

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No. 2000360

IN THE NAME OF MAASLAND NV

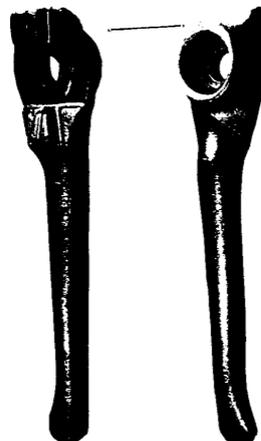
TO REGISTER A THREE-DIMENSIONAL TRADE MARK

IN CLASS 7

DECISION

On 7th January 1999 Mr. Allan James, Principal Hearing Officer, issued a decision on behalf of the Registrar of Trade Marks rejecting an application by Maasland NV (“the Applicant”) to register the shape of a tine for use as a trade mark in relation to “machines and implements included in Class 7, all for use in agriculture and horticulture and parts and fittings included in Class 7 for all the aforesaid goods”.

The shape was represented photographically in the application for registration in the following manner:



The Trade Marks Registry initially raised objections to registration under Sections 3(1)(a), 3(1)(b) and 3(1)(c) of the Trade Marks Act 1994. Evidence was then filed on behalf of the Applicant with a view to demonstrating that the shape in question possessed a distinctive character developed or acquired through use prior to the date of the application for registration (31st October 1994). However, the Registry maintained its objections and raised further objections to registration under Sections 3(2)(a), 3(2)(b) and 3(2)(c) of the 1994 Act.

A hearing was appointed to enable the Applicant to make representations in support of its application. This took place on 5th May 1998. The Applicant filed further evidence, before and after the hearing, in an attempt to persuade the Principal Hearing Officer that the shape of the tine put forward for registration was properly registrable under the 1994 Act. Registration was nevertheless refused under Sections 3(1)(a), 3(1)(b), 3(2)(b) and 3(2)(c) of the Act.

It was contended on behalf of the Applicant that the configuration of the bulbous end of the tine and, to a lesser extent, the configuration of the fixing end imparted a distinctive character to the shape of the tine as a whole. The Principal Hearing Officer disagreed. He considered that neither of the features identified by the Applicant was “unnecessary for the achievement of a technical result” and that the degree of arbitrariness involved in the design of those features did not rise above the level of trivial embellishment. He noted that the Applicant had educated the public to believe that the

fixing end of the tine enabled quick and easy fixing to the associated harrow and that the bulbousness of the bulbous end prolonged the working life of the tine. He envisaged that the relevant public would regard the shape as one of good engineering function. For these reasons he concluded that the shape of the tine was caught by the exclusions from registration contained in Sections 3(2)(b) and 3(2)(c) of the 1994 Act.

Although the Principal Hearing Officer was prepared to accept that the evidence before him showed that there was a significant degree of recognition of the shape of the Applicant's tine, he was not prepared to accept that it showed a significant degree of recognition of the shape of the Applicant's tine *as a trade mark*. He took the view that the shape of the tine primarily indicated to the eye of the observer that the implement was "an agricultural tine with two new features which will make it easier to fit and prolong its working life". He concluded that the shape was incapable of distinguishing the specified goods of the Applicant from those of other suppliers and was therefore caught by the exclusion from registration contained in Section 3(1)(a) of the Act. Further and in any event he considered that the shape did not possess a distinctive character (either at the outset or through use) and was therefore caught by the exclusion from registration contained in Section 3(1)(b) of the Act.

The Applicant gave notice of appeal to an Appointed Person under Section 76 of the 1994 Act. The appeal was listed for hearing before me on Monday 19th July 1999. On Wednesday 14th July 1999 the Applicant gave notice: (i) that it intended to apply for the hearing of its appeal to be adjourned until after the European Court of Justice had ruled on the questions referred to it by the Court of Appeal under Article 234 (ex 177) of

the EC Treaty in the case of Philips Electronics NV v. Remington Consumer Products Ltd [1999] ETMR 816; (ii) that if the adjournment was not granted, it would seek a reference to the European Court of Justice concerning the interpretation of the provisions of Community law implemented in Section 3(2)(b) of the Trade Marks Act 1994; and (iii) that if no order for reference was made, it would seek an order under Section 76(3) of the Act enabling it to bring its appeal before the High Court.

