of the container alone. It has been demonstrated in the evidence and exhibits provided by Ms Thompson that there is no one standard size or shape for the packaging of soft drinks, and that there are a great number of different-sized shapes currently being used. This variation and variety in the form of soft drink containers actually points away from shape being an immediate indicator of origin because, on the basis of information provided by the applicant, the consumer will already be accustomed to seeing a number of such shapes performing a purely functional role, namely to act as a container for liquid.'

15. Indeed, I would go further. Without exception, every container featured in the photographs carried labelling which itself featured source information – the trade marks (word and logo marks) and trade dress of the producer of the product in question. Of course, it is common for products to feature more than one trade mark and it is certainly not impossible for a secondary mark or feature of a product to gain distinctive character even where the primary indicator of origin is a well-known word mark used on drinks such as Robinsons or Sainsbury's or Ribena, to give just a few examples. However, the labelling shown in the photographs in exhibit 2 demonstrates that the average consumer was not educated (at least in this market sector) to perceive the shapes of bottles and containers as indicating trade

O-263-18

origin because the trade origins of these products is conveyed by material on the labelling. Whilst the photographs show a number of designs of container, the photographs support the Hearing Officer's finding that the consumer was already accustomed to seeing a number of shapes of container performing a purely functional role, acting as a container for liquid.

16. Mr Jennings argued the Appellant's case with real passion seeking to establish that this container had inherent distinctive character and that the Hearing Officer's decision was wrong. In substance, however, his arguments amounted to the same points discussed in *Kerly*, namely:

16.1. This container is novel and different to any other in this market sector;

16.2. This container stands out from other containers in this market sector. It would be recognised as distinct;

16.3. This container has a memorable appearance;

16.4. This container has a combination of elements which together amount to more than the sum of its parts and confer distinctive character on the whole.

17. In her decision, the Hearing Officer directed herself entirely correctly by reference to CJEU case law concerning section 3(1)(b) or its equivalent, article 7(1)(b) of the EU Trade Mark Regulation. She also cited paragraphs 10 and 11 from the judgment of Laddie J. in *Yakult* [2001] RPC 39 (of which paragraph 10 is cited in *Kerly* at 10-041). Despite pre-dating much of the CJEU case law, in my view paragraph 10 neatly encapsulates not only the problems facing those who claim their container possesses inherent distinctive character but how what are now familiar arguments (such as those I have set out in paragraph 16 above) fail to establish inherent distinctive character.

18. In conclusion, I was unable to find any error (let alone of principle) in the Hearing Officer's decision. Furthermore, and despite Mr Jennings' passionate submissions, the Hearing Officer's decision appears to me to be plainly correct.

19. In these circumstances, I dismiss this Appeal.

O-263-18

20. As is usual in *ex parte* appeals, I make no order as to costs.

JAMES MELLOR QC

The Appointed Person

27th April 2018