

Tic Tac box rejected as a trade mark: Ferrero S.p.A

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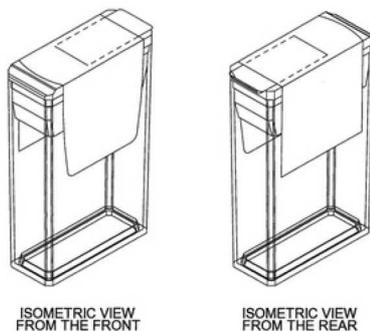
In *Re Ferrero SpA* (2012) 98 IPR 250; [2012] ATMO 79 (13 September 2012), the Registrar of Trade Marks rejected an application to register the Tic Tac box as a shape trade mark.

The application was to register a shape trade mark for confectionary (class 30). The trade mark was described as follows:

The trade mark consists of a transparent three dimensional box with a hinged lid and label over the lid, as shown in the representation of the trade mark attached to the application form.

The pictorial representation included the images shown in figure 1.

Figure 1: Tic Tac box



Comment

This application was always going to be difficult, given the generally nondescript and functional nature of the Tic Tac box. In other circumstances, if starting from scratch, an unusual or striking (non-functional) element could be added to the shape to improve the prospects of registration. In addition, if there had been further evidence available of use of the box without the Tic Tac label, this may also have improved the applicant's prospects of registration under s 41(6)(a) of the Trade Marks Act 1995 (Cth) (the Act) (discussed below).

Registration under the Trade Marks Act

Section 41 of the Act sets out the criteria to be applied in determining whether or not there are grounds for

rejecting an application for registration of a trade mark. In this case, in a nutshell, the applicant based its claim to register its trade mark on the following:

- the shape trade mark is inherently adapted to distinguish the applicant's goods (s 41(3));
- the trade mark is to some extent inherently adapted to distinguish the applicant's goods and, because of the use to which the trade mark has been put, the trade mark does distinguish the applicant's goods (s 41(5)); or
- if the trade mark is not to any extent inherently adapted to distinguish the designated goods from those of other persons, then, by reason of the extent to which the applicant has used the trade mark, the trade mark does distinguish the applicant's goods (s 41(6)(a)).

Inherently adapted to distinguish the applicant's goods

In considering whether the shape trade mark is inherently adapted to distinguish the applicant's goods (s 41(3)), the Registrar relied on the well-established test for inherent adaptability as set out by Justice Kitto in *FH Faulding & Co Ltd v Imperial Chemical Industries of Australia & New Zealand Ltd* (1965) 112 CLR 537; 39 ALJR 95; BC6500260. In that case, Kitto J stated:

The question to be asked in order to test whether a word [or shape] is adapted to distinguish one trader's goods from the goods of all others is whether the word [or shape] is one which other traders are likely in the ordinary course of their business and without any improper motive, to desire to use upon or in connection with their goods.

The Registrar also quoted *Kenman Kandy Australia Pty Ltd v Registrar of Trade Marks* (2002) 122 FCR 494; 56 IPR 30; [2002] FCAFC 273; BC200204949 where Stone J said:

... the question is whether, if the bug shape were to be registered as a trade mark, other persons trading in confectionery and "being actuated only by proper motives" would think of this shape and want to use it in connection with their goods in any manner that would infringe the appellant's trade mark...

Applying this test, the Registrar found that the shape trade mark was not inherently adapted to distinguish under s 41(3) of the Act. The Registrar stated:

The shape of the box is non-distinctive in relation to confectionery ... [T]he shape of a transparent box with a lid is one which other traders would desire to use in relation to those goods.

The next question was the extent, if any, of inherent adaptation to distinguish (s 41(5)).

The Registrar considered a number of principles set out by Sundberg J in *Global Brand Marketing Inc v YD Pty Ltd* (2008) 76 IPR 161; (2008) AIPC ¶92-286; [2008] FCA 605; BC200803168 in connection with the use of a shape as a trade mark. These principles include the following.

- In order to register a shape as a trade mark, it must have a feature that is extra and distinct from the inherent form of the particular goods.
- Non-descriptive features point towards a finding that such features are used for a trade mark purposes — that is, unusual shapes or striking features may distinguish the goods from those of others, whereas descriptive features (such as an ordinary or straight-walled bottle) are less likely to distinguish.
- If the shape has a substantial functional element, this will weigh against a finding that the shape serves as a trade mark.

The Registrar rejected the applicant's submissions and found that the box was not to any extent adapted to distinguish. In particular, the Registrar found that:

- the overall shape of the box is not unusual and it contains no colour to help distinguish the applicant's goods;

- the fact that the box is transparent is a functional element that is commonplace for the packaging of foodstuffs, and is a feature that other traders (without improper motive) are likely to want to use in relation to confectionery;
- there is no evidence that the "living hinge", relied on by the applicant, engendered trade mark distinctiveness;
- the position of the lid's opening is primarily functional, and the label was a common feature on boxes of confectionery; and
- applying all the factors, none of the features of the shape were striking or arresting of appearance and all the elements were predominantly functional.

For these reasons, and because the shape was previously patented — which weighs against a finding that a shape serves as a badge of origin (patents being granted for inventions) — the Registrar found that the trade mark is not to any extent inherently adapted to distinguish the goods of confectionery.

The Registrar also considered evidence of use to determine, based on use alone, if the shape could be registered (s 41(6)(a)). Because the evidence showed that the box was rarely used without the registered "Tic Tac" trade mark, the box alone was not sufficient to distinguish the applicant's products.

For these reasons, the application was rejected.



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