On Friday 16th July 1999 the Registrar gave notice indicating that the objection under Section 3(2)(c) of the Act would not be maintained in the light of the judgment delivered by Aldous L.J. in the Philips Electronics case and proposing: (i) that the appeal should only be adjourned pending the outcome of the order for reference in Philips Electronics if it appeared to the Appointed Person that the shape put forward for registration was free of objection under Section 3(1)(b) of the Act; (ii) that an order for reference to the European Court of Justice concerning the interpretation of Section 3(2)(b) of the Act should in any event be refused on the basis that it would unnecessarily duplicate the order for reference made by the Court of Appeal in Philips Electronics; and (iii) that refusal of an order for reference to the European Court of Justice should not be regarded as a reason for referring the present appeal to the High Court because the High Court would, in current circumstances, be in no better position than the Appointed Person to resolve issues of interpretation arising in relation to Section 3(2)(b) of the Act.

The Applicant and the Registrar were informed at the end of the afternoon on Friday 16th July 1999 that I wished to hear argument as to the extent to which the outcome of the present appeal actually depended on the outcome of the order for

reference in Philips Electronics and that the question whether an adjournment of the appeal was necessary or appropriate would be considered at the hearing on Monday 19th July 1999.

At the hearing on Monday 19th July 1999 the Applicant sought an adjournment as previously notified. Counsel for the Applicant submitted that this was the most appropriate way of proceeding on the basis that the present appeal ought not to be determined without the guidance that would in due course be provided by the European Court of Justice in response to the questions which had been referred to it by the Court of Appeal in Philips Electronics. Judgment was given on an interim basis in Philips Electronics on 5th May 1999. Thereafter the parties to that appeal proceeded to make submissions in writing relating to the questions to be referred to the European Court of Justice. I understand that the questions were then finalised by the Court of Appeal and handed down on 16th June 1999. The order for reference was entered on 24th June 1999. It requests a preliminary ruling upon the following questions concerning the interpretation of Council Directive No. 89/104/EEC of 21st December 1988 to approximate the laws of the Member States relating to trade marks:

“1. Is there a category of marks which is not excluded from registration by Articles 3(1)(b)-(d) and Article 3(3) of the Council Directive 89/104/EEC (“the Directive”), which is nonetheless excluded from registration by Article 3(1)(a) of the Directive (as being incapable of distinguishing the goods of the proprietor from those other undertakings)?

2. Is the shape (or part of the shape) of an article (being the article in respect of which the sign is registered) only capable of distinguishing for the purposes of Article 2 if it contains some capricious addition (being an embellishment which has no functional purpose) to the shape of the article?

