

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2335819
BY JSP LTD
TO REGISTER A TRADE MARK
IN CLASS 9**

BACKGROUND

1. On 24th June 2003, JSP Ltd of Worsham Mill, Minster Lovell, Oxford, OX29 0TA applied under the Trade Marks Act 1994 (the Act) for registration of the following mark:



2. Although there is no indication in the relevant section 4 on Form TM3, it is clear that the mark is intended to be a three-dimensional representation of a protective helmet. It has been treated as such in all exchanges in relation to the application. There is no claim or limit to colour on Form TM3 and so the mark has also been treated as a 'naked shape'.

3. A word needs to be said about the representation on file. It is not of the best quality. However, no objection was maintained on the basis that the mark was not graphically represented (see sections 3(1)(a) and/or 32(2)(d)). I think this representation must be at the very limit of what may be considered acceptable. In such a case, it is important to stress that both the applicant and the Registry are constrained to examine the representation which is presented on Form TM3. Other, clearer representations filed during prosecution cannot be used to substitute for what is filed at the outset. Only features which are apparent from the original filing can be taken into account.

4. The goods for which registration was sought are:

Class 9 Protective helmets and parts and fittings therefore or for use therewith, including eye shields.

The attorney of record is Mr Olaf C Rock of Rock and Company.

5. On 22nd August 2003, the Registry issued an examination report stating that the application was not acceptable as there was an objection under section 3(1)(b) and (c) of the Act because the mark was devoid of distinctive character and a sign which may serve in trade to designate the type of goods, eg protective helmets.

6. After written submissions by the agent, the Registry maintained the objection and the case came up for a hearing on 28th February 2005 before me. By that time the only objection under consideration was under section 3(1)(b) of the Act. At the hearing, the objection was maintained in the prima facie case, relying in particular on the European Court of Justice (“ECJ”) *MAG Instrument Inc ‘Torch’ Case (C-136/02P)* [2005] ETMR 46. As is often the case however, no final refusal of the application took place at the hearing. Instead, a suspension was allowed whereby several factual issues could be clarified and the attorney given the opportunity of pursuing the question of acquired distinctiveness. Between the time of the hearing and final refusal on 7th September 2006, several exchanges of correspondence had taken place whereby the attorney had sought to persuade me that the sign had acquired distinctiveness. I was not persuaded of this; the application was duly refused and through his attorney the applicant now requests a reasoned statement of grounds.

DECISION

7. The only ground for refusal is section 3(1)(b) which reads:

“Grounds for refusal of registration

3- (1) *The following shall not be registered –*

(a).....

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

8. Section 3(1)(b) has been summarised by the ECJ in paragraphs 37, 39 to 41 and 47 of its Judgment in *Joined Cases C-53/01 to C-55/01 Linde AG, Windward Industries Inc and Rado Uhren AG* [2003] RPC 45 in the following terms:

37 It is to be noted at the outset 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 in Article 3(1)(b) of the Directive, trade marks which are devoid of distinctive character are not to be registered or if registered are liable to be declared invalid.

40. For a mark to possess distinctive character within the meaning of that provision it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from products of other undertakings (see *Philips*, para 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 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, para 31 and *Philips*, para 63).
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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 other undertakings."

The prima facie case.

9. In correspondence and at the hearing, the attorney relied on the fact that the applicant's helmet was different from competitors, and that the style of the helmet (notably what I shall refer to as the front facing plate) was a feature of the applicant's product which they had used through the various generations of the product.
10. As regards the various versions of the helmet, the attorney says in a letter of 23rd February 2004 that the front facing plate configuration has been used since 1978 (the Mark II helmet). In 1997, Marks IV and V were introduced, but the only difference between those and the Mark II was the harness. The third generation of helmet with the design (the Mark VI) was introduced in October 2003. It is estimated that at least 80 million units with the design have been sold worldwide since 1978. In the UK it is said that helmets bearing the design constitute 50% of the total market.
11. At the hearing, the attorney said that those in the field tended to 'individualise' their helmets. I interpret this as meaning that, whilst the lay person may view the selection of helmets which I had before me as simple variants and no more, in fact the trade itself regarded the differences as having origin significance, in the sense that a conscious effort is made by manufacturers to put 'clear blue' design water between themselves and their competitors.
12. In judging the prima facie case however, I had to assess the application as best I could from the perspective of the average consumer (see Linde quoted above). This presented some difficulty since, as I also made clear at the hearing, I was somewhat in the dark as to who precisely the average consumer was in this case; how and to whom were the helmets sold ? I took the view that for the most part the average consumer and end- user was likely to be trade buyers rather than the general public.

