

**IN THE HEARINGS AND MEDIATION DIVISION OF
THE INTELLECTUAL PROPERTY OFFICE OF SINGAPORE
REPUBLIC OF SINGAPORE**

Trade Mark Application No. T0618780H
7 March 2011

IN THE MATTER OF A TRADE MARK APPLICATION BY

Societe des Produits Nestle S.A.

Hearing Officer: Ms Tan Mei Lin
Principal Assistant Registrar of Trade Marks

Ms GOOI Chi Duan for the Applicants

Cur Adv Vult

GROUND OF DECISION

1 On 3 May 2006, Societe des Produits Nestle S.A. ("the Applicants") on the basis of International Registration 640537 requested protection in Singapore under the provisions of the Madrid Protocol, the trade mark ("the Application Mark") shown below:



2 The trade mark consists of a three-dimensional shape of a bottle for packaging liquid seasoning. The goods for which protection is sought are "flavours for nutritional purposes" in Class 30.

3 The application met with the objection that the Application Mark is devoid of any distinctive character under section 7(1)(b) of the Trade Marks Act (Cap 332, 2005 Rev Ed) ("the Act").

Applicants' Evidence

4 In an attempt to overcome the objection, the Applicants submitted evidence in the form of a statutory declaration by Amy Ng Sing Fuay ("Ms Ng"). Ms Ng is the Regional Intellectual Property Advisor of Nestle Products Sdn Bhd. Exhibited to Ms Ng's statutory declaration was a document titled "Maggi Bottle – Trademark Survey Final Report" (the "Survey Evidence Report"). The Survey Evidence Report provides the results of a public survey undertaken in 2008 to test the Singapore public's recognition of the Application Mark. The evidence is primarily intended to support the case that the Application Mark had acquired distinctive character through use prior to the date of the application. I will return to this evidence in more detail later. At this stage it is sufficient to set out the primary facts.

5 The Examiner, held that the evidence of use adduced by the Applicants, did not sufficiently establish that the Application Mark had acquired distinctive character. In coming to her decision, the Examiner felt that neither the survey evidence nor the printed publicity material adduced established that the 3D bottle device was capable, on its own, of distinguishing the Applicant's goods from those of other traders.

6 The matter came to be heard on 7 March 2011 following a request for an ex parte hearing by the Applicants. The Examiner's decision was maintained and a decision letter (without grounds) was sent to the Applicants on 10 March 2011. The Applicants requested the grounds of the decision on 15 April 2011.

Applicable Law – Section 7(1)(b)

7 The relevant parts of section 7(1)(b) of the Act are as follows:

"7(1) – the following shall not be registered-

(a) --

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

(c) --

(d) -- "

8 Section 7(1)(b) is identical to Article 3(1)(b) of the European Directive 104/89 (the "Directive") and the following guiding principles have been laid down in cases decided thereunder:

*a. an objection under Section 7(1)(b) operates independently of objections under Section 7(1)(c) – **Linde AG (and others) v Deutsches Patent-und Markenamt** Joined Cases C-53/01 to C-55/01, paragraphs 67 to 68;*

*b. for a mark to possess a distinctive character it must identify the product or service in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product or service from the products or services of other undertakings – **Linde** paragraphs 40-41 and 47;*

*c. a mark may be devoid of distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive – **Postkantoor** paragraph 86;*

*d. a trade mark's distinctiveness is not to be considered in the abstract but rather by reference to the goods or services in respect of which registration is sought and by reference to the relevant public's perception of that mark – **Libertel Group BV v Benelux Merkenbureau** Case C-104/01 paragraphs 72-77;*

*e. the relevant public must be deemed to be composed of the average consumer who is reasonably well-informed and reasonably observant and circumspect – **Libertel** paragraph 46 referring to **Lloyd Schuhfabrik Meyer** Case C-342/97.*

Section 7(1) (b)

9 The principles enunciated in the above cases apply in assessing the distinctive character of any type of mark, including three-dimensional trade marks. In the context of three-dimensional marks, the test to be applied is whether the average consumer would, when encountering the goods sold in the shape put forward for registration, see the shape as a sign that, by itself, guarantees to them the trade origin of the goods.

10 I find that the average consumer of the goods would be the general public at large.

11 Having decided to whom the analysis is made, I next consider the impact that the sign will have when taking into account notional and fair use of the mark. Whilst the test for distinctiveness is the same for shape marks as for any other mark, non-traditional marks may be less readily accepted by the average consumer as indications of trade origin.

