

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2201461A BY COLGATE-PALMOLIVE COMPANY TO REGISTER A TRADE MARK IN CLASS 3

DECISION AND GROUNDS OF DECISION

On 29th of June 1999 Colgate-Palmolive Company of 300 Park Avenue, New York, New York 10022-7499, USA, applied to register the following two marks, then as application number 2201461:

COLGATE FRESH CONFIDENCE
FRESH CONFIDENCE

The application was made in respect of the following goods:

Class 03 Toothpaste, mouthwash.

Objection was taken to the marks under Section 41(2) of the Act in that the first mark in the series differs in its material particulars from the second mark, substantially affecting the identity of the marks.

Objection was also taken against the second mark in the series under Section 3(1)(b) and (c) of the Act because it consists of the words FRESH CONFIDENCE, being devoid of any distinctive character and a sign which may serve in trade to designate a characteristic of the goods, e.g. toothpaste/mouthwash that engenders fresh confidence.

At the hearing at which the applicants were represented by Mr Ashmead of Kilburn & Strode, their trade mark agents, the series objection was maintained. As a result the application was divided into two parts, the first mark forming Part B of the original application which then proceeded as a separate application and no further mention need be made of it.

Objections under Section 3(1)(b) and (c) of the Act were maintained against the second mark of the original application which now forms Part A.

Following refusal of the revised application bearing the suffix "A", I am now asked under Section 76 of the Act and Rule 56(2) of the Trade Mark Rules 1994 to state in writing the grounds of my decision and the materials used in arriving at it.

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

The relevant part of the Act under which the objection was taken reads as follows:

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

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

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

The mark consists of the words FRESH CONFIDENCE. Both of these words are ordinary dictionary words. Collins English Dictionary (Third Edition Updated 1994) provides several meanings of the word FRESH, the most pertinent being:

- adj. 1. not stale or deteriorated; newly made, harvested, etc.: fresh bread; fresh strawberries.
2. newly acquired, created, found, etc.: fresh publications.
5. further; additional; more: fresh supplies.

The same dictionary provides the following relevant meaning of the word CONFIDENCE

- noun 1. a feeling of trust in a person or thing.

In my view, the words FRESH CONFIDENCE serve to designate a characteristic of the goods. The primary function of goods such as toothpaste and mouthwash is to maintain or improve the cleanliness of teeth. In recent years the intended purpose of such goods has been widened and it is now commonplace for advertisements for such goods to make wider claims. Some products may reduce tooth decay or gum disease, some may have extra whitening properties. In my view, anyone encountering this mark on such goods would gain the initial impression that as a result of using the product the user will gain newly acquired (i.e. fresh) personal confidence as a result of that use. This confidence would be acquired by the ability of the goods to assist in the treatment of eg tooth decay, which will help to overcome bad breath or by making the teeth whiter. There is, in my view, a common perception by many of the users of such goods that products which e.g. reduce bad breath or whiten teeth are desirable and that that person will have fresh confidence (i.e. newly acquired confidence) in their smile or personal hygiene simply because the product has improved their appearance.

In this decision I have born in mind the comments in the unreported decision on the DAY BY DAY appeal (Application No 2068646 dated 12 April 1994) in which Simon Thorley in his role as The Appointed Person said:

“In my judgement, Mr James correctly submitted that I should have regard not only to natural use on packaging but also to natural use in the context of advertising”.

It is important that I consider whether the use of the words FRESH and CONFIDENCE in combination produce a fanciful whole. I conclude they do not. The words in combination do no more than describe the intended purpose of the goods as being the provision of FRESH i.e. newly acquired CONFIDENCE; either personally, or by the consumer, in their perception of the quality of the goods.

In conclusion, it appears to me that the mark consists exclusively of a sign that may serve in trade to designate the kind or quality of the goods/services, and is therefore excluded from registration by Section 3(1)(c) of the Act. For the same reason I consider the mark to be devoid of distinctive character and therefore not acceptable, prima facie, for registration under Section 3(1)(b) of the Act.

That is not to say that the mark can never be registered - I do not think that is the case - but, to use the words of Mr Justice Jacob in the "TREAT" case (1996 RPC 281), it is the sort of sign "which cannot do the job of distinguishing without first educating the public that it is a trade mark".

In this decision I have considered all the documents filed by the applicant and all the arguments submitted to me in relation to this application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Sections 3(1)(b) and (c) of the Act.

Dated this 13 Day of November 2000

A J PIKE

**For the Registrar
The Comptroller General**