

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NOS. 2268964 & 2268967
BY DALLI-WERKE WÄSCHE UND KÖRPERPFLEGE GMBH & CO KG**

AND

**CONSOLIDATED OPPOSITION THERETO UNDER NOS. 90462 & 90456
BY ROBERT MCBRIDE LTD**

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**IN THE MATTER OF application Nos. 2268964 & 2268967
by Dalli-Werke Wäsche und Körperpflege GmbH & Co KG**

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**Consolidated opposition thereto under No. 90462 & 90456
by Robert McBride Ltd**

Background

1. On 2 May 2001, Dalli-Werke Wäsche und Körperpflege GmbH & Co KG applied to register two trade marks, both in Classes 1 and 3, and in respect of:

Class 1 Water-softening preparations.

Class 3 Bleaching preparations and other substances for laundry use; cleaning preparations; detergents, including dishwasher detergents; stain removing preparations.

2. The marks applied for are as follows:

2268964



The mark consists of a 3-dimensional shape with the colours blue white and green (the colours in order from top to bottom of the tablet) claimed as being an element of the mark.

2268967



The mark consists of a 3-dimensional shape with the colours green white and yellow (the colours in order from top to bottom of the tablet) claimed as being an element of the mark.

3. On 5 October 2001, Robert McBride Ltd filed notice of opposition to the applications. The grounds on which the opposition is based are as follows:

1. Under Section 3(1)(b) because the mark is devoid of distinctive character,

2. Under Section 3(1)(c) because the mark consists exclusively of shapes and colours which may serve in trade to designate the kind, quality, intended purpose or other characteristic of the goods for which protection is sought.

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. Both sides filed evidence in these proceedings. The matter came to be heard on 28 January 2003, when the applicants were represented by Ms Virginia Douglas of Withers & Rogers, their trade marks attorneys, the opponents by Mr James Mellor of Counsel, instructed by Marks & Clerk, their trade mark attorneys.

Opponent's evidence

6. This consists of a Witness Statement dated 19 February 2002, from Julia Bradley, the head of marketing of Robert McBride Ltd, a position she has held since 1999. Ms Bradley states that she has been actively engaged in the textile and dishwashing business since 1988, and that she makes her statement on the basis of her personal knowledge and the exhibits produced and shown to her.

7. Ms Bradley refers to the arrangement and colours of the mark applied for, asserting that the shape of the tablet is commonplace and ensures the correct dosage of detergent. She says that these tablets are round or rectangular in shape, initially white although later on contained speckles (that may or may not denote an active ingredient) in much the same way as loose washing powders have contained more than one colour element. Ms Bradley says that this

developed into the use of tablets with colours in separate layers, the colours denoting their multi functional nature, Ms Bradley asserting that the colours of the application are commonly used in industry. She refers to exhibit JBA which consists of photocopies of packaging that depicts detergent tablets in either circular or rectangular shape, some in single colour or two colour combinations; single colour tablets are most commonly white-ish; where a second colour is used this is blue/grey, either in a separate layer or speckled in the white; are sold under a brand name and in some instances a representation of the tablet is shown on the exterior packaging. As stated by Ms Bradley, the evidence shows detergent tablets of this type have been introduced to the market by a number of traders. Although the exhibit does not establish this to have been the case at the relevant date, Ms Bradley gives a chronology of when, and in what form, particular traders introduced tablets to the market.

8. Ms Bradley says that the colours green, white red, yellow, pink and blue have commonly been used in industry, setting out those that are used to denote particular functions, for example, blue for high performance, white to indicate cleanliness, red to indicate a strong anti-grease agent, yellow to indicate lemon fragrance, etc. She asserts that through the promotional activities of traders, the functionality of colours has become known to the public, who have also been educated to the dual or double-action nature of such tablets, in support referring to exhibit JBB. The exhibit consists of further photocopies of packaging, containing clear references to the functions of the coloured elements, making statements such as “2 in 1”, “double action” and “dual action”, and in the case of the Finish Powerball, 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 residues.”

“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 residues such as baked-on egg and cheese sauces.”

9. Ms Bradley refers to exhibit JBC which comprises a video recording of a television broadcast relating to the product.

10. Ms Bradley refers to the development from single colour tablets, to two-layer and three-layer tablets, and to the “marketing advantage” gained by promoting this technical functionality to consumers. She refers to exhibits JBD and JBE which consist of details of trade mark applications for two-layered tablets made in the UK and Community Trade Mark Offices. Ms Bradley concludes her Statement by referring to decisions issued by the CFI.

