

O-043-04

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2278906
BY BIOTEX BV
TO REGISTER THE TRADE MARK:**



IN

CLASS 3

AND

**THE OPPOSITION THERETO
UNDER No 91205
BY
RECKITT BENCKISER (UK) LIMITED**

Trade Marks Act 1994

In the matter of application no 2278906
by Biotex BV
to register the trade mark:



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the opposition thereto
under no 91205
by Reckitt Benckiser (UK) Limited

BACKGROUND

1) On 23 August 2001 A/S Blumoller and McCormick (UK) Plc t/a Jenks Sales Brokers applied to register the above trade mark (the trade mark). After the date of application the trade mark was assigned to Biotex BV, which I will refer to as BBV. The application was published for opposition purposes in the "Trade Marks Journal" on 31 July 2002 with the following specification:

detergents; biological laundry detergents; detergents for commercial, domestic and laundry use.

The above goods are in class 3 of the International Classification of Goods and Services. The trade mark is in colour, although no claim to colour is made. The words are in white, with the exception of black which is in yellow. The main body of the trade mark is in blue.

2) On 31 October 2002 Reckitt Benckiser (UK) Limited, which I will refer to as Reckitt, filed a notice of opposition to this application.

3) Reckitt claims that the overwhelmingly dominant element of the trade mark is the word BLACK. It states that black is an ordinary and most basic (sic) colour. Reckitt states that use of BLACK for the goods encompassed by the application renders the trade mark incapable of distinguishing the goods of BBV from those of other undertakings. The trade mark cannot identify the source of goods to the average consumer. Consequently, registration of the trade mark is contrary to section 3(1)(a) of the Trade Marks Act 1994 (the Act).

4) Reckitt claims that the overwhelmingly dominant element of the trade mark is the dictionary word BLACK. The additional elements are minor and do not add a sufficient degree of surplus in order to make the trade mark acceptable under the Act. Consequently, registration of the trade mark would be contrary to section 3(1)(b) of the Act.

5) Reckitt claims that the word BLACK appearing in the trade mark may serve in trade to designate the intended purpose or other characteristics of goods, in that the goods of the application are intended to keep dark colours appearing stronger for longer. Consequently, the registration of the application would be contrary to section 3(1)(c) of the Act.

6) Reckitt claims that the trade mark may lead to the deception of consumers, as the specification covers all types of detergents and is not restricted to being for use only in relation to black or dark colours. Reckitt claims that consumers may purchase the product believing it contains some form of dye. It claims that registration of the application would be contrary to section 3(3)(b) of the Act.

7) Reckitt claims that the words “From the makers of Biotex” are in very small script in the top part of the trade mark and are not legible, except under close scrutiny. It claims that overall the use of BIOTEX is lost in the trade mark. Reckitt claims that the trade mark in use may consist of a label applied to a container of the product and that in use the top panel would be folded over. “The very small use of the house mark would not be visible in the same plane as the non-distinctive element BLACK.” Consequently, registration of the trade mark would be contrary to section 3(1)(b) of the Act.

8) Reckitt claims that the descriptive word BLACK is the overwhelmingly dominant element of the trade mark, and it has been positioned centrally in the main body of the label. It claims that the average consumer is unlikely to perceive the word BLACK in relation to a detergent for dark or black clothing as anything more than a generic description of that detergent. Reckitt claims that there are a number of products which already appear in the market using colour as descriptors and the consumer will take BBV’s use of BLACK as a descriptor, not a trade mark. Reckitt claims that registration of the trade mark would be contrary to section 3(1)(c) of the Act or alternatively under section 3(1)(d) of the Act, as the word BLACK has become customary in the current language of the trade. It claims, alternatively, that it is reasonable to assume that BLACK will become customary for washing detergents for dark or black colours and that the trade mark should be refused under section 3(1)(d) of the Act.

9) Reckitt claims that the get-up of the trade mark is too commonplace to imbue it with a trade mark character. It claims that the word BLACK is commonplace, the starburst device is commonplace and that there are no other elements that are sufficiently dominant to imbue the trade mark with trade mark character. It claims that registration of the trade mark should be refused under section 3(1) (sic) of the Act.

