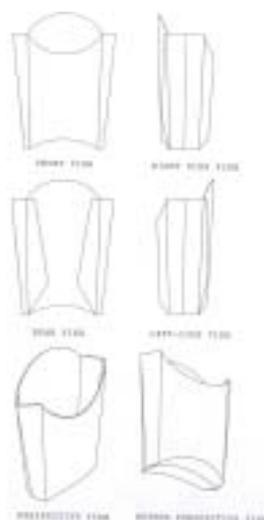


TRADE MARKS ORDINANCE (Cap. 559)

APPLICATION NO.: 300025893

APPLICANT: MCDONALD'S CORPORATION

CLASS: 29



MARK:

STATEMENT OF REASONS FOR DECISION

Background

1. On 29 May 2003, McDonald's Corporation (the "Applicant") of Illinois, United States of America applied to register the mark shown in *Annex 1* (the "subject mark") under the Trade Marks Ordinance (Cap. 559) (the "Ordinance").
2. Registration is sought in respect of the following goods in Class 29:

"foods prepared from meat, pork, fish and poultry products; meat sandwiches, fish sandwiches; pork sandwiches, chicken sandwiches, preserved and cooked fruits and vegetables; eggs, cheese, milk, milk preparations, pickles, desserts; potato products; cooked potatoes, potato fritters, French fries, chips, hash browns; nuggets; chicken nuggets; meat nuggets, pork nuggets; prepared meals".

3. Objections were raised under sections 11(1)(b) and 11(3)(b) of the Ordinance.
4. The Applicant called for a hearing which took place on 5 January 2005. Mr. Kim Nicholson of Marks & Clerk appeared on behalf of the Applicant.
5. The following cases were referred to at the hearing:
 - (a) *Philips Electronics NV v Remington Consumer Products Ltd.* [2003] R.P.C. 2;
 - (b) *Linde AG v Deutsches Patent-und Markenamt* [2003] R.P.C. 45; and
 - (c) *British Sugar Plc v James Robertson & Sons Ltd.* [1996] R.P.C. 281.
6. I reserved my decision at the end of the hearing.
7. The Applicant did not file any evidence of use of the subject mark. I therefore have only the *prima facie* case to consider.

The relevant provisions

8. Section 11 of the Ordinance provides that:

“(1) Subject to subsection (2), the following shall not be registered ---

- (a) signs which do not satisfy the requirements of section 3(1) (meaning of “trade mark”);
 - (b) trade marks which are devoid of any distinctive character;
- ... ”

“(3) A sign shall not be registered as a trade mark in relation to goods if it consists exclusively of ---

- (a) ...
 - (b) the shape of goods that is necessary to obtain a technical result;
- ...”

Decision

Section 11(1)(b)

9. The subject mark consists of the shape of a container as shown in *Annex 1*. Mr Nicholson referred to it at the hearing for convenience as the “McDonald’s three-dimensional French Fry container”.
10. Under section 3 of the Ordinance, the shape of goods or their packaging may constitute a trade mark, provided, first, that it is capable of being represented graphically and, second, that it is capable of distinguishing the goods or services of one undertaking from those of other undertakings.
11. However, the fact that a category of signs, namely the packaging of goods, is capable of constituting a trade mark within the meaning of section 3(1) does not mean that the subject mark belonging to that category necessarily has distinctive character for the purpose of section 11(1)(b) in relation to the goods applied for.
12. For a mark to possess distinctive character within the meaning of section 11(1)(b), it must serve to identify the products in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish those products from products of other undertakings (*Linde*, supra, paragraph 40). This means it must have a character which enables it to be distinctive of one trader’s goods in the sense that it has a meaning denoting the origin of the goods (*Philips Electronics v Remington* [1999] R.P.C. 809 at 819). It must fulfil the essential function of a trade mark which is to guarantee the identity of the origin of the marked product or service 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. It must offer a guarantee that all the goods or services bearing it have originated under the control of a single undertaking which is responsible for their quality (*Henkel KGaA v Deutsches Patent-und-Markenamt* (ECJ) Case C-218/01, paragraph 30).
13. The subject mark consists of the shape of a container without any word, device or colour. Protection is sought whatever the colour and irrespective of any words and devices on the container, which in real life could appear on

this sort of container. In order not to be precluded from registration by section 11(1)(b), the shape alone must offer a guarantee that food products covered by the specification offered in a container of that shape have originated under the control of a single undertaking. In other words, the shape and the shape alone must guarantee the identity of the origin of the marked product without any possibility of confusion, and thereby distinguish the product from others which have another origin.

