

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO 2150607
IN THE NAME OF INLEX LOCKING LIMITED**

**AND THE APPLICATION FOR A DECLARATION OF INVALIDITY
THERE TO UNDER NO 12442
BY HENKEL KGAA**

**Trade Marks Act 1994
in the matter of registration no 2150607
in the name of Inlex Locking Limited
and the application for a declaration of invalidity thereto under no 12442
by Henkel KGaA**

Background

1) On 2 April 2001 Henkel KGaA (Henkel) filed an application for a declaration of invalidity of trade mark registration no 2150607. This registration was filed on 12 November 1997 and registered on 14 July 2000. It is in the name of Inlex Locking Limited (Inlex). The trade mark is described in the following terms:

“The mark comprises the colour red, a representation of which is on the form of application, as applied as a patch to a thread of a fastener, or the threaded shank of a component.”

2) The application proceeded to publication on the basis of distinctiveness acquired through use and trade evidence.

3) During the proceedings the specification of the registration was amended to read as follows:

applying prevailing torque, non-metallic locking compound to fasteners and the threaded shanks of components

The specification is classified as being in class 40 of the International Classification of Goods and Services.

4) Henkel state that the registration should be declared invalid under section 47(1) of the Act on the following grounds:

- Section 3(1)(a) - As the trade mark in suit does not satisfy the requirements of section 1(1) of the Act as it is not a sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.
- Section 1(1) - As the trade mark in suit is not capable of distinguishing the services of the registered proprietor from those of other undertakings.
- Section 3(1)(b) – As the trade mark in suit is devoid of any distinctive character.
- Section 3(1)(c) – As the trade mark in suit consists exclusively of a sign which serves in trade to designate the kind or intended purpose or other characteristic of the goods to which it is applied. It consists exclusively of a red coloured coating compound used in the trade for many years.

- Section 3(1)(d) – As the trade mark in suit consists exclusively of a sign or indication which has become customary in the current language or in the bona fide and established practices of the trade.

Henkel state that the trade mark in suit has not, subsequent to registration, acquired a distinctive character.

5) Henkel request that the registration is declared invalid and seek an award of costs.

6) Inlex filed a counterstatement in which it denies the grounds of the application for invalidity. Inter alia Inlex states that the colour red is uniquely associated with the services afforded by it and no other trader. Inlex also state that the trade mark has acquired a distinctive character in relation to the services.

7) Inlex request that the application be dismissed and seek an award of costs.

8) Both parties filed evidence.

9) After the end of the evidence rounds the application was reviewed by a hearing officer. He was of the opinion that in order to reach a decision a hearing would be appropriate. However, the parties requested a decision from the papers. Consequently a decision will be taken from a careful study of the papers.

10) Acting on behalf of the registrar I duly give the following decision.

Applicant's evidence

11) This consists of a statutory declaration made by Andrew Dodwell. Mr Dodwell is the divisional director of Henkel Loctite which is a division of Henkel KGaA.

12) Mr Dodwell states that application of a locking compound to fasteners and the threaded shanks of components is not a service exclusively supplied by Inlex. He states that the locking compound applied as part of the service is very rarely colourless. Mr Dodwell states that a pigment is added so that the customer can see that the fastener or component has been treated. He states that there are many companies which specialise in the manufacture and/or supply of locking compounds. To support this claim he exhibits at AD1 an e-mail message. This emanates from after the relevant date. It appears to emanate from the USA and there is no indication as to why Kurt Andress, who sent the e-mail, should be considered to have any expertise on the topic. I consider that this exhibit cannot be afforded any weight in these proceedings.

13) Mr Dodwell states that it is customary for producers of various compounds which differ in their properties to colour code them in order to make it easier to tell

which one of their compounds is being used. He exhibits at AD2 printouts from Internet sites. All of these emanate from well after the relevant date, and so do not tell me the position at that date. Also a good number emanate from USA and Zambia and so do not have a bearing upon the position in the United Kingdom. From the internal evidence the printouts from Bondloc, Industria and Intek Adhesives Ltd would appear to clearly emanate from the United Kingdom. The web sites relate to goods rather than services; the goods are anaerobic thread locking, sealing and retaining compounds. The goods are coloured and the colours are mentioned in the specifications. The printouts show the use of the same colours by different manufacturers. Mr Dodwell states that there is an indication that colour could indicate strength. He refers to exhibit AD1 in support of this.