12 In *Henkel KGaA v Deutsches Patent – und Markenamt* C-218-01, the European Court of Justice ("ECJ") laid down a test to be applied under Article 3(1)(b) of the Directive in a scenario involving a three-dimensional trade mark consisting of the shape of packaging for goods. The ECJ stated:

"For three-dimensional trade marks consisting of the packaging of goods which are packaged in trade for reasons linked to the very nature of their product, their distinctive character within the meaning of Article 3(1)(b) of Directive 189/04 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."

13 The ECJ, in *Henkel KGaA v OHIM* C-456/01P and C-456/01P, made certain observations on possible differences between consumers perception of three-dimensional and two-dimensional marks:

"The Court of First Instance was also correct in stating that the criteria for assessing the distinctive character of three-dimensional shape-of-products marks are no different from those applicable to other categories of trade mark. It none the less observed that, for the purpose of applying those criteria, the relevant public's perception is not necessarily the same in relation to a three-dimensional mark consisting of the shape and colours of the product itself as it is in relation to a word or figurative mark consisting of a sign which is independent from 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 (see, to that effect, Linde, paragraph 48, and Case C- 218/01 Henkel [2004] ECR I-0000, paragraph 52)."

14 In *Procter and Gamble v OHIM*, Joined Cases, 468-01/482/01, the ECJ said at paragraph 37:

"In those circumstances, the more closely the shape for which registration is sought resembles the shape most likely to be taken by the product in question, the greater the likelihood of the shape being devoid of any distinctive character for the purposes of Article 7(1)(b) of Regulation No 40/94. Only a trade 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 that provision (see, in relation to the identical provision in Article 3(1)(b) of First Directive 89/104, Henkel, paragraph 49)."

15 Whilst there is no specific material on the official file to demonstrate what the norms or customs are in this particular field, I am aware, from my own general consumer

knowledge, that goods of the type sold under the sign are sold in various shapes of container ranging from the most basic and plain type to those that have more detail and design. Those with more detail or design do not necessarily function as guarantees of origin, they may simply be designed in that way to give the product a more attractive feel. Some containers may also have a design element that succeeds in imparting some form of functional purpose such as assisting with grip. In short, there is no single norm or custom for containers in this particular field.

16 The case law instructs me that to function as a guarantee of origin the mark must depart significantly from the norm or customs. The fact that various shapes are used as containers in the relevant field means that a *prima facie* registrable shape mark must at least be relatively unusual in order for it to stand out from the crowd and be seen by the average consumer as more than just another shape that has been placed on the market for the goods in question.

17 Turning to the sign in question, I do not consider that it will not be seen as anything other than just another shape. It does not strike me as being particularly unusual so that the consumer, when they encounter it in use, will see it as a guaranteeing sign of trade origin. It has a basic overall configuration of a bottle with a lid or cap. The applicant submits that the sign in question has an unusual shape by virtue of its narrow round neck and a much larger square body. Further, the applicant highlights the bottle cap, which is yellow and has a sharp tip. These aspects do not strike me as being particularly unusual.

18 An internet search reveals that that competing products are also available in shapes that possess such an appearance, often being used to imbue the bottle with a more attractive feel.

19 I therefore, find that the mark fails the *prima facie* test for registration.

Precedents from Singapore

20 The Applicants have referred me to several shape marks which have been accepted for registration in Singapore. The Applicants submit that each and every proprietor should be given fair and equal treatment with regards to their respective trade mark applications. Nevertheless, the Applicants in their submissions acknowledge that each application is to be considered on its own merits.

21 I do not find the precedents persuasive for reasons set out subsequently.

22 Six out of the eight registrations cited in the Applicants' written submissions are registered as two-dimensional marks and not three dimensional marks. Following the reasoning of the ECJ, quoted in paragraph 10 above, since the relevant public's perception may not necessarily be the same in relation to a three-dimensional mark consisting of the shape and colours of the product itself as it is in relation to a word or figurative mark consisting of a sign which is independent from the appearance of the products it denotes, I do not regard these two-dimensional precedents of relevance to the Applicants' case.

23 The registration T0628934A in Class 3 has been accepted on the basis of acquired distinctiveness. As a finding of acquired distinctiveness is fact dependant, and the facts surrounding acceptance of T0628934A are not before me, the precedent is not relevant in respect of the Application Mark.

