

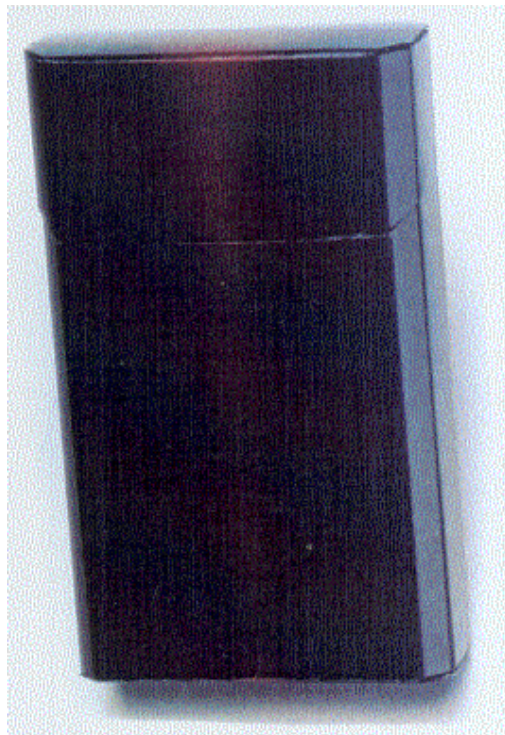
**TRADE MARKS ACT 1994**

In the matter of application no.2031898  
by Reetsma Cigarettenfabriken GmbH  
to register a Trade Mark in Class 34

## **TRADE MARKS ACT 1994**

### **IN THE MATTER OF APPLICATION TO REGISTER TRADE MARK NO 2031898 IN CLASS 34 IN THE NAME OF REETSMA CIGARETTENFABRIKEN GMBH**

On 25 August 1995, Reetsma Cigarettenfabriken GmbH of Parkstrasse 51, D22605, Hamburg, Germany, applied under the Trade Marks Act 1994 to register the trade mark shown below in respect of "Tobacco; tobacco products; cigarettes; smokers' articles; matches."



The mark is to be limited to the colours red-brown and red under Section 13 of the Act.

Objection was taken to the application under paragraphs (a), (b) and (c) of Section 3(1) of the Act. In their letter of 18 January 1996 the applicants asked that the specification of goods be limited to "Tobacco; tobacco products; cigarettes; matches.", and in their letter of 24 June 1997 that the specification be further limited to "Cigarettes".

Following a hearing at which the applicants were represented by Mr David Peters of Dr Walther Wolff & Co, their trade mark agents, the objections were maintained. Following refusal of the application under Section 37(4) of the Act, I am now asked under Section 76 of the Act and Rule 56(2) of the Trade Marks Rules 1994 to state in writing the grounds of 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) & (c) of the Act reads as follows:

**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
- (c) trade marks which consist exclusively of signs or indications which may serve, in the trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or rendering of services, or other characteristics of the goods or services.

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

**1-(1)** In this Act “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 1(1) of the Act makes it clear that signs consisting of the shape of packaging for goods are capable of being registered as trade marks, but only where it is considered to be capable of distinguishing the goods of the applicant from those of similar undertakings. The sign applied for is a representation of packaging, in this case, a packet intended to contain cigarettes. In considering such signs under Section 3(1)(a), the registrar will have regard to whether it consists *exclusively* of the usual shape of the packaging and will raise an objection to those which he considers are incapable of distinguishing the applicants' goods.

In this particular case, the registrar maintained that the shape was not novel and in itself was incapable of distinguishing the applicants' goods. However, on the application form the sign is represented in colour, which the applicants by limiting the sign to those colours have claimed as a feature of the mark. Consequently the sign cannot consist exclusively of the usual shape of packaging and in my view is, as Geoffrey Hobbs sitting as the Appointed Person in the AD2000 trade mark case (1997) RPC 174 said “..capable to the limited extent of not being incapable of distinguishing..”.

There is also the matter of the objection raised under Section 3(1)(c). Insofar as all packaging must in some way relate to the goods it is intended to contain, I do not consider that this constitutes a characteristic of the goods, otherwise all signs consisting of the shape of packaging would be *prima facie* devoid of any distinctive character regardless of their invention or novelty.

Although the objections under Section 3(1)(a) and (c) were not formally waived at the hearing, in view of my earlier comments, the objections based on Sections 3(1)(a) and 3(1)(c) should be considered as having been waived. This leaves the matter of the objection under Section 3(1)(b) of the Act.

It is established that a sign may qualify as a trade mark under Section 1(1) of the Act, but nonetheless be barred from prima facie registration by Sections 3(1)(b)(c) or (d). In the AD2000 trade mark case referred to earlier, Mr Geoffrey Hobbs described the relationship between these sections in the following terms:

“The proviso to section 3(1) indicates that the essence of the objection to registration under Section 3(1)(b) is immaturity: the sign in question is not incapable of distinguishing the goods or services of one undertaking from those of other undertakings, but it is not distinctive by nature and has not become distinctive by nurture.”