14) Mr Dodwell goes on to state that red patches are pre-applied by other traders. He exhibits documents at AD3 and AD4 in support of this. However, there is nothing in these documents that indicate that the use is in the United Kingdom. They, therefore, do not assist me in my deliberations in this case. Mr Dodwell refers to exhibit AD5, a page from a web site. Again there is no indication that the page relates to United Kingdom usage and so it does not assist me.

15) Mr Dodwell states that Inlex's coloured locking compound cannot possibly serve as an indicator of origin of services when the colour is simply a customary addition to the locking compound for practical purposes. Mr Dodwell states that Henkel uses the colour red for Dri Loc plastic and green for Dri Loc 218 but would not necessarily assert that it is entitled to a monopoly in each of these colours for the related goods or services. Mr Dodwell exhibits at AD6 various extracts from the application file. He refers inter alia to item D of this exhibit, a leaflet entitled IONIC. I note that this leaflet was not reproduced in the applicant's evidence at DJL1, which is the declaration that was adduced at ex parte stage as evidence of acquired distinctiveness. IONIC is an enterprise that applies patches to fasteners, very much as Inlex does. It even applies the same product ESLOK which Inlex does and applies it in the same colour – red. In this leaflet the following is stated:

“As the fastener is screwed into the mating part the red **Eslok**® nylon patch....”

The leaflet also states that there is easy identification by colour for inspection purposes. Mr Dodwell states that it is easy to see the compound on inspection and assess how well it is wearing when it is brightly coloured. He states that this is one of the reasons why so many manufacturers supply threadlocking compound in a bright colour such as red. I am grateful that Henkel adduced this leaflet into the proceedings as I consider it an important document in helping me reach a proper conclusion.

Registered Proprietor's evidence

16) This consists of a witness statement by David John Lucking, who is a trade mark agent. Mr Lucking adduces into the proceedings by way of exhibit DJL1 declarations made in respect of the registration at application stage. He also exhibits at DJL2 notes which he has made. These represent submissions rather than evidence of fact. Consequently, I will not rehearse them but take them into account in reaching my decision. Mr Lucking states in the third paragraph of his witness statement:

“The Declarations contrast the red “Eslok” patches applied by Inlex; the “Anu-Lok” yellow patches applied by Alson Engineers; and the blue “Tuf-Lok” patches applied by P.S.M.”

17) The first declaration exhibited at DJL1 is a statutory declaration made by Roger Bruce Tuff. Mr Tuff is the managing director of European Industrial Services Limited (EIS). Mr Tuff states that EIS manufactures, imports and sells a substantial number of fasteners annually. He states that a significant number of these fasteners are supplied to his customers with a thread locking and/or sealing patch applied to the threads. These patches are to lock the fasteners against becoming loose in use. EIS sub-contract the work of applying the patches to specialists such as Inlex. He states that EIS's suppliers all use different colours to identify who applied the patch.

18) Mr Tuff states that increasingly customers specify the colour patch they require at the time of ordering and some require test certificates to verify that the patches were applied by a supplier approved by them. He states that in general a customer of EIS knows who has applied a particular coloured patch to their products by the colour of the patch.

19) Mr Tuff exhibits at RTB1 a chart relating to various thread locking and sealing patches. He states that it is to be noted that the ESLOK patches applied by Inlex are coloured red (or purple red) whereas patches applied by other suppliers are either green, blue, copper, or black/green. In fact this document bears no reference to Inlex other than the name having been hand-written at the top of the first page. The leaflet relates to various patches which are identified by their trade marks. In the case of the patches which are red or purple red these are identified as ESLOK patches.

