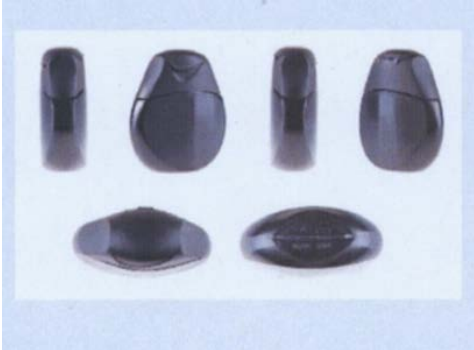


**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION NUMBER 3121849
BY ROBINSONS SOFT DRINKS LIMITED
TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 32:**



**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION NUMBER 3121849
BY ROBINSONS SOFT DRINKS LIMITED
TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 32:**



Background

1. This application was originally filed as a European Union Trade Mark ('EUTM') at the European Union Intellectual Property Office ('EUIPO'), and was awarded a filing date of 10 January 2014. The application faced an objection under Article 7(1)(b) of the Community Trade Mark Regulations ('CTMR') as the mark was said to be devoid of any distinctive character. Despite submissions being made to the EUIPO, the objection was maintained. A request was then made to convert the application into a UK trade mark application.

2. The conversion request was received at the Intellectual Property Office ('IPO') on 5 August 2015. It confirmed that Robinsons Soft Drinks Limited ('the applicant') had applied to register the above mark for the following goods:

Class 32: Non-alcoholic beverages; cordials (non-alcoholic beverages); squashes (non-alcoholic beverages); concentrates and dilutes; carbonated non-alcoholic drinks; mineral and aerated waters; fruit drinks and fruit juices; slush drinks; tablets or preparations for making effervescent non-alcoholic drinks; syrups, concentrates, powders, tablets, essences and/or other preparations for making beverages.

3. On 2 September 2015, the application was examined at the IPO. The corresponding IPO Examination Report presented an objection in the following terms:

"The application is not acceptable in Class 32. There is an objection under Section 3(1)(b) and (c) of the Act. This is because the mark consists exclusively of a 3 dimensional device of a container being a sign which may serve in trade to designate the kind of the goods e.g. containers for cordials, squashes, fruit drinks, mineral and aerated water.

The average consumer would not be able to distinguish the goods from one trader to another therefore it cannot act as a badge of origin or function as a trade mark.”

4. Further time in which to address the objection was requested by the representative on 28 October 2015. In her reply to that request, dated 29 October 2015, the examiner granted additional time but also advised that the grounds for objection had been reassessed and the objection under section 3(1)(c) had been waived. The section 3(1)(b) objection was maintained, although it was revised as follows:

“The application is not acceptable in Class 32. 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 consists of a 3D representation of a non-distinctive receptacle or container for the goods listed. As such the average consumer is unlikely to pay any trade mark significance to the mark when encountered in the context of the goods in question.”

5. In response, the applicant supplied two witness statements. The first, by Mr Kasey McPherson of Britvic plc (the applicant’s parent company) was dated 29 June 2016. The statement can be summarised as follows:

- Mr McPherson made reference to previous UK trade mark application number 3037368, which was filed at IPO on 10 January 2014 in respect of the same container shape. That application had been withdrawn on 21 August 2015 following an unsuccessful appeal to the Appointed Person;
- He referred to that earlier application as having been subject to an ex parte hearings where evidence of other similar shapes had been considered;
- He sought to clarify the position regarding first use of the mark and of competitors’ similar products, as these factors may have unfairly and erroneously influenced the previous Hearing Officer’s decision to maintain the objection;
- He emphasised that the use of similar shapes by third parties, as referred to by the previous Hearing Officer in 3037368, had all post-dated the applicant’s first use.

6. The second witness statement was from Ms Louise Thompson (Senior Consumer Innovator at Robinsons Soft Drinks Limited) who confirmed:

- The applicant is at the forefront of packaging innovations according to the British Soft Drinks Association (BSDA);
- The applicant is the largest supplier of soft drinks in the United Kingdom and the company works with different agencies regarding the reduction of packaging waste;
- In 2014, the most popular method of packaging was PET (polyethene terephthalate) and these materials were used in 69% of packaging;