10) Reckitt claims that the slogan “Keeps dark colours stronger for longer” is devoid of any distinctive character and should be excluded from registration under section 3(1)(b) of the Act.

11) Reckitt claims that BLACK is a common surname. It claims that there are over 400 references to BLACK as a surname in the London telephone directory. Reckitt claims that due to the nature of the goods covered by the application, and the intended purpose of the product, which is stated as being to maintain the darkness of clothing for longer that registration of the trade mark should be refused under section 3(1)(b) of the Act.

12) Reckitt claims that the word BLACK has not been presented in stylised form and that the graphical background does not assist in pointing the meaning of the word towards being a trade mark. It claims that BLACK in combination with the other elements of the trade mark encourage the consumer into noting the non-distinctive nature of the mark. Reckitt claims that registration of the trade mark would be contrary to section 3(1)(b) of the Act.

13) Reckitt claims that there are no distinctive elements appearing in the trade mark which are sufficiently noticeable to give it, as a whole, a distinctive character; any elements apart from the word BLACK are lost and are de minimis in the trade mark as a whole.

14) Reckitt seeks the refusal of the application and an award of costs.

15) BBV filed a counterstatement. It claims that the trade mark is a combination of elements, none of which takes precedence over the others. BBV claims that given that the word BLACK is well-known in the context of washing products, the trade mark will be perceived by the consumer in its entirety.

16) BBV admits that the word BLACK is an indication to the consumer that the goods are primarily directed to use with dark coloured clothes. It claims that as the trade mark consists of several different elements, the objection under section 3(3)(b) of the Act is denied.

17) BBV claims that though the goods may be highly advantageous for black or dark coloured materials this does not mean that they are not suitable for other materials. It claims that many detergents include the word colour or color on their packaging but that the public understands that this does not mean that the products are wholly unsuitable for non-coloured products. BBV claims that there is no ground for refusal of the trade mark under section 3(3)(b) of the Act.

18) BBV claims that the name BIOTEX and the BIOTEX device trade mark are well recognised and have a considerable reputation in their own right. It claims that although as a part of the trade mark the BIOTEX device is small, it is not insignificantly so and cannot be disregarded.

19) BBV claims that the word BLACK is a prominent component of the trade mark but that the trade mark is not BLACK per se. BBV claims that the trade mark should be considered as a whole and its registration would not be contrary to section 3(1)(d) of the Act.

20) BBV denies that the inclusion of the words “Keeps dark colours stronger for longer” is a ground for refusal of registration of the trade mark as a whole under section 3(1)(b) of the Act.

21) BBV does not deny that there are over 400 BLACKs in the London telephone directory. It denies that its application seeks to monopolise the word BLACK per se. BBV denies that registration of the trade mark would be contrary to section 3(1)(b) of the Act.

22) BBV claims that the word BLACK is presented in a stylised manner. BBV denies that its trade mark does not, as a whole, have a distinctive character.

23) BBV seeks the dismissal of the opposition and an award of costs.

24) Both sides filed evidence. After the completion of the evidence rounds both sides were

advised that it was believed that a decision could be made without recourse to a hearing. However, the sides were advised that they retained their rights to a hearing. Neither side requested a hearing. Consequently, I make this decision from the papers before me.

EVIDENCE

Evidence of Reckitt

25) This consists of a statutory declaration by Robert Rutledge. Mr Rutledge is the category marketing manager, garment care, of Reckitt. Parts of Mr Rutledge declaration can be characterised as submission rather than evidence of fact. I will make no reference to these non-evidential parts of his declaration here. However, I bear in mind his submissions in reaching my decision.

26) Mr Rutledge states that the word BLACK, along with other names of colours, is a completely non-distinctive word in relation to clothing or products for the care or cleaning of clothing. This is because it describes the colour of clothing or indicates that product is directed to black or dark colour. Mr Rutledge states that one of the primary goals in most laundry products is to preserve colours in coloured articles and to maintain brilliant white in white articles during the cleaning process. He exhibits at RR1 examples of packaging for fabric care products on sale in the United Kingdom which make reference to the colours for which they are intended or which use wording concerning colour to describe the attributes of the product. Most of these relate to keeping white clothing white or coloured clothing bright. Of particular interest to this case is the packaging for dreft dark, Persil Black Velvet and Sainsbury's Perform + Protect Black Fabric Laundry Liquid, which are all specifically designed for dark and black clothing.