20) Mr Tuff exhibits at RBT2 a leaflet issued by another supplier, Alston Engineers. He also states that another leaflet included with this leaflet is issued by PSM. This latter leaflet, other than a hand-written PSM at the top, has no reference to PSM but to TUF-LOK patches which are described as having an easily identified blue

patch. The Alston Engineers leaflet makes reference to ANU-LOK patches, which the leaflet states are coloured yellow for easy inspection.

21) Mr Tuff states that it is important to EIS and its customers that the supplier of the patch can readily be identified and that this has been possible because of the use of different colours. He states that in his view red, when the colour of a thread locking/sealing patch applied to a fastener, is indicative of the patch having been applied by Inlex.

22) Mr Tuff finally states that the word “patch” is a term of the trade. It is used widely in the industry to describe the nature of the thread locking/sealing material, the shape and position of which on the fastener threads can change for different applications.

23) The second declaration exhibited at DJL1 is by Alan John McKendrick. Mr McKendrick is the managing director of GKS Automotive Limited. Mr McKendrick has been a director of companies involved in the United Kingdom fastener industry since 1966.

24) Mr McKendrick states that the colouring of patches is important as it is essential that the patching company can be determined from the colour of the patch. He states that his company uses the colour to identify the patching company both on receipt of the product and also when investigating potential quality control concerns.

25) Mr McKendrick states that the most common patches in use, which are easily recognisable, are the red ESLOK patches applied by Inlex and the blue TUFLOC patches applied by Tufloc.

26) The final statutory declaration exhibited at DJL1 is that of Andrew Arthur Bliss. Mr Bliss is the group sales director of Inlex.

27) Mr Bliss states that the trade mark “The Colour Red” was first used in the United Kingdom on 1 September 1970 by GKN Bolts and Nuts Limited (GKN). He states that on that date GKN entered into a licence agreement with Amerace Esna Corporation to make and use patented products in the United Kingdom, Eire and the Isle of Man. He states that the licence also included the right to use the trade mark ESLOK in connection with the products and related services. He states that the colour of the product was not specified but that each licensee chose a different colour. He states that GKN chose red. Mr Bliss states that they used this from the outset in respect of all patches applied under the ESLOK trade mark. There were changes in ownership of the business; Inlex took over the business and licence on 24 July 1987. Mr Bliss states that the use of the colour red continued throughout the changes of ownership.

28) Mr Bliss states that a customer forwards his fasteners or components for Inlex to apply the red patch.

29) Mr Bliss exhibits at AAB1 various documentation relating to the use of the trade mark in suit. I deal with various of these documents in the body of decision and so will say no more about them at this stage.

30) Mr Bliss gives the following turnover figures, at ex-factory price:

Year	Value	Quantity
April 92 – March 93	£613,810	100 million units approx
April 93 – March 94	£588, 642	100 million units approx
April 94 – March 95	£663,225	100 million units approx
April 95 – March 96	£628,756	100 million units approx
April 96 – March 97	£480,070	100 million units approx
April 97 – Dec 97	£371,529	100 million units approx

He states that the trade mark has been used in connection with the services throughout the United Kingdom.

31) Mr Bliss states that the following sums have been expended in promotion of the trade mark:

Year	Literature and display materials	Exhibitions	Trade Journal Advertisements
1993	£6,100	£2,229	-
1994	-	£3,000	-
1995	£8,861	-	£4,450
1996	-	-	£7,140
1997	£10,746	£1,250	£9,785

Applicant's evidence in reply

32) This consists of a witness statement by Neil Amos. Mr Amos is national sales manager of Henkel Loctite, a division of Henkel KGaA. The comments of Mr Amos can best be described as submissions, mainly in rebuttal of the submissions of Mr Lucking. The statement does not represent evidence of fact and so I will say no more about it here. However, I have read the statement and where I consider it appropriate deal with the submissions therein.

Decision

Preliminary issues

33) Mr Amos in his statement submits that exhibit DGL2 should not carry any weight since the “notes” are not incorporated in a witness statement by the maker of the statements. If exhibit DGL2 represented evidence of fact I consider that this would be a very valid point. Evidence must be filed by means of affidavit, statutory declaration or witness statement. Without the appropriate declaration of truth evidence cannot carry weight. In this case, as I have noted above, the exhibit represents submissions; which do not require to be filed by way of the above means. I, therefore, will take exhibit DGL2 into account on the basis that it represents submissions.

