

TRADE MARKS ACT 1994

IN THE MATTER OF
APPLICATION NO 2133080
BY THE FRESH BREATH COMPANY LIMITED
TO REGISTER A TRADE MARK
IN CLASSES 3 AND 5

DECISION AND GROUNDS OF DECISION

On 16 May 1997, The Fresh Breath Company Limited of Conan Doyle House, 2 Devonshire Place, London, W1N 1PA applied under the Trade Marks Act 1994 to register the trade mark shown at Annex A in Classes 3 and 5. The form of application also indicated that the mark applied for is a 3-dimensional mark.

The goods for which registration is sought are as follows:

- Class 3 Dentifrices; oral hygiene products; preparations for cleaning and for flavouring the mouth, breath, teeth and artificial dentures; non-medicated toilet preparations for the mouth, breath, teeth and artificial dentures; disclosing tablets and liquids; mouth washes, mouth rinses and gargling preparations.
- Class 5 Pharmaceutical and medicinal preparations and substances for the mouth, breath, teeth, artificial dentures, and oral hygiene.

Objection was taken to the application under Sections 3(1)(a) and (b) of the Act because the mark consists exclusively of the shape of a bottle, not capable of distinguishing and being devoid of any distinctive character for e.g. bottles used to store goods.

Prior to the hearing which was held on 26 February 1999 the agent submitted independent evidence in support of the application. This evidence was discussed at a hearing at which the applicants were represented by Mr Eder of E Eder & Co, their trade mark agents. At the hearing the objection under Section 3(1)(a) of the Act was waived but the objection under Section 3(1)(b) of the Act was maintained. Following refusal of the application under Section 37(4) of the Act I am now asked under Section 76 of the Act and Rule 56(2) of the Trade Marks Rules 1994 to state in writing the grounds of my decision and the materials used in arriving at it.

Firstly, I must consider the prima facie case for acceptance.

Section 3(1)(b) of the Act is set out below:

3-(1) The following shall not be registered:

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

The test of distinctiveness was laid down by Mr Justice Jacob in the TREAT case [1996] RPC 281 page 306 lines 2-5 when he said:

“What does *devoid of distinctive character* mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark?”

The Registrar’s practice in relation to shape marks is set out in Chapter 6 of the Registry’s Work Manual at Page 58. The appropriate section is reproduced below:

“The appropriate test for prima facie acceptance will be whether because:

1. The shape in question immediately strikes the eye as different and therefore memorable;

2. and the differences between the applicants’ shape and those used by other traders are arbitrary and not dictated by function or some other non-trade mark purpose;

the public are likely to assume that the goods or services with reference to which the shape is to be used recurrently are those of one and the same undertaking.

Shapes, or elements of shapes, which are likely to be taken by the public as serving:

a) a functional purpose (such as improving the performance of the goods);

b) as a convenience feature (such as convenient storage);

c) a purely decorative or aesthetic purpose (such as novelty shape for goods aimed at children or the attractive shape of an ornament);

- are unlikely to be regarded by the public as identifying the *origin* of the goods, at least until they have been educated to that perception.

Such signs are therefore likely to be open to objection, prima facie, on distinctiveness grounds, whether or not there are additional grounds of refusal under Section 3(2) of the Act.”

At the hearing the agent referred to the objection raised in the examination report and argued that it was invalid because it stated that the grounds of refusal are that the mark is non-distinctive for bottles used to store goods. I accepted that bottles were not contained within the specifications filed but stressed that this was an error and maintained that the

grounds of refusal are that the mark is non-distinctive for the goods claimed. The agent then referred me to the general shape of the bottle and, in particular, to the flange that appears at the top of the neck of the bottle. It was argued that the flange is a memorable element which brought distinctiveness to the overall shape. Containers for the goods contained within the specifications applied for are available in a wide variety of shapes and sizes and I do not accept that the flange feature brings any distinctiveness to the mark. It is clear that the flange, being placed beneath the cap, simply enables the purchaser to hold the container firmly to facilitate the removal of the cap. The overall shape of the bottle narrows above the base to provide a broadly triangular front profile. I see nothing out of the ordinary in this. Whilst it is clear that a combination of non-distinctive elements can create a distinctive whole I do not accept that this is the position with this mark. I do not see that there is anything in the shape of this bottle that would serve to distinguish the goods of the applicant from those of other traders.

