

**TRADE MARKS ACT 1994**

**AND**

**THE TRADEMARKS (INTERNATIONAL REGISTRATION) ORDER 1996**

**IN THE MATTER OF  
INTERNATIONAL REGISTRATION NO. 700785  
AND THE REQUEST BY HENKEL KGaA  
TO PROTECT A TRADE MARK IN CLASSES 1 AND 3**

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TO PROTECT A TRADE MARK IN CLASSES 1 AND 3**

15 On 13 August 1998, Benckiser N.V. of World Trade Center AA, Schiphol Boulevard 229,  
NL-1118 BH SCHIPHOL, Netherlands, on the basis of international registration no. 700785,  
requested protection in the United Kingdom, under the provisions of the Madrid Protocol, of  
the mark:



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

35 *Description of the mark:* The mark is in the shape of a tablet consisting of the  
combination of two layers in the colours green and white.

*Colors claimed:* Green and white.

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

40 The International Registration is numbered 700785 and protection is sought in Class 1 in  
respect of

Chemical products for industrial purposes; descaling agents; water softeners.

45 and in Class 3 in respect of

Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; detergents, decalcifying and descaling preparations; laundry additives.

5 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(5) 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 a three  
10 dimensional shape in two colours which is devoid of any distinctive character for e.g. blocks of  
cleaning agents.

On 4 October 1999 a change of ownership was recorded and the holder of the mark is now  
Henkel KGaA, 67 Henkelstrasse, D-40191 Dusseldorf, Germany.

15 The holder's representative responded indicating that the holder intended to appeal the  
decision to refuse protection. No other representations were made under Article 9(4). Notice  
of final refusal under Article 9(6) was issued on 30 March 2000. I am now asked by the  
holders representatives W P Thompson & Co under Section 76 of the Act and Rule 62(2) of  
20 the Trade Marks Rules 2000 to state in writing the grounds of 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.

25 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.

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

35 "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?"

40 The mark consists entirely of the shape of a round tablet with a bevelled edge consisting of the  
combination of two layers in the colours green and white. From my own knowledge and  
experience of such everyday products I do not see anything novel in these elements of the  
mark.

45 It is a basic geometrical shape and there is nothing fanciful about selecting a round tablet  
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.

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 green and white that would serve to distinguish the goods of the applicant from those of other traders.

In the Proctor & Gamble Limited's (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"

I have also borne in mind the comments made by Aldous L J in the case of Phillips Electronics N.V. v. Remington Consumer Products before the Court of Appeal when he said:

"In fact I am unable to point to any feature or features of the trade mark which could be other than descriptive of a particular design of head for an electric shaver and which would enable the trade mark to acquire a distinctive character. The trade mark contains no feature which has trade mark significance which could become a distinctive character. In my view the judge was right to conclude that the trade mark was not registrable because of section (Article) 3(1)(b) in that it was devoid of distinctive character."

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 and colour combination of this tablet that would serve to distinguish the goods of the holder from those of other traders.

It is in my view that the shape 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 registration 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 27 day of June 2000.

Ian Peggie  
For the Registrar  
The Comptroller General