34) It would seem helpful to try to explain what the patches that have been referred to are. Mr Tuff states that the term is used widely in the industry to describe the nature of the thread locking/sealing material, the shape and position of which on the fastener threads can change for different applications. The actual patches in question are deposits of nylon which can be added to any male threaded fastener to provide locking, sealing and vibration proof qualities. They stop, for instances, screws being shaken out of position in machinery which vibrates a great deal.

Section 47(1)

35) Henkel seek invalidation of the registration in suit under section 47(1) of the Act. Section 47(1) of the Act states:

“The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.”

36) Inlex have adduced no more evidence of fact in the proceedings than they did at examination stage. Consequently, the issue of use after registration does not need to concern me.

37) In paragraph 3 of his witness statement Mr Amos submits that the issues before me must be judged on what is customary in trade “today”. Section 47(1) refers to when “the trade mark was registered” i.e. the registration was incorrect at the time of registration. The registration was made upon the basis of the position at the date of the application, ie the trade mark had acquired distinctiveness by 12 November 1997. Consequently, I do not concur with Mr Amos that the relevant date is

“today”. The matter is to be judged as at the date of application ie 12 November 1997; with the sole proviso that if the trade mark had become distinctive since registration I would have to take this into account.

Section 1(1) and section 3(1)(a)

38) Section 1(1) of the Act states:

“In this Act a "trade mark" means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.”

39) Section 3(1)(a) of the Act states;

“The following shall not be registered -

(a) signs which do not satisfy the requirements of section 1(1),”

40) Section 1(1) is not a ground for invalidation in itself. It expresses the basic requirements that a trade mark must fulfil to be registered. It is section 3(1)(a) that applies those requirements in the form that allows for invalidation. In an application for invalidation the two sections are mutually dependent.

41) This ground of objection, in this case, has two bases: that the trade mark is not graphically represented and that it is not capable of distinguishing the services of the registered proprietor from those of other undertakings.

Graphical representation

42) The applicant in his statement of grounds referred to the decision of Mr Hobbs, sitting as the appointed person, in *Ty Nant Spring Water Ltd's Trade Mark Application* [2000] RPC 55 where he stated that:

“These provisions call for a fixed point of reference: a graphic representation in which the identity of the relevant sign is clearly and unambiguously recorded.”

43) The issue of graphic representation was revisited by Mr Hobbs in *R. v. John Lewis of Hungerford Ltd's Trade Mark Application* [2001] RPC 28. In that decision Mr Hobbs stated:

“In my view, the need to have regard to something outside the graphic representation in order to obtain a direct perception of the sign it represents

does not always or necessarily indicate that the graphic representation is inadequate for the purposes of examination and registration under the Act. The established practice of accepting graphic representations in which colours are named and identified either "as shown in the representation on the form of application for registration" or by reference to Pantone chart numbers suggests otherwise. So does the established practice of accepting graphic representations in which sounds are represented by musical notation. So does the general principle that the use of a trade mark or sign "otherwise than by means of a graphic representation" can sustain rights and give rise to liabilities under the 1994 Act."

Mr Hobbs does not question the practice of the registry in relation to these "alternative" forms of representation.

44) Inlex have applied for a specific colour red which is then applied to the thread of a fastener. This sets a limited parameter for consideration of what the trade mark is. This parameter is then further limited by the specification; which limits its use to a very specific service. So Inlex's registration is for a specific shade of red, used in a specific manner in relation to a very specific service.

45) The issue as to what can be considered to be an acceptable graphic representation is also dealt with in the opinion of the advocate general in *Ralf Sieckmann contra Deutsches Patent- und Markenamt* C-273/00. In that opinion the advocate general states:

"No basta, pues, cualquier representación gráfica, sino que es menester que cumpla dos condiciones. La primera, que sea completa, clara y precisa, para que se sepa, sin duda alguna, lo que se monopoliza. La segunda, que sea inteligible para quienes puedan estar interesados en consultar el registro, que son los otros productores y los consumidores."