3. Where a trader has been the only supplier of particular goods to the market, is extensive use of a sign, which consists of the shape (or part of the shape) of those goods and which does not include any capricious addition, sufficient to give the sign a distinctive character for the purposes of Article 3(3) in circumstances where as a result of that use a substantial proportion of the relevant trade and public (i) associate the shape with that trader and no other undertaking; (ii) believe that goods of that shape come from that trader absent a statement to the contrary?
4. (i) Can the restriction imposed by the words “if it consists exclusively of the shape of goods which is necessary to achieve a technical result” appearing in Article 3(1)(e)(ii) be overcome by establishing that there are other shapes which can obtain the same technical result or
- (ii) is the shape unregistrable by virtue thereof if it is shown that the essential features of the shape are attributable only to the technical result or
- (iii) is some other and, if so, what test appropriate for determining whether the restriction applies?
5. Article 3(1)(c) of the Directive applies to “trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose ... of the goods or service”. Article 6(1)(b) of the Directive applies to the use by a third party of “indications concerning the kind, quality, quantity, intended purpose ... of goods or services”. The word “exclusively” thus appears in Article 3(1)(c) and is omitted in Article 6(1)(b) of the Directive. On a proper interpretation of the Directive, does this omission mean that, even if a mark consisting of the shape of goods is validly registered, it is not infringed by virtue of Article 6(1)(b) in circumstances where
- (i) the use of the shape of goods complained of is and would be taken as an indication as to the kind of goods or the intended purpose thereof and
- (ii) a substantial proportion of the relevant trade and public believe that goods of that shape come from the trade mark proprietor, absent a statement to the contrary?
6. Does the exclusive right granted by Article 5(1) extend to enable the proprietor to prevent third parties using identical or similar signs in circumstances where that use was not such as to indicate origin or is it limited so as to

prevent only use which wholly or in part does indicate origin?

7. Is use of an allegedly infringing shape of goods, which is and would be seen as an indication as to the kind of goods or the intended purpose thereof, nonetheless such as to indicate origin if a substantial proportion of the relevant trade and public believe that goods of the shape complained of come from the trade mark proprietor absent a statement to the contrary?"

Counsel for the Applicant submitted that the guidance provided by the answers to questions 2, 3, 4 and 6 would be likely to have a material effect on the determination of the present appeal.

Having heard argument for and against the application for an adjournment of the present appeal I decided that the Registrar's objections under Section 3(1) of the 1994 Act should be considered at a substantive hearing. At that hearing it would be assumed, but not decided, that the shape in question was not excluded from registration by Section 3(2) of the Act. If the shape was found to be excluded from registration by Section 3(1) of the Act, that would be the end of the matter. If the shape was found to be free of objection under Section 3(1) of the Act, the hearing to determine the objection under Section 3(2) of the Act would be adjourned to await the outcome of the reference to the European Court of Justice in Philips Electronics. The objection under Section 3(2) was thus deferred pending determination of the objections under Section 3(1). This generally accorded with the approach adopted by Lloyd J. in the Dualit Ltd's Application 5th July 1999 (see especially paragraph 54 of the Judgment). I expressed the view that there was sufficient guidance in Community and domestic case law to enable the validity of the objections under Section 3(1) to be determined independently of the objection under Section 3(2).

After I had given my decision on the application for a general adjournment, the Applicant applied for a short adjournment (in the region of 14 days) within which to formulate questions with a view to seeking a reference to the European Court of Justice in the context of the present appeal. That application was considered at some length. In the end it was not pursued on the basis that the Applicant reserved the right to make further submissions on the subject of a reference to the European Court of Justice in due course.

The substantive hearing of the appeal in relation to the objections under Section 3(1) of the Act was then adjourned to a date to be fixed on the basis that the Applicant would in the meantime provide certain additional information relating to its evidence in support of the application for registration as specified by me pursuant to Rules 51 and 59(2) of the Trade Marks Rules 1994.

At the resumed hearing of the appeal on 23rd September 1999 the Applicant indicated that it would not seek a reference to the European Court of Justice if all matters supportive of the deferred objection under Section 3(2) of the Act were excluded from consideration in relation to the objections under Section 3(1) of the Act, but would press for a reference if no such exclusion was applied. The Registrar was not prepared to accept that any such exclusion should be applied. I indicated that a request for a preliminary ruling from the European Court of Justice would be overtaken by events if the appeal proceeded to a decision in which the suggested exclusion was rejected and the Registrar's objections to registration under Section 3(1) of the Act were upheld. Counsel for the Applicant then pressed for certain questions to be referred to the European Court of Justice and for the further consideration of the appeal to be adjourned pending the outcome of the proposed reference. As formulated and refined by the Appellant in the

light of the exchanges which took place at the hearing, the questions to be referred to the European Court of Justice for a preliminary ruling would be as follows:

“1. (a) To what extent can considerations relating to functionality or technical result be raised, and properly considered, in the context of arguments under Section 3(1) of the Trade Marks Act 1994 on the issue of whether a trade mark or sign is capable of distinguishing and/or devoid of distinctive character?

