

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 2233932  
BY ROBERT McBRIDE LIMITED**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 52032  
BY UNILEVER PLC**

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by Robert McBride Limited**

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by Unilever Plc**

### **Background**

1. On 25 May 2000, Robert McBride Limited applied to register a trade mark in Class 3 in respect of:

Cleaning preparations; bleaching preparations; dish washing powders; textile washing powders; rinsing agents; all in tablet form.

2. The mark applied for is as follows:



A 3-dimensional shape with the colours yellow Pantone reference 101U, pink Pantone reference 231U and white as shown on the attached representation.

The text describes the colours in order from top to bottom of the tablet

3. On 18 January 2001, Unilever Plc filed notice of opposition to this application in which they say that the mark consists of a representation of the shape of the goods applied for, including soap, washing and laundry tablets and is constituted of a combination of colours which are common to the trade or otherwise non-distinctive. The grounds on which the opposition is based are as follows:

- 1. **Under Section 3(1)(a)** because the mark is not capable of distinguishing,
- 2. **Under Section 3(1)(b)** because the mark is devoid of distinctive character,
- 3. **Under Section 3(1)(c)** because the mark consists exclusively of a sign or indication that serves in the trade to designate the kind, quality, intended purpose or other characteristic of the goods covered.
- 4. **Under Section 3(1)(d)** because the mark consists exclusively of a sign which has become customary in the bona fide and established practices of the trade,
- 5. **Under Section 3(2)(b)** because the mark consists of a shape necessary to achieve a technical result,
- 4. **Under Section 3(6)&32(3)** because the applicants have no intention to use the mark in relation to the goods for which it has been applied.

4. The applicants filed a counterstatement in which they deny the grounds on which the opposition is based. Both sides ask that an award of costs be made in their favour.

5. Only the opponents filed evidence in these proceedings. The matter came to be heard on 21 May 2002, when the applicants were represented by Mr Keith Hodkinson of Marks & Clerk, their trade marks attorneys, the opponents by Mr Mark Hickey of Castles, their trade mark attorneys.

### **Opponents' evidence**

6. This consists of two Statutory Declarations. The first is dated 27 July 2001 and comes from Jacqueline Lake, an investigator/research operative in the employ of Farncombe International Limited. Ms Lake states that she has been employed by her company for 15 years, and confirms that the contents of her Declaration relate to matters wholly within her own knowledge.

7. Ms Lake recounts her receiving instructions to “determine the subsistence of cleaning products sold in tablet form with emphasis upon the shapes and colours thereof.”, and to the results of visits to a branch of Sainsbury’s and Tesco supermarkets during which she purchased samples of every dishwashing and laundry tablet product on display, some 28 items in total. Exhibits JL1 and JL2 consist of copies of the till receipts received following the purchases and show these to have been made on 26 February 2001. Exhibits JL3 and JL4 consist of a summary of the results of the investigations and photographs of the products purchased, respectively. Both exhibits show that there is a wide range of detergent products sold in tablet form, and that;

- S are either circular or rectangular in shape, come in single colour or two colour combinations;
- S single colour tablets are most commonly white-ish;
- S where a second colour is used this is blue/grey, either in a separate layer or speckled in the white;
- S are sold under a brand name;
- S in some instances a representation of the tablet is shown on the exterior packaging;
- S the packaging contains references such as “2 in 1”, “contains fabric conditioner”, “contains dyelock”, “brilliant cleaning plus fabric conditioner”, “in-wash stain remover- double action”, “dual layer”, “dual layer citrus”, “new built-in rinse agent”.

8. Ms Lake’s summary refers to use of green but this cannot be ascertained from the photographs. There are no examples showing use of the colours pink or yellow on the tablets themselves, but the packaging from a range of manufacturers of this type of product consistently use the colour yellow to indicate a lemon or citrus content.

9. The second Statutory Declaration is dated 6 August 2001 and comes from Stephen Francis Beale, a trade mark adviser employed by Unilever Plc, a position he held for 5 years, having practised in the field of intellectual property, with particular emphasis on trade marks, since 1993. Mr Beale confirms that the matters deposed to are from his own knowledge, save where otherwise stated.

10. Mr Beale refers to the Declaration by Jacqueline Lake, and in particular, to a “Fairy” branded product which he says appears not to have been available from the stores she visited. A photograph of the “Fairy Tab in Tab” product and the till receipt for the purchase (made on 31 July 2001) are shown as exhibit SB1.