In the Proctor & Gamble Limited's application (1996 RPC 281), Walker L J said:

“ Despite the fairly strong language of s. 3(1)(b), “devoid of any distinctive character” - and Mr Morcom emphasised the word “any” - that provision must in my judgment be directed to a visible sign or combination of signs which can by itself readily distinguish one trader's product - in this case an ordinary, inexpensive household product - from that of another competing trader. Product A and Product B may be different in their outward appearance and packaging, but if the differences become apparent only on close examination and comparison, neither can be said to be distinctive”

I have also borne in mind the comments made by Aldous L J in the case of Phillips Electronics N.V. v Remington Consumer Products before the Court of Appeal when he said:

“In fact I am unable to point to any feature or features of the trade mark which could be other than descriptive of a particular design of head for an electric shaver and which would enable the trade mark to acquire a distinctive character. The trade mark contains no feature which has trade mark significance which could become a distinctive character. In my view the judge was right to conclude that the trade mark was not registrable because of section (Article) 3(1)(b) in that it was devoid of distinctive character.”

It is my view that the shape applied for will not be taken as a trade mark without first educating the public that it is a trade mark. It follows that this application is debarred from prima facie acceptance for registration by Section 3(1)(b) of the Act.

However, that is not the end of the matter since I still have to consider the independent evidence filed in support of this application. This “evidence” is in the form of three letters and one Statutory Declaration.

The first letter is from Dr Stemmer who is a practising dentist. Dr Stemmer states that he has been in practice for over 25 years and that he has been actively involved in the importation, and sale, of dental products in the United Kingdom. Dr Stemmer goes on to state that he perceives the shape applied for to be distinctive. He also ventures an opinion on how his

patients would view the shape but he puts forward no evidence to support this and I consider it to be mere speculation. I therefore attach no weight to it.

The second letter is from Mr Chubb who is the managing director of the applicant company. Mr Chubb refers to research carried out prior to commissioning the design of the bottle in order to determine if, inter alia, any bottles of a similar shape existed. He states that they found no examples of any dental product being sold in bottles of such a shape. He then provides examples of quotations made by (unnamed) UK consumers when describing the shape of the bottle which are:

“Unlike any product”

“Very different to any other product”

“Striking and visually distinctive”

However, I have no information as to how these quotations were obtained, nor am I aware of the total number of customers contacted or if any of them provided any quotations which held a contrary view. It is therefore not possible for me to attach much weight to these particular quotations.

The third letter is from Jane Draper who is the managing director of CTS, a company involved in the supply of oral hygiene supplies to the dental profession. Ms Draper states that since 1981 she has never supplied or seen a dental product having the same, or similar, shape as the bottle shape applied for.

The Statutory Declaration is by Fiona Marshall who is a dental receptionist. Part of her duties are to meet sales personnel representing suppliers of dental products. She has studied promotional and medical literature and considers herself to be well versed in such products. She declares that she has never seen any product, dental or otherwise, in a bottle of this, or similar, shape. Attached to her declaration as Exhibit FM1 are copies of pages from the brochures of dental suppliers. For ease of reference I have attached copies of these at Annex B. This exhibit consists of three pages from a brochure produced under the MIDENT label and three pages from a brochure produced by HENRY SCHEIN REXODENT. The pages contain products relating to cross infection control, oral health products, fluoride treatments and mouthwashes. It is clear that none of the containers contained within these pages are the same, or similar, to the mark applied for. However, I have reservations about this evidence. There is no information as to the total number of products on sale throughout the United Kingdom and it is clear that the products represented in these pages are not a representation of all the bottle shapes available for these products. The exhibit does, however, bring another point to mind. The containers and bottles represented in this evidence are of a variety of shapes and it is clear that other shapes exist. Faced with such a variety of shapes it is unlikely that a container shape, unless particularly memorable and distinctive, could serve the purpose of distinguishing goods of one trader from all others.

This evidence and the unsworn letters emanate from people who have extensive knowledge of these products. There is no information as to how these sources were selected, nor is there any indication that these were the only parties approached. It appears that the evidence is from either a supplier of the goods or from parties in the business of dentistry who may well

purchase and use the products sold in this particular bottle. The evidence is from parties who have had considerable exposure to this particular bottle and there is no evidence as to how the general public perceive the mark applied for.

