

TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION No. 3568493
IN THE NAME OF HUSQVARNA AKTIEBOLAG

DECISION

1. This is an appeal from the decision of the Hearing Officer, Dafydd Collins, dated 6 January 2002 (“the Decision”), whereby he refused to allow Trade Mark Application No 3568493 to proceed to grant on the basis that it did not satisfy s.3(1)(b) of the Trade Marks Act 1994, and was devoid of any distinctive character. It raises once again the knotty issue of what is the threshold for determining the inherent distinctiveness of three dimensional shape marks.
2. The application is a three-dimensional mark, as follows:



3. The Applicant, Husqvarna Aktiebolag, has sought to register it in Class 7, for *Lawnmowers [machines]; Robotic lawnmowers.*
4. On this appeal the Applicant was represented by Beth Collett of Counsel, instructed by Sipara Limited. The Registrar was also represented, by Stuart Baran of Counsel.

5. I was assisted in my deliberations by the provision of detailed skeleton arguments and oral submissions from both the Applicant and the Registrar, for which I am most grateful.

APPROACH TO THE APPEAL

6. There was no dispute as to the standard of appeal, which is conveniently summarised in *TT Education Ltd v Pie Corbett Consultancy* [2017] RPC 17 at [52].
7. The Decision of the Hearing Officer had the following structure. After setting out the history of the examination process, he summarised the relevant legal principles at §§24-30. There was no suggestion on appeal that he had not directed himself to the correct authorities. The complaint turned on his application of the principles to the facts of the case. As to this, between §§31-40 he analysed the features of the mark applied for and the effect those would have on the average consumer. At §§41-49 he asked whether the shape departed significantly from the norm and customs of the sector and decided that it did not. Finally, he addressed the lower threshold (if he was wrong about norm and customs) and asked whether being unique or unusual amounted to being distinctive, and decided that it also did not (§§50-61).
8. The Applicant cited some 13 separate grounds of appeal in its TM55. Generally, it is not helpful to run so many separate points, as there is a danger that the strongest arguments get lost amongst the weaker ones. On this occasion the 13 grounds were broken down into three separate categories – “average consumer”, “significant departure from the norms and customs of the sector” and “inherent distinctiveness of a unique or unusual shape mark”. In her skeleton, Ms. Collett summarised the three categories as follows:
 - (a) *The Hearing Officer wrongly found that the average consumer would pay no attention to the unusual features of the Mark (see [39] and [40]). This raises the issue of the average consumer’s assessment of three-dimensional shape marks and whether the average consumer is apt to notice distinctive or unusual features of the Mark relied on by the Appellant (see **Grounds 1-4** and in particular **Grounds 1 and 3**).*
 - (b) *The Hearing Officer wrongly found that the unique twin-body and bridge structure of the Mark was a ‘mere variant’ of norms of this sector (see [48]). This raises the issue of how the distinctiveness of three-dimensional shape marks is to be assessed against the norms and customs of the relevant market sector and the concept of a ‘mere variant’ of a norm or custom of the relevant sector (see **Grounds 5-10** and in particular **Grounds 5, 6 and 8**).*

- (c) *The Hearing Officer wrongly found that it is not enough for a mark to be visually unique and unusual for it to be inherently distinctive (see [60]). This raises the issue of whether it is a sufficient condition for the distinctiveness of a three-dimensional shape mark that it departs significantly from the norms and customs of its sector (see **Grounds 11 to 13** and in particular **Ground 11**).*

9. In fact, it is convenient to deal with the second and third categories together, and I shall approach the appeal on this basis.

AVERAGE CONSUMER/FEATURES MAKING AN IMPRESSION

10. The Applicant's skeleton summarised grounds 1 to 4 as follows:

- a. *The Hearing Officer failed to approach the assessment of the distinctiveness of the Mark from the perspective of an average consumer who is 'reasonably well-informed' and 'reasonably observant' (**Ground 1**);*
- b. *The Hearing Officer erred in his findings on the level of attention of the average consumer and directed himself wrongly on the significance of price and technical sophistication to this assessment (**Ground 2**);*
- c. *The Hearing Officer did not distinguish between the different goods for which the Mark is registered and should have separate findings on each (**Ground 3**);*
- d. *If properly guided on each of the above points, the Hearing Officer should have found that the following features of the Mark would make an impression on the average consumer (**Ground 4**):*
 - a. *the twin-body shape of the Mark;*
 - b. *the "bridge" design feature between each half of the Mark;*
 - c. *the LED strip lights on the front of the Mark, designed to look like 'teased headlights';*
 - d. *the streamlined, low-slung shape of the body of the Mark, resembling a sports car; and*
 - e. *the car-like bumper at the front and back of the Mark; and*
 - f. *the fact that all four wheels on the Mark are exposed and have a "rugged" appearance with thick tire treads.*