27) Mr Rutledge states that special products have been developed for use in relation to colours in general and for a long while there was no special product in the United Kingdom directed at the very dark or black clothing market. He states that mainland Europe is more developed in this area and a wide range of products for special products for special fabrics or colours have existed for some time. He exhibits some fifteen examples of these at RR2. Of these, all but one includes the word black, or the local language equivalent, in the name of the product.

28) Mr Rutledge states that products intended to maintain a strong white colour are unsuitable for use on dark coloured articles because they often include some kind of lightning agent. Furthermore, dark clothing, and especially black clothing, has a stronger tendency to lose colour in washing. He states that special products are now made for the laundering of dark or black products and they frequently and commonly make reference to the fact that they are intended for dark clothes or black clothes. Mr Rutledge states that the use of references to the word black are essential to communicate the product characteristics.

29) Mr Rutledge states that Reckitt and other fabric care companies will be obstructed in the conduct of their businesses by registration of the black mark.

Evidence of BBV

30) This consists of a witness statement by Victoria Jane Martin. Ms Martin is a trade mark attorney whose firm is representing BBV in this case. Ms Martin's statement represents submission rather than evidence of fact. Although taking the statement into account in

reaching my decision, I will not say anymore about it here, other than to note that Ms Martin accepts that BLACK will be understood to be wholly descriptive of the product. Ms Martin also states that the name BIOTEX and the BIO TEX logo are well recognised by the purchasing public. She puts in no evidence to this effect. I note, however, that Mr Rutledge included copies of the BIOTEX packaging in his exhibit RR1.

DECISION

Deception – section 3(3)(b) of the Act

31) Section 3(3)(b) of the Act states:

“A trade mark shall not be registered if it is——

(b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).”

The above rehearses the language of article 1(g) of First Council Directive 89/104 of December 21, 1988 (the Directive).

32) Reckitt claims that the trade mark may lead to the deception of consumers as the specification covers all types of detergents and is not restricted to being for use only in relation to black or dark colours. Reckitt also claims that consumers may purchase the product believing it contains some form of dye. There is nothing in the trade mark that indicates that it includes some form of dye. In my view, there is nothing that suggests or even hints that there might be some form of dye in the product. I see no basis for the second of Reckitt’s claims.

33) There is a dearth of case law in relation to this part of the law. In “Kerly’s Law of Trade Marks and Trade Names” (thirteen edition) the following is stated:

“Section 3(3)(b) of the 1994 Act prevents the registration of deceptive marks, a notion familiar from section 11 of the 1938 Act. The paragraph itself cites some non-exhaustive examples: trade marks which are of such a nature as to deceive the public as to nature, quality or geographical origin of the goods or services. In general, if a mark gives rise to an expectation which will not be fulfilled, then registration will be refused. The expectation (and hence the objection) must be a real one, as opposed to something obscure or fanciful, arising from the mark itself.

There are two features of this provision to note. First, it is an absolute and not a relative ground for refusal. It is concerned with deceptiveness which is inherent in the mark itself, as opposed to deception caused by the similarity of the mark to another. [Relying on *Jardex* [1946] R.P.C. 63, an opponent tried to use s.3(3)(b) against GALAXY for "Preparations for killing weeds and destroying vermin", citing public policy in the risk to children accustomed to eating the chocolate so named. This ground failed, because the mark in itself would not deceive the public. The opposition succeeded under s.5(3): GALAXY, May 19, 2000, Regy.] The latter type of objection arises under the relative grounds in section 5. Likewise, an objection that use of a mark would result in passing off arises under section 5(4)(a) and not under section 3(3)(b).”