In the case of *Dualit Limited v Rowlett Catering Appliances Limited* in the High Court of Justice Lloyd J said:

“The survey was carried out at three retail premises: Selfridges, Divertimenti and Jerry’s Home Store. 126 people completed the interview. A number of people were filtered out at each of two stages, let alone those not present at the particular premises or not approached. The first filter was to exclude those whose financial means did not seem to be such as to make them likely or probable purchasers of the Applicant’s relatively expensive products. Both this process and the choice of premises are criticised as tending to weight the sample in favour of those more likely to be familiar with and recognise the Applicant’s product. The significance of this is that the Applicant’s product is much more expensive than those of rivals for the domestic market, and therefore it does not by any means necessarily appeal to so wide a section of the market. Nevertheless, in terms of recognition required for the acquisition of distinctive character, it ought to be tested by reference to the market for domestic toasters generally, not just the market for extremely expensive toasters.

So far as I can tell from the survey questionnaire, if it was strictly applied, the filter by reference to available income sources was at a fairly level, and might not have been unfair as between the Applicant’s and the Opponent’s products, or have led to the survey being unrepresentative as regards customers for toasters generally, but the way it is referred to in the survey is that only “AB” respondents were to be proceeded with. The implications of that were not explored fully in the evidence but it does seem to me that the choice of premises may well have been designed to eliminate, and in fact to have eliminated, those not falling within the “AB” categories, in social and economic terms. This is borne out by evidence in Michael Groves’ statutory declaration of 12 February 1998, paragraph 9. I think there is force in the point that in these respects the survey produced a sample which was characteristic of the sector of the market aimed at by the applicant, but not a properly representative sample of the market for domestic toasters generally.”

During the hearing it became clear that the goods are sold to ordinary members of the public through high street stores. There is no evidence that the relevant public would see the mark applied for as a badge of origin for these particular goods, nor is there any evidence that the same public would perceive this particular shape as being so different that it is memorable and therefore distinctive.

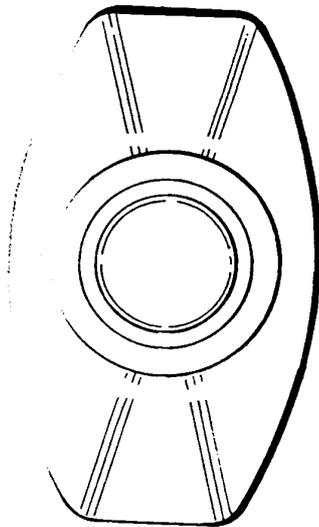
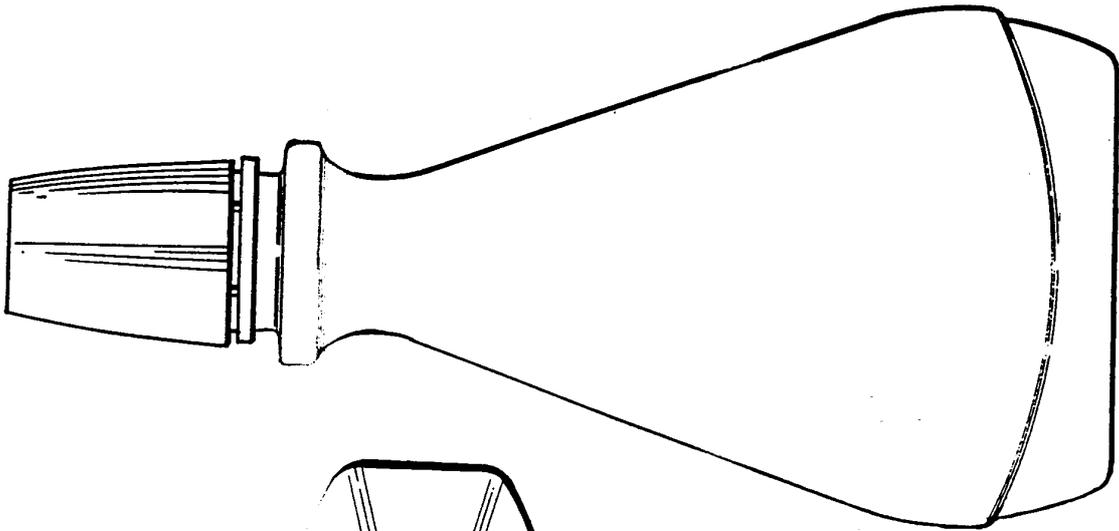
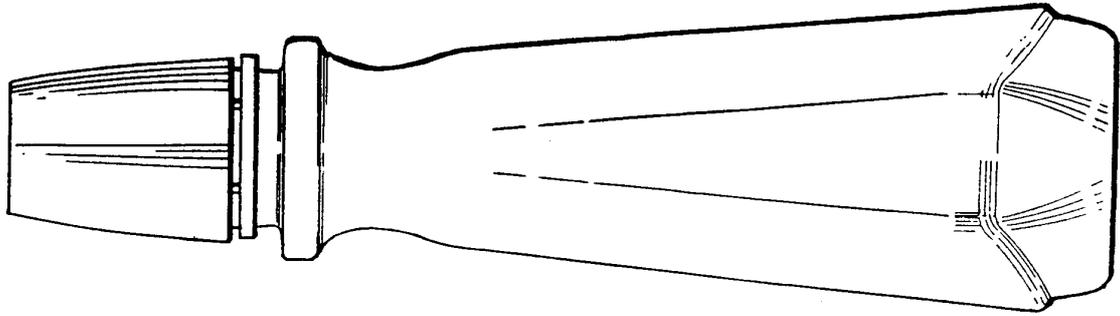
The mark applied for is the 3-dimensional shape of a bottle which, in the prima facie case, lacks any features of trade mark significance. The independent evidence submitted in support of this application does not prove that relevant public regard the mark as distinctive or that it is recognised as a badge of origin for the goods applied for. I do not say the mark is unregistrable but in the absence of evidence that the mark has acquired a distinctive character I do not consider it appropriate to grant a monopoly in this particular shape. I therefore conclude that the sign is debarred from registration by virtue of Section 3(1)(b) of the Act.