11. In short, although the Hearing Officer directed himself correctly as to the nature of the Average Consumer, the Applicant contends that he failed to apply this properly to the facts. In doing so, the Applicant realistically accepted the hurdles inherent in seeking to appeal findings based on the Hearing Officer's assessment of the evidence.

12. Turning to the Decision, the Hearing Officer made a number of observations in coming to his conclusion. First, in §31, he summarised the features of the mark which are apparent on close inspection. He described them as follows:

The body of the lawnmower is in two parts, which are connected by a “bridge”. The body is black/dark grey, whilst the bridge is light grey. Upon close inspection, it is possible to see what appear to be reflective strips on the front end of the lawnmower, although I acknowledge that they may be perceived as “teased head lights”, as submitted by the attorney during the Hearing. There are flecks of red on the wheels, which are “rugged” in so far as they appear to have thick tread. Based on the six representations of the lawnmower, taken from a variety of angles, it is not immediately obvious that the lawnmower has noticeable bumpers. However, I agree to a certain degree that the lawnmower has aspects that make it look like a car

13. However, he then pointed out that he did not think that some of these features (e.g. headlights, wheel tread) would make a relevant impression on the average consumer, because they required close inspection and so would not be apparent. In support of this he cited paragraph 32 of *C-136/02 Mag Instrument v OHIM*, which states (his emphasis):

“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.**”

14. He also referred to the principle that the assessment of a trade mark’s distinctiveness is a test of immediacy, citing *Sykes T-130/01*. A requirement for in-depth analysis is inconsistent with the notion that a trade mark can be perceived immediately as indicating trade origin.
15. Next, in §35, he turned to the fact that consumers would pay a higher level of attention to a technical product. He noted the price of some robotic lawnmowers as £3,000-£4,000 but referred to *Bang & Olufsen A/S v OHIM*, Case T-460/05, for the contention that price is irrelevant because it is not the subject of the registration. Nevertheless, he accepted that a higher degree of attention would arise because the consumer is purchasing a product with a technical function which would be expected to last a number of years.
16. Finally, he tackled the relevance of evidence from technical/design experts to the question of what the average consumer would perceive, referring to the decision of Her Honour Judge Melissa Clarke in *Jaguar Land Rover Limited v Ineos Industries*

Holdings Limited [2020] EWHC 2130 (Ch). The Applicant had supplied reviews from a number of technology reviewers which referred to some of the more detailed features in the Applicants lawnmowers. The Hearing Officer rejected the notion that these represented the features that would be noticed by the average consumer.

17. He summarised his conclusion in §39:

To conclude on the potential issue of paying too much attention to the design features of the lawnmower, I do not consider it likely that the features would be immediately noticed by the average consumer. I also do not consider it likely that even if the design features were immediately noticed, then consumers would attach the same level of trade mark significance to those features as either an “expert” or technological journalist would.

18. Thus, the features that he concluded would be noticed were the “bridge” feature and the twin body design (§40). These were the features which he then took forward into the analysis of whether the shape departed significantly from the norm or customs of the sector.

19. The Applicant attacked each of the steps taken by the Hearing Officer. It contended that the skilled person would rely on more features than just the bridge and twin-body design, just as the articles referred to had done, that the average consumer would pay a higher level of attention than the Hearing Officer had postulated, and that the high price of the goods was a factor that the Hearing Officer should have taken into account in support of this.

20. I disagree. I consider that the Hearing Officer directed himself correctly with respect to the law, and then applied it appropriately. Further, I consider that he was entitled to reach all the conclusions that he did based on the evidence before him.