(b) If and insofar as the answer to question 1(a) is in the affirmative, how and in what circumstances are such considerations relevant to the said issue?

2. (a) To what extent (if any) does possession of a distinctive character by a trade mark or sign defeat any grounds of objection in relation to functionality or technical result?

(b) If and insofar as the answer to 2(a) is in the affirmative, how and in what circumstances does such possession of a distinctive character defeat such objection?”

The application for a reference was opposed by the Registrar on the basis that the answers to Questions 1 (a) and 1 (b) were readily apparent without the need for a reference; even if (which was disputed) Questions 2(a) and 2(b) raised seriously arguable issues as to the operation of Section 3(2) of the Act, they were questions which could have no decisive effect on the present appeal unless and until the application for registration was found to be unobjectionable under Section 3(1) of the Act; and Questions 2(a) and 2(b) would in the meantime be premature.

The European Court of Justice has jurisdiction under Article 234 of the EC Treaty to give “*preliminary rulings*” concerning the interpretation of Community law at the request of any court or tribunal of a Member State. A court or tribunal may request a preliminary ruling from the European Court of Justice when it considers that a decision

on a question of Community law is “*necessary to enable it to give judgment*” . If, however, it is not a court or tribunal “*against whose decisions there is no judicial remedy under national law*”, it may if it thinks fit decide the question and give judgment without requesting a preliminary ruling. The obligation to request a preliminary ruling under Article 234 applies to courts and tribunals of last resort; it does not apply to courts and tribunals whose decisions are challengeable (whether by way of appeal or judicial review) for failure to give substantive effect to Community law: Chiron Corporation v. Murex Diagnostics Ltd (No. 8) [1995] FSR 309 (CA); Anderson References to the European Court of Justice (1995) paras. 6-005 et seq.

The Appointed Person acts as an appeal tribunal with jurisdiction to hear and determine appeals from decisions of the Registrar under the Trade Marks Act 1994. Section 76(4) of the Act provides that decisions of the Appointed Person “*shall be final*”. However, it is generally understood that proceedings for judicial review may be brought in respect of such decisions in appropriate circumstances. On the assumption that this is correct and on the further assumption that such proceedings may be brought in circumstances where there has been a failure to give substantive effect to Community law, I consider that the Appointed Person is not an appeal tribunal of last resort for the purposes of Article 234.

In my view, the Appointed Person may (but need not) request a preliminary ruling from the European Court of Justice on a question of Community law if he considers that a decision on the question is necessary to enable him to give judgment in a particular case. Any such reference would need to accord with the guidance provided by the text and

Schedule B of the Practice Direction (ECJ References: Procedure) [1999] 1 WLR 260.

When considering whether to request a preliminary ruling from the European Court of Justice, the Appointed Person must bear in mind that Section 76(3) of the 1994 Act and Rule 57 of the Trade Marks rules 1994 enable him to refer appeals to the High Court in cases where it appears to him that a point of general legal importance is involved. I would expect an appeal to the Appointed Person which could not sensibly be determined without a request for a preliminary ruling from the European Court of Justice to involve a point of general legal importance. The referral of such an appeal to the High Court under Section 76(3) of the Act would enable the parties to obtain a ruling on the question of a reference to the European Court of Justice from a higher tribunal whose decision would not be subject to the restriction imposed by Section 76(4) of the Act.

On that basis I turn to consider whether, in order to determine whether the shape put forward for registration in the present case is registrable in accordance with the provisions of Council Directive No. 89/104/EEC of 21st December 1988, it is necessary and, if so, appropriate for this tribunal to seek guidance from the European Court of Justice in relation to the points identified in the questions raised by the Applicant.