- The industry promotes use of a process called 'lightweighting'. This ensures fewer materials are used for packaging and manufacturing;
 - The goods intended for protection are super-concentrated drinks products that can be used without expensive mixing equipment, and which are aimed at the general public. They can be added to water to create a flavoured drink quickly, and without any mess;
 - There are no similar sized products on the marketplace;
 - The colour of the container was not one used by others in the sector;
 - The shape of the container, although appearing to be simplistic, actually contains a number of engineered design features;
 - Exhibits 4-34 of her witness statement compared and contrasted the applicant's product to those of the competitors in the industry.
7. The examiner replied in correspondence dated 10 August 2016. In her letter, she noted that the container was unlike other shapes in the marketplace at the time of filing, but also emphasised that that fact alone was not deemed sufficient to demonstrate that the mark was inherently distinctive. She stated that the appearance of the three-dimensional shape would not convey trade mark significance without the average consumer first being educated that the mark was there to serve such a purpose. The objection under section 3(1)(b) was therefore maintained.
8. A request for an *ex parte* hearing was submitted on 12 August 2016.
9. The hearing was held on 3 October 2016 where the applicant was represented by Mr Steven Jennings of Lewis Silkin LLP. Mr Jennings' submissions can be summarised as follows:
- There are approximately 14 billion litres of drinks sold annually in the UK, and there are no similar containers competing in the marketplace;
 - The applicant was the first to provide super concentrated dilute soft drinks to consumers for the purpose of being portable and easily accessible
 - By way of her witness statement and exhibits, Ms Thompson provided an overview of other containers in use on supermarket shelves and she confirmed that the shape applied for is not in use by others;
 - The mark's unique visual identity would be capable of indicating trade origin as it is different in concept, shape, colour and closure to any other container.
10. In my hearing report of 1 November 2016 I concluded that:

- Assessment of a mark's distinctiveness must take into account both the nature of the goods claimed and the likely immediate perception of the relevant consumer using those goods. Whilst I agreed that it is not appropriate to apply more stringent criteria when assessing the distinctiveness of a three-dimensional shape compared to when assessing other categories of marks, the average consumer is not used to making decisions in relation to the origin of goods based on the appearance of the container alone;
 - Although it had been demonstrated in the evidence and exhibits provided by Ms Thompson that there is no one standard shape for the packaging of soft drinks, and that there are a large number of different sized shapes currently being used, the mere 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 fact that the shape of the container is not in use by other traders, and that the colour of the container is different to others, does not mean that the average consumer would immediately perceive the shape as being an indicator of trade origin in the *prima facie* case.
 - Given the wide variety of shapes available for the packaging of soft drinks, it was my view that the average consumer of the goods in question would not attach any trade mark significance to the mark without first being educated that it was there to serve such a purpose. The mark is not capable of distinguishing the goods of one individual trader from those of other traders.
11. On 14 December 2016, the representative filed a Form TM55 'Notice of Appeal to The Appointed Person'. However, as the application had not - at that point - been formally refused, the representative was informed that the application would need to be refused *before* any appeal against the refusal could be filed.
12. On 4 January 2017, the notice of formal refusal was issued.
13. On 6 January 2017 the IPO received a Form TM5 requesting a statement of reasons for the Registrar's decision. As a result, I am now required to set out the reasons for refusal. No formal evidence has been put before me for the purposes of demonstrating acquired distinctiveness. Therefore, I have only the *prima facie* case to consider.

Decision

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

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

(a) ...

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

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 Court of Justice of the European Union ('CJEU', formerly 'ECJ') has repeatedly emphasised the need to interpret the grounds for 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 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 *Celltech R&D Ltd v OHIM*, C-273/05P).
16. 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 (see paragraph 23 of the above-mentioned judgement). Marks which are devoid of any distinctive character are incapable of fulfilling that essential function. Section 3(1)(c), on the other hand, pursues an aim which reflects the public interest in ensuring that descriptive signs or indications may be freely used by all (*Wm Wrigley Jr v OHIM*, 'Doublemint', C-191/0P, paragraph 31).
17. The question then arises as to how distinctiveness is assessed under section 3(1)(b). Paragraph 34 of the CJEU Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* ('Postkantoor') reads as follows:

"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 C-55/01 Linde and Others 5 [2003] ECR I-3161, para 41, and Case C-104/01 Libertel [2003] ECR I-3793, paras 46 and 75)."
18. So the question of a mark being devoid of any distinctive character is answered by reference to the goods and services applied for, and the perception of the average consumer in relation to those goods or services.
19. The sign applied for is a three-dimensional representation of the shape of a container. The suitability of such signs for registration as trade marks was considered in *Henkel KGaA v Deutsches Patent-und Markenamt* (C-218/01) and *Henkel KGaA v Office for Harmonisation in the Internal Market* (C-456/01) where the CJEU provided guidance on section 3(1)(b) as follows:

"49. It follows that a simple departure from the norm or customs of the sector is not sufficient to render inapplicable the ground for refusal given in Article 3(1)(b) of the Directive. In contrast, a trade mark which significantly departs from the norm or customs of the sector and thereby fulfils its essential origin function is not devoid of distinctive character.

50. That distinctive character of a trade mark within the meaning of Article 3(1)(b) must be assessed by reference, first, to the goods or services in respect of which registration is sought and, second, to the perception of the relevant persons, namely the consumers of the goods or services. That means the presumed expectations of an average consumer who is reasonably well informed and reasonably observant and circumspect.