21. Thus, I consider that he was entitled to concluded that the average consumer would not pay attention to more than the bridge and twin-body design aspects of the mark. The other features are much less easy to discern, and so I can see no error in a finding that the average consumer would not notice them when first seeing the mark, let alone use them to attribute trade origin.

22. As to this, I consider that the Hearing Officer was right to direct himself by reference to the quote from *Mag Instrument* cited above. Consumers are not used to conducting detailed analysis of all the features of shape of an item in order to distinguish them from those of other undertakings. The Hearing Officer was plainly entitled to consider that they would not carry out the sort of detailed technical

comparison undertaken by the technology journalists in the articles relied on by the Applicant. Further, the Hearing Officer made no error in referring to the test of immediacy in *Sykes*, nor in referring to the same test by reference to first impression (which comes to the same thing).

23. Finally, I do not think the Hearing Officer made any error in assessing the amount of care that consumers would take in purchasing the goods in the Applicant's specification. Nor did he fail to consider this for "robotic lawnmowers" as well as "lawnmowers", as it is clear that he must have had in mind the former when he quoted the price of £3,000-£4,000.
24. Indeed, the argument about ignoring price is an unnecessary distraction, because it is clear that the Hearing Officer acknowledged that the technical function and the expected longevity (which are ultimately reflected in the high price) would mean that consumers would pay a relatively high level of attention to the features inherent in the product. But even paying this level of attention does not mean that the Hearing Officer was wrong to identify the potentially distinctive features of the shape mark as the bridge and the twin body design, as opposed to the additional features (headlights, bumper, tyre treads) which might appeal to a technical journalist but are much less discernible to the notional average consumer of these products.
25. Accordingly, I reject each of Grounds 1-4. The Hearing Officer was entitled to assess the evidence and reach the conclusions that he did, and he made no error of principle in so doing.

SIGNIFICANT DEPARTURE FROM THE NORM AND CUSTOMS OF THE SECTOR

26. This issue was at the heart of the Appeal and the submissions of both the Applicant and the Registrar. It engages both the standard of the test, and whether satisfying the test is all that is required to demonstrate sufficient inherent distinctiveness. That is why it is convenient to deal with all the remaining grounds of appeal together.
27. Grounds 5-10 in the appeal were helpfully summarised by the Applicant as follows:
 - a. *Rather than assessing this issue on the basis of a comparison of the impressions made by the Mark and the norms of the sector on the average consumer, the Hearing Officer's assessment was generalised and significantly influenced by his view that all robotic lawnmowers were vehicular in appearance and featured wheels (Grounds 5-7) (see in particular [45]). The Hearing Officer should have found that although other products in this sector, like the Mark, were vehicular*

and had wheels, the actual appearance of the Mark would make a significantly different impression on the average consumer.

- b. *The Hearing Officer did not separately assess this point in relation to both the goods of the Mark despite the average consumer being different (**Ground 9**).*
 - c. *The Hearing Officer treated the distinctive and unusual features of the Mark as 'mere variants' (see [48]) when there was no evidence before him that there was no precedent for these features in the norms and customs of the sector (**Ground 8**).*
 - d. *The Hearing Officer was wrong to disregard secondary evidence on this issue in the form of product reviews in newspapers and magazines (see [39]) (**Ground 10**).*
28. As noted above, part of this debate centres around the correct legal test, and Grounds 11-13, namely whether the norm and customs test was necessary and sufficient (**Ground 11**), whether aesthetic qualities are irrelevant (**Ground 12**) and whether the mark departed significantly from the norm and customs (**Ground 13**).
29. The Hearing Officer found that the mark in issue did not depart significantly from the norm or customs of the sector. As a result, he refused the application. The Applicant submitted before me that the Hearing Officer had fallen into error in this assessment, that the mark did depart significantly from the norm or customs of the sector, and that satisfying this test was necessary and sufficient to demonstrate inherent distinctiveness under s.3(1)(b).
30. The Registrar supported the findings of the Hearing Officer. He also urged me to confirm, for the benefit of future cases, that the above test was necessary but not sufficient to satisfy the requirements of s.3(1)(b).

The Caselaw

31. There was no dispute as the relevant caselaw. The principles have been reiterated on a number of occasions by the Court of Justice and discussed by the Court of Appeal in *The London Taxi Corporation Ltd v Frazer-Nash Research Ltd* [2017] EWCA Civ 1729 where Kitchin LJ and Floyd LJ determined that the point was not *acte clair*.
32. The relevant authorities are as follows, helpfully summarised chronologically by Dr Baran for the Registrar. As can be seen, there has been something of a back and forth on the topic between the English Courts and those in Europe.