Applicant’s evidence

11. This consists of a Witness Statement dated 30 May 2002 from Renny Patrick Brunnock, Managing Director of dicom-dalli UK Limited, a wholly owned subsidiary of Dalli-Werke Wäsche-und Körperpflege GmbH & Co KG, a position he has held since 3 April 2001, having previously been involved in the field of dishwashing preparations in the UK since 1992.

12. Mr Brunnock refers to the shape and colours of the marks applied for, stating that these do not designate a characteristic of the goods, Whilst accepting that the colours may be used in advertising to indicate the various functions performed by the tablets, he states that the colours do not derive from the ingredients and that different colours are used by different manufacturers to identify their products.

13. Mr Brunnock refers to the Statement of Julia Bradley, commenting that her evidence shows that ingredients to perform different functions could be incorporated into a single white tablet, and that using colour to distinguish the different functions in a graphical manner is very different from using ingredients which are themselves of a particular colour and would appear as such in the final product. He states that the evidence shows that manufacturers use different colours to denote similar functions.

14. Mr Brunnock refers to exhibit JBB (of Ms Bradley's Statement) in particular, to the FINISH blue, white and red Powerball tablet, noting the references to the different functions of the various coloured elements. He disputes Ms Bradley's assertion that there is an industry "code" in the use of colours. He concludes his Statement by commenting on the substance of the opposition and stating that in his view the mark is registrable.

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

Decision

16. The opposition stands under Sections 3(1)(b) and 3(1)(c) of the Act. Those sections read as follows:

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

- (a) ...
- (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) ...

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."

17. 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?”

18. I am also mindful of the decision of Geoffrey Hobbs QC in the “*Cycling IS ...*” trade mark case [2002] RPC 37, in which he said:

“It thus appears to be legitimate, when assessing whether a sign is sufficiently distinctive to qualify for registration, to consider whether it can indeed be presumed that independent use of the same sign by different suppliers of goods or services of the kind specified in the application for registration would be likely to cause the relevant class of persons or at least a significant proportion thereof, to believe that the goods or services on offer to them come from the same undertaking or an economically-linked undertaking.”

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 whether or not this is the case will depend on factors such as how they are presented and to what they have been applied. The practice also indicates that where the colours have been applied to the packaging of the product (and by extension or inference to the product itself) it is unlikely that they will be recognised, *prima facie*, as a trade mark. Ms Douglas made reference to the fact that at the time that her client’s made their application, the mark in suit was considered acceptable for registration and it would be unfair if through no fault of their own the goalposts had now shifted. Whilst I have some sympathy with Ms Douglas, this cannot be a determining factor, for if it were, it would compel me to find against the opponents even if I were satisfied that they had made their case.

20. The role and significance of the Registrar’s practice was considered in the case of *Henkel KGaA’s* appeal to the Appointed Person against the refusal of the Registrar to grant protection in respect of International Registration number 708442. In his decision 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."

21. To the above I would add that whilst it is desirable that practice should be constant, it must also reflect the current understanding of the relevant statutes, and accordingly, may be subject to revision.

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

23. 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."

24. 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.

25. The marks are in three layers of colour. The opponent's 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 functions, and as far as the colours themselves are concerned, these are commonly used for such goods, for example, to indicate the presence of certain qualities in the tablet, yellow for a softener or lemon fragrance being one example given. The applicants

submit that particular colours do not denote specific characteristics of the tablets, and even if they do indicate the presence of an active ingredient, fragrance or whatever, the combination of colours used can still also function as a badge of origin.

26. The exhibits contain copies of cleaning tablets and their packaging. These show consistent use of the colour yellow in connection with tablets said to be “citrus” or “lemon” fragranced, although the use of other colours seems to be more arbitrary. A number of the tablets have different coloured layers, albeit only consisting of two colours, usually white with blue or white with green, although there is one example of a dishwasher tablet from Sainsbury’s that relates to a 3-layer detergent tablet in the colours green, white and yellow (the same colours and arrangement as in 2268967) describing the tablet as “triple action”-“action 1-enzymes attack the stubborn dried and burnt on foods, action 2-silver-friendly agents protect your silverplated and sterling silver cutlery, action 3- the white layer cleans away the toughest of stains, removing food and greasy residue to give sparkling results and clean, fresh smell”. The packaging also states “Each individual tablet fits directly into the dispenser giving an exact dosage with no more mess or waste.” which confirms the statement to this effect made by Ms Bradley.

27. The exhibits also include an example of the packaging for a product known as “FINISH POWERBALL”, 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 residues.”

“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 residues such as baked-on egg and cheese sauces.”

28. Other examples of layered detergent tablets shown in the exhibits, such as 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.”, the Vanish washing machine tablets as “powerful stain removers in the green layer get to work immediately, gently penetrating and loosening the toughest stains...whilst the white layer works through the wash with the detergent to remove them completely.”

