

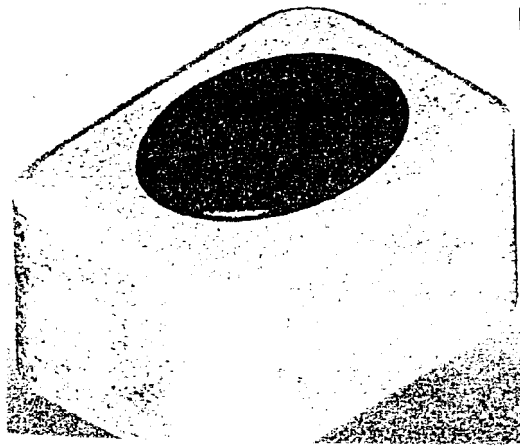
TRADE MARKS ACT 1994

AND

THE TRADEMARKS (INTERNATIONAL REGISTRATION) ORDER 1996

**IN THE MATTER OF
INTERNATIONAL REGISTRATION NO. 708467
AND THE REQUEST BY HENKEL KGaA
TO PROTECT A TRADE MARK IN CLASSES 1 AND 3**

On 15 January 1999 Henkel KgaA of 67, Kenkelstrasse, D-40191 Düsseldorf, Germany on the basis of international registration no. 708467, requested protection in the United Kingdom under the provisions of the Madrid Protocol, of the mark



The following words appear beneath the mark on the form of notification:

Colors claimed: Blue, white.

Indication relating to the nature or kind of mark: three-dimensional mark.

The International Registration is numbered 708467 and protection is sought in Class 1 in respect of:

Chemical products for industrial purposes; softening agents for water; crust preventing and crust solving agents for use in tubes and apparatuses; scale removing preparations.

And in Class 3 in respect of:

Soaps; washing and bleaching agents; rinsing agents for dishwashing and laundry; cleaning and polishing agents; chemical preparations for cleaning wood, metal, glass, synthetics, stone, porcelain and textiles.

It was considered that the request failed to satisfy the requirements for registration in accordance with Article 3 of the Trade Marks (International Registration) Order 1996 and

notice of refusal under Article 9(3) was given because the mark is excluded from registration by Section 3(1)(b) of the Trade Marks Act 1994. This is because the mark consists of the goods in tablet form, being devoid of any distinctive character and that the prominent blue element is also lacking in distinctive character for laundry whiteners. The designation was also refused under Section 5(2) of the Act because there was considered to be a likelihood of confusion with Community Trade Marks Nos 924829, 949545, 949578 and 949610 but this ground for refusal was subsequently waived and I need say no more about it.

At a hearing on 24 September 1999, Mr J D McCall of W P Thompson, the holders' representatives, made submissions in support of this request. I deferred my decision and wrote to the holders' representatives on 20 October 1999 maintaining the objection.

In response to a request from the holders' representatives I agreed that this request may be suspended pending the outcome of an appeal on a closely related application. That appeal was unsuccessful and on 17 January 2001 the holders' representatives were invited to provide the Registry with their proposals for overcoming the objection under Section 3(1)(b) of the Act. No response was received and notice of final refusal under Article 9(3) was issued on 24 April 2001. I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Marks Rules 2000 to state in writing the grounds of decision and the materials used in arriving at it.

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

Firstly I turn to Section 3(1)(b) of the Act which reads as follows:

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

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

The test for distinctiveness was laid down by Mr Justice Jacob in the TREAT case [1996] RPC 281 page 306 lines 2-5 when he said:

“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?”

The mark consists entirely of the shape of a rectangular tablet with a bevelled edge, slightly rounded corners and a raised oval on the upper surface. The tablet is predominately white in colour with the raised oval element being blue. The tablet is of a basic geometric shape and there is nothing fanciful about selecting a rectangular shape for the manufacture of solid detergents. White is a natural colour for cleaning agents and I see nothing unusual in the presence of a single contrasting colour which may, in addition to being decorative, indicate the presence of different ingredients or scents. These features do not make the shape of the tablet recognisable as a trade mark in the sense that a typical consumer of the product would deduce that the tablets emanate from a particular source.