14. A trade mark's distinctiveness must be assessed by reference to, first, the goods or services in respect of which registration is sought and, second, the perception of relevant persons, namely the consumers of the goods or services. That means the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and circumspect (*Linde*, supra, paragraph 41).
15. The criteria for assessing the distinctive character of three-dimensional trade marks are no different from those to be applied to other categories of trade marks. The provisions of the Ordinance do not require that the shape of the article in respect of which the sign is registered must include some capricious addition such as an embellishment which has no functional purpose. It must simply be capable of distinguishing the product of the proprietor of the trade mark from those of other undertakings and thus fulfil its essential purpose of guaranteeing the origin of the product. (*Philips Electronics BV v Remington Consumer Products Ltd*, Case C-299/99 [2003] R.P.C. 2, paragraphs 48 to 50).
16. 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 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 the 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 (*Linde*, supra, paragraph 48; *Henkel KGaA v Deutsches Patent-und-Markenamt* (ECJ) Case C-218/01, paragraph 52).

17. Where the goods in question are ordinary food products as in this case, the Registrar's hearing officers are entitled to rely upon their own experience and perceptions when considering the presumed expectations of an average consumer of the goods in question.
18. The subject mark consists of the shape of a container shown in *Annex 1* for food products covered by the specification referred to in paragraph 2 above. The folds at the side and at the bottom of the container allow the container to be flattened when emptied. The back of the container is taller than the front, allowing easy access by the hand to the food products from the front of the container whilst providing support to the food products from the back. The subject mark therefore comprises a simple and practical shape of a container for holding the food products. The average consumer is likely to perceive the mark as nothing more than a simple container fulfilling the purpose of holding the food products. It does not have a meaning denoting the origin of the goods. The average consumer is unlikely to rely on the shape alone as a guarantee that food products coming in a container of this shape have originated under the control of a single undertaking.
19. The Applicant argues that the objections relating to whether a mark achieves a technical result can only be raised under section 11(3)(b).
20. Where the shape applied for fulfil certain functions, and its features would be perceived by the average consumer as functional and not having a meaning denoting origin, this would have a bearing on the assessment under section 11(1)(b).
21. The Applicant submits that the subject mark goes beyond being a simple box or container as it possesses a number of shaped and curved planes that render the appearance of the container original and distinctive.
22. The curved planes in the subject mark may have been intended to be a design feature of the container. However, this does not necessarily mean that the shape therefore has distinctive character for the purpose of section 11(1)(b).
23. Having regard to the curved planes and the various features of the subject

mark described in paragraph 18 above, the overall impression created by the shape in question does not enable consumers to distinguish the product concerned from those having a different trade origin. It would, as a whole, be perceived by the average consumer as an ordinary container for holding the food products.

24. The Applicant submits that the subject mark is sufficiently capable of distinguishing because when considered as a whole the mark does not directly denote or indicate the prepared food products covered by the application. There is nothing in the mark as a whole which specifically identifies the products covered by the subject application.
25. I agree that the subject mark must be considered as a whole. However in assessing distinctiveness of a mark, the question is not whether the average consumer, when seeing the subject mark alone, could make out what products would be sold under the subject mark. The relevant question is, when the average consumer sees the subject mark used in relation to the food products applied for, whether that shape as a whole would be perceived as having a meaning denoting the origin of the goods.
26. 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 section 11(1)(b) (*Henkel v OHIM*, (ECJ) Joined Cases C-456/01 P and C-457/01 P, paragraph 39). A simple departure from the norm or customs of the sector is not sufficient to render inapplicable the ground for refusal under Section 11(1)(b) of the Ordinance (*Henkel KGaA v Deutsches Patent-und-Markenamt* (ECJ) Case C-218/01, paragraph 49).
27. In the Registry's letter dated 24 November 2004, the Registry referred the Applicant to several examples of similar containers. These are now reproduced at *Annex 2*. The subject mark is very similar to the shapes of the containers at *Annex 2*. The average consumer would perceive the subject mark as nothing more than an ordinary container.
28. The Applicant submits that if the examples at *Annex 2* are not registered, they have minimal bearing to the subject matter, and it would not be enough for the Registrar to refer to those examples.

29. Where the relevant goods are ordinary consumer food products, and in the absence of any evidence of the perception of consumers of these products, the Registrar's hearing officers would have to rely upon their own experience and perceptions. The examples at *Annex 2* merely reinforces my view that the subject mark would be perceived by the average consumer as nothing more than a container, and merely serves as a means of packaging the food products for sale. The shape does not have a meaning denoting origin.

