

O/0042/25

Trade Marks Act 1994

In the matter of the international registration number WO0000001789520

In the name of

HAVE&BE CO., LTD

to register the following mark in class 3



The mark is declared as 'Figurative' on the International Register.

It is accompanied by the following description:

"This trademark is inspired by a bear face motif, with rounded ear shapes depicted on both upper sides. At the circular bottom, a convex snout and nose shape are portrayed, evoking the image of an adorable bear figure."

### Background

1. On the 16 May 2024, HAVE&BE CO., LTD ("the holder") designated the United Kingdom in relation to the above mark for the following goods in Class 3:

*Class 3: Lip balm; lipsticks; cosmetics; skin masks for cosmetic use; skin creams; lavender oil; tissues impregnated with cosmetic lotions; cleaning preparations; shampoos; dentifrices.*

2. On 3 June 2024 the Intellectual Property Office ("IPO") issued an examination report in response to the application. In that report, an objection was raised under Section 3(1)(b) of the Trade Marks Act 1994 ("the Act"):

#### **Section 3(1)(b)**

*The designation is not acceptable in Class 3. There is an objection under Section 3(1)(b) of the Act as the mark is devoid of any distinctive*

*character. This is because the mark appears to comprise the shape of the packaging of the goods. Consumers do not generally regard shapes as comprising trade marks and the shape concerned does not appear to differ significantly from the norms of the trade in such a way that enables it to function as a trade mark*

3. In line with standard IPO procedure, a period of two months was allowed for the holder to respond.
4. On 5 July 2024 Sipara Limited were appointed as the attorney for the holder and submitted a request for a hearing.
5. The hearing took place on the 13 August 2024 between myself and Mr Robert Furneaux of Sipara Limited.
6. Mr Furneaux's submissions and the discussion at hearing may be summarised as follows:
  - The examiner had provided no evidence for their claim that the mark did not depart significantly from the norms and customs of the sector.
  - Mr Furneaux contended that the mark departs significantly from the norms and customs of the lip balm and cosmetics sector, referencing the General Court's decision (*GUERLAIN T-488/20*) to support that; even minor and subtle variations could lead to establishing that a shape departed significantly from the norms and customs.
  - The distinctive bear's face and unusual heart shaped nose must be held to be unusual in the trade.
  - When used as a figurative trade mark on the outer packaging of the product, the sign would stand out and be unusual. Mr Furneaux offered to provide an example of how the mark would be used in this manner (these were received shortly after the hearing).
7. I deferred my decision at the hearing in order to wait for examples of the holder's use of the mark.
8. After considering the submissions made at the hearing and further examples of the use of the mark as a figurative mark on the outer packaging of the product I accepted that the mark departed from the norms and customs of the relevant sector, but I did not find that the average consumer would attribute any trade mark significance to the sign.
9. I maintained the objection and informed Mr Furneaux of my decision in my letter dated 21 August 2024, and provided a deadline for a response of one month.

10. In the absence of any further response the notification of refusal was sent to the World Intellectual Property Organisation (“WIPO”) on 29 October 2024.
11. A form TM5, (Request for a statement of reasons for registrar’s decision) was filed on 5 December 2024. The form was initially filed on 23 September 2024, which was within the given deadline, but had been misplaced. It is accepted that this was an administrative error on the part of the IPO, capable of rectification and nothing more will be said about this.
12. Having received a request for a statement of reasons for the registrar’s decision, I am now obliged to set out the reasons for my decision.
13. I should say that no plea of acquired distinctiveness has been made and so I only have the case in the prima facie to consider.

## **The Law**

14. The relevant parts of section 3 of the Act read as follows:

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

*(47) ...*

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

*I ...*

*(d) ...*

*Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it*

## **The relevant legal principles – Section 3(1)(b)**

15. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to some decisions of the EU courts which predate the UK’s withdrawal from the EU.

