

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2183867
BY UNILEVER PLC
TO REGISTER A TRADE MARK IN CLASS 3**

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DECISION AND GROUNDS FOR DECISION

On 8 December 1998, Unilever PLC, Port Sunlight, Wirral, Merseyside, England, applied to register the mark COLOURHOLD SYSTEM in respect of "Detergents; preparations and substances, all for laundry use; fabric conditioning preparations; bleaching preparations; cleaning, polishing, scouring and abrasive preparations; soaps; soaps for brightening textiles; laundry starch; sachets and sheets for perfuming fabrics; pot pourris; scented water; deodorants; hand washes." This specification was later amended in a letter accompanying the request to the Registrar for a statement of grounds of decision (Form TM5) to be: "Detergents; preparations and substances, all for laundry use; fabric conditioning preparations; bleaching preparations; laundry starch; sachets and sheets for perfuming fabric".

Objection was taken under Sections 3(1)(b) and (c) of the Act on the grounds that the mark consists exclusively of the words "Colourhold System" being a sign which may serve in trade to designate the kind, quality and intended purpose of the goods.

At a hearing, at which the applicants were represented by Mr M J Hickey of Castles, their trade mark agents, the objections under Sections 3(1)(b) and (c) of the Act were maintained. Following refusal of the application under Section 37(4) of the Act, 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 decision and the materials used in arriving at it.

Sections 3(1)(b) and (c) of the Act read as follows:

"Section 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, geographical origin, the time of production of goods or of rendering of services or other characteristics of goods or services,

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it."

No evidence of use has been put before me, therefore, the proviso to this Section of the Act does not apply and I have only the prima facie case to consider.

5 The mark consists of the words "COLOUR" and "HOLD" conjoined and the word "SYSTEM". Therefore, the mark consists of ordinary dictionary words which, individually, are so well known that I believe I do not need to set out any dictionary references here. I am, in any case, bound to accept or reject the mark in its totality.

10 When filing the request to the Registrar for a statement of grounds of decision (form TM5) a letter was also attached by the agents which helpfully summarises the arguments made by them at the hearing. Their first point concerns not only the combination of words outlined above but, in particular, the combination "COLOURHOLD" on the basis that this element of the mark not only "constitutes an inversion of the words HOLD COLOUR, but more significantly that in the context of laundry preparations and clothing, manufacturers more readily refer to their cleaning preparations as having colour guarding or colour preserving properties."

15 In support of the above statements, and in particular the use of "HOLD" in the context of the goods, the agent attached a statutory declaration to the letter which accompanied Form TM5, and asked that it be admitted into the proceedings. In summary, the statutory declaration attests to the findings of an investigation to determine whether the word "HOLD" is used in respect of laundry preparations, in particular those which are specifically designed to clean coloured clothing. During the research it was noted that a number of other manufacturers use the word "COLOUR" in combination with words other than "HOLD", eg "ACE COLOURSAFE", "ACDO GLO WHITE COLOUR CATCHER", "ARIEL COLORGARD".

20 The information was not before me when refusing the mark and I do not consider I can allow it to be admitted into the proceedings at this stage - any more than the Registrar's hearing officer could provide new information in support of refusal. That said, I would comment that I do not believe it assists the applicants. It does not claim to be a complete survey and simply demonstrates that there are alternatives to the mark applied for. Indeed each of their competitors may equally seek to register their "COLOUR....." marks and seek to show that the applicants, as a competitor, use "COLOURHOLD" instead of their own chosen combination. The fact that others sell goods with similar descriptions merely serves to demonstrate that businesses wish to draw attention to this characteristic of the goods. However, if the applicants wish to rely on the declaration in an appeal, they will have to make their case for this evidence to be admitted before the Appointed Person or the Courts, depending upon which route they wish to pursue.

25 I should mention that the agent submitted similar arguments at the hearing - that there are alternatives to the combination "colour hold" or "hold colour". However, I do not consider this assists. I bear in mind the comments of Mr Hugh Laddie QC, as he then was, in the PROFITMAKER decision, 1994 RPC 613 at page 616, lines 38-44:

40 "The fact that honest traders have a number of alternative ways of describing a product is no answer to the criticism of the mark. If it were, then all those other ways could, on the same argument, also be the subject of registered trade marks. The honest trader should not need to consult the register to ensure that common

descriptive or laudatory words, or not unusual combinations of them, have been monopolised by others"

5 Although this decision was taken under the 1938 Trade Marks Act I consider the comments equally valid today.

10 It seems to me that I must consider the distinctiveness of this mark - or at least the element COLOURHOLD, as the applicant's agent has drawn attention to it - on its own facts. I consider that words which describe a product which "holds" the colour in clothing is describing a characteristic of the goods and that the word is equally valid as a description in line with any alternatives available. In my view the inversion of the words "HOLD" and "COLOUR" does not take away from the meaning of this combination and that this element of the mark is devoid of any distinctive character for the goods at issue.

15 The agent also refers to use of the word "SYSTEM" as more readily lending itself to use in other fields such as those of a mechanical/electrical nature and that, in combination with the other elements, was somewhat fanciful. I do not consider that this word is used so narrowly or that it adds anything to the totality and simply indicates that the goods contain a method of retaining (or holding) colour in fabrics. He refers, in particular, to the comments of Geoffrey
20 Hobbs QC in AUTOMOTIVE NETWORK EXCHANGE, 1998 RPC 885, when considering the mark as a whole, at lines 26-28:

25 "However, the expression as a whole seems to me to succeed in saying nothing particular about"

I also note the above decision goes on to say, at lines 30-33:

30 "I think that the degree of effort and analysis required to interpret them *merely* as a statement about the nature or characteristics of the relevant services is greater than people would normally devote to such matters when going about their everyday business."

35 I find that, in relation to the mark applied for and the goods at issue, I disagree with the agent's contention that this decision assists and I consider that the combination is a simple statement about a characteristic of the goods i.e. that they have a method of holding or retaining colour in fabric when it is washed using the applicant's goods. I do not consider it requires any great degree of effort or analysis by the purchaser to arrive at this meaning.

40 I therefore conclude that the mark COLOURHOLD SYSTEM is devoid of any distinctive character and consists exclusively of a sign that others may use in the course of business to designate the kind and intended purpose of the goods and is thus excluded from registration under Sections 3(1)(b) and (c) of the Act in respect of the goods applied for.

In this decision I have considered all the documents filed by the applicants 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.

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Dated this 24 day of July 2000.

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R A Jones
For the Registrar
The Comptroller General

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