13. Even on the premise of a trade consumer, I felt there was no option in this case but to reject the application in the prima facie. General authority on ‘shape’ marks has in my view developed sufficiently at ECJ as well as national level to warrant such a position. The case upon which I expressly relied on at the hearing was the ECJ *MAG Instrument Inc’ Torch’ case (C-136/02P)* [2005] ETMR 46, referred to earlier, which states at paras 31 and 32:

“31. In those circumstances, the more closely the shape for which registration is sought resembles the shape most likely to be taken by the product in question, the greater the likelihood of the shape being devoid of any distinctive character for the purposes of Article 7(1)(b) of Regulation No 40/94. **Only a mark which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin, is not devoid of any distinctive character for the purposes of that provision** (see, to that effect, *Henkel v OHIM*, paragraph 39 and the case-law cited there).

32. Therefore, contrary to what the appellant submits, where a three-dimensional mark is constituted by the shape of the product for which registration is sought, **the mere fact that that shape is a ‘variant’ of a common shape of that type of product is not sufficient to establish that the mark is not devoid of any distinctive character for the purposes of Article 7(1)(b) of Regulation No 40/94.** It must always be determined whether such a mark permits the average consumer of that product, who is reasonably well informed and reasonably observant and circumspect, to distinguish the product concerned from those of other undertakings without conducting an analytical examination and without paying particular attention.”

(my emphasis in bold)

14. Applying those emboldened parts of the *MAG Torch* case, I had little doubt that the shape before me was not aberrational in relation to its competitors, but simply appeared to be a variant of a protective helmet. Although the precise configuration of the helmets brought to my attention arguably varies, I did not feel that an average consumer of the goods would accord such variation any trade mark significance in the prima facie. Furthermore, the submission that the configuration of the applicant’s helmet had been adopted through several generations of the product was not, of itself, sufficient to concede that the mark was protectable in the prima facie.

15. The question as to whether the variant has trade mark significance at the date applied for, by which I mean that average consumers had come to regard the differences in shape as denoting the origin of the product, was a matter on which I retained an open mind. What was clear to me however was that such a question had to be addressed by way of formal evidence of acquired distinctiveness.

The case for acquired distinctiveness.

16. I should say at the outset that the evidence submitted subsequent to the hearing on the prima facie case was not, and still has not been, properly formalised as a witness statement or statutory declaration. This is an unsatisfactory state of affairs. I said in

my letter to Mr Rock of 3rd March 2006 that informal evidence had attracted criticism in the past (see eg *FRESH BANKING (BL O/298/98)* on appeal before the Appointed Person), and that I was unable to give it any consideration.

17. In the interests of efficiency however, I feel compelled to deal with such matters of substance as the ‘evidence’ and further submission gives rise to.

18. With his letter of 26th May 2005, four batches of material were supplied: general matters (catalogues, imitations, sales figures); responses to questionnaires submitted by the applicant to major customers; examples of unauthorised copies of the applicant’s helmet; information on exhibitions attended by the applicant and a review of competing products. It is worthwhile noting that none of the evidence (apart from the questionnaires I shall refer to in para 27) originates from anyone other than the applicants, eg competitors or trade associations.

19. The guiding principles to be applied in determining whether a mark has become distinctive through use are to be found in *Windsurfing Chiemsee Produktions v Huber* [1999] E.T.M.R. 585.

“51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.

52. 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 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.”

20. I also bear in mind Morritt LJ’s observation in *Bach and Bach Flower Remedies Trade Mark* [2000] RPC 513 at para 49 stating that:

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

21. The crucial question therefore is not the quantitative amount of use made by an applicant, but whether the use made is qualitative, in terms of generating customer recognition by use, in this case, of the shape. There is no doubting the huge volume of worldwide sales in relation to the product (80 million since 1978) or the large market share in the UK. But mere use does not suffice. Has the use been ‘material’ in terms of transforming the shape from just a shape to an indication of origin recognised by the average consumer?

22. The tantalising legal question whether, additionally, the applicant must have used the mark as a trade mark is still, I believe, unclear, but in the present case it does not arise. At the very minimum, the applicant has to persuade me that the average consumer had in fact come to recognise that the shape of the applicant's helmet is not just 'novel' (meaning different), but also distinctive in a trade mark sense. (see eg *Yakult Honsha's Application* [2001] RPC 39).