16. The Court of Justice of the European Union ('CJEU') has emphasised the need to interpret the grounds of refusal of registration listed in Article 3(1) and Article 7(1), the equivalent provision in Council Regulation 40/94 of 20 December 1993 on the Community Trade Mark, in the light of the general interest underlying each of them (*Bio ID v OHIM*, C-37/03P paragraph 59 and the case law cited there and, more recently, *Celltech R&D Ltd v OHIM*, C-273/05P).
17. The general interest to be taken into account in each case must reflect different considerations according to the ground for refusal in question. In relation to section 3(1)(b) (and the equivalent provision referred to above) the Court has held that "*...the public interest... is, manifestly, indissociable from the essential function of a trade mark*", *SAT.1 SatellitenFernsehen GmbH v OHIM*, C-329/02P. The essential function thus referred to is that of guaranteeing the identity of the origin of the goods or services offered under the mark 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. Marks which are devoid of distinctive character are incapable of fulfilling that essential function.
18. Section 3(1)(b) must include within its scope those marks which, whilst not designating a characteristic of the relevant goods and services (i.e. not being necessarily descriptive), will nonetheless fail to serve the essential function of a trade mark in that they will be incapable of designating origin. In terms of assessing distinctiveness under section 3(1)(b), the ECJ provided guidance in *Koninklijke KPN Nederland NV v Benelux-Merkenbureau (Postkantoor)* C-363/99 where, at paragraph 34, it stated:

*"A trade mark's distinctiveness within the meaning of Article 3(1)(b) of the Directive must be assessed, first, by reference to those goods or services and, second, by reference to the perception of the relevant public, which consists of average consumers of the goods or services in question, who are reasonably well informed and reasonably observant and circumspect (see inter alia Joined Cases C-53/01 to 55/01 Linde and Others [2003] ECR I- 3161, paragraph 41, and C-104/01 Libertel [2003] ECR I-3793, paragraphs 46 and 75)"*

19. As will be discussed in greater detail below, despite being termed 'figurative' on the International Register, the sign appears to depict the top view of a jar. It is therefore of primary importance to consider whether the sign consists of a faithful representation of the product or packaging itself or whether the sign is in fact a figurative mark not representing the product. I shall discuss this further below in the body of my main decision. This point has been illustrated by the CFI in Case T-30/00, *Henkel v OHIM (Image of a detergent product)* [2001] ECR II-2663:

*“48. Article 7(1)(b) of Regulation No 40/94 does not distinguish between different categories of trade marks. The criteria for assessing the distinctive character of figurative marks consisting of the representation of the product itself are therefore no different from those applicable to other categories of trade marks.*

*49. Nevertheless, when those criteria are applied, account must be taken of the fact that the perception of the relevant section of the public is not necessarily the same in relation to **a figurative mark consisting of a faithful representation of the product itself** as it is in relation to a word mark or a figurative or three-dimensional mark not faithfully representing the product. Whilst the public is used to recognising the latter marks instantly as signs identifying the product, this is not necessarily **so where the sign is indistinguishable from the appearance of the product itself**. It follows that an assessment of distinctive character cannot result in different outcomes for a three-dimensional mark consisting of the design of the product itself and for a figurative mark consisting of a faithful representation of the same product.” (emphasis added).*

20. It is important to recognise that the position in the UK as regards signs which constitute the appearance of a product or its packaging is uncertain. For the reasons set out in BL O/555/22 (Device of a lawnmower) at paras 31-48, the UK courts do not regard the jurisprudence of the CJEU as being ‘acte claire’, despite being assimilated law. That is to say, whether the CJEU test of ‘departing significantly from the norms and customs of the trade’ is both a necessary and sufficient test for Trade Mark distinctiveness and registration. I refer also to Henkel KGaA v OHIM (Case C-144/06 P) which refers to the criteria for assessing the distinctive character of three-dimensional trade marks as being no different to other category of marks, but that consumers are not in the habit of making assumptions about the origin of products on the basis of their shape or their packaging (I shall refer to this as ‘the legal presumption’):