So the advocate general considers that two conditions must be met in relation to graphic representation. Firstly, the representation must be complete, clear and precise so that it is known without doubt what is being monopolised. Secondly, it must be intelligible to those who have an interest in consulting the registrar, both producers and consumers.

46) In this case both the consumers and the producers involved in the service that Inlex supply will be very specialist and have a very specialised knowledge of what is meant by the description. (It is inevitably the case that with certain trade marks there will be a description rather than a representation. This is the case for instant with sound marks represented by musical notation.)

47) I consider that the representation will be understood by other producers and consumers. It will have a precise meaning for them. A problem arises in that the representation does not appear in colour in "The Trade Marks Journal", nor on the

web site of The Patent Office. An enquirer would have to call for the file to see the exact colour red for which rights are being claimed. It is possible to produce journals in colour, it is possible to show trade marks on the web site in colour. The technology is readily available to show the trade mark; unlike in the case of smell marks which were being considered in *John Lewis and Ralf Sieckmann*. I cannot see that it can be appropriate for a proprietor or applicant to suffer owing to the limitations of the current means used by the registry to show trade marks. If there was not a readily available technology the matter would be very different.

48) Taking into account all the factors that I have considered in the previous paragraphs I find that the trade mark in suit is graphically represented.

Capable of distinguishing the services

49) Henkel argue that the trade mark in suit is not capable of distinguishing the services of the registered proprietor from those of other undertakings. In *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* C-299/99 the European Court of Justice dealt with this matter. The Court stated that:

“It follows that there is no class of marks having a distinctive character by their nature or by the use made of them which is not capable of distinguishing goods or services within the meaning of Article 2 of the Directive.”

(Section 1(1) of the Act implements Article 2 of First Council Directive 89/104/EEC of 21 December 1988.) If a trade mark has become distinctive of an undertaking through use it cannot be refused under section 3(1)(a). The potential for being registrable means that section 3(1)(a) cannot be an impediment. This part of the Act, in relation to trade marks that are not capable of distinguishing the services of one proprietor from another, can only have effect if the trade mark, whatever the use, could not perform this function. There is nothing in the evidence before me to suggest that the trade mark in suit could never fulfil its function of distinguishing the services of Inlex from those of other undertakings, whatever the evidence of use.

50) Taking into account the above I do not consider that the registration should be declared invalid under section 3(1)(a) on the basis that the trade mark in suit is not capable of distinguishing the services of the registered proprietor from those of other undertakings.

Consideration of the evidence

51) In order to consider the other grounds relied upon by Henkel I think it best to first consider the evidence.

52) Mr Lucking states in the third paragraph of his witness statement:

“The Declarations contrast the red “Eslok” patches applied by Inlex; the “Anu-Lok” yellow patches applied by Alson Engineers; and the blue “Tuf-Lok” patches applied by P.S.M.”

53) Mr Tuff states, “Increasingly our customers specify the colour patch they require at the time of ordering and some require Test Certificates to verify that the patches were applied by a supplied approved by them. Hence in general our customers know who has applied a particular colour patch to our products, by the colour of the patch.” It might be argued that Mr Tuff’s conclusion is wrong; it is that the customer identifies the patch with its licensor and their trade mark – ESLOK. Mr Tuff goes on to exhibit at RBT1 a chart which compares the properties of the various patches. He states that, “It will be noted that the Eslok patches applied by Inlex are coloured red (or purple red)”. What this exhibit actually seems to identify is that the colour of ESLOK patches are red or purple red; the colour is related to the patch and not the act of applying the patch. There is no reference to the registered proprietor in exhibit RBT1.

54) Mr Tuff refers to the leaflet of Alston Engineers, exhibited at RBT2. He states that they offer a thread locking and sealing patch which is yellow. The leaflet rather than identifying the colour yellow with the company which applies the patch identifies it with the manufacturer of the patch. The patch is identified as “Anu-Lok® 180° Standard Locking Patch Colour Yellow”. Also included in this exhibit is a leaflet relating to TUF-LOK patches. The leaflet states that they have the advantage of an “easily identified Blue patch”. Again the colour of the patch relates to the type of patch and not the undertaking which applies it. The TUF-LOK leaflet would appear to be designed to give information to those who apply the patch.