There must be something about the trade mark and the goods which it covers which will lead to deception. The two elements have to be considered in the general context of the trade and

the nature of goods. In this case there is clearly a trade and a market for the goods of the specification which are especially adapted to the task of maintaining black and dark colours in clothing. The trade mark tells the consumer that is what the product will do. However, the specification includes goods which will not perform this function. It is difficult to conceive that BBV would sell goods which did not perform the function claimed by the trade mark; they would have very disappointed customers if they did so. Nevertheless, there is a clear discrepancy between the message of the trade mark and the goods in the specification. However unlikely to occur in reality, the public would be deceived if the goods of the specification were not specifically designed for use with black and dark colours. As the evidence of Mr Rutledge shows certain detergents would have a deleterious effect on black and dark colours. The European Court of First Instance (CFI) in *Daimlerchrysler AG v. Office for Harmonisation In the Internal Market (Trade Marks and Designs)* [2003] ETMR 61 pointed out that the marketing strategy of a proprietor cannot be taken into account when considering the descriptiveness of a trade mark:

“46 However, contrary to what the Office argues, the Court finds that a sign's descriptiveness must be assessed individually by reference to each of the categories of goods or service listed in the application for registration. For the purposes of assessing a sign's descriptiveness in respect of a particular category of goods or service, whether the applicant for the trade mark in question is contemplating using or is actually using a particular marketing concept involving goods and services in other categories in addition to the goods and services within that category is immaterial. Whether or not there is a marketing concept is of no consequence to the right conferred by the Community trade mark. Furthermore, since a marketing concept is purely a matter of choice for the undertaking concerned, it may change after a sign has been registered as a Community trade mark and it cannot therefore have any bearing on the assessment of the sign's registrability.”

I consider that the same reasoning must be applied in relation to a marketing strategy, or in this case presumed marketing strategy, and the issue of deceptiveness. Consequently, I consider that if the trade mark was used for goods other than those especially adapted for black and dark colours the public would be deceived. The specification of the trade mark encompasses such “deceptive” goods.

34) In this case BBV could have amended its specification to overcome the ground of opposition under section 3(3)(b) of the Act, if it had so wished. It has chosen not to do so. Article 13 of the Directive states:

“Where grounds for refusal of registration or for revocation or invalidity of a trade mark exist in respect of only some of the goods or services for which that trade mark has been applied for or registered, refusal of registration or revocation or invalidity shall cover those goods or services only.”

I do not consider that Article 13 can come to the aid of BBV. I cannot decide what goods are of interest to BBV. I might be able to guess from the nature of the trade mark. However, it is not in my remit to guess, infer or conjecture what specification of goods might be of interest to BBV. It must stand and fall by its chosen specification. If the specification included terms that were clearly not the subject of objection, they would remain. However, all the terms in the specification are subject to the objection. Any amendment to overcome the objection would require the entry of new terms; that is a matter for the proprietor not for me. I cannot

guess as to what form of wording might or might not be acceptable to BBV. As I have indicated BBV has had plenty of time to amend its specification if it so wished, and has been professionally represented. (This ground of opposition is not even referred to by Ms Martin in her witness statement.)

35) I find that the ground of opposition under section 3(3)(b) of the Act is upheld and the application is to be refused in its entirety.

36) In the event that I am wrong in my finding above, I will consider the other grounds of opposition.

Distinctiveness – sections 3(1)(a), (b), (c) and (d) of the Act

37) Section 3(1) of the Act reads 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.”

Section 1(1) of the Act reads:

“1.-(1) 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.”

38) In this case no use of the trade mark has been shown and so BBV cannot benefit from the proviso. Reckitt has also pleaded section 3(1) of the Act as a whole as a ground of opposition (see paragraph 9 above). Section 3(1) is not one piece; it is not one ground for refusal. Any ground for refusal must relate to one or more of the specific sub-clauses, these represent the actual bases of refusal. The ground of opposition under section 3(1) is rejected on the basis that it does not represent a valid ground.

39) The basis of the ground of opposition under section 3(1)(a) is that the trade mark is incapable of distinguishing the goods of BBV from those of other undertakings. In *Philips Electronics NV v Remington Consumer Products Ltd* [2003] RPC 2 the European Court of Justice held that:

“It is true that Art.3(1)(a) of the Directive provides that signs which cannot constitute a trade mark are to be refused registration or if registered are liable to be declared invalid.

