

O-284-04

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2039840
BY MARS U.K. LIMITED
TO REGISTER A TRADE MARK
IN CLASS 30
AND IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 90619
BY LUDWIG SCHOKOLADE GMBH & CO. KG

BACKGROUND

1) On 4 October 1995, Mars U.K. Limited of 3D Dundee Road, Slough, Berkshire SL1 4LG applied under the Trade Marks Act 1994 for registration of the following trade mark:



The mark consists of the shape of a confectionery bar, in particular the rounded ends and the wave pattern across the top.

2) The mark was in respect of the following goods in Class 30: “Chocolate covered coconut or coconut flavoured confectionery bars; coconut or coconut flavoured ice-cream bars, ices and frozen confections”.

3) The mark was allowed to proceed because of distinctiveness acquired through use and survey evidence.

4) On 16 May 2002 Ludwig Schokolade GmbH & Co. KG (hereafter called Ludwig) of Susterfeldstrasse 190, 52072, Aachen (DE) filed notice of opposition to the application, subsequently amended. The amended grounds of opposition are in summary:

a) The opponent is the manufacturer of confectionery products including a chocolate bar with a coconut centre (the Ludwig bar). This bar has been supplied to various UK supermarkets, retailers and distributors for a number of years. The Ludwig bar is sold in the UK under various “own brand” names by the opponent’s UK customers. For example Aldi UK sell the bar under the name ROMEO. Since July 1990, Aldi UK has sold 60 million Romeo bars. Currently the opponent sells 14 million Ludwig bars per annum to its customers in the UK.

b) The opponent questions the survey evidence as it was collected in 1999/2000 whilst the filing date of the application was 4 October 1995. Also that as members of the public were only shown a photograph of a “Bounty” bar, the evidence does not support “coconut, or coconut flavoured ice cream bars”, “ices” or “frozen confections”.

c) The opponent alleges that an account manager of the applicant has already approached one of the opponent’s UK customers, advising that the applicant will shortly be granted a UK Trade Mark registration for the “Bounty” bar. The opponent therefore concludes that the applicant considers that the Ludwig bar is

identical in shape, or sufficiently similar, to the product the subject of the mark applied for as to constitute an infringement.

d) The opponent contends that the mark offends against Section 3(1)(a) of the Trade Marks Act 1994 as it is not capable of distinguishing the applicant's Bounty bar from the opponent's Ludwig bar, or any other bar produced by another undertaking but having the same or similar shape.

e) The opponent contends that the mark is devoid of any distinctive character and hence offends against Section 3(1)(b) of the Trade Marks Act 1994. The opponent contends that the applicant has only ever used the mark in suit as the shape of its product rather than as a trade mark and has used it in conjunction with a trade mark which is distinctive such as "Bounty".

f) The opponent also contends that the mark consists exclusively of a shape which results from the nature of the goods and hence offends against Section 3(2)(c) of the Trade Marks Act 1994.

5) The applicant subsequently filed a counterstatement denying the opponent's claims.

6) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 25 March 2004 when the applicant was represented by Mr Purvis of Counsel instructed by Messrs Clifford Chance, and the opponent by Mr Bloch of Queens Counsel instructed by Messrs Hulse & Co.

OPPONENT'S EVIDENCE

7) The opponent filed a statutory declaration, dated 13 December 2002, by Ian James a Director of Fairway GB Limited which provides management services for Ludwig Chocolate Ltd (Ludwig UK) a wholly owned subsidiary of the opponent. Mr James is the Director of sales of Ludwig UK and is involved in its day to day running and has access to its records and those of Fairway GB Limited.

8) Mr James states that his company sells and distributes in the UK confectionery products of the opponent company. Amongst these products is a bar of desiccated coconut encased in chocolate, the bar having rounded ends and a top surface decoration in the form of a three point ripple which is called the Ludwig bar. Mr James states that this bar is sold to UK customers such as Aldi, Iceland, Asda, Booker and Waitrose.

9) Mr James repeats the allegations set out in paragraph 4(c) above. However, he does not name the individuals spoken to, the statement was made some time after the alleged conversations, and I can see no reason why the individuals concerned could not have provided first hand evidence by way of witness statements. Therefore, whilst admissible I attach little weight to this evidence.

10) The opponent also filed an affidavit, dated 18 December 2002, by Udo Walter the Director of Sales for the opponent company. He has been employed by the opponent since 1965 and claims to have a competent knowledge of English. He states that

previously the company was named “Monheim” and had a branch called “van Houten”.