55) Mr McKendrick states that the colour is used to identify the patching company. However, his company will only be using a limited number of companies. So if Inlex always apply ESLOK patches for his company and they are the only red patches that his products have he can identify them. However, another company could be applying ESLOK patches for other undertakings in the colour red and there would be no identification with Inlex. There is nothing to indicate that Inlex have the exclusive rights to apply ESLOK patches, so other users of patches who supply or may supply ESLOK patches can or will also apply the patches. According to the leaflet relating to IONIC, which was originally furnished by Inlex at the examination stage, IONIC apply ESLOK patches in the colour red. Mr McKendrick talks of red ESLOK patches applied by Inlex and blue TUFLOC patches applied by Tufloc; identifying the colour with the licensor rather than the licensee. He demonstrates that he knows that ESLOK patches are red. It can also be seen from the Nylok literature that he has adduced into the proceedings that it is the manufacturer of the patch which identifies the colour, in this case blue, with the product. The patch is described as “only one original “BLUE” NYLOK® self-locking, self-sealing, reusable fastener”.

56) Mr Bliss states how GKN entered into a licence agreement with Amerace Esna Corporation to make and use their patented products in the United Kingdom. The licence also included the right to use the trade mark ESLOK in connection with the products and related service. He states that the colour of the product applied was not specified but that each licensee, of which there were several, chose a different colour. Inlex are the eventual successors in title to GKN of the licence. From Mr Bliss's declaration it can be taken that there are several licensees for Eslok products. He states that each licensee chose a different colour. However, he does not advise how he knows this and he has not adduced a copy of that licence agreement. Mr Bliss makes his comments about GKN on what must be at best a hearsay basis or at worst a guess. He has not worked for GKN. He does not establish that there is any relationship between GKN and the other predecessors in title and Inlex. Mr Bliss has not adduced a copy of the licence agreement which Inlex hold.

57) Exhibited at AAB1 is a copy of a publication for GKN ESLOK patched fasteners. Page 1 of the publication refers to the ESLOK red nylon patch and states: "The GKN ESLOK self-locking feature is a carefully calculated deposit of red nylon, applied to dimensionally controlled area of screw threads...." The publication runs to nine pages in which there are numerous references to ESLOK and GKN ESLOK. There are no other references to the red colour of the patch. A further publication exhibited at AAB1 is "Facts and figures on fasteners". Of the four pages exhibited there is one reference to the colour red, where the following is stated: "An important feature of the Eslok red nylon locking patch is the fact....". Again the indicator of origin is the trade mark ESLOK. A publication from the Anochrome Group of Companies is exhibited at AAB1, Inlex is part of this group, reference is made to ESLOK; there is no reference to the patch being coloured red. Various other documents are exhibited which refer to ESLOK but do not refer to the colour of the patch.

58) Mr Bliss states:

"The red ESLOK patch has become well known in the industry and is often referred to by its colour".

I do not consider that Mr Bliss is in a position to speak for the industry as a whole. However, if what he states is the case he is not stating that the service of Inlex is associated with the red patch as an indicator of origin. He is stating that the ESLOK trade mark is associated with the red patch. Mr Bliss refers to exhibit AAB3 in support of his case. This is a Rover Engineering Standard issued in 1993. It is stated on the last page that the colour of the ESLOK system is red and the vendor/coating authority is Inlex. I see no reason to assume that the colour red is associated with Inlex rather than the ESLOK trade mark. The exhibit also refers to POLY-LOK as being green and the vendor/coating authority being Inlex. As the latter is in green why should the red be associated with Inlex rather than the green? The more reasonable conclusion is that goods under the trade mark ESLOK are

coloured red. That two different colours are used by Inlex for two different products appears to indicate that the colours are indicative of the product rather than of the enterprise which applies the product. (I do not go so far as to state that the colour red would be seen as a secondary trade mark of the ESLOK goods.) It is also to be noted that ESLOK is an approved system as per paragraph 9 of this document. This paragraph states that this approved system could be from another source "provided that parts supplied fully meet all requirements of this specification". Part of this specification would appear to be the colour red. So the document indicates another undertaking could apply the ESLOK patch in red. Rover do not seem to see red as being indicative of Inlex.