11. Mr Beale refers to a visit to Sainsbury’s where he purchased a range of coloured shaped products from the household area, a copy of the receipt being shown as exhibit SB2, and photographs of the products as exhibit SB3. The photographs depict a range of single and multi-coloured detergent, soap and sponge-type cleaning products. Mr Beale makes some assertions regarding the use of colours in the household cleaning area, including that the combination yellow, pink and white is common in relation to the packaging of household cleaning products although he provides no evidence, nor does he say that the combination is commonly used in respect of the tablets themselves. He goes on to explain how his company and the major supermarkets (which I take to be a reference to “own label” products) use various colours to indicate a characteristic of the goods, for example, green to indicate a biological or fragrance content, yellow to indicate citrus or lemon, etc.

12. Mr Beale goes on to say that multi-layer tablets are common place in the United Kingdom for household cleaning products. He says that the layered aspect is often used to communicate a performance characteristic, dosage or constituent, citing Dual action (Vanish tablets, Tesco dishwasher tablets) and Triple action (Sainsbury's dishwasher tablets, Domestos rim and cistern blocks). By way of example he refers to exhibit SB4 which consists of copies of external packaging for multi-layered dishwashing and toilet cleaning blocks, all of which describe the layers as containing a particular constituent to perform various parts of the cleaning process. There is, however, nothing by which to date them.

That concludes my review of the evidence insofar as it is relevant to these proceedings.

## Decision

13. At the hearing Mr Hickey informed me that the opponents would only be pursuing the opposition on the basis of the grounds under Section 3(1)(b), 3(1)(c) and 3(1)(d). Those sections read as follows:

“**3(1)**.- The following shall not be registered -

- (a) signs which do not satisfy the requirements of section 1(1),
- (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,
- (d) 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:

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.”

14. In his submissions, Mr Hodgkinson outlined his clients position as follows:

*“I would also concede that in my clients’ opinion, the policy decision taken by the Registry to accept registration of three-layer tablets of this type is unfortunate and does appear to deviate from and conflict with the views expressed by the Court of First Instance in a Henkel case.*

*My clients’ perception here is that they do not feel strongly about the merits of marks of this type. It would be quite happy if they were not to be registrable. However, since the Registry is permitting registration of Henkel and Benckiser marks, major competitors of my clients, and such large numbers of them as to force my clients into*

*taking defensive measures such as filing applications of this kind, we should be treated no worse than Henkel and Benckiser.”*

15. This is a somewhat unusual position in that the applicants all but agree that the mark that they seek to register is not, in fact, distinctive, at least, absent of distinctiveness acquired through use, basing their arguments on the premise that what is good for their competitors must also hold good for them. Whilst I have some sympathy with the position that Mr Hodkinson’s clients find themselves in, the prior acceptance of similar, or even identical trade marks can have no bearing on my decision; I do not know on what basis those marks were accepted

16. So how stands the law? In relation to Section 3(1)(b), Mr Justice Jacob in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 said:

*“Next is “TREAT” within Section 3(1)(b). 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?”*

17. In *Procter and Gamble v OHIM, Case C-383/99* (the BABY-DRY case), the ECJ indicated that Section 3(1)(c) should be regarded as follows:

*“The signs and indications referred to in Article 7(1)(c) of Regulation 40/94 are thus only those which may serve in normal usage from a consumer’s point of view to designate, either directly or by reference to one of their essential characteristics, goods or services such as those in respect of which registration is sought. Furthermore, a mark composed of signs or indications satisfying that definition should not be refused registration unless it comprises no other signs or indications and, in addition, the purely descriptive signs or indications of which it is composed are not presented or configured in a manner that distinguishes the resultant whole from the usual way of designating the goods or services concerned or their essential characteristics.”*

18. In relation to Section 3(1)(d), the ECJ has said in *Merz v Krell GmbH, Case C-517/99*, that:

*“It must first of all be observed that, although there is a clear overlap between the scope of Article 3(1)(c) and 3(1)(d) of the Directive, marks covered by Article 3(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the trade mark is registered.”*

19. Both sides made reference to the Registrar’s practice in relation to marks where colour is a feature. This states that marks composed of two or more colours may be registrable, prima facie, but this will depend on factors such as how they are presented and what they have been applied to. The practice indicates that where the colours have been applied to the packaging of the product, and by extension or inference, the product itself, it is unlikely that the colours

will be recognised as a trade mark, and if the mark is to stand any chance of being registered, evidence of factual distinctiveness will be required. The role and significance of the Registrar's practice was considered in the case of Henkel KGaA's appeal to the Appointed Person against a refusal by the Registrar to grant protection in respect of International Registration number 708442, in which Simon Thorley QC gave the following opinion:

