

TRADE MARKS ACT 1994

AND

THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996

IN THE MATTER OF INTERNATIONAL REGISTRATION NO. 715087

AND THE REQUEST BY HENKEL FRANCE

TO PROTECT A TRADE MARK IN CLASS 3

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10 On 22 July 1999, HENKEL FRANCE of 161 Rue de Silly, F-92100, Boulogne-Billancourt,
France, on the basis of International Registration no. 715087, requested protection in the
United Kingdom, under the provisions of the Madrid Protocol of the mark -

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The following words appear beneath the mark on the form of application:-

35 *Description of the mark:* The trade mark consists of the representation of a bottle with a dark
blue cap, the upper part of the bottle being fluorescent green and the lower part yellow.

Colors claimed: Dark blue, fluorescent green and yellow.

40 *Indication relating to the nature or kind of mark:* 3-dimensional mark.

The International Registration is numbered 715087 and protection is sought in class 3 in
respect of:

45 Laundering, cleaning and rinsing products in liquid, gel or paste form.

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 appears to be devoid of any distinctive character. The designation was also refused under Section 3(1)(a) of the Act because the mark consists of a sign which does not appear to be capable of functioning as a trade mark, but this ground of refusal was subsequently waived and so I need to make no further reference to it.

Through Mr J D McCall of W P Thompson & Co, their representatives, the holder requested a hearing, which subsequently took place on 19 April 2000. At the hearing, the objection under Section 3(1)(b) was maintained and notice of final refusal was issued on 14 August 2000. I am now asked by the holder's representatives, W P Thompson & Co, under Section 76 of the Act and Rule 62(2) of the Trade Mark 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.

At the hearing, Mr J D McCall argued for acceptance of this application on the basis that this is effectively a three colour combination mark, in view of the colour claim on the cap of the bottle (the cap being dark blue). The colours of the bottle, he submitted, are not the natural colours of the product, especially not so in combination, and therefore the overall impression given by the total colour combination is not devoid of distinctive character. He did not argue however that the actual shape of the bottle is distinctive.

Decision

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.

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

"What does *devoid of any 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?"

On the form of application, the description of the mark tells us that it consists of a bottle with a dark blue cap, the upper part of the bottle being fluorescent green and the lower part yellow. The actual representation of the mark shown however appears to depict a clear bottle with two colours applied to immiscible liquids which are visible through the bottle, with the cap of the bottle coloured dark blue. I questioned the apparent ambiguities in the rights claimed at the hearing, not least because if the applicant wished to proceed by satisfying the proviso to Section 3 then use of the mark as applied for would be difficult, given such contradictory

5 explanations between the wording of the description and the actual representation. At the hearing, the agent was not able to clarify the matter but encouraged me to accept the application in accordance with the wording i.e. three colours applied to the bottle itself. If so, then I consider that the colours applied to the bottle in this way give the appearance of a clear bottle with 2 colours applied to the liquids within it.

10 From my own knowledge and experience of household cleaning products such as these, I do not see anything novel in the combination of the colours. The dark blue cap in my view is typical and offers very little, if anything, in the way of a distinctive character either on its own or in combination with the claim as a whole, and therefore my view is that this is essentially a claim of two colours applied to immiscible liquids which are visible through a clear bottle with a dark blue cap (or the appearance thereof). I know from my own experience that such products appear in this way at the point of sale, either by the liquid itself consisting of two colours, or by the container being filled only in part so that the clear section at the top of the container appears to be a contrasting colour.

15 I also know from my own experience, that green and yellow are colours that are traditionally associated with cleaning preparations such as these. For example, green often represents the essence of pine, and yellow the essence of lemon. The mark applied for appears, to me, to depict two separate substances in a bottle which are not meant to mix together. Consequently the two colours are the natural colours of the product, and presenting the two constituent substances in contrasting colours is an effective way, in my view, of informing the consumer that the product has two ingredients.

20 Whilst I accept that a combination of non-distinctive elements can create a distinctive whole I do not accept that this is the case in this application. The shape of the bottle is typical with a narrower middle section to enable an easy grip. Whether it is evident from the colours of the liquids within or as applied to the bottle itself so as to give the same effect, the two colours of the bottle are insufficient to imbue the mark with a distinctive character in the prima facie. The dark blue cap, even when considered as part of the whole mark, offers very little, if anything, in the way of distinctiveness.

In the Proctor & Gamble Limited case [1999] RPC 673, Walker L J said:

35 "Despite the fairly strong language of Section 3(1)(b), "devoid of any distinctive character" - and Mr Morcom emphasised the word "any" - that provision must in my judgement 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".

45 I have also borne in mind the comments made by Aldous L J in the case of Philips Electronics N.V. versus 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".

I do not believe that the purchasing public, bearing in mind that these are ordinary consumer items which are offered for sale in all supermarkets and household stores nationwide, would consider the mark the subject of this application to denote trade origin. The public are well used to seeing bottles of this shape depicting two or three colours whether the colours are applied to the bottle itself or to the liquid within which is visible through the clear container. I do not see anything in the shape and colour combination as a whole to persuade me that this would serve to distinguish the goods of this applicant from those of other traders.

It is my view that the sign applied for (taking either the description of the mark or the actual representation 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.

In this decision I have considered all the documents filed by the holder and for the reasons given protection was refused.

Dated this 24 day of November 2000

JANET FOLWELL
For the Registrar
the Comptroller General

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My written decision in this matter, dated 24 November 2000, contained two clerical errors. It has been brought to my attention that Article 9(5) on page 2 should read Article 9(3), and the reference in the Proctor and Gamble Ltd case on page 3 should read [1999] RPC 673. The necessary power to correct these errors is provided by Rule 40.12 of the Civil Procedure Rules which states:

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"The Court may at any time correct an accidental slip or omission in a judgement or order"

I therefore correct my written decision by making these amendments on pages 2 and 3.

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Dated this 19 day of February 2001.

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JANET FOLWELL
For the Registrar
the Comptroller General

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