

## **TRADE MARKS ACT 1994**

### **IN THE MATTER OF APPLICATION MO 2162950 BY TY NANT SPRING WATER LTD TO REGISTER A TRADE MARK IN CLASS 32**

#### **DECISION AND GROUNDS OF DECISION**

On 1 April 1998, Ty Nant Spring Water Limited of Bethania, Llanon, Ceredigion, SY23 5LS applied under the Trade Marks Act 1994 to register the trade mark shown below in Class 32 of the register in respect of “Bottled water; bottled mineral water; bottled spring water; bottled carbonated water.”

“The trade mark consists of a blue bottle of optical characteristics such that, if the wall thickness is 3mm, the bottle has, in air, a dominant wavelength of 472 to 474 nanometres, a purity of 44 to 48%, an optical brightness of 28 to 32%”

The form of application included the following statement:

“The trade mark is defined in terms of characteristic optical properties”

Objection was taken to the application under Sections 3(1)(a) and (b) of the Act because the mark is not graphically represented and is considered to be devoid of any distinctive character, eg devoid of any distinctive character for drinks sold in blue bottles.

At a hearing, at which the applicants were represented by Mr Austin of Urquhart-Dykes & Lord, their trade mark agents, the objections were maintained and the application was refused in accordance with Section 37(4) of the Act.

Following refusal of the application under Section 37(4) of the Act I am now asked under Section 76 of the Act and Rule 56(2) of the Trade Marks Rules 1994 to state in writing the grounds of my decision and the materials used in arriving at it.

No evidence of use has been put before me. I have, therefore, only the prima facie case to consider.

Section 3(1)(a) & (b) of the Act are set out below:

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

(a) signs which do not satisfy the requirements of Section 1(1),

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

Section 1(1) of the Act reads as follows:

1-(1) In this Act a “trade mark” means any sign capable of being represented graphically which is capable of distinguishing the goods or services of one undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.

### **Section 3(1)(a)**

At the hearing, Mr Austin said that the definition of the mark is very specific and argued that the mark, as defined, is clearly represented. Mr Austin also referred to the dictionary meaning of the words “Graphical” and “Representation” and argued that as a consequence the mark must be graphically represented because it is a mark that is defined by words alone.

I was not persuaded by these arguments and the objections were maintained.

The Registrar’s practice in relation to acceptable forms of graphical representation is set out in Chapter 6 of The Registry’s Work Manual, at page 18, and is reproduced below:

“In the Registrar’s view a sign is graphically represented when:

- a) it is possible to determine from the graphical representation precisely what the sign is that the applicant uses or proposes to use without the need for supporting examples etc;
- b) the graphical representation can stand in place of the sign used or proposed to be used by the applicant because it represents that sign and no other;
- c) it is reasonably practicable for persons inspecting the register, or reading the Trade Marks Journal, to understand from the graphical representation what the trade mark is.”

Firstly, I do not believe that it is possible to determine, from the representation filed, precisely what the mark is. One fundamental problem is that the mark is initially described as “- a blue bottle -” and the use of the word blue without further qualification immediately brings to mind the problems associated with the graphical representation of such marks. The Registrar’s practice in relation to the graphical representation of colour marks is set out in Chapter 6 of The Registry’s Work Manual, at page 20, and the relevant section is reproduced below:

“It is recommended that applications to register a sign consisting of:-

- a) colour(s) applied to the goods, their packaging or to advertising materials or business premises
- b) a device and/or word in colour(s)

- should be filed with the trade mark shown in the appropriate colour(s).

Applications to register colours represented purely in words, such as “the colours brown and red”, will be regarded as too vague to form a graphical representation of the sign.

The Registrar will not object to colour(s) represented in words, **provided** that the colour(s) is (are) properly defined by a **widely known and readily available** colour standard.”