59) One of the most interesting documents in relation to the issues before me is the IONIC leaflet. No doubt as a result of an oversight or error Inlex did not reproduce this leaflet when the evidence of Mr Lucking was adduced into these proceedings. IONIC apply the same product, ESLOK, using the same colour, red. If at least one other licensee is applying the same product using the same colour what does this say about the ability, simply through the colour, to identify the processor? It is also to be noted that the IONIC exhibit seems to contradict the statement of Mr Bliss that each undertaking licensed to use the ESLOK trade mark chose a different colour. This exhibit, which it is to be remembered was originally that of Inlex, also contradicts the claim in the counterstatement that no one else uses the colour red in relation to the relevant service. It shows that another undertaking uses the colour red in relation to exactly the same service applying exactly the same product.

60) The figures in relation to promotion do not greatly assist Inlex; there is nothing to suggest that promotion has emphasised the use of the colour red in the process. Equally, the turnover figures tell me little about the position of the trade mark in suit. From the evidence they tell me more about the use of the names ESLOK and Inlex.

61) The web site printouts at AD2 of the declaration of Mr Dodwell emanate from well after the relevant date. However, in relation to the use of colour for patches there is nothing to indicate that this was not the position at the relevant date. The evidence from Inlex shows that this was common prior to the relevant date. The document from Rover refers to ESLOK being red, POLY-LOK being green and TUF-LOK being blue.

62) Mr Dodwell states that colour could indicate strength. He refers to exhibit AD1 in support of this. The inadequacies of this document are so great that I do not feel I can place any reliance upon what is stated in it. I have found no evidence that in the United Kingdom that the colours of these compounds relates to their strength. Indeed the evidence suggests the opposite. In the printout from the Bondloc web site, exhibited at AD2, the colour green is used on products whose strengths are described as being high, low, medium/high and very high.

Section 3(1)(c)

63) Section 3(1)(c) of the Act states that the following shall not be registered:

“(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,”

64) There is nothing in the evidence that leads me to the conclusion that the trade mark in suit falls foul of any of the above criteria. Henkel have claimed that the colour could indicate strength. I have referred in paragraph 62 to the inadequacies of the evidence in relation to this.

65) I find that there is no evidence to substantiate the claim that the trade mark in suit should be declared invalid on the basis of section 3(1)(c). This ground for a declaration of invalidity is dismissed.

Section 3(1)(d)

66) Section 3(1)(d) of the Act states that the following shall not be registered:

“trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:”

67) Inlex have pointed out that their trade mark is for a service, not for the goods. They draw a distinction between their supplying of the service and the use of the trade mark upon the goods. The service of Inlex is to apply the patch to products. According to Mr Bliss the licence agreement with Amerace Esna Corporation includes the right not only to use the ESLOK product but also to produce it (see paragraph 2 of his statutory declaration). The purpose of the service is to have the patch applied. Inlex state that one of the reasons for the patch being coloured is so that it can be seen that it is applied. The proximity of the goods and services leads me to believe that the differentiation between the service and the goods is an artificial one. They are inextricably linked; especially as the purpose of the service is to apply the specific product and the trade mark is the colour of the product that has been applied. I do not believe that the customer will make the distinction that Inlex wish me to make.

68) I am, therefore, left with the issue as to whether the particular colour is common in the trade in the United Kingdom. My decision can only be made upon the basis of the evidence before me. There are various references to red in documents. However, there is an absence of evidence to show that the red referred to is the particular red which is the subject of the trade mark in suit.

69) In the absence of evidence to substantiate the ground of invalidity under section 3(1)(c) this ground is dismissed.