*36 According to equally consistent case-law, 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. 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 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 (Case C-136/02 P Mag Instrument v OHIM [2004] ECR I-9165, paragraph 30, and Storck v OHIM, paragraphs 26 and 27)*

*37 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 (Case C-173/04 P Deutsche SiSi-Werke v OHIM [2006] ECR I-551, paragraph 31, and Storck v OHIM, paragraph 28)*

21. This was further reiterated in joined cases C-344/10 P and C-345/10 P Freixenet SA:

*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, para 31; Deutsche SiSi-Werke v OHIM, para 31, and Storck v OHIM, para 28).*

22. Assuming that the starting (if not the end) question in the analysis of trade mark registration comprises the 'differing significantly from the norms and customs of

the trade' test, when considering this I refer to the three steps identified by Lord Justice Kitchen in [2017] EWCA Civ 1729, *London Taxi* and paragraph 45:

*45. The first step in the exercise is to determine what the sector is. Then it is necessary to identify common norms and customs, if any, of that sector. Thirdly it is necessary to decide whether the mark departs significantly from those norms and customs.*

23. It would appear then, that when determining if a sign such as this is inherently distinctive the CJEU may be (but as I have said, it is not 'acte claire'), saying that the only necessary and sufficient test is whether the sign departs significantly from the norms and customs of the sector. However, whilst the UK Courts seem to acknowledge that the question of 'departing significantly from the norms and customs' is a necessary test, they do not appear to agree that it is also a 'sufficient' test. In other words, it is only the statutory test of being 'devoid of distinctive character' (from a trade mark perspective) that matters, rather than any Court substituted test of 'differing significantly'. The UK Courts' perspective also appears to differentiate between the concept of distinctiveness per se (i.e. the ability to stand out in a general sense), and distinctiveness in the trade mark sense (i.e. denoting trade origin). In this regard, it is worth noting the following comments from Kerly's, 16th Edition, Chapter 10:

*10-035 The essential function of a trade mark is to distinguish the goods and/or services of one undertaking from those of other undertakings and the term "distinguish" must be understood in that way. The attribute of a trade mark which gives it the necessary ability to "distinguish" is its distinctive character, but the assessment of distinctive character is really an assessment of whether the sign/trade mark can distinguish in the sense just mentioned.*

*10-036 Problems arise if the term "distinguish" is used or understood more loosely. The examples given below demonstrate that "distinguish" can and has been used to mean different things. First, there is the correct meaning: see the citations from the Court of Justice judgments set out above.*

*10-037 Secondly, the term "distinguish" can be used in the sense of "different". In the past, this meaning tended to be used (especially in CFI judgments) in cases involving the shapes of goods or their packaging, where the applicant frequently argues to this effect: "my mark has (the minimum degree of) distinctive character because it can clearly be distinguished from others in the market." This type of argument is utterly bogus. It amounts to nothing more than saying that "my mark is different". Deployment of this type of argument is a clear sign that the mark does not have distinctive character.*

10-038 Thirdly, “distinguish” or “distinctive” is used in the sense of “standing out”, likely to attract the attention of the consumer. This is a slight variation on “different”, in that the mark is now adjudged to be sufficiently different such that it attracts the attention of the consumer. However, there are many things which will attract the attention of the consumer (bright or garish colours, snazzy graphics, bold claims) which have nothing to do with distinctive character. The usefulness of this concept depends entirely on whether the consumer’s attention is attracted in the right “trade-origin message” manner.

10-039 Fourthly, the term “distinguish” is used in the “recognition” sense. Again, this may be only a slight variant on the above, but it has a greater aura of respectability because it involves the average consumer. Thus, the applicant argues to this effect: “my mark has distinctive character because the average consumer would recognise it, thereby enabling him or her to repeat the purchasing experience if positive or avoid it if negative.” The CFI has correctly rejected recognition as being sufficient in some cases, e.g.: 49 The fact that consumers may get into the habit of recognising such a product from its get up is not enough to preclude the ground for refusal based on Article 7(1)(b) of the Regulation – *Unilever v OHIM* (T-194/01).

