

In re Coca-Cola Co.'s Applications

England, House of Lords, 1986.

All England Law Reports, vol. 2, p. 274 (1986).

LORD TEMPLEMAN.

My Lords, this is another attempt to expand on the boundaries of intellectual property and to convert a protective law into a source of monopoly. The attempt to use the Copyright Act 1956 for this purpose failed recently in *British Leyland Motor Corp., Ltd. v. Armstrong Patents Co., Ltd.*⁷² The present attempt is based on the Trademarks Act 1938.

Since the early 1920s the appellant, the Coca-Cola Co., has sold in the United Kingdom a nonalcoholic beverage under the

⁷²*All England Law Reports*, vol. 1, p. 850 (1986).

name "Coca-Cola" contained in bottles of a distinctive shape.

The Patents Act 1977 and its predecessors conferred on the inventor of a registered novel product the right for a period, now 20 years, to control the use of the invention. The Coca-Cola bottle is not a novel product. The Copyright Act 1956 and its predecessors conferred on the author of an original artistic work the right for the life of the author and 50 years thereafter to control the reproduction of the work. The Coca-Cola bottle is not an artistic work. The Registered Designs Act 1949 and its predecessor, the Patents and Designs Act 1907, conferred on the author of a registered design the right for 15 years to control the use of the design. By § 1(3) of the 1949 Act "design" means:

features of shape, configuration, pattern or ornament applied to an article by any industrial process or means, being features which in the finished article appeal to and are judged solely by the eye. . . .

The shape of the Coca-Cola bottle was accepted as a design and was registered under the 1907 Act. The effect of this registration expired in 1940 since when any rival manufacturer has been free to use the design of the Coca-Cola bottle.

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The Coca-Cola Co. now claims that during and since the period of protection for the Coca-Cola bottle under the 1907 Act the Coca-Cola Co. has been entitled to a monopoly in the Coca-Cola bottle as a trademark. The application of the Coca-Cola Co. to register the Coca-Cola bottle as a trademark has been rejected by the hearing officer, by Falconer J, and by the Court of Appeal. . . . The Coca-Cola Co., undeterred by this formidable display of judicial unanimity, now appeals with the leave of the House.

The 1938 Act confers on the proprietor of a registered trademark the exclusive right in perpetuity, subject to payment of fees and the observance of certain conditions not here relevant, to the use of a trademark which is distinctive. By § 9(2) of the 1938 Act:

... "distinctive" means adapted, in relation to the goods in respect of which a trademark is registered or proposed to

be registered, to distinguish goods with which the proprietor of the trademark is or may be connected in the course of trade from goods in the case of which no such connection subsists. . . .

I assume, without deciding, that the Coca-Cola bottle is distinctive of a bottle containing the Coca-Cola beverage purveyed by the Coca-Cola Co. The application by the Coca-Cola Co. is for the registration of the Coca-Cola bottle with its distinctive shape as a trademark in respect of nonalcoholic beverages.

It is not sufficient for the Coca-Cola bottle to be distinctive. The Coca-Cola Co. must succeed in the startling proposition that the bottle is a trademark. If so, then any other container or any article of a distinctive shape is capable of being a trademark. This raises the spectre of a total and perpetual monopoly in containers and articles achieved by means of the 1938 Act. Once the container or article has become associated with the manufacturer and distinctiveness has been established, with or without the help of the monopolies created by the Patents Act, the Registered Designs Act or the Copyright Act, the perpetual trademark monopoly in the container or article can be achieved. In my opinion the 1938 Act was not intended to confer on the manufacturer of a container or on the manufacturer of an article a statutory monopoly on the ground that the manufacturer has in the eyes of the public established a connection between the shape of the container or article and the manufacturer. A man must be free to sell any container or article of similar shape provided the container or article is labelled or packaged in a manner which avoids confusion as to the origin of the goods in the container or the origin of the article. The Registrar of Trademarks has always taken the view that the function of trademark legislation is to protect the mark but not the article which is marked. I agree. By § 68(1) of the Act of 1938:

"mark" includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, or any combination thereof . . . "trademark" means . . . a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate, a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the mark, whether with or without any indication of the identity of that person. . . .