33. First, *Yakult* [2001] RPC 39, which was an appeal from the Registrar's refusal to register the shape of a bottle for certain goods in classes 29 and 32. Laddie J. upheld that refusal on appeal. At [8] and [10] he said (emphasis added):

8. There was little dispute between the parties as to the correct approach to the application of section 3(1)(b). The onus is on the applicant to show that the proposed mark is inherently distinctive. Mr Thorley agreed that Mr James was entitled to rely upon first impressions, as long as in doing so he directed his attention to the correct issue. According to Mr Thorley, that issue, in a case where a container is the subject of the application, is **whether the design is eye catching in a relevant trade mark sense. The fact that a particular design is eye-catching because it is unusual or decorative is not enough by itself. At all times the Registry has to ask whether the design is distinctive as a badge of origin. ...**

...

10. Where inherent distinctiveness is concerned, the Registry has to find that the mark performs the function of identifying origin even before the public is educated that it is so used for that purpose. Where invented, non-descriptive word marks are concerned, it may be easy to come to such a finding. But where a container is in issue it may well be much more difficult. **As Mr Thorley rightly conceded, the fact that a container is unusual or attractive does not, per se, mean that it will be taken by the public as an indication of origin. The relevant question is not whether the container would be recognised on being seen a second time, that is to say, whether it is of memorable appearance, but whether by itself its appearance would convey trade mark significance to the average customer.** For the purpose of this appeal, I am prepared to accept that the bottle shape which is the subject of these applications is both new and visually distinctive, meaning that it would be recognised as different to other bottles on the market. That does not mean that it is inherently distinctive in a trade mark sense.

34. In other words, whilst something could be set apart visually from other products, Laddie J. was of the view that that was not a *sufficient* consideration to show distinctiveness in a trade mark sense. Something more was required, namely the requirement for the shape to convey trade mark significance.

35. Next came *C-136/02P Mag Instrument Inc.*, an appeal to the CJEU from OHIM's refusal to register five three-dimensional signs comprising the shape of torches. The CJEU set out guidance at §§30-31 (emphasis added):

30 The criteria for assessing the distinctive character of three-dimensional marks consisting of the shape of the product itself are no different from those applicable to other categories of trade mark. None the less, for the purpose of applying those criteria, the relevant public's perception is not necessarily the same in the case of a

three-dimensional mark consisting of the shape of the product itself as it is in the case of a word or figurative mark consisting of a sign which is independent from the appearance of the products it denotes. **Average consumers are not in the habit of making assumptions about the origin of products on the basis of their shape** or the shape of their packaging in the absence of any graphic or word element and it could therefore prove more difficult to establish distinctiveness in relation to such a three-dimensional mark than in relation to a word or figurative mark (see *Henkel v OHIM*, paragraph 38 and the case-law cited there).

- 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).
36. As the Registrar submitted, the CJEU confirmed that the same law about the extent and application of Art 7(1)(b) CTMR (the then-counterpart to s. 3(1)(b) TMA94) applies, even in the case of a 3D marks. However, there are additional considerations that must be borne in mind in the case of 3D marks because consumers are not used to attributing origin to shape. Consideration of whether there is significant departure from the norm or customs of the sector (“the Norm/Customs Test”) helps a tribunal to apply the law on Art 7(1)(b) – but it does not replace it.
37. Further, §31 is expressed negatively: only marks which satisfy the Norm/Customs Test are registrable as far as Art 7(1)(b) goes. However, it does not establish that every mark satisfying the Norm/Customs Test complies with Art 7(1)(b).
38. Thus, the use of “thereby” is ambiguous. It could indicate that only a mark which departs significantly from the norm or customs of the sector has the potential to fulfil the essential function of indicating origin. Alternatively, it could suggest that the Court thought that the test was satisfied by all marks which depart significantly from the norm or customs of the sector.
39. That last point was addressed by Jacob L.J. in *Bongrain* [2004] EWCA Civ 1690, [2005] ETMR 47. The Court of Appeal unanimously rejected an appeal from a refusal of registration for the shape of a cheese, and in doing so rejected an argument that

meeting the Norm/Customs Test sufficed to defeat an equivalent objection. Jacob LJ explained (emphasis in the original):