...

52. In any event, the perception of the average consumer is not necessarily the same in the case of a three-dimensional trade mark, consisting of the packaging of a product, as it is in the case of a word or a figurative mark which consists of a sign that is independent from the appearance of the goods it denotes. Average consumers are not in the habit of making assumptions about the origin of goods based on 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 the case of such a three dimensional trade mark than in the case of a word or figurative mark.

53. In view of the foregoing considerations, the answer to the second question must be that, for three-dimensional trade marks consisting of the packaging of good which are packaged in trade for reasons linked to the very nature of the product, their distinctive character within the meaning of Article 3(1)(b) of the Directive must be assessed by reference to the perception of the average consumer of such goods, who is reasonably well informed and reasonably observant and circumspect. Such a trade mark must enable such a consumer to distinguish the product concerned from those of other undertakings without conducting an analytical or comparative examination and without paying particular attention."

20. On the basis of the guidance presented above, it is clear that any assessment of a mark's distinctiveness must take into account both the nature of the goods claimed, and the likely immediate perception of the relevant consumer using those goods. In the case of non-alcoholic beverages and, more specifically, cordials and squashes, the average consumer will be the general public - likely to be reasonably observant and circumspect, but unlikely to spend a great deal of time considering the outward appearance of the container prior to purchase. The goods concerned are not highly specialised, but rather everyday items that the average consumer is likely to purchase quickly and without conducting any prior research or detailed investigation. In my view, potential purchasers of squashes, cordials etc. are likely to rely on features such as a 'house' trade mark and/or other markings such as those indicating products type or flavour, rather than base their purchasing decision on container shape.

21. Annex A provides an extract from 'The Grocer' publication dated 30 November 2013. This was provided as Exhibit 4 of Mr McPherson's witness statement (see paragraph 5 above) and it provides an indication of how the product would be seen by the average consumer at the point of sale. The container is designed to hold a smaller amount of liquid than the standard sizes of 750ml and 1 litre, as commonly used for this type of product. The container is 7cms high, it contains 66ml of liquid, and is small enough to fit into the palm of one's hand. It is reasonable to speculate that the container could be stored in a pocket or bag for ease of use when travelling and/or outside of the home.
22. As confirmed in relevant case law, and already emphasised in my earlier *ex parte* Hearing Report (see first bullet point at paragraph 10 above), I agree that it is not appropriate to apply more stringent criteria when assessing the distinctiveness of a three-dimensional shape compared to when assessing other categories of marks. However, the average consumer is not used to making decisions relating to the origin of goods based on the appearance of the container alone. It has been demonstrated in the evidence and exhibits provided by Ms Thompson that there is no one standard size or shape for the packaging of soft drinks, and that there are a great number of different-sized shapes currently being used. This variation and variety in the form of soft drink containers actually points away from shape being an immediate indicator of origin because, on the basis of information provided by the applicant, the consumer will already be accustomed to seeing a number of such shapes performing a purely functional role, namely to act as a container for liquid.
23. At the hearing I was also referred to the decision of Laddie J in the 'Yakult' bottle case (RPC 2001/39) as being supportive of *prima facie* acceptance. In response, I would refer to Laddie J's comments at paragraphs 10 and 11 of that decision:

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.

11. Mr James came to the conclusion that the average consumer was likely to conclude that the design in the applications was nothing more than a bottle of pretty ordinary shape. I agree. Like Mr James, I can see nothing which would convey to someone who was not a trade mark specialist that this bottle was intended to be an indication of origin or that it performed that function. Even were it to be recognised

as of different shape to other bottles on the market, there is nothing inherent in it which proclaims it as having trade mark significance.

24. In that case, it was clear that the container in question was not a shape currently being used in trade, by others, at the time of filing. However, Laddie J confirmed that the relevant question is not whether the container is unique or unused at the time of filing, but whether the shape itself is understood as conveying trade mark significance to the average customer. It is my view that this would not be the case here. The goods under consideration are low value, and are not of a type where the average consumer would spend time to consider in any depth, nor be likely to undertake research prior to purchase. It is common in the non-alcoholic drinks sector for products to be available in different sizes, with smaller containers being marketed on the basis of their convenience for use in, say, lunch boxes, or on their general portability (for example, when participating in sports and leisure pursuits). The use of a smaller container, which provides a more convenient quantity of squash or concentrate for use outside of the home, would be seen by the average consumer as nothing more than a product development which follows in the established traditions and customs of the trade. In my view, no trade mark significance would be apportioned to the product based on the size or shape of the container alone.
25. I would also refer to the more recent decision by Mr Justice Arnold in *London Taxi Corporation Ltd trading as the London Taxi Company* (2016 EWHC 52Ch) where, at paragraph 170, he confirmed the following:

170. In Bongrain SA's Trade Mark Application [2004] EWCA Civ 1690, [2005] RPC 14 Jacob LJ, with whom Potter and Longmore LJ agreed, said:

"25. ...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 semi descriptive 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).