24 As for T0718102A, I find that by virtue of the red sombrero, being an embellishment which does not serve a functional purpose and is not commonly used in the industry, the mark is registrable on its own merits.

25 I therefore find these prior registrations of little assistance in determining the outcome of this application.

26 Further, it is trite law that in considering an application for registration, comparison with other marks on the register is irrelevant. I draw support for this from the judgment of Jacob J in *British Sugar* [1996] R.P.C. 281 at 305 where he stated:

"Both sides invited me to have regard to the state of the register. Some traders have registered marks consisting of or incorporating the word "Treat". I do not think this assists the factual enquiry one way or the other, save perhaps to confirm that this is the sort of word in which traders would like a monopoly. In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the registrar to put the marks concerned on the register. It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see e.g. MADAME Trade Mark and the same must be true under the 1994 Act. I disregard the state of the register evidence."

Precedents from other jurisdictions

27 The Applicants have further highlighted that the Application Mark has been registered in numerous other jurisdictions. I do not find this useful or relevant as these jurisdictions would likely have different laws and practices. As for the Hong Kong precedent, I note that the Application Mark was not accepted prima facie there, but rather on the basis of acquired distinctiveness and survey evidence. This precedent thus does not support the Applicants' contention that the Application Mark has inherent distinctiveness. As such, I do not see how any of the precedents assist the Applicants' case or how I can really place any weight on these acceptances when deciding issues relating to an application in Singapore.

The case for registration based on acquired distinctiveness

The Law

28 Section 7(2) of the Act permits acceptance of a mark that is otherwise unacceptable under the provisions of Section 7(1)(b) if it has in fact acquired a distinctive character because of the use made of it. Section 7(2) of the Act provides as follows:

“7.-(2) A trade mark shall not be refused registration by virtue of subsection (1) (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.”

29 The question to be determined here is whether, through the use made of it, the sign applied for has acquired a distinctive character in respect of the goods.

30 It is well established that this question must be asked through the eyes of the average consumer who is reasonably well informed and reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel BV* Case C-342/97 [1999] ECR I-3830 paragraph 26).

31 In *Windsurfing Chiemsee v Boots* (1999) ETMR 585, the ECJ set out the test to be applied in order to determine whether a trade mark has acquired distinctive character under Article 3(3) of the Directive (similar to section 7(2) of the Act). The ECJ held that the national courts may recognise evidence from a variety of sources. The ECJ held:

"In determining whether a mark has acquired distinctive character following the use made of it, the competent authority must make an overall assessment of the evidence that the mark has come to identify the product concerned as originating from a particular undertaking, and thus to distinguish that product from goods of other undertakings." (Para 49)

....

"In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations." (Para 51)

.....

"If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify the goods as

originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied. However, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general abstract data such as predetermined percentages." (Para 52)

32 It is also well established that use does not necessarily equate with distinctiveness. As Morritt L.J. put it in ***Bach Flower Remedies Ltd v Healing Herbs Ltd*** [2000] RPC 513:

".....use of a mark does not prove that the mark is distinctive. Increased use, of itself, does not do so either. The use and increased use must be in a distinctive sense to have materiality."

33 Further guidance on the test to be applied can be gleaned from the ECJ in the ***Philips v Remington Case C-299/99*** where the Court decided that a finding of acquired distinctiveness could only be made where reliable evidence shows that recognition of the mark as indicating the goods or services of one undertaking is as a result of its use as a trade mark. The ECJ, in ***Societe des produits Nestle SA v Mars UK Ltd Case C-353/03***, at paragraph 29, indicated that this later point means "use of the mark for the purposes of the identification, by the relevant class of persons, of the product or services as originating from a given undertaking."

34 Applying the case law to the case at hand, it seems to me that the evidence must show that the sign is taken by the average consumer as a guarantee that the goods originate from a particular undertaking because of the use of the sign for that purpose.

35 Has the mark been used in a manner which has permitted it to fulfil the essential function of a trade mark (which is to guarantee that all the goods offered for sale under it are the responsibility of one undertaking responsible for their quality)? In trade, it is often the case that more than one trade mark is used by a trader to guarantee the trade origin of the goods to the consumer. These are commonly referred to as "secondary" trade marks. It is fair to say that the evidence relied upon by the Applicants demonstrates that the Maggi label is the primary trade mark used to distinguish their goods. Mere use of a particular shape (or other sign) may not be enough to prove that it has acquired a meaning as a secondary trade mark. The less plausible it appears on the face of it that consumers would take the mark in question as serving a trade mark function (such as containers that carry the goods) the more important it is to consider what, if anything, has been done to highlight to the consumer that the mark is a distinguishing sign.