11) Herr Walter states that his company produces a bar of desiccated coconut encased in chocolate, the bar having rounded ends and a top surface in the form of a three pointed ripple. The bars have been produced in this form since 1971. At exhibit 1 he provides a copy of pages from catalogues dated 1974 & 1976 which show pictures of a chocolate bar in the shape described and branded “Mounds”. The illustration on the packaging shows the inside of the bar which is white and appears to consist of a coconut confection.

12) Herr Walter states that in 1990 the opponent began delivery of these bars to the UK market, initially to Aldi and then to other customers such as Lidl, Iceland, Asda and Booker. He states that the UK customers sell under their own brands, Aldi sells the bar under the name ROMEO, Iceland as OASIS and Lidl as Mr CHOC. Herr Walter states that in all cases the bar is the same product as depicted in the catalogue pictures. At exhibit 2 he provides a list of the deliveries of these bars to three of its UK customers, Aldi, Iceland and Lidl. Between 1990 and 1998 these customers were supplied with 2122.5 tons which he states represents approximately 85 million bars. Prior to 4 October 1995 Herr Walter states that approximately 22 million bars were supplied to Aldi UK.

13) At exhibit 3 Herr Walter provides a list of deliveries of the bars made to UK customers between January 2000-November 2002. Whilst at exhibit 4 he provides copies of specimen invoices from 1994 – 1999.

APPLICANT’S EVIDENCE

14) The applicant filed a witness statement, dated 12 June 2003, by Catherine Burge the Regional Marketing Property Manager for the Mars Group of Companies. She states that the applicant has manufactured the product known as the Bounty Bar since 1951. She describes this as being “a chocolate bar filled with coconut” and having “rounded ends and a distinctive wave feature on the top surface of the bar”. She states that none of the features of this bar are dictated by manufacturing considerations. Ms Burge adopts, at exhibit CB1, the evidence filed in support of the application. I will detail this later. Ms Burge claims that the evidence shows that the applicant has “educated our customers to see the BOUNTY shape as being our product and no-one else’s”. She states that if a third party were to sell a product having the same appearance there is likely to be confusion.

15) Ms Burge states that the Ludwig bar was copied from the Bounty Bar. She also disputes whether all the Ludwig bars are similar in appearance. At exhibit CB3 she provides a photograph of the Asda product which has a different surface pattern to the “Mounds” bar shown in the opponent’s evidence. Ms Burge states that there are a wide range of shapes that can be used for this type of product and at exhibit CB4 she provides photographs of a coconut bar which is rectangular with no discernable surface pattern and what appears to be two different types of small sweets which also contain coconut.

16) I will now detail exhibit CB1. This consists of six statutory declarations. The first declaration, dated 20 August 1999, is by Claire Christina Hutchinson, the applicant's Trade Mark Attorney. She states that she commissioned a survey which was conducted between 2-6 July 1999 by Taylor Nelson Sofres plc. At exhibit CCH1 she provides an extract from the survey showing the methodology. Ms Hutchinson states that: "The survey encompassed approximately 2000 interviews weighted to match the demographic make-up of the population for all adults age 15 or over." She explains that the interviews were conducted face to face. The individual was shown a photograph of a chocolate bar (exhibit CCH2) and asked to name the product. She states that 70% of those interviewed identified the product as Bounty, 14% named other brands, whilst 16% were recorded as "don't know". At exhibit CCH3 Ms Hutchinson provides a copy of the table detailing the results of the survey. Exhibit CCH2 shows a chocolate bar with two rounded ends and a wave/ripple pattern on the top. This is identical to the mark in suit. Those who were deemed to have answered "bounty" were recorded by number only, no record of their exact answer was recorded, nor were notes kept of their responses. Records were made of the responses of those recorded as "other".

17) The applicant filed two almost identical declarations. One, dated 17 February 1998, by John Easter Newman a Director of the Biscuit, Cake, Chocolate & Confectionery Alliance, a position he has held for twenty years. The second, dated 16 February 1998, by Trevor Michael Joseph Dixon the Chief Executive of the Association of Convenience Stores. Mr Dixon states that he has worked in the grocery trade for thirty years and that he has a thorough knowledge of the grocery trade which includes the confectionery trade.

18) Both men state that they received a questionnaire from the applicant's Trade Mark Attorney which included an unwrapped chocolate bar and a colour photograph. Having completed and sent back the first questionnaire they received a second which they also completed and returned. The completed questionnaires and the colour photograph are attached to the declarations as exhibits. The first questionnaire asked the recipient to identify the name and producer of the product shown in the photograph. The second asked whether the individual would be prepared to sign a declaration prepared by the applicant's Trade Mark Attorney formally submitting the reply as evidence. In both cases the photograph was identified as a Bounty Bar and the manufacturer as the applicant company.