...

27. ...Even if the shape of the goods themselves is indeed fancy, that is not enough to entitle a would-be trader in them to registration as a trade mark. (I say would-be because one is here working on the hypothesis of an unused mark.) Although a trade mark may also be a design, there are real differences between creating a fancy shape to sell as such and a fancy shape which truly in itself will denote trade origin if used. 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."

26. The shape of the container in question is *not* one of the many variant shapes of containers referred to in the exhibits accompanying Ms Thompson's witness statement of 28 June 2016. However this is not a determinative factor. The mere fact that a container is different does not *per se* mean that it will be taken by the public as an indication of origin. I acknowledge that the colour of the container is not one which is commonly used in trade, but it is my view that the average consumer would not make a purchase based purely on the colour aspect. I also acknowledge that the container's size might make it more aesthetically attractive to the average consumer, but I still consider the size to be a functional aspect on the basis that it allows the consumer to purchase a smaller quantity of the goods. Small size containers are commonly used in the drinks sector for a wide variety of non-alcoholic products and the container would not be seen as capable of performing the role of a trade mark namely to indicate origin from a single trade source.
27. Having considered the mark as a whole and the likely perception of the average consumer, it appears to me that the overall impression created by the sign is not one capable of indicating the origin of the goods in the *prima facie* case.

Conclusion

28. In this decision, I have considered all documents filed by the applicant and all 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) for all of the goods claimed.

Dated this 27th day of July 2017

Carol Bennett
For The Registrar
The Comptroller General

Annex A

Exhibit 4 of Witness Statement of Mr Kasey McPherson:



6/16/2016

Britvic predicts £200m category for super-concentrate

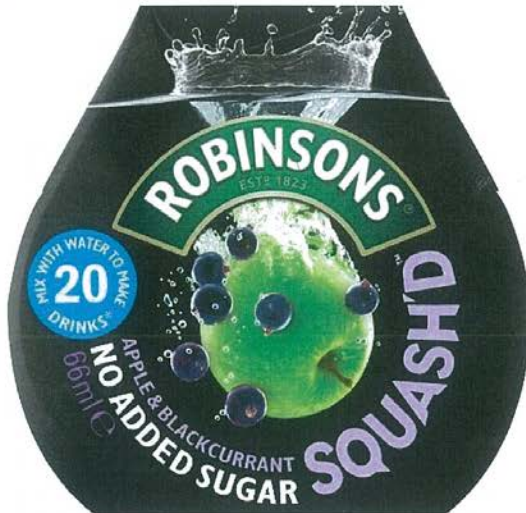
The Grocer

Get more with Gold Membership

Join now and save £23.20

Sign up

Britvic predicts super-concent



30 Nov 2013 |Vince Bamford

Britvic is hoping to create a £200m category with the launch of super-concentrated squash that can make 20 drinks but fits in the palm of a hand.

Robinsons Squash'd is sold in a 7cm high bottle containing 66ml of liquid - but makes the same amount of squash as a standard one-litre bottle. It is designed to be carried in a pocket or handbag and squeezed into a 500ml bottle or glass of water to make up to 20 drinks.

Squash'd will roll out to Tesco in January in three flavours- summer fruits, apple & blackcurrant and orange & peach - and will be in full retail distribution by March. The flavours are aimed at a target market of 25 to 35-year-olds - an age when consumers often drop out of the squash market - while the portable format, which features a valve and flip-top cap to prevent spills, is designed for the office, on the go or at home.

The product is set to tap into rising consumer demand for flavoured waters, which have grown 8.9% by value year on year while the squash market has grown 4.3% [Nielsen 52 w/e 16 November 2013].

Squash'd will sell at a considerable premium to standard, at an rsp of £2.49 compared with the £1.49 rsp of a one-litre bottle of Robinsons.

Britvic has high hopes for "portable pocket squash", which it said had grown to \$300m in the US in two years following the success of products such as Mio and a Kool Aid liquid.

"We estimate portable pocket squash could become a £200m category in five years," said Helen Gorman, brand controller for Robinsons. "We would expect to see other suppliers launch into this market, including private label."

Gorman said a bespoke fixture had been developed for the range as had shelf-ready packaging. The launch will be supported with promotions and a "multimillion" marketing campaign.

READERS' COMMENTS (2)

• Lynda Bøwmer | 09 Apr 2014

I'm delighted with this product. I prefer soft non fizzy drinks and only purchase squash. I can now take this on the plane and buy plain water. It will save me a fortune.

Thanks for this

• arron pearson | 13 Apr 2014

Woop'wooop plink'plink fizza. Ahhhh