*"....I must mention the Registry Practice which was drawn to my attention by Mr McCall and subsequently clarified by Mr Knight. Mr McCall submitted that the Registry Practice consisted of allowing registration of a shape/colour mark without evidence of use, on a prima facie basis, where there was a three colour combination. Mr Knight amplified upon this stating that the Registry Practice was indeed that, as a guideline, the combination of three colours was the minimum necessary to qualify for registration but that each case had to be considered separately and that three colours by themselves might not be sufficient. In each case the Registry had to be satisfied that the combination of colours and shape was distinctive.*

*It must always be remembered that the Registry Practice is a guideline and nothing more. It is helpful both to the Registry and to practitioners, but it cannot absolve the Registrar's hearing officers, or me on appeal, from approaching each case on its own facts. The fact that a mark consists of three colours will not necessarily qualify it for registration and the fact that it consists of only two cannot be an absolute bar to registration. In each case it is necessary to have regard to the combination of colours and shape in reaching a conclusion as to whether or not the overall combination is distinctive in a trade mark sense."*

20. So the fact that the mark in suit is composed of three colours does not, on Registry Practice, make the mark in suit registrable. Each case must be considered on its own merits and with regard as to whether the overall combination of colours and shape is distinctive in a trade mark sense.

21. In *Benckiser NV's* appeal in respect of International Registration No. 700785, Geoffrey Hobbs QC looked at the question of the registrability of the two-layered tablet in the following way:

*"My approach to the question of registrability under section 3(1) of the 1994 Act is as indicated in Reetsma's application 7 September 2000; see pages 6 to 10 of the decision under the heading "Section 3(1)(b) of the 1994 Act."*

*The get-up (in terms of the shape and colours) of the tablets I am now considering must be sufficient in and of itself to denote origin in order to be separately registrable as a trade mark under the Act. The higher the degree of individuality it possesses, the greater the likelihood of it possessing trade mark significance in the perceptions and recollections of the average consumer.*

*It is therefore, appropriate to consider the extent to which the relevant features or shape and colours may have broken new ground in the presentation of Class 1 and Class 3 goods in the United Kingdom at the relevant date and what effect that might have upon the perceptions and recollections of the average consumer of such goods."*

22. Not surprisingly both parties pay little regard to the shape, which can best be described as a rectangular tablet, each edge of which is slightly bevelled. The evidence shows this to be one of a number of shapes used by traders of detergent and disinfectant tablets, and adopting the words of Geoffrey Hobbs QC “*represents only a minor variation of a basic geometric shape*.”. I see nothing that persuades me that the shape in this case is any more distinctive in a trade mark sense than the round tablet was found to be in the *Benckiser* case.

23. The mark is stated to be in three layers of colour; yellow (Pantone 101U) on the top, pink (Pantone 231U) in the middle and white on the bottom. The opponents assert that the fact that there are three distinguishable layers would be taken as no more than an indication that the tablet contains three different active ingredients, and that as far as the colours themselves are concerned, the colours used are commonly used for such goods, for example, to indicate the presence of certain qualities in the tablet, yellow for citrus being one example given.

24. The evidence substantiates both of these submissions. Exhibit JL4 consists of photographs of cleaning tablets and their packaging. A number of the tablets have different coloured layers, albeit only consisting of two colours, and primarily white and blue. The packaging of such products shows consistent use of the colour yellow in connection with tablets said to be “citrus” or “lemon” fragranced. Exhibit SB4 contains an example of the packaging for various block detergents, inter alia, a product known as “FINISH POWERBALL TABS”, a two-layer rectangular tablet of blue and white, with a red ball impressed into the upper surface. Whilst providing an example of product with three components distinguished by colours, this is not strictly an example of a three-layered tablet in the “traditional” shape shown by the evidence in this case. However, the packaging for this product contains the following descriptions related to the coloured elements:

“The white layer cleans all traces of dirt away, for a spotless and brilliant finish.”

“The blue layer breaks down and lifts off the dried-on food residue.”

“New Finish tablets have the revolutionary POWERBALL which contains unique StainSoakers. The POWERBALL starts to dissolve instantly to release the StainSoakers which get to work straight away, soaking and softening really dried-on food residue such as baked-on egg and cheese sauces.”