29. The exhibits include two pages of what appears to be advertising materials dating from August-September 1999, relating to a Persil two layer tablet, indicating that one layer “cares” whilst the other “cleans”. Although the remainder of the evidence cannot be dated, and therefore, 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, and I am aware of several other decisions involving similar marks filed between April and October 1998 in the name of separate proprietors. On the evidence and information

available to me I believe that it is clear that the concept of detergents 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, have been actively promoted as denoting the presence of different active ingredients and/or fragrances, a fact readily accepted in the cases to which I have referred.

30. 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].”

31. In the Benckiser case referred to above, 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.”

32. 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. That case involved tablets comprised of two coloured layers, but given the reasoning behind Mr Hobbs' findings and the arguments and evidence before me, I see no logical reason as to why the position should be found to be any different where there are three coloured layers. Mr Mellor suggested that having reached this position, the colours used becomes immaterial to the question of distinctiveness. I would agree with this to a certain extent, but would not go so far as to say that there is no threshold over which a mark such as this may step into distinctiveness.

33. 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.”

34. The evidence in these cases show that the colours specified in the application, namely, blue, white, green and yellow are all used, albeit in varying shades, arrangement and combination (although in the Sainsbury's case in an almost identical get-up) by other traders, both on the goods themselves and on the packaging. These are the very colours that the case above refers to as being in common use in relation to detergents. White is so commonly used that it does not even warrant a mention.

35. It may well be that particular combinations of colour and/or shape impart a degree of individuality to a tablet that enables the consumer to tell it apart from other tablets, but as Mr Mellor said in quoting Mr Hobbs (in Henkel's appeal in relation to international registration number 700785) that is not the question. The issue is whether the individuality is sufficient to render the tablet distinctive in terms of trade origin.

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

37. My decision under Section 3(1)(b) effectively decides the matter, and I do not, therefore, need to go on to consider the grounds under Sections 3(1)(c) in detail. 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 indication 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.”

38. In the decision of the Court of First Instance of the European Communities in relation to Henkel KGaA's appeal against the refusal of OHIM to grant protection in respect of a similar three-dimensional mark, the CFI upheld the findings of the Appeals Board of OHIM, saying:

“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]”

39. Whilst there is commonality in the use of some colours by a number of traders, for example, yellow to denote a lemon or citrus fragrance, there is nothing in the evidence that establishes that specific colours serve in the trade to designate a particular feature, nor that the consumer has been educated to recognise specific colours as denoting a particular characteristic of the tablets. Apart from the obvious usages such as the example I have given, the choice of the individual and combination of colours appears to be somewhat arbitrary. The most that can be said is that the number of colours used indicates the presence of a corresponding number of features in the tablet, but says nothing about the features themselves. As indicated in the case above, the objection is not that the mark may serve 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), 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). The ground under Section 3(1)(c) is therefore dismissed.

40. At the conclusion of the hearing I indicated that I considered the case to be unremarkable and that costs awarded from the scale would be appropriate. Mr Mellor concurred with this. Ms Douglas took issue, arguing that should this case go against her clients it would be unreasonable for her clients to be penalised by having costs awarded against them.

41. Ms Douglas stated that her clients had not been aware that the opponents were being represented by counsel. She also mentioned that the application was made on the basis of the prevailing Registry practice, and that should the opposition succeed, this will be a fundamental change from the position at the time that they made the application. This is a reference to the Registrar's practice which accepted marks composed of three colours as being distinctive.

42. It is regrettable that the applicants were not made aware that Mr Mellor would be appearing for the opponents, but apart from stating that had they known the applicants may well have also appointed counsel, an option that they always had, Ms Douglas did not say how this had disadvantaged her clients.

43. I have already mentioned the Registrar's practice, which Ms Douglas accepted formed no more than guidance on the way that particular marks may be viewed by the Registrar. Whilst the benefits of a practice are self evident, it cannot, and should not be taken as being set in stone. As case law relating to the provisions of the statutes develops, the way in which practice is applied will also change. In this case practice is evolving as much as a result of actions and evidence from the trade, as from a revision of the understanding of the law. Having been made aware of circumstances of the trade that cast doubt upon the correctness of the acceptance, the Registrar is, I consider, duty bound to act.

44. The applicants were free to withdraw their application at any time, but in electing to defend it against an attack by a third party, they knew that they would be liable for costs should their defence prove unsuccessful. In my view, what would be inequitable, would be for the opponents, having been successful, to be denied their costs, and I see nothing that persuades me to do this.

45. 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 £2,950 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 02 day of April 2003

**Mike Foley
for the Registrar**