36 The evidence filed does not, in my opinion, demonstrate that anything significant has been done to highlight to the consumer that the mark is a distinguishing sign. In my assessment there is nothing in the evidence to show that the mark applied for has been used in a distinctive manner as a trade mark or promoted as one. It is always used in conjunction with the Maggi name and logo. I acknowledge that there may be some promotional material that might bring the bottle itself to the attention of the consumer, for example, the Health Promotion Board recipe cards which depicts the bottle. However, this does not necessarily equate to the average consumer being educated that the shape itself is a guaranteeing sign of trade origin.

37 In addition to lodging sales turnover and advertising and promotional expenditure, the Applicants also lodged results of a public survey conducted in October 2008 to establish the level of consumer recognition of the shape applied for and the degree of association between the shape and the word marks used by the Applicants in relation to products sold in packaging of the shape applied for.

38 The survey was designed and carried out by a specialist market research company. They interviewed a sample of 312 people across various residential areas of Singapore. Each respondent was first shown a visual showcard with a picture of an empty unbranded sample of the bottle as well as an actual sample of an empty unbranded bottle which is the subject of this application.

39 The survey evidence, titled "*Maggi Bottle – Trademark Study*" appended to Ms Ng's statutory states the questions put to the respondents as follows:

*"A1 Can you please let me know which **specific brand(s)**, if any, do you associate with this bottle shape?"*

A second question, "*Any other brands which come to mind?*" was then asked.

"B1 Now looking at the bottle shape again, can you let me know if you associate any of the following brands with this?"

7 brands selected by Nestle were listed for respondents. They included MAGGI, TIGER BRAND, LEE KUM KEE, KNORR, KIKKOMAN, HEINZ, and GOM JOO MIN. Respondents were then asked if they associated any of the brands with the bottle shapes."

"C1 Which of the following brands do you usually buy and/or use?"

The list of brands shown in B1 was shown to the respondents to assist them to answer C1

40 A summary of the results of the survey, as provided in the report titled "*Maggi Bottle – Trademark Study*" reads:

"6. Conclusions

Singaporeans strongly associate the bottle shape with the MAGGI brand. Spontaneous awareness is high at 71%. When aided with a list of brands, 85% of respondents linked the bottle shape with MAGGI. This demonstrates a very strong association between the MAGGI brand and the bottle shape.

The results may be indicative of MAGGI's dominant market position whereby 77% of respondents usually buy MAGGI brand products.

Independent from purchase, 73% of respondents use MAGGI brand products."

41 The Applicants appear to assume that whenever the shape in question prompted a respondent to "mention" Maggi, the shape was acting as a guarantee of trade origin. This does not follow. It is of no value simply to record the number of "mentions" of a word mark or brand without taking into account the context in which the association is made and the overall significance of the respondents' answers.

42 In the case of *Imperial Group v Philip Morris* [1984] RPC 293, Whitford J. set out certain guidance which should be followed if survey evidence is to be given weight in legal proceedings. This guidance makes it clear that questions must not be leading and should not lead the respondent into speculating about matters about which he or she would not have concerned him or her in an ordinary commercial situation.

43 However, I find that the questions posed to the respondents, in particular, A1 and B1, are leading and this completely undermines the results of the survey. Apart from the fact that the questions prompt the respondents to think of "brand", it makes it difficult to determine between those who genuinely believed that the shape designates Maggi and those who were not considering the shape but the type of product and guessing that the market leader was most likely to be the "correct" answer to the question.

44 The lack of verbatim answers from those who gave the "correct" answer makes impossible to determine the extent of guesswork involved.

45 Even if one discounts the shortcomings of the survey, at its best the survey merely establishes that there is product recognition by a significant proportion of the relevant public. However, to establish acquired distinctiveness, the Applicants are required to show that Application Mark had been used distinctively, as a trade mark and by virtue of this use, there was consequent reliance on the shape by consumers as a trade mark. This does not come through anywhere, be it the Applicants' submissions or evidence of use lodged by the Applicants.

Conclusion

46 In light of the above reasons, Trade Mark Application No. T0618780H is refused.

Dated this 15th day of June 2011.

Tan Mei Lin

Principal Assistant Registrar of Trade Marks

Registry of Trade Marks

Intellectual Property Office of Singapore