The raised blue oval element, which is visible on the upper surface, brings an additional feature to the shape of the tablet but I do not believe that this additional feature when applied to a simple white tablet is sufficient to give the sign as a whole the impact required to function as a

trade mark. Although the oval addition is a slightly unusual way of combining a second ingredient, in my view, the typical customer is likely to see it as an indication of an additional ingredient of these tablets rather than as an indication of trade source.

Whilst it is clear that a combination of non-distinctive elements can create a distinctive whole I do not accept that this is the position with this mark. I do not see that there is anything in the shape of this tablet in the colours blue and white that would serve to distinguish the goods of the applicant from those of other traders.

In the Proctor & Gamble Limited's application (1996 RPC 281), Walker L J said:

“ Despite the fairly strong language of s. 3(1)(b), “devoid of any distinctive character” - and Mr Morcom emphasised the word “any” - that provision must in my judgment be directed to a visible sign or combination of signs which can by itself readily distinguish one trader's product - in this case an ordinary, inexpensive household product - from that of another competing trader. Product A and Product B may be different in their outward appearance and packaging, but if the differences become apparent only on close examination and comparison, neither can be said to be distinctive”

In this decision I have born in mind the comments in the unreported decision on an application by Henkel KAaG to register a 3-Dimensional shape of a tablet (International Application No 708442 dated 15 January 1999) where Geoffrey Hobbs QC in his role as The Appointed Person said:

“It seems to me that the tablet shape in question represents only a minor variation of a basic geometric shape. The colours have a degree of visual impact, but not to an extent that I would regard as particularly striking. There is every likelihood, in my view, that they would be taken to indicate the presence of two active ingredients in the relevant tablets and, as a corollary to that, every likelihood that they would not be perceived as possessing significance in terms of the trade origin of the goods.

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.

Giving the matter the best consideration I can, I think that the appearance of the tablets put forward for registration is not sufficiently arresting to perform the essential function of a trade mark. In the absence of distinctiveness acquired through use, the mark put forward for registration was, in my view, devoid, by which I mean unpossessed, of a distinctive character, and therefore excluded from registration by section 3(1)(b) of the Act at the relevant date.

In the unreported decision on the applications by Reemtsma Cigarettenfabriken GmbH to register a 3-Dimensional shape of a cigarette packet (Applications Nos 2031898 and 2031899 dated 25 August 1995) Geoffrey Hobbs QC, in his role as the appointed person, said:

“On the basis of my general awareness of cigarette packaging acquired through exposure to it as a (non-smoking) member of the public, I think that the features I have

mentioned render the Applicant's packaging distinguishable from the general run of cigarette packaging in relatively small details which provide it with a low, but not negligible, degree of individuality. The question is whether the degree of individuality imparted by those features is sufficient to render the packaging not merely distinguishable, but distinctive of the trade origin of the goods it contains. I have not found it easy to answer that question on the basis of the materials before me. Giving the matter the best consideration I can, I think that the get-up (in terms of the shape and colour) of the packaging put forward for registration is aesthetically pleasing without also being sufficiently arresting *per se* to perform the "essential function" of a trade mark (as identified in Canon paragraph 28. In the absence of distinctiveness acquired through use it was, in my view, devoid (by which I mean unpossessed) of "*a distinctive character*" and therefore excluded from registration by Section 3(1)(b) of the Act (Article 3(1)(b) of the Directive) at the relevant date."

The public are well used to seeing coloured tablets of this sort of shape. At best it may be a slight variant on other such tablets but to my mind there is nothing memorable or distinctive about it. I do not see that there is anything in the shape or colour combination of this tablet that would serve to distinguish the goods of the holder from those of other traders.

It is my view that the sign applied for will not be taken as a badge of origin without first educating the public that it is a trade mark. It follows that this application is debarred from prima facie acceptance by Section 3(1)(b) of the Act.

In this decision I have considered all the documents filed by the holder and for the reasons given the notice of refusal was upheld.

Dated this 27th day of June 2001

A J PIKE

**For the Registrar
The Comptroller General**