

TRADE MARKS ACT 1994

AND

THE TRADEMARKS (INTERNATIONAL REGISTRATION) ORDER 1996

**IN THE MATTER OF
INTERNATIONAL REGISTRATION NO. 701260
AND THE REQUEST BY HENKEL KGaA
TO PROTECT A TRADE MARK IN CLASSES 1 AND 3**

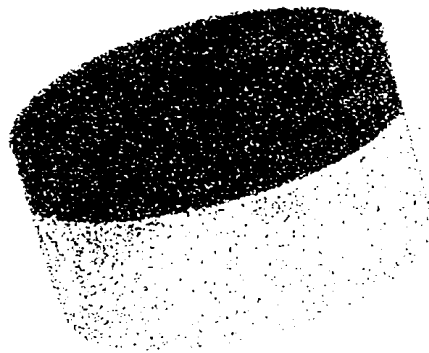
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On 18 September 1998, Benckiser N.V. of World Trade Center AA, 229, Schiphol Boulevard, NL-1118 BH SCHIPHOL, Netherlands, on the basis of international registration no. 701260, requested protection in the United Kingdom, under the provisions of the Madrid Protocol, of the mark:



The following words appear beneath the mark on the form of notification:

Description of the mark: The mark is three-dimensional in the form of a tablet, consisting of two layers in the colours green and white as depicted on the representation of the tablet.

Colors claimed: Green and white. The upper part of the mark is green, and the lower part of the mark is white.

Indication relating to the nature or kind of mark: three-dimensional mark.

The International Registration is numbered 701260 and protection is sought in Class 1 in respect of:

Chemicals used in industry; descaling agents, water softeners; all aforementioned products with or without disinfective components.

and in Class 3 in respect of:

Bleaching preparations and other substances for laundry use and dishwashing; cleaning, polishing, scouring and abrasive preparations; detergents, decalcifying and descaling preparations; laundry additives; all aforementioned products with or without disinfective components.

It was considered that the request failed to satisfy the requirements for registration in accordance with Article 3 of the Trade Marks (International Registration) Order 1996 and notice of refusal under Article 9(5) was given because the mark is excluded from registration by Section 3(1)(b) and (c) of the Trade Marks Act 1994. This is because the mark consists of a tablet coloured green and white, being a sign devoid of distinctive character which may be required in trade to designate eg tablets consisting of different detergent substances.

On 4 October 1999 a change of ownership was recorded and the holder of the mark is now Henkel KGaA, 67 Henkelstrasse, D-40191 Dusseldorf, Germany.

This mark is one of several similar marks designating the United Kingdom for protection under the Madrid Protocol, which were filed by the holder at around the same date. The holder's representative responded to the provisional refusal of protection with a request to suspend action on this designation pending the outcome of an appeal to be lodged in respect of a test case, International Registration no 700785. That appeal was unsuccessful, but the holder's representative wrote to the registry again on 14 March 2001 submitting that, "despite the outcome of the appeal in respect of 700785, the present case should be allowed to proceed. The mark of this case is a three dimensional mark of a cylindrical shape having a bevelled upper edge. In addition it appears that the surfaces are not smooth." and "whilst it may be argued that no single feature of the mark of the present case when taken alone has sufficient distinctive character for registration, it is clear that a mark should be considered as a whole, without dissecting the separate elements within it. The mark of the present case as a whole consists of a combination of a number of individual features and it is submitted that the mark as a whole does have sufficient distinctive character for registration. It is the combination of colours, shapes and textures which enables the goods of the present applicant to be distinguished from the goods of other undertakings." and "this combination as a whole is not one which consists exclusively of signs or indications which serve in trade to designate the kind, quality, quantity, intend purpose etc., [*sic*] of the goods in question".

The examiner was not persuaded by these submissions and in a letter to the holder's representative dated 9 April 2001 the objections were maintained. No other representations were made under Article 9(4). Notice of final refusal under Article 9(6) was issued on 2 August 2001. I am now asked by the holders representatives W P Thompson & Co under Section 76 of the Act and Rule 62(2) of the Trade Marks Rules 2000 to state in writing the grounds of decision and the materials used in arriving at it.

No evidence of use has been put before me. I have, therefore, only the prima facie case to consider.

Section 3(1)(b) & (c) of the Act read as follows:-

3(1) The following shall not be registered -

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

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

The test for distinctiveness was laid down by Mr Justice Jacob in the TREAT case [1996] RPC 281 page 306 lines 2-5 when he said:

“What does *devoid of distinctive character* mean? I think 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?”