Other shape marks

30. In its written representations dated 4 January 2005, the Applicant referred to various shape marks on the Register. I note, however, that Registration No. 300177363 consists of a three-dimensional shape with a device on it. Registration Nos. 300172359 and 300201121 each consists of a three-dimensional shape with a word appearing on it. Registration No. 300257030 consists of a shape which is much more complex and elaborate when compared with the subject mark.
31. The above four accepted marks are different from the subject mark which consists of a simple shape with no words or device on it. Each case must be considered on its own merits and not by reference to other marks. As stated in *British Sugar Plc v James Robertson & Sons Ltd.* [1996] R.P.C. 281 at 305, "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*¹ and the same must be true under the 1994 Act."
32. The Applicant also referred me to Application No. 200117210 applied for under the repealed Trade Marks Ordinance (Cap. 43). That application was filed by the Applicant for registration of a container having the same shape as the subject mark but with the colours red and yellow and also what is called the Applicant's Golden Arches Logo on it. That mark, with the colour and logo elements, is as a whole different from the subject mark. Application for registration of that mark was, in any event, withdrawn.

¹ [1966] R.P.C. 541

That application does not assist the Applicant in this case.

33. For the above reasons I find that the mark is devoid of any distinctive character within the meaning of section 11(1)(b) of the Ordinance.

Section 11(3)(b)

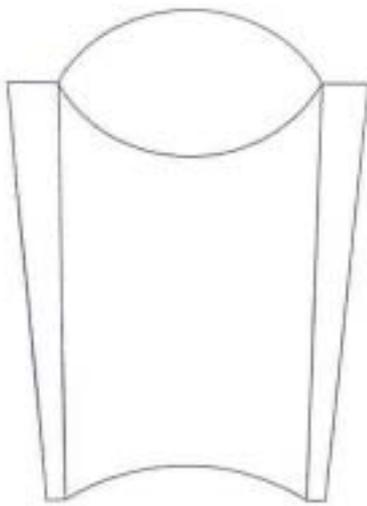
34. As I have found that the subject mark is devoid of any distinctive character, registration of the subject mark must be refused. It is therefore unnecessary for me to consider the objection under section 11(3)(b).

Conclusion

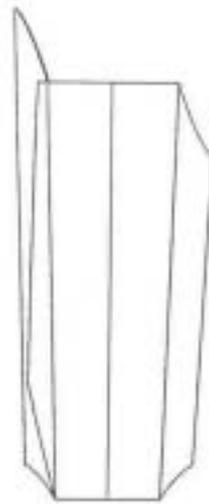
35. Having considered all the documents filed by the Applicant and all the arguments submitted in relation to this application, I find that the subject mark as a whole is devoid of any distinctive character, and is precluded from registration by section 11(1)(b) of the Ordinance. Accordingly, I refuse the application under section 42(4)(b) of the Ordinance.

Finnie Quek
for Registrar of Trade Marks

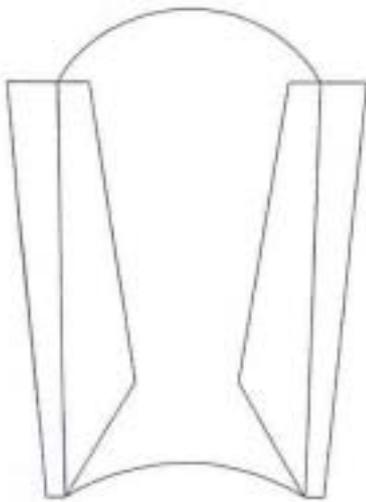
28 April 2005



FRONT VIEW



RIGHT SIDE VIEW



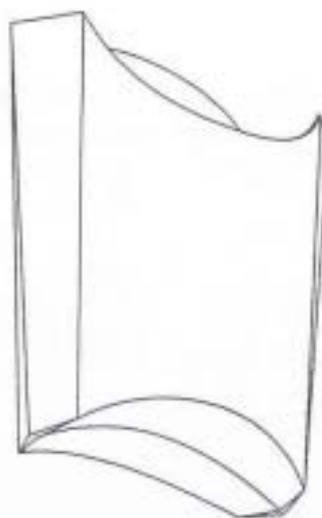
REAR VIEW



LEFT-SIDE VIEW



PERSPECTIVE VIEW



BOTTOM PERSPECTIVE VIEW

Annex 2

Examples of containers referred to in Registry's letter dated 24 November 2004:

<http://www.wendys.com/food/images/nutrition/product/21.jpg> :



http://www.cinnabon.com/images/prod_3.jpg :



<http://www.bk.com/Food/products/fries.aspx> :



http://www.hardees.com/images/upload/homepage/bnr_intermenu.jpg :



http://www.lotteria.co.jp/html/images/p_variety11.jpg :



http://www.sonicdrivein.com/images/menu_catFavesAndCraves.jpg :



<http://www.whataburger.com/images/menu/mainlinks.jpg> :