37 However, it is clear from the wording of Art.3(1)(a) and the structure of the Directive that that provision is intended essentially to exclude from registration signs which are not generally capable of being a trade mark and thus cannot be represented graphically and/or are not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

38 Accordingly, Art.3(1)(a) of the Directive, like the rule laid down by Art.3(1) (b), (c) and (d), precludes the registration of signs or indications which do not meet one of the two conditions imposed by Art.2 of the Directive, that is to say, the condition requiring such signs to be capable of distinguishing the goods or services of one undertaking from those of other undertakings.

39 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 Art.2 of the Directive.

40 In the light of those considerations, the answer to the first question must be that there is no category of marks which is not excluded from registration by Art.3(1)(b), (c) and (d) and Art.3(3) of the Directive which is none the less excluded from registration by Art.3(1)(a) thereof on the ground that such marks are incapable of distinguishing the goods of the proprietor of the mark from those of other undertakings.”

Consequently, for Reckitt to succeed under section 3(1)(a) the trade mark must be of such a nature that it can never act as a trade mark. The nature of the trade mark needs to be such that its failings can never be “cured” by use, it is *Bach Flower Remedies for Bach Flower Remedies* (see *Bach and Bach Flower Remedies Trade Marks* [2000] RPC 513). I cannot see that BBV’s trade mark, even if it is objectionable under sections 3(1)(b), (c) and/or (d), is of such a nature that it can never act as a trade mark.

40) Consequently, I dismiss the ground of objection under section 3(1)(a) of the Act.

41) I now turn to the objection under section 3(1)(b). It is accepted by both sides that the word BLACK for the goods of the specification is completely devoid of distinctive character. Ms Martin states that BBV has no wish to monopolise the word BLACK; although I note that BBV has not disclaimed this element. She also states that the slogan (her word) “keeps dark colours stronger for longer” would not on its own have sufficient distinctive character to function as a trade mark. She states, however, the combination of the slogan with all the other elements of the trade mark, and in particular the inclusion of BBV’s BIOTEX logo, enables the trade mark as a whole to function as a trade mark and to identify the trade source of the goods. This is the bone of contention between the sides. BBV considers that there is enough in the trade mark as a whole for it to act as an indicator of origin, Reckitt takes the opposite view.

42) The European Court of Justice (ECJ) in *Libertel Groep BV v Benelux Merkenbureau (C104/01)* [2004] FSR 4 dealt with the issues involved in section 3(1)(b) of the Act; although in the context of a colour trade mark. In that case the ECJ stated:

“That approach is incompatible with the scheme of the Directive, which is founded on review prior to registration, not an *a posteriori* review. There is nothing in the Directive to suggest that Article 6 leads to such a conclusion. On the contrary, the large number and detailed nature of the obstacles to registration set out in Articles 2 and 3 of the Directive, and the wide range of remedies available in the event of refusal, indicate that the examination carried out at the time of the application for registration must not be a minimal one. It must be a stringent and full examination, in order to prevent trade marks from being improperly registered. As the Court has already held, for reasons of legal certainty and good administration, it is necessary to ensure that trade marks whose use could successfully be challenged before the courts are not registered (Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 21).

It is settled case-law that the essential function of a trade mark is to guarantee the identity of the origin of the marked goods or service to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin (see *Canon*, paragraph 28, and Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 22). A trade mark must distinguish the goods or services concerned as originating from a particular undertaking. In that connection, regard must be had both to the ordinary use of trade marks as a badge of origin in the sectors concerned and to the perception of the relevant public.

The relevant public, as defined in paragraph 46 of this judgment, is made up of average consumers, reasonably well-informed and reasonably observant and circumspect.

Account should be taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect picture of them that he has kept in his mind (see, in different contexts, *Lloyd Schuhfabrik Meyer*, paragraph 26, and Case C-291/00 *LTJ Diffusion* [2003] ECR I-0000, paragraph 52).”

The CFI in Case T-79/00 *Rewe Zentral v OHIM (LITE)* stated:

“The signs referred to in Article 7(1)(b) of Regulation No 40/94 are signs which are regarded as incapable of performing the essential function of a trade mark, namely that of identifying the origin of the goods or services, thus enabling the consumer who acquired them to repeat the experience, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent acquisition.”