The word "mark" both in its normal meaning and in its statutory definition is apt only to describe something which distinguishes goods rather than the goods themselves. A bottle is a container not a mark. The distinction between a mark and the thing which is marked is supported by authority. In *James's Trademark, James v. Soulbey*⁷³ the plaintiffs sold their lead in the form of a dome and in other shapes. Their products

⁷³*Law Reports, Chancery Division*, vol. 33, p. 392 (1886).

were impressed with the representation of a dome and their labels carried a picture of a black dome. The plaintiffs were allowed to register the representation or picture of a black dome as their trademark. Similarly, the Coca-Cola Co. has been allowed to register a line drawing of a Coca-Cola bottle as a trademark. But, dealing with the article itself, in *Re James's Trademark*, Lindley, L.J., said:⁷⁴

A mark must be something distinct from the thing being marked. The thing itself cannot be a mark of itself, but here we have got the thing and we have got a mark on the thing, and the question is, whether that mark on the thing is or is not a distinctive mark within the meaning of the Act. Of course the plaintiffs in this case have no monopoly in black lead of this shape. Anybody may make black lead of this shape provided he does not mark it as the plaintiffs mark theirs, and provided he does not pass it off as the plaintiffs' black lead. There is no monopoly in the shape, and I cannot help thinking that that has not been sufficiently kept in mind. What the plaintiffs have registered is a brand, a mark like a dome intended to represent a dome.

In the course of argument counsel for Coca-Cola Co. relied on the decision of this House in *Smith Kline and French Lab-*

⁷⁴*Id.* at p. 395.

*oratories, Ltd. v. Sterling-Winthrop Group, Ltd.*⁷⁵ In that case the plaintiffs were allowed to register 10 distinctive color combinations as trademarks for drugs sold in pellet form within capsules. One typical example was. . . :

The trademark consists of a maroon color applied to one half of the capsule at one end, and the other half being colorless and transparent, and yellow, blue and white colors being each applied to a substantial number of pellets so that each pellet is of one color only.

Lord Diplock rejected the argument that a mark could not cover the whole of the visible surface of the goods to which it was applied.⁷⁶ The *Smith Kline* case only related to the color of goods and has no application to the goods themselves or to a container for goods. A color combination may tend to an undesirable monopoly in colors but does not create an undesirable monopoly in goods or containers. I do not consider that the *Smith Kline* case is of assistance to the Coca-Cola Co. I would accordingly dismiss this appeal.

Appeal dismissed.

⁷⁵*All England Law Reports*, vol. 2, p. 578 (1975).

⁷⁶*Id.* at p. 584.

Monsanto Co. v. Coramandal Indag Products, (P) Ltd.

India, Supreme Court, 1986.

Supreme Court Journal, vol. 1, p. 234 (1986).

CHINNAPPA REDDY, JUDGE.

The long and grasping hand of a multinational company, the Monsanto Company of St. Louis, Missouri, United States of America, has reached out to prevent the alleged infringement of two of their patents (Numbers 104120 and 125381) by the defendant, an Indian private limited company. Though the suit, as initially laid, was with reference to two patents, the suit was ultimately confined to one patent only (Number 125381), the period for which the other patent (104120) was valid having expired during the pendency of the suit. . . .

We may first refer to a few preliminary facts. Weeds, as is well known, are a menace to food crops, particularly crops like rice which belong to the grass variety. Research has been going on for years to discover a weed killer which has no toxic effect on rice, that is to say, a herbicide which will destroy the weeds but allow rice to survive without any deleterious effect. For long the research was futile. But in 1966-67 came a breakthrough. A scientist, Dr. John Olin, discovered CP 53619

with the formula 2-Chloro-2, 6-Diethyl-N-(Butoxy-Methyl)-Acetanilide, which satisfied the requirement of a weed killer which had no toxic effect on rice. The annual report of the International Rice Research Institute for 1968 stated: "Weed control in rice was an important part of the agronomy program. The first agronomic evidence of the efficacy of granular-trichloroethyl styrene for the selective control of annual grasses in transplanted rice was obtained at the Institute. Another accession, CP 53619, gave excellent weed control in transplanted flooded and nonflooded, upland rice." It was further stated: "CP 53619 at 2 and 4 kg/ha appeared at least twice among the 20 best treatments," and "the most outstanding new pre-emergence herbicide was 2-Chloro-2, 6-Diethyl-N-(Butoxy-Methyl)-Acetanilide (CP 53619)." The annual report of the International Rice Institute for 1969 shows that the herbicide CP 53619 came to acquire the name of Butachlor.

. . . The first plaintiff is the Monsanto Company and the second plaintiff is a subsidiary of the first plaintiff registered as a company in India. It was stated in the plaint that the first plaintiff was the patentee of inventions called "Phytotoxic Compositions" and "Grass Selective Herbicide Compositions," duly patented under patent numbers 104120 dated March 1, 1966 and 125381 dated February 20, 1970. The claims and the particulars relating to the inventions . . . stated . . . and this is very important, "the active ingredient men-