The objection under Section 3(1)(b) of the Act was taken because, even if the sign was capable of being a trade mark, it was unlikely to be regarded as such without first educating the public to the fact. Mr Peters explained that the shape is that of a packet which was to contain cigarettes. He referred to the chamfered edges of the shape which he contended gave the packet a highly stylised appearance, and argued that in combination with the colours created a mark which was not devoid of any distinctive character. In the TREAT trade mark case (1996) RPC 296 Jacob J considered the question “What does devoid of distinctive character mean?” and said:

“... 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.”

Cigarettes come in a small number of standard sizes and are usually packaged in quantities of either 10 or 20 to a pack. That being the case, there is nothing in the size of the packet to differentiate the cigarettes of one trade from those of another. Mr Peters provided an example of a pack from another brand of cigarettes to illustrate the “usual” shape of the packaging. He also drew my attention to registered design number 1022574, which he claims is for “a lower, wider pack, but embodies the unique canted edges.”

In Mr Peters submissions, the subject matter of the trade mark makes “a conventional pack style look somewhat untidy and dated”. In essence the applicant claims that the canted edges of the packets are unique, that the shape improves the appearance for the goods, that the eye appeal of the shape is reflected in a registered design - which is evidence that the shape is distinctive.

I reject that submission. It is of course the case that a registered design may also be a trade mark. However, the subject matter of a registered design is the eye appeal of the shape or design in question. The subject matter of a registered trade mark is the characteristic (or characteristics) which identifies the trade origin of the goods or services for which it is registered. The presence of design features with an aesthetic appeal will not necessarily result in a shape with the necessary trade mark character. In simple terms, shapes which appear to be dictated by aesthetic considerations do not necessarily identify the origin of the goods or services.

It is also appropriate to consider the manner in which cigarettes are offered for sale by the retailer, and selected by the consumer. Because of the age restrictions on the purchase of cigarettes, they are not a self-service item, being almost invariably displayed away from the reach of the purchaser and selected on request by a sales assistant behind a counter. Potential purchasers will view the packet front-on and from a distance which would make the chamfered edge difficult to see. In

the Court Of Appeal in the Procter & Gamble Limited case (CHANF 97/1203/3), Lord Justice Robert Walker said:

“Product A and Product B may be different in their outward appearances and packaging, but if the differences become apparent only on close examination and comparison, neither can be said to be distinctive (unless, of course, one constitutes an unlawful infringement of some existing registered trade mark)”

The sign is limited to colour, and thereby the colours become a feature to be taken into account in determining the distinctiveness. Cigarette packets come in a wide range of colours and designs, although to my knowledge (and as in the example provided by Mr Peters) usually bear some other sign by which to distinguish the goods. While the colours may come to be recognised and associated with a particular cigarette, in my view unless the colours appear to be more than mere decoration, the association with one trader is only likely to come about through substantial use of the mark, and even then the “association” may not be sufficiently firm to amount to recognition of the colour(s) as a trade mark.

Trade marks should of course be considered as a whole and I must consider whether the combination of the shape and colour is devoid of any distinctive character. In the Procter & Gamble Limited case mentioned above, Lord Justice Robert Walker considered the comments of Jacob J in the TREAT trade mark case and went on to say:

“Despite the fairly strong language of Section 3(1)(b), “devoid of any distinctive character”, and Mr Morcom emphasised the word - “any” - that provision must in my judgement be directed to a visible sign or combination of signs which can by itself readily distinguish one trader's product - in this case an ordinary, inexpensive household product - from that of another competing trader.”

and

Like the hearing officer and the Judge, I see nothing inherently distinctive about three bottles which were the subject-matter of Procter & Gamble's applications. Taking three elements together - shape, “ghosted” label and colours - and treating them in combination I find that they are not distinctive but typical of the get-up of products used for cleaning different kitchen and bathroom surfaces. Typical, that is in every respect except there is no identification by any distinctive product name or device.”

It is clear that a combination of non-distinctive elements can create a distinctive whole, although I do not consider that to be the position with this mark. The public are well used to seeing highly coloured packaging of this sort of shape, which, to quote Lord Justice Walker, is “typical of the get-up” (in this case used for cigarette packaging) “except that there is no identification..”. I take the view that the consumer will regard the mark as no more than it is; decoration applied to a vehicle to contain the goods, and not as a trade mark. I therefore consider the sign to be devoid of any distinctive character in the prima facie case.

In this decision I have considered all the documents filed by the applicant and all the arguments submitted to me in relation to this application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Section 5(2) of the Act.

**Dated this 21 day of May 1999**

**MIKE FOLEY  
For the Registrar  
The Comptroller General**