25. Other examples of layered detergent or disinfectant tablets shown in the exhibit make references such as “New Domestos Triple Action Rim Blocks are the only rim blocks that 1. Freshen 2. Prevent limescale and 3. Kills germs.”. The Tesco dishwasher tablets refer to the “New improved Dual Layer Action - The enzymes in the blue layer combine with a gentle but effective bleaching system to deliver best ever cleaning.”.

26. Although the evidence does not establish that coloured layered tablets were in use at the date that the application in suit was made, the *Benckiser* case referred to above dates from at least 13 August 1998. At the hearing I was also referred to several other decisions involving similar marks that had been filed between April and October 1998 in the name of four separate proprietors. Based on this and the evidence and information available to me, I believe that it is clear that the concept of detergents, disinfectants and the like, being available in the form of a



tablet composed of different layers of colour had been around for some time prior to the relevant date, and that a number of traders had placed, or proposed to place, such goods on the market. The evidence also clearly establishes that the colours, whether represented in layers or speckled one into another, denotes the presence of different active ingredients and/or fragrances, a fact readily accepted in the cases to which I have referred.

27. In the decision of the Court of First Instance of the European Communities in Henkel KGaA's appeal against the refusal of OHIM to grant protection in respect of a similar three-dimensional mark, the CFI said:

*“Indeed distinctiveness must be denied if, as in the present case, the sectors of the market addressed are induced to understand the presence of coloured elements as an indication of given properties of goods and not as an indication of their origin. The mere possibility that consumers become accustomed to recognising goods by their colours is not sufficient to remove the obstacle to registration provided by Article 7, paragraph 1, letter b of Regulation 40/94 [GMVO].”*

28. In the *Benckiser* case, Mr Hobbs put the position as follows:

*“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.”*

29. Mr Hobbs went on to hold that the appearance of the tablets put forward for registration was not sufficiently arresting so as to perform the essential function of a trade mark, and to be devoid or unpossessed of a distinctive character, and excluded from registration by Section 3(1)(b) of the Act at the relevant date. Although that case involved tablets comprised of two coloured layers, given the reasoning behind Mr Hobbs' findings and the arguments and evidence before me, I see no logical reason why the position should be found to be any different where there are three coloured layers.

30. In *Procter & Gamble Company's* appeal against the decision of OHIM to grant protection in respect of a similar three-dimensional mark, the Court of First Instance (case 62000A0117) said:

*“As regards the use of the colour green, it must be observed that the use of basic colours, such as blue or green, is commonplace and is even typical of detergents. The use of other basic colours, such as red or yellow, is one of the most obvious variations on the typical design of these products. The same is true of the various shades of those colours. For that reason, the applicant's argument that the mark applied for is distinctive because one of the layers of the tablet is “pale green” must be dismissed.”*

31. In this case the evidence shows that the colours specified in the application, namely, white, yellow and pink (a shade of red) are used, to differing degrees and varying shades by other traders, both on the goods themselves and on the packaging. In my view there is nothing sufficiently arresting about the combination of these three colours, nor anything in the individual and collective features of the mark applied for that persuades me that the mark in

this case should be regarded as being capable of distinguishing or denoting trade origin. Consequently, the opposition in respect of Section 3(1)(b) succeeds.

32. My decision under Section 3(1)(b) effectively decides the matter. Although I do not, need to go on to consider the grounds under Sections 3(1)(c) and 3(1)(d) in detail, it is worth mentioning the decision of the Court of First Instance of the European Communities in Henkel KGaA's appeal against the refusal of OHIM to grant protection in respect of a similar three-dimensional mark. In their decision upholding the findings of the Appeals Board of OHIM, the CFI said:

*“The coloured particles therefore indicate the given properties of the goods but cannot therefore be regarded as descriptive particulars in the sense of Article 7, paragraph 1, letter c of Regulation 40/94 [GMVO].”*

33. So the objection is not that the mark may serve, or has become customary in the trade as an indication or designation of the kind, quality, intended purpose or other characteristic of the goods covered, and contrary to Section 3(1)(c) and 3(1)(d), but that it cannot serve to distinguish such goods and is not distinctive in terms of trade origin as required by Section 3(1)(b).

34. The opposition having been successful, the opponents are entitled to an award of costs. I order the applicants to pay the opponents the sum of £1,500 as a contribution towards their costs. This sum 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 03 day of February 2003**

**Mike Foley  
for the Registrar**