The following matters appear to me to be clear in the present state of the law:

1. Section 1(1) of the Act (Article 2 of the Directive) confirms that the “*shape of goods or their container*” can constitute a “*sign*” susceptible of registration as a “*trade mark*”.

2. However, the registration of signs which consist “*exclusively*” of “*the shape which results from the nature of the goods themselves*” or “*the shape of goods which is necessary to obtain a technical result*” or “*the shape which gives substantial value to the goods*” is prevented by Section 3(2) of the Act (Article 3(1)(e) of the Directive).

3. Further, in order to be free of objection under Sections 3(1)(a) to (d) of the Act (Articles 3(1)(a) to (d) of the Directive) a sign must possess “*a distinctive character*”. The four paragraphs of Sections 3(1)(a) to (d) of the Act (Articles 3(1)(a) to (d) of the Directive) are not mutually exclusive in this respect; and the proviso to Section 3(1) of the Act (Article 3(3) of the Directive) is applicable only to signs which are “capable” of affording the required distinction because there is no point in considering whether a sign which is not capable of affording the required distinction has come to do so through use: Bach Flower Remedies Trade Marks (Morritt, Thorpe and Chadwick L.JJ) 21st October 1999, see in particular paragraph 33 of the judgment of Morritt LJ. A sign cannot be free of objection under all four paragraphs if it does not possess enough of “*a distinctive character*” to be perceived as an indication of trade origin by “*the relevant class of persons or at least a significant proportion thereof*”: paragraphs 44, 46 and 52 of the Judgment of the European Court of Justice in Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee Produktions-und Vertriebs v. Boots-und Segelzubehör Walter Huber and Franz Attenberger [1999] ETMR 585.

4. Paragraph 29 of the Judgment in the Windsurfing case confirms that the “*relevant class of persons*” consists of “*the trade and ... average consumers of that*”

category of goods in the territory in respect of which registration is applied for”.

The “*average consumer* of the products concerned is to be regarded as “*reasonably well-informed and reasonably observant and circumspect*”: Case C-342/97 Lloyd Schuhfabrik Meyer GmbH v. Klijsen Handel BV [1999] ETMR 690 paragraph 26; Bach Flower Remedies Trade Marks (Morritt, Thorpe and Chadwick L.JJ) 21st October 1999. The part played by the hypothetical average consumer in the more recent case law of the European Court of Justice is examined in the Opinion delivered by Advocate General Fennelly in Case C-220/98 Estée Lauder Cosmetics GmbH & Co. v. Lancaster Group GmbH (16th September 1999). Procter & Gamble Company’s Application (‘Complete’) [1999] ETMR 664 at 668 is an example of a sign being assessed for registrability by the Third Board of Appeals of the Community Trade Marks Office with reference to the perceptions of the hypothetical average consumer of the relevant goods.

5. A sign possesses enough of “*a distinctive character*” to be registrable as a trade mark if goods identified by it would for that reason be thought by “*the relevant class of persons or at least a significant proportion thereof*” to have come (directly or indirectly) from one and the same undertaking as envisaged by the Judgment of the European Court of Justice in Case C-39/97 Canon Kubushiki Kaisha v. Metro-Goldwyn Mayer Inc. [1999] ETMR 1:

“27. Indeed, Article 2 of the Directive provides that a trade mark must be capable of distinguishing the goods or services of one undertaking from those of other undertakings, while the tenth recital in the preamble to the Directive states that the function of the protection conferred by the mark is primarily to guarantee the indication of origin.

28. Moreover, according to the settled case-law of the Court, the essential function of the trade mark is to guarantee the identity of the origin of the marked product to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin. For the trade mark to be able to fulfil its essential role in the system of undistorted competition which the Treaty seeks to establish, it must offer a guarantee that all the goods or services bearing it have originated under the control of a single undertaking which is responsible for their quality (see, in particular, Case C-10/89 HAG GF (HAG II) [1990] ECR I-3711, paragraphs 14 and 13).