28. With that I can turn to Mr Malynicz's main point – that a very fancy shape is necessarily enough to confer an inherent distinctive character. I would reject it. As a matter of principle I do not accept that just because a shape is unusual for the kind of goods concerned, the public will automatically take it as denoting trade origin, as being the badge of the maker. At the heart of trade mark law is the function of a trade mark – expressed in Recital 10 of the Directive as an indication of origin. The perception of the public – of the average consumer is what matters. Mr Daniel Alexander QC, for the Registrar, helpfully pointed out that the kinds of sign which may be registered fall into a kind of spectrum as regards public perception. This starts with the most distinctive forms such as invented words and fancy devices. In the middle are things such as semidescriptive words and devices. Towards the end are shapes of containers. The end would be the very shape of the goods. Signs at the beginning of the spectrum are of their very nature likely to be taken as put on the goods to tell you who made them. Even containers, such as the fancy Henkel container, may be perceived as chosen especially by the maker of the contents (e.g. shampoo) to say "look – here is the product of me, the maker of the contents". But, at the very end of the spectrum, the shape of goods as such is unlikely to convey such a message. The public is not used to mere shapes conveying trade mark significance, as the Court pointed out in *Henkel* (detergent tablets). The same point was made about slogans in *Das Prinzip der Bequemlichkeit*, para. 35:

"the authorities may take account of the fact that average consumers are not in the habit of making assumptions about the origin of products on the basis of such slogans."

...

30. ...In so holding I am not saying (and indeed Mr Alexander did not contend otherwise) that a shape of goods (including that of a cheese) cannot become a trade mark by acceptance as such by the public. Mere use may not be enough, but if it can be shown that, following such use, the average consumer has come to say: "by this shape I know I can rely upon getting goods from the same maker as before", then the design of goods will also have become a trade mark. Registration pursuant to Art.3(3) would then be permissible because the shape would have acquired a distinctive character in the trade mark sense.

40. The position as far as the CJEU is concerned was subsequently summarised in C-344/10P *Freixenet*:

Findings of the Court

42 According to settled case-law, for a trade mark to possess distinctive character for the purposes of Article 7(1)(b) of Regulation No 40/94 it must serve to identify the goods in respect of which registration is sought as originating from a particular

undertaking, and thus to distinguish those goods from those of other undertakings (see, in particular, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 34; Case C-136/02 P *Mag Instrument v OHIM* [2004] ECR I-9165, paragraph 29, and Case C-238/06 P *Develey v OHIM* [2007] ECR I-9375, paragraph 79).

43 That distinctive character must be assessed, first, by reference to the goods or services in respect of which registration is sought and, second, by reference to the perception of the relevant public (see, in particular, *Henkel v OHIM*, paragraph 35; Case C-25/05 P *Storck v OHIM* [2006] ECR I-5719, paragraph 25, and *Develey v OHIM*, paragraph 79).

...

45 It is also settled case-law that, the criteria for assessing the distinctive character of three-dimensional trade marks consisting of the appearance of the product itself are no different from those applicable to other categories of trade mark (see, in particular, *Mag Instrument v OHIM*, paragraph 30; Case C-173/04 P *Deutsche SiSi-Werke v OHIM* [2006] ECR I-551, paragraph 27; *Storck v OHIM*, paragraph 26, and Case C-144/06 P *Henkel v OHIM* [2007] ECR I-8109, paragraph 36).

46 However, when those criteria are applied, account must be taken of the fact that the perception of the average consumer is not necessarily the same in relation to a three-dimensional mark consisting of the appearance of the product itself as it is in relation to a word or figurative mark consisting of a sign which is independent of the appearance of the products it designates. Average consumers are not in the habit of making assumptions about the origin of products on the basis of their shape or the shape of their packaging in the absence of any graphic or word element, and it could therefore prove more difficult to establish distinctive character in relation to such a three-dimensional mark than in relation to a word or figurative mark (see, in particular, *Mag Instrument v OHIM*, paragraph 30; *Deutsche SiSi-Werke v OHIM*, paragraph 28, and *Storck v OHIM*, paragraph 27).