24. This line of reasoning is reinforced in the *Robinson’s Squash Bottle* decision (BL 0-263-18) where James Mellor QC (as Appointed Person) states:

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 my view paragraph 10 (in *Kerly*) 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*

25. It seems therefore to be clear from these comments that from the UK Court's perspective, simply being different, novel, eye-catching, or standing out is not, in itself, sufficient for establishing distinctiveness in a trade mark sense.
26. I refer also to the comments of Laddie J in *Yakult* [2001] RPC 39, when he upheld the refusal on appeal to register the shape of a bottle for goods in Classes 29 and 30. At paragraphs 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.*

### **Applying the legal principles in the prima facie case**

27. The sign consists of a circular figurative shape being likely to be that of a bear (confirmed by the description on the international Register). I say 'likely' as

there are two prominent ear shapes present and a convex snout and heart shaped nose at the circular bottom. The average consumer for the products listed will be the general cosmetic purchasing public whose level of attention in such a purchase will not be at the highest end in my opinion but neither will be at the very low end, such as a bag of sweets. It will be somewhere in between but a precise finding on this question will in any event have no impact on my overall conclusion. The goods in respect of which the specification comprises are "*Lip balm; lipsticks; cosmetics; skin masks for cosmetic use; skin creams; lavender oil; tissues impregnated with cosmetic lotions; cleaning preparations; shampoos; dentifrices.*" all in Class 3.

28. As I have said I note that the sign applied for is described on the international register as 'figurative' and as an 'adorable bear motif'. The primary question for me as I have suggested above, in applying the correct legal principles, is whether the sign in fact is a 2D representation of the products themselves or of their packaging. If I find that to be the case, I am entitled to apply the legal presumption set out in *Henkel et al*, that consumers are not in the habit of treating such signs as trade marks, unless they depart significantly from the norms and customs of the sector. I would also note perhaps that the attorney appeared to accept the Henkel 'legal presumption' from the outset by addressing the question of 'differing significantly from the norms and customs of the sector' from the very outset in his submissions but I place no great store by that as it is a crucial part of my analysis I must arrive at for myself.
29. To assess this, I have been helped by the example of use provided by the holder and to its website. Fig 1, provided by the holder, shows the outer box in which the product comes prepackaged. While the outer box contains a large (figurative) representation of the sign on the top of the box, I believe the average consumer will merely view this representation as an image of the product contained within the box, in other words, its inner packaging. This is confirmed by reference to the holder's website as shown in Fig 2 below.



Fig 1- Use of mark as a figurative element on the goods

30. To clarify, after receiving the above image from the applicant, I conducted further research into the use of the mark on the outer packaging as compared to the applicant's other cosmetic products. When seeking these examples, I identified the following web page showing use of the sign on the holder's UK based website. I believe that the findings shown in *Fig 2* demonstrate that the mark applied for is intended to seek protection for the shape of the inner packaging of the goods. It is noted that the primary mark in both Fig 1 and Fig 2 is 'DR JART+'.