It is clear that the words “blue bottle” are too vague for the mark to be graphically represented. Even if the colour of the bottle was precisely defined the word bottle may be taken as a reference to any bottle of any shape or of any dimension. This lack of definition is further accentuated by the inclusion of the words “- if the wall thickness is 3mm -”. It is clear from the inclusion of these words that the precise technical terms that follow this part of the definition will only be relevant if the wall thickness of the bottle is 3mm. There is nothing in the definition which states that the wall thickness of the bottle will be 3mm, nor is there any indication as to what the effect would be if the wall thickness of the bottle was anything but 3mm. It is clear that this attempt to define the colour of the bottle by reference to such terms must fail as they are dependent on the bottle having a wall thickness of 3mm. In my opinion it is not possible to determine from the representation filed exactly what the sign is without the need for supporting examples.

Secondly, I do not consider the description is capable of standing in place of the sign used or proposed to be used, by the applicants because it represents that sign and no other. The description applied for could relate to any bottle of any shape and, although it is difficult to be sure, probably a range of blue colours.

Thirdly, it is not reasonably practicable for persons inspecting the register, or reading the Trade Marks Journal, to understand from the graphical representation what the trade mark is. The precise colour and shape of the bottle are not defined. There may be some who are familiar with the terms used in the description of the sign and would understand precisely what the colour would be if the wall thickness of the bottle was 3mm, but even they would be unable to determine the actual shape of the bottle. It is important to note that the goods are relatively inexpensive, and are those purchased in the normal course of consumer shopping by ordinary members of the public. In my opinion such members of the public would not be able to determine either the colour or the shape of the bottle. It is my view that people viewing the description on the Register or seeing it in the Trade Marks Journal are, in all probability, likely to interpret it differently or fail to interpret it at all.

At the hearing Mr Austin referred to the dictionary meaning of the words GRAPHICAL and REPRESENTATION and sought to persuade me that the mark, as presented on the form of application, must be graphically represented because the mark is presented in words only.

Collins English Dictionary (Third Edition Updated 1994) provides several meanings of the word GRAPHICAL, the most pertinent being:

- adj. 1. vividly or clearly described: *a graphic account of the disaster.*
- 2. of or relating to writing or other inscribed representations: *graphic symbols.*

The same dictionary provides the following relevant meaning of the word REPRESENTATION:

- n. 1. the act or an instance of representing or the state of being represented.
2. anything that represents, such as a verbal or pictorial portrait.
3. anything that is represented, such as an image brought clearly to mind.

Whilst one of the dictionary definitions of GRAPHICAL indicates that it relates to written matter it is clear that the primary meaning of this word is “vividly or clearly described.” The meaning of REPRESENTED is self evident.

It is clear from these references that to be graphically represented, the representation of the mark on the form of application must provide a clear description of the sign so that it is possible to determine from that representation precisely what the sign is. In my view the mark, as applied for, does not meet this requirement.

For all these reasons, I therefore conclude that the mark is not graphically represented, and so does not satisfy Section 1(1) of the Act, and as a consequence it is debarred from registration by Section 3(1)(a) of the Act.

Since I have found that the application fails to meet the requirements of Section 1 of the Act I do not need to go on to consider the objection under Section 3(1)(b) . However, in the event that I am found to be wrong under Section 1(1), I will do so.

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

Section 3(1)(b) bars registration of “marks which are devoid of any distinctive character”.

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

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

The representation of the mark on the form of application starts with the words “The trade mark consists of a blue bottle” and then goes on to provide further details of the characteristics of the colour of the bottle if the bottle has a wall thickness of 3mm. Although the mark is not graphically represented it is, nevertheless, clear from these words that the mark is a bottle coloured blue.

The goods of this application consist of various types of bottled water. Such goods are usually sold in bottles made from plastic or glass. Bottles containing water may be made from clear materials but it is also likely that such bottles may be produced from materials that are of a particular colour. There are, of course, a finite number of colours, and the Registrar has always taken the view that applications to register a single colour, especially when applied to packaging, will need to be supported by strong evidence showing that the public would expect goods sold under that particular colour to be the goods of one trader. I have already stated that no such

evidence has been submitted and I do not consider that the public would, without education, regard this sign to be an indication of origin of the goods. I therefore conclude that the sign is also debarred from registration by virtue of Section 3(1)(b) of the Act.

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

Dated this 12      Day of October 1998

A J PIKE  
For the Registrar  
The Comptroller General