In this decision I have considered all the documents filed by the applicant and all the arguments submitted to me in relation to this application and, for the reasons given, 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 15 day of October 1999

A J PIKE
For the Registrar
The Comptroller General

ANNEX A



ANNEX B

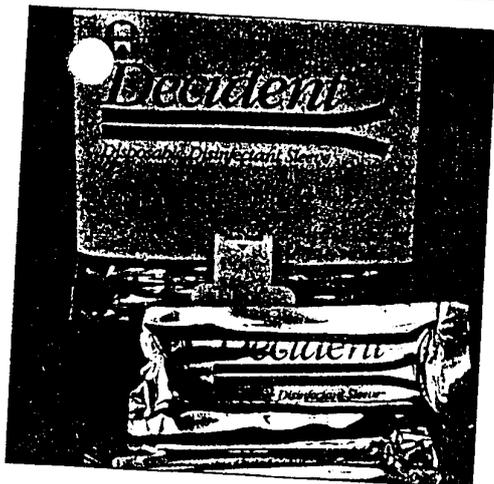
This Exhibit "FM.1" referred to in the Statutory Declaration of FIONA MARSHALL declared before me this 7th day of February 1999.

(Solicitor's Signature) J. C. Dignan

(Print Name): J. C. DIGNAN

(Firm's Stamp):

KENWRIGHT & COX
SOLICITORS
LLOYDS BANK CHAMBERS
45 CRANBROOK ROAD
ILFORD, ESSEX IG1 4PF



DECIDENT

Disposable disinfectant sleeve with a powerful broad spectrum anti-microbial activity provides a High Level of Disinfection for handpieces, curing light wands/tips etc. Tuberculocidal, Bactericidal & Fungicidal.

DCD072	Standard Pack 72 Sleeves	39.95
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TERRALIN

Large surface cleaner/disinfectant. Cleans and disinfects without streaking, no need to rinse. 50ml sachet of concentrated liquid will dilute with tap water at 1% solution to make 5 litres of lightly perfumed disinfectant/cleanser. Effective against Bacteria, Viruses, HIV, HBV and TB. Contains: Mixed phenoxypropanols, Benzalkonium chloride.

SWT002	2ltr Bottle	38.75
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SURFACEWAYS

CHLORHEX SPRAY

Ozone friendly 0.02% Chlorhexidine in 70% alcohol for fast disinfection of all hard surfaces including spitoon bowls, surgery furniture and work tops.

CODE			
CRS500	450ml	450ml	12 Bottles
		2.75	2.29 each

MIKROZID

NEW

NEW Mikrozyd is now Aldehyde FREE. This hard surface disinfection spray is just as effective as the original Mikrozyd but now contains no aldehydes. Offers broad spectrum activity and maintains a low level of contamination on unused surfaces for up to one hour. Contains a new surfactant which enables the active ingredients to achieve high levels of efficacy. Leaves surface's dry and smear free within minutes. Suitable for use on most surfaces (except perspex). Presentation 1ltr Bottle.