Section 3(1)(b)

70) Section 3(1)(b) of the Act states that the following shall not be registered:

“trade marks which are devoid of any distinctive character,”

71) What does devoid of any distinctive character mean? In *British Sugar Plc v. James Robertson & Sons Ltd* [1996] RPC 281 Jacob J stated that:

“Next, is "Treat" within section 3(1)(b)? What does *devoid of any 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? A meaningless word or a word inappropriate for the goods concerned ("North Pole" for bananas) can clearly do. But a common laudatory word such as "Treat" is, absent use and recognition as a trade mark, in itself (I hesitate to borrow the word from the old Act but the idea is much the same) devoid of any distinctive *inherently* character.”

72) Mr Hobbs, sitting as the appointed person, has referred to trade marks which are origin neutral and those which are origin specific; ie those signs which act as indicators of origin and those which do not. The purpose of a trade mark is to act as an indicator of origin. To effect this it must be distinctive of an enterprise. If it does not effect this then it is liable to fall foul of section 3(1)(b). With certain trade marks there is a presumption that they can act as an indicator of origin; for instance an invented word with no allusion to the goods in relation to which it is used. In other cases the presumption is that a sign cannot act as an indicator of origin, without evidence of factual distinctiveness; this might be the case of a single letter mark. Sections 3(1)(c) and (d) define clear parameters as to the nature of the objection, section 3(1)(b) does not give any such definition. It is the section of the Act which gathers those trade marks which fall through the net of sections 3(1)(c) and (d) but still do not fulfil the function of a trade mark.

73) In the absence of use will the trade mark in suit act as an indicator of origin? As the colour is the colour applied to the product I cannot see why anyone should assume that there is a relationship between the colour and Inlex a priori. The colour will simply be seen as the colour applied to the product. I do not think that anyone would assume that it has trade mark properties. This is especially the case when there is much evidence to show that colours are applied to patches to make them readily visible; in the normal course of events the colour is performing a function of showing that the patch has been applied.

74) The Court of First Instance in *Mag Instrument Inc. v Office for Harmonization in the Internal Market (Trade Marks and Designs)* Case T-88/00 stated:

“Under Article 7(1)(b) of Regulation No 40/94, moreover, it is sufficient, in order to defeat the absolute ground for refusal, to demonstrate that the mark possesses a minimum degree of distinctiveness. It is therefore necessary to determine - in the context of an a priori examination and without reference to any actual use of the sign within the meaning of Article 7(3) of Regulation No 40/94 - whether the claimed mark will enable the targeted public to distinguish the marked goods or services from those of other undertakings when they come to make a purchasing choice.”

75) I do not consider that the trade mark in suit has that minimum degree of distinctiveness. The trade mark in suit is a priori devoid of distinctive character. As such it can seek aid from the proviso.

The proviso

76) The proviso states, in relation to sections 3(1)(a), (b) and (c) the following:

“Provided that, a trade mark shall not be refused registration by virtue of paragraph (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.”

77) Does the evidence of Inlex show at the date of application that the trade mark in suit had acquired a distinctive character through use? In considering the use I have born in mind the following points:

- Inlex use other colours for other patches, this use of other colours is likely to lead the consumers as not seeing one specific colour as being an indicator of origin of Inlex.
- The use of bright colours is common in the trade. They are used so that the patch can readily be seen.
- There is no clear identification in the evidence that the red which is referred to in the literature is the red of the trade mark in suit.
- At least one other enterprise uses the colour red for exactly the same products that it applies.
- The evidence links the colour with the trade mark ESLOK far more than with Inlex.

78) The evidence of use does not convince me that the trade mark in suit would be seen as identifying the business of Inlex.

79) Inlex cannot benefit from the proviso.

Conclusion

80) Under section 47(1) of the Act I find that registration no 2150607 is invalid on the ground that it was registered in breach of section 3(1)(b) of the Act. Accordingly I direct that registration no 2150607 be declared invalid and removed from the register and, in accordance with section 47(6), be deemed never to have been made.

81) The applicant having been successful he is entitled to a contribution to his costs. I order the registered proprietor to pay the applicant the sum of £1,450. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 19th day of August 2002

**D.W. Landau
For the Registrar
the Comptroller-General**