19) The fourth declaration, dated 23 June 1999, is by Evie Kyriakides the Marketing Property Manager responsible for trade marks within the applicant company. She states that the applicant has used the subject trade mark in relation to confectionery continuously since 1951. At exhibit EK1 she provides photocopies of packaging on which she states representations of the product have occurred. Only five of the exhibits are dated, these cover the period 1953 -1956. Whilst whole or "broken" Bounty bars are pictured or depicted, none are identical with the mark in suit, although the differences in a few cases are slight.

20) Ms Kyriakides provides figures for units sold (individual pack of ice cream or chocolate), turnover and advertising in the UK as follows:

Year	Units sold (millions)	Turnover £ Millions	Advertising £ Millions
1990	178	41	3
1991	198	48	2.9
1992	192	50	2.9
1993	172	47	3.4
1994	167	48	3.3
1995	152	45	3

21) Ms Kyriakides states that the applicant sells its confectionery and ice cream products under the mark in suit throughout the UK. She provides a schedule of television commercials at exhibit EK2 and also a video of commercials for the period 1958-1995. In none of the fifty one commercials, lasting 27 minutes, was the mark applied for actually shown. There were glimpses of whole and broken bars but none which were identical to the mark in suit. In the earlier advertisements from the 1950s & 1960s the image of a whole Bounty bar was shown. In the later advertisements there were fleeting glimpses of chocolate bars but it was not possible to discern whether they had rounded ends or a wave pattern on the top.

22) The last two declarations, dated 30 June 2000 and 14 June 2001, are by Alan John Wicken who describes himself as “a research consultant specialising in surveys for legal purposes”. He states that he has provided the declarations in order to explain a further survey that was undertaken under his direction the purpose of which was to illustrate what it is about the shape of the mark applied for which makes the bar distinctive of Bounty. He states that the survey produced a result consistent with the earlier survey which showed that the mark in suit is distinctive for two thirds of the adult general public with Bounty.

23) Mr Wicken explains that four shapes were devised, all of which were whole (their contents could not be seen) bars covered in chocolate:

- Bar A: the wave/ripple pattern retained but the corners squared;
- Bar B: both the wave/ripple pattern replaced by three longitudinal lines and the corners squared;
- Bar C: the wave/ripple pattern with two rounded ends (the mark in suit);
- Bar D: the wave/ripple pattern replaced by three ridges on the top surface parallel with the long side.

24) The survey involved the use of four equivalent samples of the general public, each group involving approximately 1,000 persons, with each group asked to name the product shown in one of the four pictures. The survey took place during two consecutive weeks 29 March – 2 April and 5-9 April 2000. Each respondent was asked “Can you tell me the name of the product in this picture?”. Although the responses were marked in three categories, the full breakdown for Bar B was not included in the exhibits. However, Mr Wicken had provided a figure for those who either named/did not name Bounty for each of the four bars. The figure for Bar B is this amalgamation of the two rows “Other” and “don’t know”. The results were as follows:

% who:	Bar A Square/Waves	Bar B Square/lines	Bar C Round/wave	Bar D Round/lines
Named Bounty	5	4	66	24
Other	72	96*	17	36
Don't Know	23		17	41

*amalgamated figure.

25) Mr Wicken states that there were three pre-coded answers, “Bounty”, “Other” and “don’t know”. Each respondent was included in only one category. He states:

“I believe it is unlikely that an interviewer who realised that a respondent did not actually recognise the product, and was simply guessing at a number of different brands of chocolate bar, will have recorded that respondent as having given the answer BOUNTY even if BOUNTY was one of the brands guessed at by the respondent”.

26) Mr Wicken states that he discussed this point with the Senior Research Executive at Taylor Nelson Sofres who carried out the research and was informed that any interviewees giving more than one answer would have been recorded in the “other” category. Mr Wicken provides copies of the “other” answers provided in the survey and these show on a few occasions that Bounty was named along with other products. He also states that “verbatim responses were not recorded in respect of respondents who gave the answer “BOUNTY”; in such cases, respondents were simply recorded as having given that pre-coded answer”. Mr Wicken states that the results show it is the combination of rounded corners and the wave/ripple pattern which are essential to the distinctiveness of the shape of the Bounty Bar.