CODE			
SAF002	1ltr Bottle		Price
			11.75

ALKASPRAY

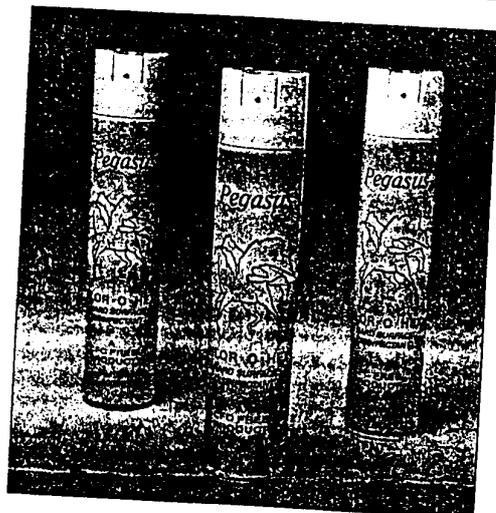
New Alkaspray is a surface disinfectant with a DIFFERENCE. Because of its unique formula it is no longer necessary to clean soiled surfaces before spraying to disinfect. With the launch of new Alkaspray, you can now CLEAN and DISINFECT surfaces in one procedure with ONE product. Alkaspray is very user friendly, contains no phenols or chlorine and is aldehyde free. Ideal for use between patients it leaves surfaces smear free. Effective against bacteria, fungi and viruses including TB, HBV, HIV and rotavirus

CODE			
AKS002	2ltr Bottle	Price	4 Bottles
		19.25	17.33 each
AKS500	500ml Bottle	5.25	4.72 each

DENTIRO SPRAY

Dentiro Spray is a ready to use, fast drying solution for quick disinfection of instruments and surfaces.
EFFECTIVE: Only 1 minute acting time against Hepatitis B and HIV, 5 minute acting time against Bacteria and Fungi. Also Tuberculocidal.
USER FRIENDLY: Aldehyde free and no fumes.
Composition: Ethyl and isopropyl alcohol, quaternary ammonium compound of a new generation and chlorhexidine.

DTS501	500ml Spray Bottle	
DTS500	500ml Refill	11.45
DTS005	5ltr Refill	8.45
DTS001	1ltr Refill Pouch	38.95
		8.45



AGROSEPT WIPES

in and surface disinfectant wipes. Alcohol based with addition of lactic acid to match pH of the skin. Effective in vitro against pathogenic bacteria, fungi and viruses including HIV and HBV. Contains: 2-propanol, 1-propanol, Benzoic acid.

WS090	Tub of 90 Wipes	5.75
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ZOWIPE

owipe bactericidal wipes. 200 pull through wipes, saturated with 70%W solution of isopropyl alcohol.

ODE	Each	Case of 10
T8110	200 Wipes	4.70
		4.23 each



ZOWIPETTES

wipettes 100 pull through bactericidal wipes.

8114	100 Wipes	2.49
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KAWIPE

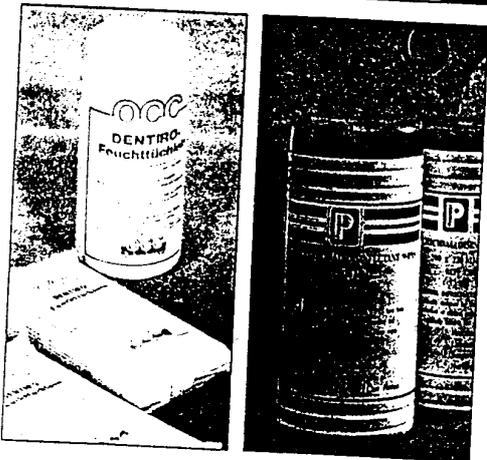
Purpose surface disinfectant and cleanser wipe. Alcohol based wipe designed to clean and protect in one procedure. Effective against bacteria, fungi, viruses, HIV & HBV. Presented in a user tub of 250 wipes

DE	Price
V250	250 Wipes
	5.95

MIER WIPES

urface bactericidal/disinfectant wipes. 160 wipes.

DE	Each	Case 12
00	160 Wipes	3.95
		3.55 each



DENTIRO WIPES

wipes are premoistened with Dentiro liquid for quick disinfection of instruments and surfaces. EFFECTIVE: Only a 1 minute action time against Hepatitis B viruses and HIV, 5 minutes action time against bacteria and fungi. USER FRIENDLY: No fumes or discolouring and aldehyde free. Composition: Ethyl and isopropyl alcohol, new generation quaternary ammonium compound and benzalkonium chloride.

