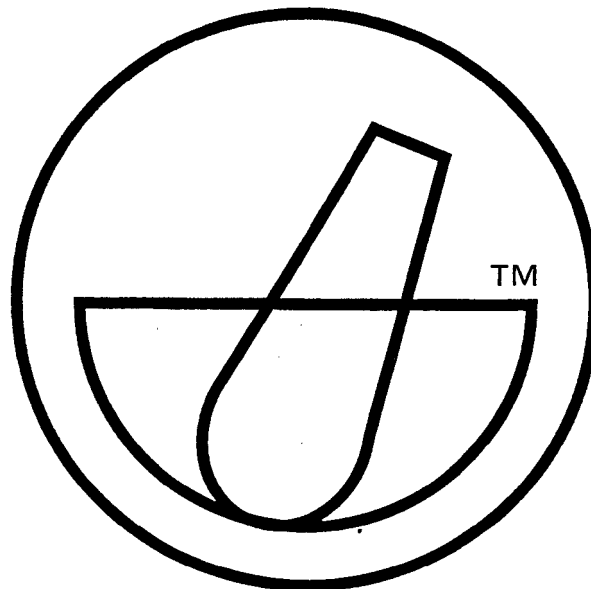


## TRADE MARKS ACT

**IN THE MATTER OF  
APPLICATION NO 2158336  
BY GEHE UK PLC  
TO REGISTER A TRADE MARK  
IN CLASSES 3, 5, 39 AND 42**

### DECISION AND GROUNDS OF DECISION

1. On 14<sup>th</sup> February 1998 Gehe UK plc of Hampton Court, Tudor Road, Manor Park, Runcorn Cheshire, WA7 1TX applied to register the trade mark shown below in classes 3, 5, 39 and 42:



2. The goods and services for which registration is sought are as follows:

- |          |  |
|----------|--|
| Class 3  | Personal hygiene products; perfumery; essential oils; cleaning and polishing preparations; soaps; cosmetics; hair lotions.                               |
| Class 5  | Pharmaceutical, veterinary and sanitary products; disinfectants; plasters and materials for dressings; dental wax, dietetic substances; food for babies. |
| Class 39 | Transport, distribution, packaging and storage services; all relating to pharmaceutical products.  |
| Class 42 | Pharmacy services.   |

3. Objection was taken under Section 3(1)(b) of the Act because the mark consists of the device of a mortar and pestle being devoid of distinctive character for eg goods which are

mixed together using this method and services relating thereto. This objection relates only to Classes 3, 5 and 42. No such objection was taken to Class 39.

4. Objection was also taken under sections 3(6) and 5(2) of the Act but these objections were subsequently waived and I will make no further reference to them in this decision.

5. At a hearing, at which the applicants were represented by Mr Collins of White & Case, their trade mark attorneys, the objection was maintained and the application was subsequently refused in accordance with Section 37(4) of the Act.

6. Following refusal of the application I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Mark Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

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

8. Section 3(1)(b) of the Act reads as follows:

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

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

9. 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?”

10. This application is for a sign which appears to be a representation of a mortar and pestle contained within a circle. A mortar is a vessel in which substances are ground or crushed with a pestle, a pestle being the tool used to crush, mash or grind materials in a mortar. To my own knowledge the mortar and pestle has been in use as a tool by, *inter alia*, pharmacists and chemists for many years. Whilst I accept that in these days there may well be more modern and more efficient tools available for such activities I am of the view that the device of a mortar and pestle remains as a symbol which indicates the nature of the goods and services provided by pharmacists and chemists.

11. The representation of the mortar and pestle contained in this application is in outline and it is represented in such a way that it may be described as one being superimposed on the other. The representation has the effect of portraying a pestle placed inside a mortar, this being enclosed within a circle. In my view the circle itself is a simple geometric device which does no more than provide a basic border to the more substantial elements of the mark. I have given no weight to the letters “TM” appearing within the mark as they simply indicate that the sign is used, or is to be used, as a trade mark. At the hearing, and during correspondence prior to the hearing, Mr Collins argued that the stylisation of the mortar

and pestle device is sufficient to meet the requirements of Section 3(1)(b) of the Act. I am, of course, bound to consider the mark as a whole and I take the view that the degree of stylisation which exists in this mark is so small and insignificant that the mark will be seen, by any prospective purchasers of these goods and services, as an ordinary representation of a mortar and pestle. I consider this sign to be totally non-distinctive for these goods and services. 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 sign. I do not see that there is anything in this sign which would serve to distinguish the goods and services in Classes 3, 5 and 42 from those of other traders of these goods and services.

12. 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”

13. In my view the sign applied for will not be taken as a trade mark 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.

14. 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 in that it fails to qualify under Section 3(1)(b) of the Act.

**Dated this 9<sup>TH</sup> day of November 2001**

**A J PIKE**

**For the Registrar  
The Comptroller General**