

O-225-03

**TRADE MARKS ACT 1994**

**IN THE MATTER OF INTERNATIONAL REGISTRATIONS Nos.  
708433, 708469, 708470, 712758, 719924, 719927, 719931, 719933, 732788, 739779 and  
739780 AND REQUESTS BY  
HENKEL KGAA FOR PROTECTION IN THE UNITED KINGDOM**

**AND**

**IN THE MATTER OF OPPOSITIONS THERETO UNDER Nos. 70307, 70326, 70327,  
70328, 70357, 70354, 70355, 70353, 70459, 70534 and 70532  
BY ROBERT McBRIDE LTD**

## **TRADE MARKS ACT 1994**

**IN THE MATTER OF International Registrations Nos. 708433, 708469, 708470, 712758, 719924, 719927, 719931, 719933, 732788, 739779 and 739780 and requests by Henkel KGaA for protection in the United Kingdom**

**and**

**IN THE MATTER OF Oppositions thereto under Nos. 70307, 70326, 70327, 70328, 70357, 70354, 70355, 70353, 70459, 70534 and 70532 by Robert McBride Ltd**

### **Background**

1. These are consolidated oppositions to requests by Henkel KGaA for protection in the UK of eleven international registrations. The applications have in common that they consist of shapes and combinations of colours in respect of textile washing and dishwashing tablets. They differ in terms of the precise shape and the colour combinations employed. The requests for protection (hereafter for ease of reference I will simply refer to them as applications ) are in the main for goods in Classes 1 and 3 of the International Classification system but also extend to Class 21 in 3 cases. There are, too, minor variations in the precise wording used to describe the goods. Nothing appears to turn on this point. For ease of reference I have summarised the case numbers and relevant dates in Annex A to this decision. Full print outs of the applications themselves can be found at Annex B.

2. All of these applications are opposed by Robert McBride Ltd on the following basis:

Under Section 3(1)(b) they say that the marks are devoid of distinctive character in that they consist exclusively of three dimensional tablet shapes commonly used in the trade along with colours which have also been commonly used in relation to soaps, detergents and other washing products. As a consequence it is said that the public would not in the absence of further information or education interpret these colours as an indication of source as opposed to decoration or indication of function. In further support of this ground reference is made to a decision of OHIM's First Board of Appeal (No. R0064/1999-1) where a three dimensional tablet having two layers of colour was refused registration as being devoid of distinctive character.

3. Under Section 3(1)(c) in that they say that the marks applied for consist exclusively of shapes and colours which may serve in trade to designate the kind, quality, intended purpose or other characteristics of the goods for which protection is sought. In particular it is said that the use of colours is to indicate technical functions of the products.

4. Under Section 3(1)(d) on the basis that the practices and functional indications referred to were established at the relevant date such that they could be said to have become customary in the trade.

5. Under Section 3(6) the opponents claim that the applicants have applied to register three dimensional tablet using many different combinations of colours including many which are not currently capable of being produced using technology known to the industry and which make use of colours traditionally associated with the industry. The opponents say that this gives rise to the inference that the applicants have no bona fide intention to use the marks in issue. Alternatively it is said that the applicants are seeking to monopolise all or nearly all conventional colour combinations that are capable of being manufactured and that this constitutes an abuse of the registration process contrary to Section 3(6).

6. The applicants (I will, for convenience, refer to the international registration holders as such) filed counterstatements denying the above grounds.

7. Both sides ask for an award of costs in their favour.

8. Both sides filed evidence. The matter came to be heard on 10 July 2003 when the applicants were represented by Mr D McCall of WP Thompson & Co and the opponents by Mr J Mellor of Counsel instructed by Marks & Clerk.

9. I should also mention that two further applications involving coloured tablets are the subject of separate consolidated proceedings which were heard on the same day. The evidence on which I am asked to base my decisions is largely the same in each of the separately consolidated sets of actions save that there are two additional points that I should record.

- in relation to oppositions Nos. 70532 and 70534 there is evidence from Mr Hodkinson, the opponents' professional representative, dealing with the question as to whether the applications in suit amount to an attempt to monopolise all or nearly all colour combinations (a claim that is denied by the applicants). Mr Hodkinson refers to his clients' own application for 3 layer/3 colour tablets which were opposed by the current applicants on the basis of a claim to prior rights in 3 layer tablets for different colour combinations;
- Ms Bradley's evidence in relation to opposition No. 70532 also contains a video recording of a television advertisement entitled "Finish 3 in 1 TV" as further evidence of the fact that the functionality of different colours is promoted to customers. I understand that it is intended that this piece of evidence be considered in each of the cases.

10. A copy of my decision in relation to the other proceedings is, therefore, relevant to this decision as well and can be found at Annex C.