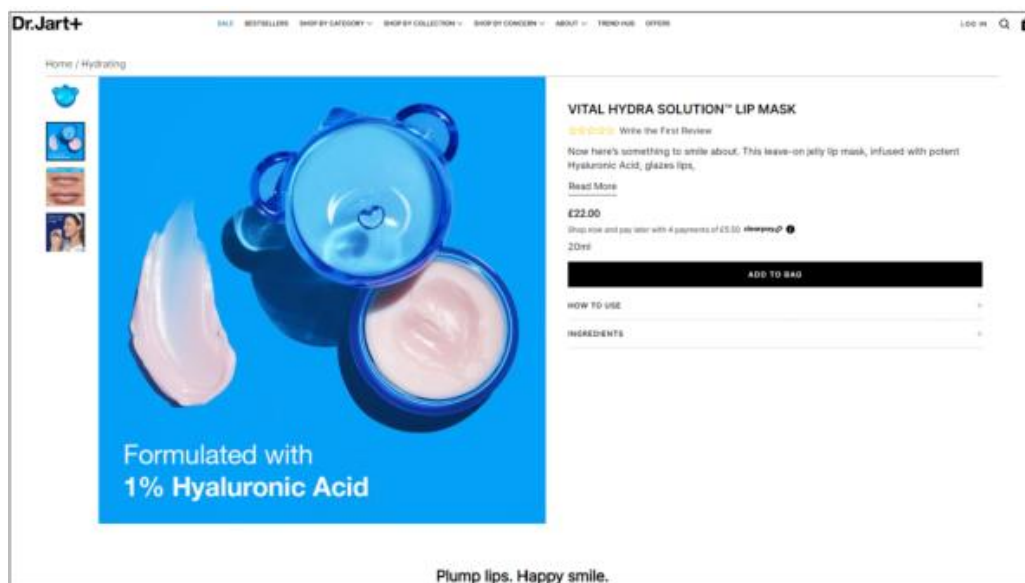


Fig 2- Use of mark identified on the applicant's UK website

[Vital Hydra Solution™ Lip Mask | Dr. Jart](#)

31. From this information, I believe I am entitled to treat the sign as a 2D representation of the products or their packaging themselves, being encased in a jar having a lid shaped in the manner depicted by the sign. The case can thus be distinguished from, e.g. BL O/302/07 (Device of a mouse) where the figurative sign was held not to be a representation of the product or packaging and thus the legal presumption could not properly apply. Thus, in my opinion and in this case the legal presumption set out by *Henkel et al* applies. The next question relates to whether such a sign departs significantly from the norms and customs of the trade.

32. I must begin by applying the appropriate test as to the relevant sector established by Lord Justice Kitchen, *London Taxi* case. From the applicable goods listed in Class 3, I find the relevant sector to be the cosmetics industry, specifically in regards to lip balms and lipsticks, as well as skin creams and hydration cosmetics. In considering what are the norms and customs of this relevant sector, it appears from the submissions made by the attorney and my own general knowledge, that such goods are contained in tubes, jars, and 'standard' bottles. In my opinion, I am prepared to accept the attorney's

submission that the shapes of the jar lid as having an animal like head shape does in fact significantly depart from the norms and customs of the trade in this sector. I would regard such a shape as having a novelty factor, it is more than simply a standard jar or other container.

33. Nevertheless, it is generally accepted within UK case law as I have explained above, that such a shape, even if it departs significantly from the norms and customs of the trade may not, as a result, meet the threshold for trade mark registration. The final test is a statutory one, 'is the sign devoid of distinctive character', not whether the shape happens to be novel or original or even distinctive in a purely general sense. I therefore endorse the position taken by the AP in *'Robinson's Squash Bottle' to which I have referred above.*
34. I conclude that the sign is inherently non-distinctive in a trade mark sense. It is settled case law that the average consumer is not necessarily in the habit of establishing distinctive character when confronted with unconventional signs, such as the shape of the packaging of the goods. I believe that when confronted with the sign applied for, and in the absence of education, the average consumer would be unlikely to attribute any trade mark significance to the sign; instead they would perceive the shape of the packaging as nothing more than a property of the goods, including when shown on the outer packaging of the product. Specifically, the average consumer would view the shape as an aesthetically pleasing container but importantly, they would be unlikely to perceive that they are being presented with a trade mark.
35. As such, while I accept that the sign departs significantly from the norms and customs of the relevant sector, in accordance with UK authorities I find such features do not convey, in and of themselves, trade mark distinctiveness in the prima facie; it would need education in my opinion for such a sign to function as a guarantee of origin.

## **Conclusion**

36. In this decision, I have considered all documents filed by the applicant, and all the arguments submitted to me in relation to this application. Having done so, and for the reasons given above, the application is refused because it fails to qualify under Section 3(1)(b) of the Act.

**Dated this 16<sup>th</sup> Day of January 2025**

**Darren Smith  
For the Registrar  
Comptroller General**