

Suggested Answers to the Questions in Chapter 11

1. Why are geographical names excluded from registration as UK trade marks according to s. 3(1)(c) TMA?

The good answer will:

- Start by explaining that s.3(1)(c) lays down an absolute ground for refusing the registration of geographical names.
- Indicate that the meaning of ‘geographical name’ was explained by the ECJ in Cases C-108/97 and 109/97 *Windsurfing Chiemsee Produktions und Vertriebs GmbH v Boots und Segelzubehor Walter Huber* [1999] ECR I-2779 at [31–35]. It means that consumers currently associate the name with the place where the goods come from.
- Explain that a ‘fanciful’ geographical name (such as ‘North Pole’ for bananas) can always be registered because consumers are unlikely to believe that those goods originate from that location. Equally registrable are names of places which consumers do not (and are unlikely to) associate with the goods.

Relevant cases that can be discussed are Case T-379/03 *Peek & Cloppenburg KG v OHIM* [2005] ECR II-4633; *Berkshire and Hartley LLP’s Trade Mark Application*, No.3107552.

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2. Under which conditions are marks considered to be devoid of distinctive character by virtue of s. 3(1)(b) TMA?

The good answer will:

- Indicate that s.3(1)(b) prohibits the registration of trade marks that are devoid of any distinctive character. According to Jacob J in *British Sugar* (at p. 306), 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?’ In other words, is the mark inherently distinctive?
- Explain the rationale for this requirement, which was first set out in *Libertel*, where the Benelux court asked about the registrability of the colour orange for telephone equipment and services. The Court of Justice said that the public interest was aimed at the need not to restrict unduly the availability of *colours* for other traders in the same field of business (the Court did not refer to ‘trade marks’ generally).
- Explain the test in ascertaining whether a mark is devoid of distinctive character is the concrete test, confirmed by the ECJ in *Philips v Remington*. The mark is considered in relation to the list of goods and services on Form TM3 through the eyes of the reasonably attentive consumer. Does such a person regard the sign as a trade mark, taking into account all the relevant circumstances, remembering that the average consumer will make an overall assessment of the mark? The concrete test, dependent as it is upon consumer perception, helps to explain why, even though s. 3(1)(b) is to be applied in an identical manner to all types of mark, certain signs (shapes, colours, sounds and smells) are more likely to be found lacking in inherent distinctiveness.
- Discuss cases that have developed the concept of distinctive character, such as Case T-305/02 *Nestlé Waters France v OHIM* [2003] ECR II-5207; Cases C-53/01, 54/01 & 55/01 *Linde AG, Winward Industries Inc & Rado Uhren AG v Deutsches Patent- und Markenamt* [2003] ECR-I 3161, Case C-404/02 *Nichols plc v Registrar of Trade Marks* [2004] ECR I-8499, etc.
- Elaborate on how the test of distinctiveness has been applied by reference to specific types of marks, e.g. unconventional marks, composite marks, etc. by reference to relevant case law.

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3. What is the rationale behind the exclusion of marks that have become customary in the current language, or in the *bona fide* and established practices of the trade by virtue of s. 3(1)(d) TMA?

The good answer will:

- Indicate that according to s. 3(1)(d), a mark will be refused registration if it has become customary, either in the current language, or in the *bona fide* and established practices of the trade.
- Explain that the public interest of para (d) is, according to the Court of Justice, the same as under para (c), that is, it protects the interests of other traders (Case C-517/99 *Merz & Krell GmbH & Co v Deutsches Patent- und Markenamt*, (*BRAVO*) [2001] ECR I-6959). However, the ECJ, in clarifying the overlap between the two paragraphs, stated that the use of the mark does not have to be descriptive of the goods.
- Explain that, as with all aspects of s. 3, the test is the same, namely the concrete test. The sign is considered in relation to the products listed on Form TM3 through the eyes of the notional consumer: Case C-371/02 *Björnekulla Fruktindustrier AB v Procordia Food AB* [2004] ECR I-5791.

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4. To what extent and under which conditions can absolute grounds be overcome?

The good answer will:

- Discuss the proviso to s. 3(1), which makes clear that marks which are caught by paras (b), (c) and (d) can still be registered where the applicant can show acquired distinctiveness.
- Explain that there is a major exception to these three objections: *Windsurfing Chiemsee*. The proviso is nicely explained by the Appointed Person in *AD2000 Trade Mark* [1997] RPC 168 as the difference between nature and nurture. A mark which began life by being inherently non-distinctive, descriptive or generic can still be registered if after use the relevant customers come to regard it as indicating origin. Such use must be before the application date.
- Discuss relevant case law, such as Cases C-108/97 and 109/97 *Windsurfing Chiemsee Produktions und Vertriebs GmbH v Boots und Segelzubehor Walter Huber* [1999] ECR I-2779.

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5. To what extent can shapes be registered as UK trade marks?

The good answer will:

- Indicate that there are specific absolute grounds, such as the one covering shape trade marks.
- Explain that the ECJ has held, in *Linde*, that s. 3(2) is an independent ground of objection and should be applied first, *before* s. 3(1). In consequence, if an application is rejected under s. 3(2), evidence of acquired distinctiveness will be of no assistance (*Philips v Remington*). Even if the shape does not fall within any of the specific prohibitions in s. 3(2), it still needs to be considered under s. 3(1) to see if it is distinctive, descriptive or common to the trade.
- Explain that the public interest underlying s. 3(2) has been set out by the ECJ. In *Philips v Remington*, relying on its earlier statement in *Windsurfing Chiemsee* about the policy of s. 3(1)(c), the Court said that shapes falling within the wording of the provision had to be left free for all other traders to use. It would seem, therefore, that the policy of s. 3(2) is not about avoiding overlap with patents and designs, but ensuring competitors' freedom of choice.
- Discuss relevant case-law which has focused on shape objections, such as Case T-128/01 *DaimlerChrysler Corporation v OHIM* [2003] ECR II-701 (a car radiator grille) and Case T-460/05 *Bang & Olufsen A/S v OHIM* [2007] ECR II-4207.
- Mention that the recast Directive has expanded the exclusions to registrability beyond shapes. Art. 4(1)(e) states that registration will be refused by reference to signs which consist exclusively of the shape, *or another characteristic*, which results from the nature of the goods themselves; the shape, *or another characteristic*, of goods which is necessary to obtain a technical result; the shape, *or another characteristic*, which gives substantial value to the goods.