11. The marks in issue in this case are undeniably three colour tablets, though, as I have indicated in the separate set of cases, one of the marks contains two quite distinct shades of blue in addition to white. The arguments for and against registration are in practice not materially different and I adopt the reasoning contained in Annex C for the purposes of these eleven consolidated cases. The composite nature of submissions at the hearing strongly indicates that

the parties do not anticipate a different answer in this set of cases. Furthermore there has been no submission to the effect that some of the eleven may succeed whilst others may fail. It is, nevertheless, appropriate to give a brief indication of my views having considered the individual marks.

12. Nos.708433, 708469, 708470, 712758, 719924, 719927, 719931, 719933 and 732788 consist of oval, circular or rectangular tablets that are within the range of simple geometrical shapes that have been shown to exist and be in use for washing/dishwasher tablets. No. 739779 is also rectangular in shape but with what appear to be a white and a blue dome (or ball insert) projecting from the uppermost surface. It is not a shape that has been shown to exist based on the evidence filed. But it is a slight variant only on the Finish powerball product illustrated at Exhibit JBA. It does not break new ground (to use Mr Hobbs' expression) in relation to the goods to the point where it is likely to impact on consumer perception of the goods. It will, in my view, be taken as a variation on an established theme rather than contributing to the message that either in itself or in combination with the other features of the mark it is intended to convey a message as to trade origin.

13. No. 739780 is in the shape of a rectangular tablet with a rod or bar running the length of the upper surface of the tablet (in a contrasting colour to the rest of the upper surface). There appears to be a groove of corresponding shape in the lower surface of the tablet. The evidence does not show anything quite comparable to this particular form. But I take the view that the rod or bar would be seen as no more than an alternative way of incorporating a third active ingredient in the tablet (a variant in effect to the Finish powerball product).

14. The marks are more than simply shapes. The various layers/inserts are shown in contrasting colours. Each consists of three colours. All of the tablets depicted in these applications are made of combinations drawn from the colours blue, white, yellow, green and red. These are all colours that the evidence shows are in use in relation to tablets of this kind to indicate that three functional ingredients are present. There appears to be nothing novel or unexpected in the choice or presentation of the colours.

15. The question, nevertheless, remains as to whether the combination of shapes, colour and the arrangement of those colours is sufficient to denote trade origin bearing in mind that the marks in question are presented as unused ones. I have little hesitation in concluding that they are not. The applicants' position, at its highest, is that certain of the shapes are different from shapes already in the marketplace. But that is not enough in itself. They are not distinctively different in the sense that they carry a message as to trade origin. The opposition succeeds under Section 3(1)(b).

### **Costs**

16. The opponents are entitled to a contribution towards their costs. The different filing and opposition dates appears to have resulted in these cases being consolidated somewhat later than might have seemed desirable. A further two cases were separately consolidated and are the subject of my related decision of the same date. Technically these other two cases relate to two colour marks although for practical purposes it is a distinction without a difference in the case of

one of the marks. Both sets of consolidated proceedings were dealt with by means of a single set of submissions. I have issued separate decisions in case any point is taken on the differences if either matter goes to appeal.

17. So far as costs are concerned I have reviewed the position across both sets of consolidated proceedings taking account of the fact that separate oppositions and counterstatements needed to be filed; that the opponents filed separate evidence but of a substantially similar nature in each case (save for amendments to headings etc); that the small amount of additional evidence filed in two of the cases does not materially affect the position; that the applicants filed consolidated evidence; and that composite submissions were made at the hearing. It is also my understanding that the consolidation process was initiated by the Registry rather than the parties.

18. Taking all these factors into account I have decided to base my award of costs on the position and economies of scale achieved across both sets of consolidated proceedings but allowing also for the fact that the opponents, of necessity, had to file individual actions. I order the applicants to pay the opponents the sum of £6,500 of which £5,500 relates to this particular group of cases.

19. 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 11<sup>TH</sup> day of August 2003**

**M REYNOLDS  
For the Registrar  
the Comptroller General**

**ANNEX A**

Summary of cases:

<b>International registration Nos.</b>	<b>Date (Priority date shown in brackets)</b>	<b>Opposition Nos.</b>
708433	15 January 1999 (14 October 1998)	70307
708469	15 January 1999 (22 October 1998)	70326
708470	15 January 1999 (22 October 1998)	70327
712758	16 April 1999 (20 January 1999)	70328
719924	7 August 1999 (19 March 1999)	70357
719927	7 August 1999 (19 March 1999)	70354
719931	7 August 1999 (19 March 1999)	70355
719933	7 August 1999 (19 March 1999)	70353
732788	24 March 2000 (30 November 1999)	70459
739779	10 August 2000 (1 March 2000)	70534
739780	10 August 2000 (1 March 2000)	70532