A sign which cannot (yet) be expected to perform that “*essential function*” to the required extent is liable to be excluded from registration by one or more of the provisions of Sections 3(1)(a) to (d) of the Act (Articles 3(1)(a) to (d) of the Directive): Bach Flower Remedies Trade Marks (Morritt, Thorpe and Chadwick L.JJ) 21st October 1999.

29. Paragraphs 51 and 52 of the Judgment of the European Court of Justice in the Windsurfing case provide guidance as to the matters to be taken into account when assessing whether a sign possesses the distinctive character which is “*a pre-requisite for its registration*” (paragraph 44) and “*one of the general conditions for registering a trade mark*” (paragraph 46):

“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.”

30. These observations were re-affirmed (with the addition of the words underlined below) in paragraphs 22 and 23 of the Judgment of the European Court of Justice in the Lloyd Schuhfabrik case:

“22. In determining the distinctive character of a mark ... the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v. Huber and Attenbereg* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; 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 section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other professional associations (see *Windsurfing Chiemsee*, paragraph 51)”.

It would not be right, in the light of the words I have underlined, to overlook or ignore the presence of functional or technical features in a three-dimensional shape when assessing whether the shape in question possesses enough of “*a distinctive character*” to be registrable as a trade mark. Such features “*may serve, in trade, to designate the kind, quality ... intended purpose ... or other characteristics*” of the relevant goods to an extent that renders the shape as a whole unregistrable under one or more of the provisions of Section 3(1)(a) to (d) of the Act (Articles 3(1)(a) to (d) of the Directive).

24. Paragraph 11 of the Judgment in the Lloyd Schuhfabrik case confirms that it is for the national court to determine whether any given sign can in fact be said to possess enough of a distinctive character to be registrable. This accords with the established position that the European Court of Justice generally has no jurisdiction under Article 234 to apply Community law to the facts of a specific case: Case C-98/94 Schmidt v. Rijksdienst Voor Pensioenen [1995] ECR I-2559 para. 22.

25. In Bach Flower Remedies Trade Marks the Court of Appeal confirmed that the meaning and significance of a sign may depend on the manner in which it has been used; that it is “*permissible and necessary*” to determine the meaning and significance a sign would possess when used at the date upon which it is put forward for registration; that use of a sign does not of itself prove that the sign is distinctive; that increased use does not of itself do so either; and that use and

increased use must be in a distinctive sense in order to have any materiality: see, in particular, paragraph 31-35 and 49 of the judgment of Morritt L.J.

26. The outcome of an application to register a three-dimensional shape which: (i) possesses enough of “*distinctive character*” to be free of objection under Sections 3(1)(a) to (d) of the Act (Articles 3(1)(a) to (d) of the Directive); but (ii) “*consists*” of “*the shape which results from the nature of the goods themselves*” or “*the shape of goods which is necessary to obtain a technical result*” or “*the shape which give substantial value to the goods*”; necessarily depends upon the meaning and effect of the word “*exclusively*” as used in Section 3(2) of the Act (Article 3(1)(e) of the Directive). The guidance of the European Court of Justice would be required in order to ensure that the provisions of Section 3(2) of the Act (Article 3(1)(e) of the Directive) were correctly applied in a case of that kind. It seems likely that the required guidance will be provided by the answers to the questions referred to the European Court of Justice by the Court of Appeal in Philips Electronics. In the meantime there would seem to be no inevitable bar to considering, in accordance with the guidance provided by the case law noted above, whether objections to the registration of three-dimensional shapes are well-founded for lack of a distinctive character, intrinsic or acquired through use: c.f. Dualit Ltd’s Application 5th July 1999 (Lloyd J); Procter & Gamble Plc v. Registrar of Trade Marks [1999] ETMR 375 (CA).

