

**TRADE MARKS ACT 1994
AND
THE TRADE MARKS (INTERNATIONAL REGISTRATION)
ORDER 1996
IN THE MATTER OF INTERNATIONAL REGISTRATION No.
708442 AND THE REQUEST BY HENKEL KGaA TO PROTECT A
TRADE MARK IN CLASSES 1 AND 3**

DECISION

1. This is an appeal to the Appointed Person from a Decision of Anne Pritchard, the Hearing Officer acting on behalf of the Registrar, dated 29th August 2000 in which she refused a request by Henkel KGaA to protect a trade mark in Classes 1 and 3. Protection was sought in the United Kingdom from an International Registration No. 708442.
2. As can be seen from the reproduction of the mark annexed to this decision, the mark is a three dimensional mark being a tablet of cylindrical shape with a bevelled upper edge. Mr. McCall of W.P. Thompson & Co., who appeared before me on behalf of the Appellant, described the mark as comprising two layers of different thicknesses, each being of a mottled or coarse grained effect with the upper layer being thinner, with, in addition, a white dome in the centre of the top of the cylinder which, in contrast to the coarse grained effect, was smooth.
3. The colours claimed are blue and white, it being apparent that the lower cylinder and the dome are in white with the intermediate

cylinder in blue. Whilst therefore only two colours are specified, Mr. McCall contended that, overall, there was a three colour effect being the relationship between the blue upper cylinder and the white lower cylinder and also the relationship between the blue upper cylinder and the white dome.

4. Mr. McCall therefore contended that the description of the mark given by Ms. Pritchard on page 2 line 45-47 of her decision: namely,

“The mark consists entirely of a picture of a round tablet with a bevelled edge consisting of the combination of two layers in the colours blue and white, with a circle of plain white on the top of the blue layer”.

was inadequate.

5. Mr. Knight, who appeared on behalf of the Registrar, did not dispute that Mr. McCall’s description of the mark was accurate, as indeed can be seen from the representation of the mark. However I do not believe that there is great substance in Mr. McCall’s criticism of the description in the Decision since the description was coupled also with a representation of the mark from which it was quite apparent that the points addressed by McCall were before the hearing officer.
6. The main thrust of Mr. McCall’s submissions to me, amplifying upon the very full and clear Statement of Grounds of Appeal, was that the decision of Ms. Pritchard was in error in failing properly to

apply the settled law under section 3(1)(b) of the Act to the totality of the trade mark applied for.

7. Mr. McCall drew my attention to the now well known decisions of Jacob J. in the *Treat* case (1996) RPC 281 at 306 and of Mr. Geoffrey Hobbs Q.C., acting as the Appointed Person in *AD 2000* (1997) RPC 168 at 173. He also drew my attention to a more recent decision of Mr. Hobbs Q.C. in *Reemtsma's* Application of 7th September 2000, a case which was referred to with approval in a subsequent appeal to Mr. Hobbs Q.C. in Application No. 700785 by *Henkel* KGaA to register a 3-dimensional round tablet (13th October 2000). The latter case concerned another application by the current applicants in respect of a tablet and, in considering the question of registrability under section 3(1), Mr. Hobbs Q.C. stated as follows:

“The get-up (in terms of the shape and colours) of the tablets I am now considering must be sufficient in and of itself to denote origin in order to be separately registrable as a trade mark under the Act. The higher the degree of individuality it possesses, the greater the likelihood of it possessing trade mark significance in the perception and recollection of the average consumer.

It is, therefore, appropriate to consider the extent to which the relevant features of shape and colour may have broken new ground in the presentation of Class 1 and 3 goods in the United Kingdom at the relevant date and what effect

that might have had upon the perception and recollection of the average consumer of such goods”.

8. In directing himself in this manner, Mr. Hobbs was correctly identifying that in order to be registrable as a trade mark, a shape must not only be distinctive, in the sense of being different and eye-catching, but also must be distinctive as a badge of origin. This point, and it is a very important point when considering shape marks, has recently been emphasised by Laddie J. in Re: Kabushiki Kaisha Yakult Honsha’s Application (Chancery Division 8th March 2001), an appeal relating to an application to register the shape of a container. He stated the law as follows:

“The fact that a particular design is eye-catching because it is unusual or decorative is not enough by itself. At all times the Registry has to ask whether the design is distinctive as a badge of origin. The exercise to be undertaken was described by the European Court of Justice in Lloyd Schuhfabrik Meyer & Co. GmbH .v. Klijsen Handel B.V (2000) FSR 77:

“In determining the distinctive character of a mark the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or

services from those of other undertakings”

(para 22).