DE	Price
50	Dispensing Tub 150 Wipes
	4.95
20	Refill Sachet 120 Wipes
	3.39

PRIMASEPT MED **NEW**

al skin cleansing lotion

	Bottle 500ml	2.10
	5ltr Bottle	16.45
	Hand Pump	3.50

SEPT MED

Med hand cleanser and disinfectant scrub. Provides effective cleansing and rapid drying of the hands and gloves while still kind to the skin. Effective against bacteria (including Staphylococcus aureus), fungi, HBV, HIV and papova virus. Contains no Chlorhexidine. At a recommended measure of 10ml per hand wash, a bottle of 450ml is equivalent to 150 applications.

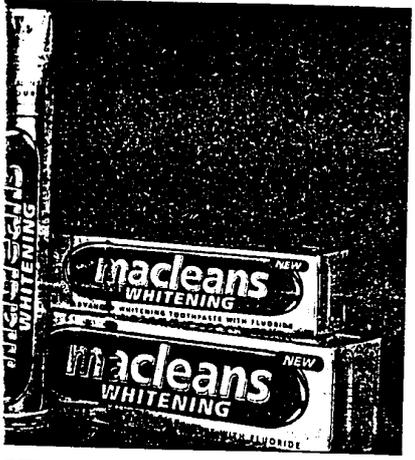
	1 x 450ml Bottle	3.85
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2 ORAL HEALTH PRODUCTS



CORSDYL MOUTHWASH		NEW
CDY300	Mint Flavour Bottle 300ml Case of 12	19.95
CDY600	Mint Flavour Bottle 600ml Case of 6	19.95

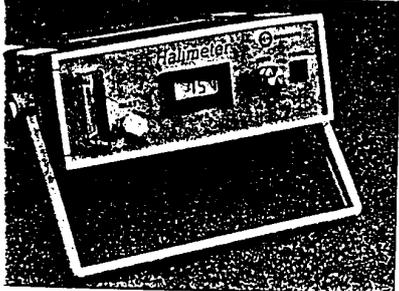


MACLEANS WHITENING TOOTH PASTE		NEW
MWT050	Tube 50ml Case of 24	28.50
MWT100	Tube 100ml Case of 24	44.95

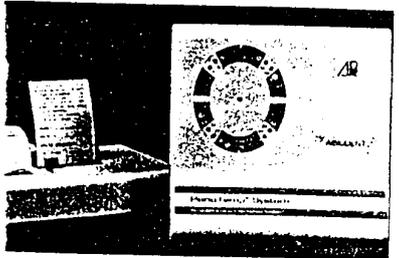
AQUAFRESH WHITENING TOOTH PASTE		NEW
AQW050	Tube 50ml Case of 24	26.50
AQW100	Pump Dispenser 100ml Case of 6	12.60

AQUAFRESH FLOSS		NEW
AQF300	Dispenser 30m Case of 12	8.95

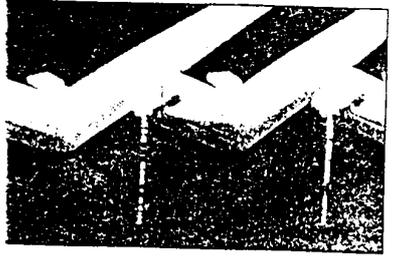
DR MEL'S TONGUE CLEANER		NEW
After exhaustive research, Professor Mel Rosenberg has designed the ultimate tongue cleaner, which is the essential tool required in treating/containing halitosis. Available EXCLUSIVELY from Mident, DR MEL'S tongue cleaner is ergonomically designed & easy to use. Available in various colours, this will compliment your range of oral-hygiene products available to your patients. Individually packed, with instruction leaflet. 12 per pack assorted colours.		
DMT012	Pack of 12	18.00



HALIMETER		NEW
Bad Breath (halitosis) meter, measures volatile sulphur compounds in the breath. These being some of the worst gasses produced by bacteria in the mouth. An essential piece of equipment for the diagnosis, monitoring and treatment of halitosis.		
HLM001		P.O.A.



PERIOTEMP		NEW
The Periotemp has been designed to assist in the early detection and diagnosis of Periodontal disease. The Periotemp automatically charts and measures pocket-depth and associated sub-gingiva temperature, the only detectable and measurable parameters of disease.		
PTM004		P.O.A.