27. Under Section 40(3) of the Act the rights conferred by registration of a trade mark date back to the date of the application for registration. In the interests of legal certainty it is desirable that valid applications for registration should succeed and

valid objections to registration should be upheld without avoidable delay. If a three-dimensional shape is unregistrable under one or more of the provisions of Sections 3(1)(a) to (d) of the Act (Articles 3(1)(a) to (d) of the Directive), no useful purpose would be served by waiting for the outcome of the reference to the European Court of Justice in Philips Electronics in order to determine whether it is also unregistrable under Section 3(2) of the Act (Article 3(1)(e) of the Directive).

It appears to me that the propositions noted in points 1 to 9 above answer the questions raised by the Applicant to the extent necessary to enable the Registrar's objections under Section 3(1) of the Act to be determined substantively in accordance with Community law. I recognise that it would be necessary in the present case to have guidance from the European Court of Justice in order to determine the Registrar's objection under Section 3(2) of the Act substantively in accordance with Community law. However, I do not think it should be assumed that the fate of the present application for registration necessarily depends on the meaning and effect of Section 3(2), either as to the implications of the word "*exclusively*" in a case of the kind identified in point 10 above or at all.

It will only be necessary to consider the objection under Section 3(2) if the shape put forward for registration is free of objection under Section 3(1). The application for registration has been pending since 31st October 1994. For the reasons indicated in point 11 above, I think it is undesirable to let the Registrar's objections under Section 3(1) of the Act remain unresolved for as long as it may take to obtain authoritative guidance from the European Court of Justice in relation to the provisions of Section 3(2) of the Act. In my view the objections under Section 3(1) should be dealt with, consideration of the

objection that might or might not need to be resolved under Section 3(2) should in the meantime be deferred and the necessity (if any) for a reference to the European Court of Justice in relation to the provisions of Section 3(2) of the Act should be assessed in the circumstances prevailing if and when the shape in question is found to be free of objection under Section 3(1) of the Act.

As matters stand, following the decision and directions I gave on 19th July 1999, I consider that a request for a preliminary ruling from the European Court of Justice in respect of the questions raised by the Applicant is not necessary (and may never become necessary) and would undesirably increase the risk of avoidable delay in the determination of the present application for registration. However, I am aware that the correctness of my approach is a matter of concern to the Applicant and the Registrar: the former being concerned to test the validity of my conclusion that the Registrar's objections under Section 3(1) can and should be determined independently of the objection under Section 3(2) without seeking a preliminary ruling from the European Court of Justice; the latter being concerned to know whether the approach I have adopted can properly be adopted in relation to other applications for the registration of three-dimensional shapes awaiting determination in the Trade Marks Registry.

The approach to be adopted by the Registrar generally in relation to applications to register three-dimensional shapes appears to me to involve a point of general legal importance. In that state of affairs I think that the right course will be for me to direct that the Applicant's appeal from the decision issued on behalf of the Registrar of Trade Marks on 7th January 1999 be referred to the Court under Section 76(3) of the Act so that the Applicant and the Registrar can have the opportunity, free of the limiting effects of

Section 76(4) of the Act, to persuade a higher tribunal as to the correctness or otherwise of the views I have expressed. It is conceded by the Applicant and the Registrar that the requirements of Rule 58 of the 1994 Rules can be taken to have been complied with. My direction under Section 76(3) is given on that basis. As agreed at the hearing, there will be no order as to costs in respect of the proceedings before me.

Geoffrey Hobbs Q.C.

12th November 1999

Denise McFarland instructed by Messrs. Heseltine Lake Trademarks and Messrs Taylor Joynson Garrett, Solicitors, appeared as Counsel on behalf of the Applicant.

Allan James, Principal Hearing Officer, appeared on behalf of the Registrar of Trade Marks.