In my view the same point was made even more succinctly by Lloyd J. in Dualit Limited’s (Toaster Shape) Trade Mark Application (1999) RPC 890, a case concerning an application to register the shape of an electric toaster as a trade mark;

“... Does (the mark) have a meaning denoting the origin of the goods?” (p.897)

Where inherent distinctiveness is concerned, the Registry has to find that the mark performs the function of identifying origin even before the public is educated that it is to be used for that purpose. Where invented, non-descriptive word marks are used, it may be easy to come to such a finding, but where a container is in issue it may well be much more difficult. As (Counsel for the Appellants) rightly conceded, the fact that a container is unusual or attractive does not, per se, mean that it will be taken by the public as an indication of origin. The relevant question is not whether the container would be recognised on being seen a second time, that is to say, whether it is of a memorable appearance, but whether by itself its appearance would convey trade mark significance to the average consumer. For the purposes of this appeal, I am prepared to accept that the bottle shape, which is the subject of these applications, is both new and visually distinctive, meaning that it would be

*recognised as different to other bottles on the market.
That does not mean that it is inherently distinctive in a
trade mark sense”.*

9. Although this judgment was given in relation to a container, the reasoning is equally applicable to shape and colour marks in general and is wholly consistent with the approach of Mr. Hobbs in *Reemtsma’s* Application and the earlier *Henkel* Application referred to above. It is insufficient to show that the subject matter is new and visually distinctive; it must be distinctive in a trade mark sense. The necessary measure of distinctiveness may be inherent in the shape and colour combination chosen or may only become distinctive in a trade mark sense as a result of use.
10. In the present case there is no evidence of use and I must therefore have regard to the inherent distinctiveness of the combination of shape and colour of the tablet in seeking to assess whether or not it qualifies for registration.
11. Before doing this, I must mention the Registry Practice which was drawn to my attention by Mr. McCall and subsequently clarified by Mr. Knight. Mr. McCall submitted that the Registry Practice consisted of allowing registration of a shape/colour mark without evidence of use, on a prima facie basis, where there was a three colour combination. Mr. Knight amplified upon this by stating that the Registry Practice was indeed that, as a guideline, the combination of three colours was the minimum necessary to qualify

for registration but that each case had to be considered separately and that three colours by themselves might not be sufficient. In each case the Registry had to be satisfied that the combination of colours and shape was distinctive.

12. It must always be remembered that the Registry Practice is a guideline and nothing more. It is helpful both to the Registry and to practitioners but it cannot absolve the Registrar's hearing officers, or me on appeal, from approaching each case on its own facts. The fact that a mark consists of three colours will not necessarily qualify it for registration and the fact that it consists of only two cannot be an absolute bar to registration. In each case it is necessary to have regard to the combination of colours and shape in reaching a conclusion as to whether or not the overall combination is distinctive in a trade mark sense.
13. I turn then to consider the combination of colours and shape in the present article. The hearing officer reasoned as follows:

“The mark consists entirely of a picture of a round tablet with a bevelled edge consisting of the combination of two layers in the colours blue and white, with a circle of plain white on the top of the blue layer. From my own knowledge and experience of such everyday products I do not see anything novel in these elements of the mark.”

The tablet is of a basic geometric 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 such as laundry whiteners 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.

In his submissions in correspondence Mr. McCall referred to a “central core”, which I take to be indicated by the circle of plain white on the top of the tablets. I do not see anything in this additional feature which would make the shape of the tablet recognisable as a trade mark. In my view the typical customer is likely to see it as an indication of an additional ingredient or feature of these tablets which is not present in tablets consisting only of two colours.

Whilst it is clear that a combination of non-distinctive elements can create a distinctive whole, I do accept that this is the position with this mark. I do not see there is anything in the shape of this tablet or in the colours blue

and white that would serve to distinguish the goods of the applicant from those of other traders". (emphasis added).

14. As indicated out the outset, Mr. McCall criticised Ms. Pritchard's analysis of the nature of the mark and particularly emphasised that the combination of colours had a three coloured effect (having regard to the Registry Practice, it is quite understandable why he sought to argue this). He went on to contend that the three coloured effect was rendered more striking by virtue of the mottled or coarse grained effect of the colours of the two cylinders in contrast to the smooth effect of the dome.

15. I see the substance in Mr. McCall's submissions but I am no more satisfied than the hearing officer was that the combination of colours and shapes in a tablet of this nature would be seen by the average consumer as being indicative of anything more than the different ingredients present in the tablet in contrast, no doubt, to other tablets which did not have the benefit of three separate ingredients. I am unpersuaded that there is anything in the combination of shape, colour and texture which inherently will suggest to the average consumer that the combination constitutes an indication of origin rather than an indication of contents. Whilst therefore there is some force in Mr. McCall's submission that the hearing officer may have taken too general a view of the overall effect of the combination of colour and shape, I am quite satisfied that there was nothing in the combination of colours and shape in

the mark applied for which would inherently serve to distinguish the goods of the applicant from those of other traders.

16. The appeal will accordingly be dismissed and, as agreed, there will be no order as to costs.

Simon Thorley Q.C.

15th March 2001