47 In those circumstances, 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 Article 7(1)(b) of Regulation No 40/94 (see, in particular, *Mag Instrument v OHIM*, paragraph 31; *Deutsche SiSi-Werke v OHIM*, paragraph 31, and *Storck v OHIM*, paragraph 28).

41. As noted above, the Court of Appeal considered all of this law in the *London Taxi* case. Ultimately, it determined that the sign in question did not meet the Norm/Customs Test, and so the question did not formally arise, though it did say there was “much force” in the submission that the Norm/Customs Test suffices to defeat any s. 3(1)(b) objection (Floyd L.J. at [42]). (The Court relied in part on the

use of “consequently” instead of “thereby” in a passage in a General Court decision T-629/14 *Jaguar Land Rover*, but I am not sure how much weight can be placed on the use of this single word). A preliminary reference to the Court of Justice under Art 267 TFEU would have been required if the point had been material. That route, of course, is no longer available from this jurisdiction.

42. James Mellor QC (as he then was) considered the same issue in O-263/18 *Robinsons* (drinks pouch). He upheld the Registrar’s refusal of a three-dimensional trade mark registration for the shape of a plastic soft drinks pouch. As part of his reasoning he cited §§10-035–10-045 (especially 10-042 and 10-043) of *Kerly’s Law of Trade Marks and Trade Names* 16ed (2017). The Hearing Officer cited some of those same paragraphs in the present Decision at §50.

43. Mr Mellor QC said:

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

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

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

16.3. This container has a memorable appearance;

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

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

44. Finally, there are two more recent cases, straddling the UK’s departure from the EU: Case C-783/18P *EU IPO v Wajos GmbH* EU:C:2019:1073 in the CJEU and Case T-488/20 *Guerlain v EU IPO* EU:T:2021:443 in the General Court. *Wajos* is part of retained EU law; *Guerlain* is merely persuasive under s. 6(2) European Union (Withdrawal) Act 2018 (as amended).

45. The Applicant submitted that these decisions were sufficient to answer the question raised by the Court of Appeal in the *London Taxi* case and render the point *acte clair*. Regrettably, I disagree.
46. The key part of the *Wajos* decision is at §24 (emphasis added):
- 24 In that regard, the criteria for assessing the distinctive character of three-dimensional marks consisting of the shape of the product itself or the shape of its packaging are no different from those applicable to other categories of marks. However, in the context of the application of these criteria, **the perception of the average consumer is not necessarily the same in the case of a three-dimensional mark**, consisting of the appearance of the product itself or of its packaging, as in the case of a word or figurative mark, which consists of a sign independent of the appearance of the products it designates. Indeed, **average consumers are not in the habit of presuming the origin of products based on their shape or that of their packaging**, in the absence of any graphic or textual element, and it could therefore turn out more difficult to establish distinctive character in the case of such a three-dimensional mark than in the case of a word or figurative mark. Under these conditions, the closer the shape for which registration is sought as a trade mark to the most probable shape that the product in question or its packaging will take, the more likely it is that that shape is devoid of distinctive character, within the meaning of Article 7(1)(b) of the Regulation No 207/2009. **Only a mark which significantly deviates from the norm or habits of the sector and, as a result, is capable of fulfilling its essential original function is not devoid of distinctive character** within the meaning of that provision (judgments of the 20 October 2011, Freixenet/OHIM, C344/10 P and C345/10 P, EU:C:2011:680, points 45 to 47, as well as 7 May 2015, Voss of Norway/OHIM, C445/13 P, EU :C:2015:303, points 90 and 91 and case law cited).
47. This was applied in *Guerlain* where the mark was upheld.
48. I do not think that either case advances the debate very much, as they merely appear to restate the previous pronouncements. It is correct that they use slightly different wording (“as a result” compared to “thereby” or “consequently”), but I do not consider that this resolves matters. Either interpretation (necessary versus necessary and sufficient) is still possible. The Applicant relied on both cases for the point that the marks were deemed allowable, based on their significant deviations from the norm and customs. The Applicant also pointed out that aesthetic features were seemingly taken into account insofar as they amounted to an objective and unusual visual effect (e.g. *Wajos* §32). I will return to this below. But overall I do not think the law has moved on since the *London Taxi* case. It is still not *acte clair*.