OPPONENT’S EVIDENCE IN REPLY

27) The opponent filed two witness statements and an affidavit in reply. The first witness statement, dated 19 September 2003, is by Ian James who provided an earlier declaration. At exhibit IJ1 he provides a photograph of a wrapper in which Iceland sold their “Ludwig” bars under the name of OASIS in the UK between March 1995 and February 2002. He states that during this period approximately 5 million “6-packs” were sold by Iceland. The wrapper has an illustration of the Ludwig bar showing it as having rounded ends and the wave pattern on the top surface.

28) The affidavit, dated 26 August 2003, is by Udo Walter who filed an earlier affidavit. Herr Walter refutes the claim made by Ms Burge that the Ludwig bars sold by Asda differed from those sold by other UK customers. Herr Walter states that initially Asda were supplied with the normal Ludwig bar with the surface wave/ripple. Shortly after, Asda requested that their Ludwig bars have a different surface decoration. For approximately two months Asda were supplied with the Ludwig bar with the surface decoration as described by Ms Burge. However, as this different surface decoration was causing difficulties to Herr Walter’s company Asda agreed to accept the standard Ludwig bar with the surface ripple. No other customer has asked or been supplied with anything other than the standard Ludwig bar.

29) The second witness statement, dated 12 September 2003, is by Brian Christopher Houlihan who was, during the period 1993 – June 2002, the Buying Director of Aldi

Stores Ltd in the UK. He confirms that Aldi UK has sold the Ludwig bar under the trade mark ROMEO since mid 1990. In exhibits BCH1-BCH7 he provides copies of orders and invoices between his company and the opponent. He states that Aldi has sold “vast quantities” of these bars throughout the UK during this period.

30) That concludes my review of the evidence. I now turn to the decision.

DECISION

31) I shall first deal with the grounds of opposition under Sections 1(1), 3(1)(a) & 3(1)(b) which read:

“1.-(1) In this Act a "trade mark" means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.”

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

- (a) signs which do not satisfy the requirements of section 1(1),
- (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 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.”

32) The opponent has offered no evidence as to why the mark cannot function as a trade mark, other than their own view that members of the public would not view the shape as a trade mark. I do not think that the shape mark is such that I can say now that the applicant will never be able to educate the public to regard the shape as a trade mark denoting only their goods or services. The opposition under Sections 1(1) & 3(1)(a) therefore fails.

33) I therefore move to consider the ground of opposition under Section 3(1)(b). When considering the opposition under this section I adopt the approach taken by the European Court of Justice in its judgment in Joined Cases C-53/01 to C-55/01 *Linde AG, Windward Industries Inc. and Radio Uhren AG* (8 April 2003) which state:

“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).

.....

47. As paragraph 40 of this judgment 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.”

34) It is clear from the above that I must assess the mark's distinctiveness in relation to the goods for which the applicant seeks registration. Broadly the specification is for confectionery. I must also take into account the perception of the relevant consumer of the goods which, to my mind, means the general public.

35) The applicant draws attention to the rounded ends and the wave/ripple pattern across the top as being distinctive elements of the overall shape. In my view, the mark consists of a number of constituent parts, which in totality, fail to bestow upon the mark the minimum degree of distinctive character required to allow prima facie acceptance. It is well settled that the test for distinctiveness of a trade mark must be judged against the mark as a whole. The depiction of the goods is not strikingly novel or distinctive. In my view the average consumer would not see the mark as being origin specific and would not attach trade mark significance to the mark. Confectionery comes in all shapes and sizes with, in my experience, rounded ends being somewhat commonplace. Similarly, confectionery frequently has a form of decoration on the top, which sometimes acts as a code as to the type of filling. In addition confectionery tends to be wrapped and so shape and decoration are not evident at the point of sale. Prima facie the mark is devoid of any distinctive character and the opposition under Section 3(1)(b) succeeds. However, the applicant seeks solace from the proviso, claiming that the mark has acquired distinctiveness through use.

36) 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 the 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).

“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. However, the circumstances on 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).

37) The applicant provided evidence of the level of sales and also promotional activity. However, from the packaging provided it is clear that the mark applied for has not been used. Similarly, in my opinion, the promotional material provided does not show the mark in suit. The applicant accepted that the advertisements did not show the mark in suit although it was contended that they showed the “essential features” of the mark. In my view, the essential features are not apparent when watching the advertisements at normal speed. The applicant has provided “stills” from the adverts which show the chocolate bars in more detail but these would not be available to the general public. I do not consider either the level of sales or the promotional material to be of assistance to the applicant as it cannot be said to be evidence of use of the mark in suit.

38) The applicant filed evidence from two prominent members of the trade. Both were sent an unwrapped “Bounty” bar and asked if they could identify it and the manufacturer. Both did identify the product and the manufacturer correctly and gave statements to that effect. However, the chocolate bars sent to them, photographs of them or their equivalent were not provided in evidence. I could not determine therefore whether there was anything embossed or printed onto the bars that would

have assisted identification. Neither witness commented on whether they tasted the bar before identifying the product.