VIVACARE TRUE PRESSURE SENSITIVE PROBE		NEW
The Vivacare True Pressure Sensitive Probe represents a big step forward in periodontal screening, simplifying diagnostic procedures that are gaining increasing importance in the surgery. Thanks to a unique spring mechanism, special markings on the handle and disposable probe head line up when 20gm pressure is applied, enabling you to probe periodontal pockets safely and with total accuracy. Trial Pack.		
IPP9300	10 Assorted Probe Heads and 1 Handle (WHILE STOCKS LAST)	12.95
Tactile Sensor (Rigid Metal)		
IPP1011	10 Probe Heads and 1 Handle	9.25
IPP9001	50 Probe Heads and 5 Handles	35.95
Screening Surveyor (Flexible Plastic)		
IPP1013	10 Probe Heads and 1 Handle	9.25
IPP9003	50 Probe Heads and 5 Handles	26.95
Universal Explorer (Flexible Plastic)		
IPP1012	10 Probe Heads and 1 Handle	9.25
IPP9002	50 Probe Heads and 5 Handles	26.95

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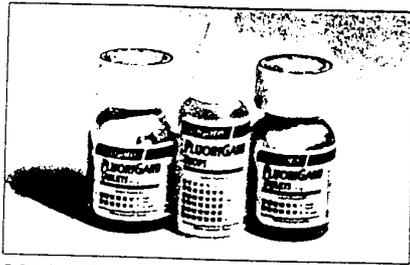
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FLUORIDE TREATMENTS 16.2

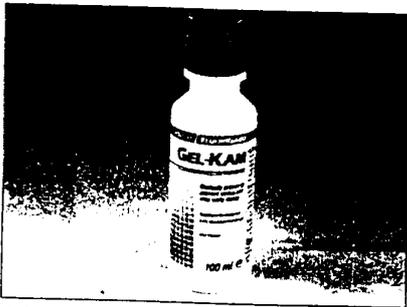


COLGATE Fluoridant
 610 12 Drops 30ml x 1218.60
 610 113 0.5mg tablets x 200 22.80
 610 115 1.0mg tablets x 200 22.80

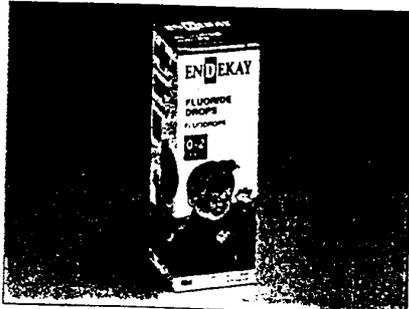


Fluoridant Daily Rinse 0.05%
 610 131 500ml x 12 32.40

Weekly Rinse 0.2%
 610 14 150ml x 12 23.88



Gel-Kam
 Mint flavoured 0.4% Stannous fluoride BP in glycerine base
 610 522 100ml 2.65



En-De-Kay Fluoridrops 60ml x 6
 611 015 8.75

Daily Fluoride Rinse
 Mint 0.05% Sodium Fluoride 250ml x 12
 611 019 16.99



Omni-Gel
 0.4% Stannous Fluoride gel

Unflavoured
 610 551 2.3oz 2.40
 610 561 7oz 4.99

Mint
 610 552 2.3oz 2.40
 610 562 7oz 4.99

Lemon & Lime
 610 553 2.3 oz 2.40
 610 563 7oz 4.99

Raspberry
 610 554 2.3oz 2.40
 610 564 7oz 4.99

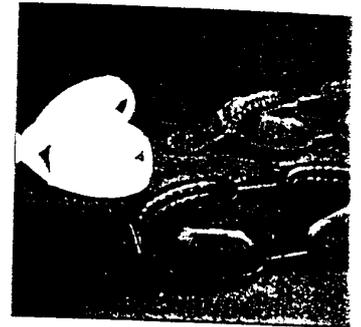
APPLICATOR TRAYS



HENRY SCHEIN Foam Trays
 611 401 Small x 100 9.95
 611 402 Medium x 100 9.95
 611 403 Large x 100 9.95
 611 404 Assorted x 100 9.95

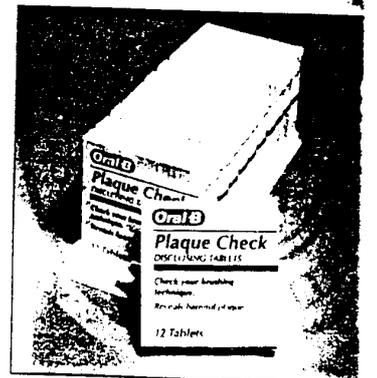
ORAL-B Centrays
 612 021 Small x 100 22.75
 612 022 Medium x 100 22.75
 612 023 Large x 100 22.75

Intropack Centrays
 30 x Small, 40 x Medium+ 30 x Large
 612 024 22.75



HENRY SCHEIN Double Trays
 611 290 Small x 30
 611 291 Small x 100
 611 292 Medium x 30
 611 293 Medium x 100
 611 294 Large x 30
 611 295 Large x 100