The mark consists entirely of the shape of a cylindrical tablet consisting of the combination of two layers, the upper layer in the colour green and the lower layer in the colour white, with the lower layer being somewhat deeper than the upper layer. The mark appears to be speckled throughout with blue speckles, but the colour blue is not claimed as an element of the mark. From my own knowledge and experience of such everyday products I do not see anything novel in these elements of the mark.

The holder's representative submitted in correspondence with the examiner that, in addition to the features I have identified, the mark has a bevelled upper edge and that it appears that the surfaces are not smooth. These additional features add nothing to my impression of the mark as a whole.

The tablet is of a basic geometric shape and there is nothing fanciful about selecting a cylindrical shape for the manufacture of solid detergents. White is a natural colour for cleaning agents and I see nothing unusual in the presence of a single contrasting colour, nor in the presence of the blue speckles, both of which may, in addition to being decorative, indicate the presence of different ingredients or scents. These features do not make the shape of the tablet recognisable as a trade mark in the sense that a typical consumer of the product would deduce that the tablets emanate from a particular source.

Whilst it is clear that a combination of non-distinctive elements can create a distinctive whole I do not accept that this is the position with this mark. I do not see that there is anything in the shape of this tablet in the colours green and white that would serve to distinguish the goods of the applicant from those of other traders.

In Proctor & Gamble Limited's application (1996 RPC 281), Walker L J said:

“ Despite the fairly strong language of s. 3(1)(b), “devoid of any distinctive character” - and Mr Morcom emphasised the word “any” - that provision must in my judgment be directed to a visible sign or combination of signs which can by itself readily distinguish one trader's product - in this case an ordinary, inexpensive household product - from that of another competing trader. Product A and Product B may be different in their outward appearance and packaging, but if the differences become apparent only on close examination and comparison, neither can be said to be distinctive”

In this decision I have born in mind the comments in the unreported decision on an application by Henkel KAaG to register a 3-Dimensional shape of a tablet (International Application No 700785 dated 13 August 1998) where Geoffrey Hobbs QC in his role as The Appointed Person said:

“It seems to me that the tablet shape in question represents only a minor variation of a basic geometric shape. The colours have a degree of visual impact, but not to an extent that I would regard as particularly striking. There is every likelihood, in my view, that they would be taken to indicate the presence of two active ingredients in the relevant tablets and, as a corollary to that, every likelihood that they would not be perceived as possessing significance in terms of the trade origin of the goods.

The question is whether the degree of individuality imparted to the tablets by the features of shape and colour in combination is sufficient to render them not merely distinguishable from other such goods, but distinctive in terms of trade origin.

Giving the matter the best consideration I can, I think that the appearance of the tablets put forward for registration is not sufficiently arresting to perform the essential function of a trade mark. In the absence of distinctiveness acquired through use, the mark put forward for registration was, in my view, devoid, by which I mean unpossessed, of a distinctive character, and therefore excluded from registration by section 3(1)(b) of the Act at the relevant date.

I have also born in mind the comments in the unreported decision on another application by Henkel KAaG to register a 3-Dimensional shape of a tablet (International Application No 708442 dated 15 January 1999) where Simon Thorley QC in his role as The Appointed Person said:

“I am no more satisfied than the hearing officer was that the combination of colours and shapes in a tablet of this nature would be seen by the average consumer as being indicative of anything more than the different ingredients present in the tablet in contrast, no doubt, to other tablets which did not have the benefit of three separate ingredients. I am unpersuaded that there is anything in the combination of shape, colour and texture which inherently will suggest to the average consumer that the combination constitutes an indication of origin rather than an indication of contents.”

The public are well used to seeing coloured tablets of this sort of shape. At best it may be a slight variant on other such tablets but to my mind there is nothing memorable or distinctive about it. I do not see that there is anything in the shape or colour combination of this tablet that would serve to distinguish the goods of the holder from those of other traders.

It is my view that the sign applied for will not be taken as a badge of origin without first educating the public that it is a trade mark. It follows that this application is debarred from prima facie acceptance by Section 3(1)(b) of the Act.

Objection was also taken under Section 3(1)(c) of the Act. Having found that the mark is debarred from registration under Section 3(1)(b) I do not need to consider the case under Section 3(1)(c).

In this decision I have considered all the documents filed by the holder and for the reasons given the notice of refusal was upheld.

Dated this 09 day of November 2001

Anne Pritchard

**For the Registrar
The Comptroller General**