Application of the Norm/Customs test in the present case

49. As noted above, the Registrar urged me to decide this point of principle in order to provide future guidance. Whilst this would no doubt be of assistance for other cases, the task before me is to decide the case in hand. If it is necessary for me to resolve the point in order to decide the case, then of course I will do so. However, I do not think it is useful to attempt to determine difficult and important points of law unless they are central to the case in hand. Nor am I convinced that, even if I did, the weight of a single Appointed Person decision (in addition to the decision of Mr Mellor QC already given) would be sufficient to guide future policy. If the matter is central to the determination of a case, it may well be one which is more appropriate to be appealed to the High Court, and if necessary, beyond. See s.76(3) Trade Marks Act 1994. I was not asked to refer the present case to the High Court and I do not consider that it is appropriate to do so in the light of my other findings.
50. The starting point in the present case is the relevant features found by the Hearing Officer, namely the “bridge” feature and the twin body design discussed above.
51. The first question for me is whether the Hearing Officer fell into error in holding that they did not deviate significantly from the norm and customs of the relevant sector, whether that be lawnmowers or robotic lawnmowers. If he was wrong about that then I need to go on and consider the point of law summarised above.
52. The Hearing Officer addressed this question from §41 onwards. He identified the relevant sector in §43 as lawnmowers at large, albeit that he noted that the focus in the Applicant’s submissions to him had been on robotic lawnmowers.
53. This was criticised by the Applicant on appeal (Ground 9), but I do not think it is a fair criticism. The Hearing Officer did address the norm for robotic lawnmowers in §45. He held that the only notable differences were the fact that the application has a bridge and is twin bodied. So he did properly consider both types of good applied for.
54. He then went on to consider the norm for non-robotic lawnmowers in §46. He did this by reference to a search on the website of B&Q which he depicted and described in §47 as a snapshot of a random collection of non-robotic lawnmowers. He explained that he was doing this because the Applicant had not produced details of the norm in this field.
55. It is not generally good practice for a Hearing Officer to consider material which is only generated after a hearing and which, by definition, the parties have not had an

opportunity to comment upon. In the present case the material was limited and amounted to representations of six lawnmowers which look like any common or garden lawnmower that an average consumer might think of. An alternative course would have been for the Hearing Officer to have taken judicial notice of the shape of non-robotic lawnmowers from his own experience. In the circumstances of the present case, where the Applicant had not supplied such material itself but the Hearing Officer was expected to make a decision based on the norm and customs of the field of non-robotic lawnmowers, the Hearing Officer was entitled to take judicial notice of the field and I do not consider that there is any material difference between that and the extract he found and depicted. Accordingly, I do not think his reference to the B&Q website amounts to an error which should result in the decision being impugned.

56. Nevertheless, it is necessary for me to review the Hearing Officer's conclusions in relation to this field. He identified the presence of wheels, often with tread, and a vehicular appearance, with bumpers, lights and a sloped shape as part of the norm (§47).
57. In §48 he analysed whether the features in the mark departed significantly from the norm, and held that they did not. Instead, he was of the opinion that the bridge and twin-body were mere variations of the common-norm body shape of a lawnmower. I think he was entitled to do so. Although he explained in §49 that he considered that these features were "unusual and potentially unique", he makes clear in the same paragraph that in spite of this they did not depart significantly from the norms and customs of the trade. Contrary to the submissions of the Applicant, I do not consider that there is anything inconsistent in these findings. The requirement for the features to depart "significantly" from the norm places a high hurdle, and the Hearing Officer was clear that the bridge and twin-body did not reach this hurdle. This was all part of his multifactorial decision.
58. The Hearing Officer also addressed the question of aesthetics. He held in §57 that aesthetic appeal or attractiveness can be a consideration in the purchase of a product, albeit that in some sectors it is likely to be more important (e.g. clothing and jewellery). He then quoted from §37 of *Mag Instrument* where the attractiveness of the products was held to be a mere variant of the common shape rather than capable of differentiating origin. The Applicant had relied on the following paragraphs of *Guerlain* on this point, which refer back to *Wajos*:
 43. However, it cannot be excluded that the aesthetic appearance of a mark taking the form of the packaging of a product, in this case of its container, may be taken into

account, among other elements, in order to establish a difference from the norm and the uses of a sector, provided that this aesthetic aspect is understood as referring to the objective and unusual visual effect produced by the specific design of the said mark (judgment of 12 December 2019, EUIPO/ Wajos, C - 783/18 P, unpublished, EU: C: 2019: 1073, paragraph 32).