In *Cycling Is...TM* [2002] RPC 729, Mr Hobbs QC, sitting as the appointed person, describes trade marks as being origin neutral and origin specific ie those which act as an indicator of origin and those which do not. The purpose of a trade mark is to indicate origin. In *Sykes Enterprises, Incorp v OHIM (Real People Real Solutions)* T-130/01 the CFI stated:

“Since the relevant consumer is not very attentive if a sign does not immediately indicate to him the origin and/or intended use of the object of his intended purchase,

but just gives him purely promotional, abstract information, he will not take the time either to enquire into the sign's various possible functions or mentally to register it as a trade mark.”

43) The case law means that consideration of whether a trade mark acts as an indicator of origin must be placed within the context that the average consumer, although circumspect, will not undergo an analysis of a trade mark. He or she will view the trade mark as a whole and be given a message that tells him or her of origin or not as the case may be. The average consumer is not expected to search for trade mark significance.

44) Reckitt comments on the BIOTEX element of the trade mark being de minimis. I am wary of commenting or considering of whether an element is de minimis. It seems to me that once one goes down that route one is in danger of not considering the trade mark as a whole. However, in order to consider the trade mark as a whole, in the context of a decision, it is necessary to comment upon the various elements of the trade mark. It is accepted that the word BLACK for the goods is hopeless; it tells, or in the context of section 3(3)(b) should tell, the purchaser what the goods do. I do not consider that the stylisation makes any practical difference. Ms Martin accepts that KEEPS DARK COLOURS STRONGER FOR LONGER is a slogan and that it would not have trade mark significance on its own. However, she states that it is a slogan of some distinctive character. I find this a difficult concept to follow. In the terms of section 3(1), distinctive character means able to distinguish the goods or services of one undertaking from those of another. Ms Martin accepts that the slogan cannot distinguish the services of one undertaking from another yet considers that it has some distinctive character. To me, the two arguments are mutually contradictory. Her basis for this argument is that the word STRONGER is somehow unusual within the slogan. Unusual or not, if the slogan does not identify the goods as being those of one undertaking it is not distinctive. I would also state that I do not consider that the use of the word STRONGER is novel. Ms Martin comments that a more normal word would be bright, brightness, vivid or vibrant. I cannot say that in relation to the colour black any of those words strikes me as more normal. STRONGER seems to be a perfectly appropriate word to use in the context of a product that acts against the fading of black and dark colours during washing. The get-up and colours, to which the trade mark is not limited anyway, strike me as being purely presentational and are not, in my view, in any way distinctive – indicative of origin. This leaves the remaining elements of the trade mark FROM THE MAKERS OF BIOTEX, the BIOTEX element is combined with a device element.

45) In considering the trade mark, I need to consider how it is likely to be used in normal and fair use. Mr Rutledge in his statement, and Reckitt in its statement of grounds, says that the BIOTEX element appears on a flap which may be part of the side or on top of the product. If Mr Rutledge is correct then this element could appear on a different plane; so for instance on a supermarket shelf would not be visible to the consumer. Ms Martin in her statement does not comment upon this; no evidence has been put in by BBV to show how it intends to use or does use the trade mark. In its counterstatement, BBV denies the paragraph that contains the claim in its entirety but says nothing specifically about it. It seems to be that Mr Rutledge’s comment is reasonable and perfectly possible. Normal and fair use, from the presentation of the trade mark, could include the BIOTEX element appearing on a different plane; effectively invisible to the consumer.

46) It might be argued that, owing to the non-distinctive nature of the other elements of the trade mark, the consumer would search for something that indicated origin, the BIOTEX

element. This seems to be putting rather an onus upon the consumer. It might also require the consumer picking up the product, as the BIOTEX element might be on a different plane. The premise of a consumer searching for trade mark significance flies in the face of the case law. It also flies in the face of my experience. Perhaps members of the public do hunt for trade marks, it is certainly not a pastime that I have indulged in.