23. This is not to say of course that a customer survey based on recognition of the shape is the *only* thing that will persuade the Registry of this point. In such a case as this, one would expect: - background information as to the trade itself, including exactly who the average consumer is, market share held by the applicants, length of time that the mark has been exposed to consumers, precisely how the mark has been exposed (with other indicia, or as a 'naked' shape), whether the applicant has drawn particular attention in advertising to the shape, and most importantly of course, whether the average consumer has been educated to the use of shape as identifying origin. This is not necessarily an exhaustive list, but positive responses on these elements can often persuade the registry that acquired distinctiveness has come about.

24. By way of background to the trade in protective helmets, the applicant says he is the largest manufacturer and exporter of safety helmets in Europe. The market in helmets is supplied by major distributors. Unsurprisingly, it is the construction industry which mostly requires the helmets, of which 70% of firms in the UK employ 10 people or less. According to the attorney, those responsible for selecting helmets tend to be health and safety staff whose buying habits tend to be 'informed' (paras 3 and 4 of the attorney's letter of 12th August 2005).

25. The major distributors in the trade stock helmets from a number of manufacturers – they are not exclusive. The availability of choice has encouraged the applicant to select a family resemblance in the design over the various generations of the product. The availability of choice can be seen in two examples of trade catalogues included in the bundles - the Greenham Catalogue 2003/2004 and the Fisher Safety Catalogue 2003/2004. In the Greenham Catalogues the helmets are referred to as JSP helmets, together with the secondary brand 'Invincible'. The helmet is shown in photographs and attention is drawn to the fact that the helmet can be personalised with either a company name or logo. The Fisher Safety Catalogue clearly shows the different versions of the JSP helmet. In both Catalogues, and unsurprisingly given the prosaic nature of the product, the technical properties of the helmet are amplified. Shape alone is not used in the catalogues as identifying the origin of the product. This fact alone is not decisive of the question of acquired distinctiveness. But, the fact that such reference as is made to the front face plate is in terms of it being used to carry a company's name or logo, leaves one with the impression that the benefit of that plate is seen by the applicants as being of more practical value than as a means of distinguishing the trade source of their goods.

26. The attorney also submits that the existence of alleged imitators of the applicant's helmet is supportive of a claim to 'goodwill' in the product which has arisen over the decades. Several examples of imitators have been supplied. I note in passing in relation to one of the alleged imitators (the Nigerian one), that as with the authentic JSP product (photographed for comparison), the imitators have felt the need to put the

letters 'JSP' boldly on the back of the helmet. The existence of alleged imitators does not in my view make the case for acquired distinctiveness in relation to this shape any more persuasive.

27. There has also been a questionnaire sent to major customers by the applicant. On closer review the questions relate to product characteristics and in no way show that customers make any connection between the shape used and the origin of the product.

28. Case law tells us that the use of other indicia does not of itself condemn applications for registration (see eg *ECJ Case C-353/03 'Have a Break'* [2006] FSR 2). Furthermore, the ECJ recognises that no different or sterner legal test for shapes, as compared with other marks, should be applied, whilst at the same time recognising that consumers do not as a rule see shapes as indicating origin.

29. However, none of the 'evidence' filed in this case directly addresses the question of whether the average consumer sees the shape as denoting origin. This is what I believe to be crucially lacking in this case.

30. When posed the direct question: how does the trade perceive the helmet shape ? The answer from the attorney was as follows: "As I presently understand the situation there is no such evidence yet available as to how the trade perceives the JSP helmet except as a means of distinguishing a JSP helmet from the products of other manufacturers" (para 5 of the attorney's letter of 12th August 2005). Later in that letter in para 8 : "On the basis of the existing evidence I would respectfully suggest that the present device only mark would only convey the message to an end user that the goods bearing this mark are the goods of the applicant JSP. Contrariwise it cannot reasonably be said that the present mark shows an article confusable with the goods of any other manufacturer. It is also observed that none of the other manufacturers of safety helmets have a comparable mark but could doubtless pursue one."

31. These submissions are in my view intended to replace what I have said is crucially lacking in this case – evidence of acquired distinctiveness. The mere fact that the applicant's helmet looks different when placed against competitors does not mean the shape functions as a trade mark. Other factors, which may have made the ground fertile for acquired distinctiveness, such as: the applicant's reliance on a similar design through successive versions, a specialised buying public, a limited number of manufacturers, alleged imitators, are all just that – factors – which go into the multi-factorial assessment, but can in no way substitute for the real thing – does the average consumer regard the shape as indicating origin ? The answer based on the evidence before me in this case is an emphatic no.

Conclusion

32. In this decision I have considered all the documents filed by the applicants and all the arguments submitted to me in relation to this application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Section 3(1)(b) of the Act.

Dated this 23rd day of October 2006

**Edward S Smith
For the Registrar
The Comptroller General**