44. Consequently, it should be noted that taking into account the aesthetic aspect of the mark applied for must not amount to an assessment of the beauty or lack thereof of the product in question, which would be by definition subjective, but aims to verify, in accordance with the case-law cited in paragraph 43 above, whether it is capable of generating an objective and unusual visual effect in the eyes of the relevant public.
59. As Dr Baran submitted, it would be surprising if the CJEU in *Wajos* had intended to overrule §37 of *Mag Instruments* without expressly saying so. In any event, the Hearing Officer held in §57 that on the facts of the present case “*the attractive details of the shape mark at issue would not draw the consumer’s attention or be considered by them to indicate trade origin*”.
60. Again, I cannot fault the conclusions of the Hearing Officer and see no reason to interfere with them. This is the sort of classic multifactorial analysis with which appellate tribunals should be reluctant to interfere.
61. The Applicant focussed on the technical reviews it had provided as providing evidence that the mark did differ from the norm and customs of the sector. The Hearing Officer dismissed these as not representing the views of the average consumer (as opposed to specialist reviewers) and I think he was justified in doing so. The sorts of comments made in those documents require a closer analysis and a much more technically detailed understanding of the rival products than I think should be attributed to the average consumer, even of an expensive and likely one-off purchase such as a robotic lawnmower.
62. So for all these reasons I consider the Hearing Officer was correct to reject the notion that the Applicant’s mark satisfied the test as laid down in the CJEU decisions I have quoted. The CJEU has expressly recognised the difficulty facing applicants for shape marks because consumers “*are not in the habit of presuming the origin of products based on their shape or that of their packaging*”. Further, as it explained in *Libertel Group BV v. Benelux Merkenbureau* (C-104/01) [2004] FSR 4 at [59], the filter on absolute grounds for lack of distinctiveness “*must be a stringent and full examination, in order to prevent trade marks from being improperly registered*”. The present decision is simply a reflection of that.

Is the Norm/Customs test necessary or necessary and sufficient?

63. As for the precise nature of the test, and whether it is necessary or necessary and sufficient, it is not necessary for me to decide that based on my findings above. Therefore, I will make only the following necessarily tentative observations.
64. First, the ultimate test is the one set out in the statute – the norm and customs test is merely a means to answering the statutory question in shape mark cases, and should be treated accordingly. Second, although the emphasis has been on the last sentence in the quote from §24 of *Wajos* and its earlier versions, the previous sentences should not be ignored, and place the last sentence in context. Third, it would be a brave tribunal to decide that, as a matter of English law, the guidance given by judges with the experience of Laddie J. and Jacob LJ in *Yakult* and *Bongrain* respectively, as summarised in *Kerly*, should be ignored. To that end I would endorse the conclusion reached by Mr Mellor QC in *Robinsons*.
65. Fourth, as the Hearing Officer recognised in §48, the debate may turn more properly on what amounts to a “significant” deviation. That is ultimately a matter for the first instance tribunal, but there can be no doubt that because consumers are not in the habit of presuming the origin of products based on their shape, the standard is a high one. Fifth, it should not be forgotten that shape marks can accrue acquired distinctiveness, so applicants who are refused registration on the grounds of lack of inherent distinctiveness have an opportunity to overcome this by use.
66. Finally, I repeat my view that the issue is best determined in a case where it matters. One can easily think of aspects of the debate that might be argued but which it was not necessary to get into on the facts before me. For example, what happens when a shape is the first in a new field. Should that result in an automatic registration (because it is unique) or automatic refusal (because it is by definition, the norm)? The test needs to be flexible enough to deal with this scenario, and I am not convinced that the norm and customs test alone has this attribute. That may be why, in the end, it is safest to return to the words of the statute, however useful/convenient the norm and customs approach might be in some cases.
67. For all these reasons I dismiss the appeal. The application should be refused.
68. As is customary in such cases, I make no order as to costs.

Thomas Mitcheson QC
The Appointed Person
28 June 2022