47) Various non-distinctive elements can create a distinctive whole. However, this will depend on how they are used. A conglomeration of slogans and statements about the product, however many, is likely to be seen as promotional and not of trade mark significance. In this case the various elements do not link together to naturally form a holistic whole, they continue to lead their separate lives; this is not a Diamond T case (see *Diamond T Motor Car Co, Re* (1921) 38 R.P.C. 373).

48) Considering the trade mark as a whole, I am of the view that its immediate effect is to tell the consumer what the goods do. It does not indicate origin. I am of the view that this applies whether the BIOTEX element is on the same plane as the other elements or on a different plane. In either case the consumer would need to hunt for the trade mark significance, which he or she cannot be expected to do. I also bear in mind that the ECJ in *Libertel* (see above), pointed out that “that the average consumer only rarely has the chance to make a direct comparison between different trade marks but must place his trust in the imperfect picture of them that he has kept in his mind”. This is not a trade mark that, without educating the public, would allow the consumer to repeat the purchase or to avoid purchasing the goods again (*Rewe Zentral v OHIM (LITE)*). The trade mark does not immediately indicate origin (*Sykes Enterprises, Incorp v OHIM (Real People Real Solutions)*). I do not consider that the trade mark can fulfil its essential function as acting as an indicator of origin; it is devoid of any distinctive character. **I find that registration of the trade mark would be contrary to section 3(1)(b) of the Act.**

49) Reckitt states that registration of the trade mark could obstruct its business and that of other undertakings in the same field. This is valid in respect of section 3(1)(b) as was stated by the CFI in *Deutsche SiSi-Werke GmbH & Co. Betriebs KG v Office for Harmonization in the Internal Market (Trade Marks and Designs)* Joined Cases T-146/02 to T-153/02:

“The Court finds that the applicant's conclusion on the legal basis of the need for availability is incorrect. First, Article 7(1)(b) of Regulation No 40/94 is the only legal basis mentioned in the contested decisions. Second, no direct and exclusive link can be established between the risk that a monopoly may be created and a specific absolute ground for refusal. On the contrary, there is settled case-law to the effect that the absolute grounds for refusal set out in Article 7(1)(b) to (e) of Regulation No 40/94 address the concern of the Community legislature to prevent the grant to one operator of exclusive rights which could hinder competition on the market for the goods or services concerned (see, as regards the ground for refusal relating to a trade mark's distinctive character, Case C-104/01 *Libertel* [2003] ECR I-3793, paragraph 60).”

The nature of this trade mark is such, in my view, that Reckitt has a reasonable case that there is a need to refuse this application as registration could hinder competition. As the ECJ made clear in *Libertel* an onus should not be put upon others to challenge the legitimacy of a registration in the court.

50) Jacobs AG in his opinion in *Procter & Gamble v. Office for Harmonization In the Internal*

Market [2001] ETMR 75 stated:

“As the Court of First Instance rightly noted, it is sufficient for one of the absolute grounds for refusal to apply for a sign to be ineligible for registration as a trade mark. Moreover, I cannot envisage any circumstances in which, in practice, it might be important to determine whether more than one absolute ground might apply.”

As the application is to be refused under section 3(1)(b) of the Act I see no need to consider the grounds of opposition under sections 3(1)(c) and (d) of the Act. In this case, also, I do not consider that these grounds raise any different issues and I cannot see how Reckitt could be in any better position under these grounds. Owing to the descriptive nature of the word BLACK, I cannot see that Reckitt’s position could be any stronger if this word was viewed as a surname.

51) Both sides have made references to the Registry’s Practice Amendment Notice (PAN) 6/02. PANs serve a useful purpose in the examination process. However, when it comes to a formal decision the law must be accessed from its source, not through the medium of an intermediary. Consequently, I have not alluded to the PAN here but have relied upon the case law directly; quite a bit of which postdates the PAN anyway.

52) The application is to be refused in its entirety.

COSTS

53) Reckitt Benckiser (UK) Limited having been successful is entitled to a contribution towards its costs. I order Biotex BV to pay Reckitt Benckiser (UK) Limited the sum of £1450. 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 12th day of February 2004

**David Landau
For the Registrar
the Comptroller-General**