39) The applicant relies upon two surveys, both involved questioning approximately two thousand persons. Both surveys were carried out by a market research company Taylor Nelson Sofres. The first survey involved the interviewee being shown the mark in suit and being asked to name the product. If they named the product as Bounty, or if they responded “don’t know” the relevant box was ticked by the interviewer. Only if they responded with other brand names were their responses accurately recorded. The survey showed that 70% identified the product as Bounty, 16% named other brands whilst 14% responded “don’t know”.

40) The second survey was carried out in 2000 and involved the interviewees being split into four groups. Each was shown one out of four pictures of chocolate bars and asked to name the product. Of the four pictures one was the mark in suit, the others being specially devised either to reflect one or none of what the applicant describes as the distinctive characteristics of the mark in suit, the rounded ends and the wave pattern on the top. In this survey of those shown the image of a Bounty bar 66% identified it correctly. Only 4-5% of those shown a square bar with either lines or waves on the top identified the bar, incorrectly, as a Bounty ; whilst 24% of those shown a bar with rounded ends and straight lines on the top incorrectly identified the picture as a Bounty bar. Again, those responding “Bounty” or “don’t know” had a box ticked by the interviewer, only those responding with other brand names had their responses accurately recorded.

41) The applicant claims that any respondent naming two brands or who was clearly guessing would have been marked down in the “other” category. The responses for this group do show a few individuals who named Bounty amongst other brands. However, these surveys do not put the mentions of Bounty into context, anyone who guessed the answer but only mentioned the applicant’s brand would have been recorded as providing the “correct” answer.

42) Over the years there has been considerable judicial comment on the appropriate method of conducting a public survey. At the hearing I was referred to perhaps the best known case, *Imperial Group v Philip Morris* [1984] RPC 293 in which Whitford J. set out guidance on the conduct of surveys in order for the result to be given weight in legal proceedings. It is clear from his guidance that questions should not be leading and that the respondent should not be led into speculating about matters about which would not have concerned them in an ordinary commercial situation.

43) I accept that almost any survey can be criticised, and the fact that a survey can be criticised should not automatically render the survey as without weight. However, to my mind, asking the respondent to name the product shown in the photograph held up by the interviewer is inviting the respondent to name the word brand associated with a shape whilst implying that there is only one such brand or make. Where the shape concerned is used in connection with a market leading product, as is the case here, the approach used by the interviewers makes it difficult to determine between those who genuinely believed that the shape designated the Bounty bar and those who were not considering the shape but the type of product and guessing that the market leader was most likely to be the “correct” answer to the question.

44) The lack of verbatim answers from those who gave the “correct” answer makes it impossible to determine the extent of guesswork involved. Quite why it was decided to record in full only the “wrong” answers is unclear. However, despite these shortcomings the level of recognition revealed by the surveys clearly demonstrates that a significant proportion of the relevant public recognised the shape shown to them as being one used by the applicant.

45) I have to consider whether evidence of product recognition is sufficient to establish acquired distinctiveness as a trade mark. It is claimed that the design of the confectionery bar is unusual and that the product was easy to distinguish from the products of other manufacturers, prior to the copying of the shape by rivals. However, even if this was true at the date of application, it is clear from *Philips v Remington* [2001] RPC 38 paras 64 & 65 that 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.

46) The essential function of a trade mark is to identify the commercial origin of a product so as to enable the consumer who purchased it to either make a subsequent purchase of the product if it proves satisfactory or to avoid the product in future if the experience is unsatisfactory. When sold the applicant’s product is within a wrapper so its shape and decoration cannot be seen. The packaging exhibited does not have printed upon it the mark in suit. There is no evidence of the role that the shape plays in the selection of these goods, and it would appear from the evidence, in particular the packaging, that they are selected by reference to the brand name BOUNTY rather than by reference to the shape of the product. Therefore, the shape mark cannot be said to assist the consumer in choosing the product or avoiding it.

47) To my mind the applicant’s evidence shows product recognition by a significant proportion of the relevant public, but not use by the applicant, with consequent reliance on the shape by consumers, as a trade mark. I do not consider that 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. The opposition under Section 3(1)(b) succeeds.

48) As this finding decides the matter I do not need to consider the ground under Section 3(2)(c).

49) The opposition having been successful I order the applicants to pay the opponent the sum of £1750. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 21st day of September 2004

George W Salthouse
For the Registrar,
the Comptroller-General