

TRADE MARKS ACT 1994

AND

**THE TRADE MARKS (INTERNATIONAL REGISTRATION)
ORDER 1996**

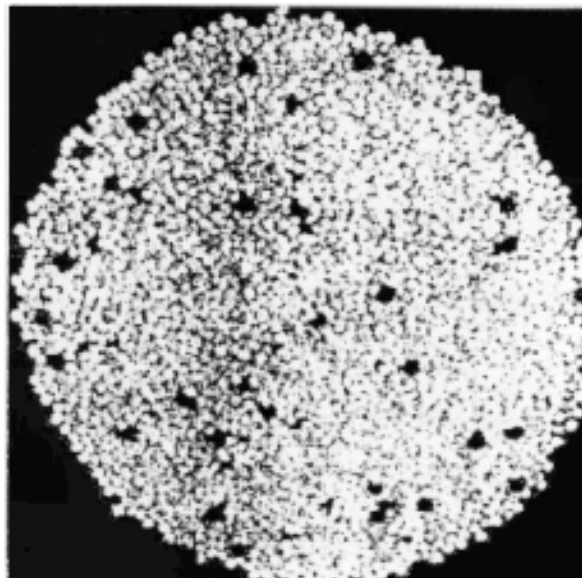
**IN THE MATTER OF INTERNATIONAL REGISTRATION NO. 721512
AND THE REQUEST BY HENKEL FRANCE
TO PROTECT A TRADE MARK
IN CLASSES 1 AND 3**

**TRADE MARKS ACT 1994
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5 **IN THE MATTER OF INTERNATIONAL REGISTRATION NO. 721512
AND THE REQUEST BY HENKEL FRANCE
TO PROTECT A TRADE MARK
IN CLASSES 1 AND 3**

10 On 18 November 1999, HENKEL FRANCE of 161 Rue de Silly, F-92100 Boulogne
Billancourt, France, on the basis of International Registration no. 721512, requested
protection in the United Kingdom, under the provisions of the Madrid Protocol for the
following mark -

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

Indication relating to the nature or kind of mark; three dimensional mark.

40 The International Registration is numbered 721512 and protection is sought in Classes 1 and
3 as follows:

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|----|---------|---|
| 45 | Class 1 | Chemical products for industrial use; water softening agents; chemicals to prevent or dissolve deposits in pipes and appliances; antiliming agents. |
| | Class 3 | Soaps, laundry bleaching and washing agents; rinsing agents for dish washing and laundry washing machines; cleaning and polishing agents; |

chemical preparations for cleaning wood, metal, glass, synthetic materials, stone, porcelain and textiles.

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(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 is devoid of any distinctive character.

10 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, objection under Section 3(1)(b) was maintained and I put Mr McCall on warning that a late Section 3(1)(a) objection may be raised once clarification of the mark applied for was provided by him. Following clarification of the mark applied for subsequent to the hearing, I proceeded to raise
15 a late Section 3(1)(a) objection on the grounds that the mark, as applied for, is not capable of functioning as a trade mark. Notice of final refusal was issued on 3 November 2000. I am now asked by the holder's representative, W P Thompson & Co, under Section 76 of the Act and Rule 62(2) of the Trade Marks Rules 2000 to state in writing the Grounds of Decision and the materials used in arriving at it.

20 No evidence of use has been put before me. I have therefore only the prima facie case to consider.

25 At the hearing, Mr J D McCall was not able to fully explain what the trade mark applied for consists of, other than to say that it is a three dimensional shape. The form of application does not contain any descriptive wording. I said that the representation suggests to me that the particles shown in the representation are not attached to each other and that, therefore, the representation shows numerous particles arranged in a circle on a flat surface, the majority of which are coloured white and the remainder coloured red. In later correspondence Mr McCall
30 confirmed that the particles had indeed been poured from their container and arranged in a circle for the purpose of the photograph as shown on the form of application. The trade mark claimed is therefore the mixture of white particles with a fewer number of red particles within the mixture. He submitted that this sign is not devoid of any distinctive character and is capable of distinguishing his client's goods from those of other undertakings.

35 **Decision**

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

40 3(1) The following shall not be registered -

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

45 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?"

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On the form of application, the representation shown consists of numerous particles. The majority of the particles are coloured white, the remainder are red. As these particles have been arranged onto a flat surface for the purpose of the photograph, they cannot be used in the course of trade as they are presented. The sign claimed in this three dimensional application therefore can only be the mixture of red particles within white particles, regardless of the shape or colour of the container in which they are housed in the course of trade.

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From my own knowledge and experience of household products which form the majority of the claim in this application, I know that these goods often come in particle form. I do not see anything novel in the combination of these two colours. I also know from my own experience that the colour white often forms a base colour for cleaning tablets and powders and the introduction of another colour usually means that the cleaning process has a dual purpose, firstly basic cleaning and secondly, for example, stain removal or to produce a particular fresh smell.

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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. We have a three dimensional sign comprising numerous white particles with a fewer number of red particles mixed in. But as these particles are not either bound together or housed within a transparent container, the rights claimed extend to any presentation. And I do not believe that the combination of red particles mixed with white particles is sufficient to imbue the mark with a distinctive character without first educating the public that it is a trade mark.

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In the Proctor & Gamble Limited case [1999] RPC 673, at page 680 lines 42 to 49, Walker LJ said:

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"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 be 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".

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I have also borne in mind the comments made by Aldous LJ in the case of Philips Electronics N.V. versus Remington Consumer Products before the Court of Appeal [1999] RPC 809 at page 819 lines 34 to 40 when he said:

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"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".

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It is my view that the sign applied for (taking either the exact mark applied for or the claim of red particles mixed in with white particles in any form of presentation) will not be taken as a trade mark without first educating the public that it is a trade mark. It follows that the application is debarred from prima facie acceptance by Section 3(1)(b) of the Act.

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As I indicated above, an objection has also been taken under Section 3(1)(a) on the grounds that the sign is incapable of functioning as a trade mark at all. However, the applicant was not given a further opportunity to be heard on that objection before the application was refused. In view of this, and my clear conclusions under Section 3(1)(b), there is no reason for me to finally determine the objection under Section 3(1)(a).

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

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Dated this 31 day of January 2001

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JANET FOLWELL
For the Registrar
The Comptroller General

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