DISCLOSING MATERIALS

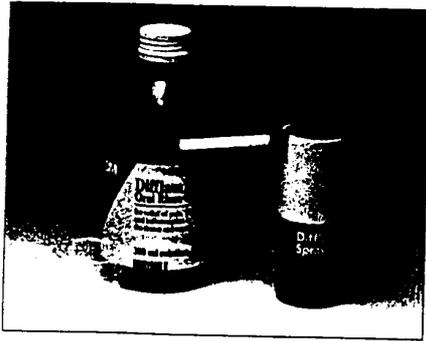


ORAL-B Disclosing Tablets
 613 515 Plaque Check 12 x 12
 613 52 Surgery pack 100 x 4 tablets
 613 53 Bulk pack 1000 tablets



Plaque Test 10ml Disclosing Solution
 Fluorescent plaque disclosing liquid, w only under curing light
 613 510

MOUTHWASHES 16.4



3M Diffiam
 637 206 30ml Spray 4.55
 637 204 300ml Rinse 5.35

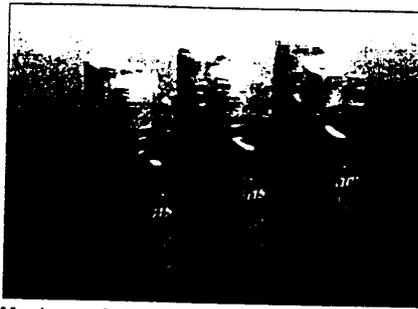


3M Breathe Rite
 505 550 Small x 10 4.20
 505 551 Medium/Large x 10 4.20



Eludril Mouthwash
 Eludril Mouthwash and Spray contains Chlorhexidine which has been tested and proven to be an effective agent against bacterial plaque. Eludril mouthwash contains Chlorbutol, an analgesic for pain relief. Anti-fungal properties are active against Candida Albicans & the mouthwash is anti-inflammatory for long periods of time.

637 2 90ml 1.75
 637 201 250ml 3.55
 637 202 500ml 6.25
 637 205 Spray 55ml 3.25



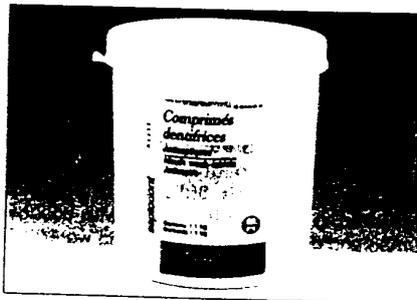
Macleans Active Mouth Guard
 630 825 300ml x 6 7.50
 630 826 600ml x 6 12.50
 630 827 Mint 300ml x 6 7.50
 630 828 Mint 600ml x 6 12.50
 630 829 Junior 300ml x 6 7.50



Minamint Mouthwash Concentrate
 90ml Mint flavoured (1100 doses)
 507 011 11.75



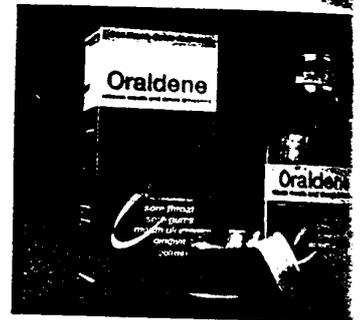
HENRY SCHEIN REXODENT
Mouthwash Tablets
Thymol
 507 0 1 x 1000 5.99
 6 x 1000 31.50
Spearmint Green
 507 001 1 x 1000 5.99
 6 x 1000 31.50



Septodont Mouthwash Tablets
 507 01 1 kilo 22.95



SS WHITE Mouthwash Tablets
 507 040 Thymol x 1000
 507 045 Lime x 1500



Oraldene Antiseptic Mouthwash
 ■ Contains antimicrobial Hexetidine
 ■ Indicated for mouth infections: Mouth ulcers, Sore throat, Gingivitis, Periodontitis, Oral Thrush.
 ■ Non teeth staining
 ■ Palatable

630 820 200 ml x 12



Listerine
 ■ Twice daily rinsing after brushing reduces plaque build up more than brushing
 ■ No demonstrable adverse effect on oral ecology
 ■ Freshens breath, enhances patient compliance
 ■ Original and Coolmint flavours

630 800 500ml x 6
 630 801 200ml x 6
Listerine Coolmint
 630 804 200ml x 6
 630 806 500ml x 6