

TRADE MARKS ACT

IN THE MATTER OF APPLICATION 2148672 BY COLGATE-PALMOLIVE COMPANY TO REGISTER A TRADE MARK IN CLASS 3

DECISION AND GROUNDS OF DECISION

On 20 October 1997 Colgate -Palmolive Company of 300 Park Avenue, New York, N.Y. 10022-7499, USA, applied to register a series of 2 marks in respect of the following goods:

Class 03 Toothpaste, mouthwash.

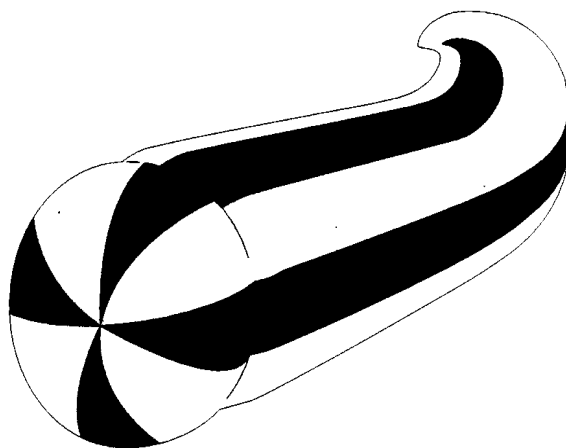
Objection was taken under Sections 3(1)(a) and (b) of the Act because the marks consist of mere representations of the goods in question, and as a result are not thought to be capable of distinguishing.

Objection was also taken to the marks under Section 41(2) of the Act in that the marks differ in their material particulars, substantially affecting the identity of the marks.

The following colour claim was entered on the form of application:

“The marks are in the colours dark blue and light blue as shown in the representations.”

At the hearing at which the applicants were represented by Mr Ashmead of Kilburn & Strobe, their trade mark agents, the 2nd mark was deleted and the objection under Section 41(2) was therefore waived. The remaining mark for which registration is sought is represented below:



The remaining mark is a two dimensional pictorial mark.

At the hearing the specification was revised to "Toothpaste" only. I deferred my decision in relation to the objection under Section 3(1)(a) and (b) of the Act and wrote to the agent on 16

October 1998 waiving the objection under Section 3(1)(a) but the objection under Section 3(1)(b) was maintained.

Following refusal of the application, I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Mark Rules 2000 to state in writing the grounds of my 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.

Firstly I turn to Section 3(1)(b) of the Act which reads as follows:

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

(b) trade marks which are devoid of distinctive character,

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

“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?”

This application is for a mark which is a device of what could be described as “a slug of toothpaste”. The mark has two colours which are divided diametrically. A colour claim has been entered on the form of application. The two colours are light blue and dark blue. The two colours are evenly spaced diametrically and gradually narrow to a point in the centre of one end of the device. The other end of the device is curved and tapers to a point.

The shape in question is, in my view, nothing more than a reasonably accurate representation of a slug of toothpaste that one encounters on squeezing an ordinary tube of toothpaste. It is a simple representation of the toothpaste which is squeezed from the toothpaste tube and deposited onto a toothbrush. In my view members of the purchasing public encountering such a mark would see it as being a representation of the goods in use.

However, this mark is more than a simple device. There is the colour combination to consider. The mark is represented in two shades of blue i.e. dark blue and light blue. The colours are in an alternating pattern which gives the effect of stripes. From my own knowledge and experience of the market for these goods I am aware that the use of contrasting colours in the form of stripes is not distinctive per se.

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 this device, in these colours, which would serve to distinguish the goods of the applicant from those of other traders.

In the Proctor & Gamble Limited's application (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”

In this decision I have born in mind the comments in the unreported decision on an application by Henkel KAaG to register a 3-Dimensional shape of a tablet (International Application No 708442 dated 15 January 1999) where Geoffrey Hobbs QC in his role as The Appointed Person said:

“It seems to me that the tablet shape in question represents only a minor variation of a basic geometric shape. The colours have a degree of visual impact, but not to an extent that I would regard as particularly striking. There is every likelihood, in my view, that they would be taken to indicate the presence of two active ingredients in the relevant tablets and, as a corollary to that, every likelihood that they would not be perceived as possessing significance in terms of the trade origin of the goods.

The question is whether the degree of individuality imparted to the tablets by the features of shape and colour in combination is sufficient to render them not merely distinguishable from other such goods, but distinctive in terms of trade origin.

Giving the matter the best consideration I can, I think that the appearance of the tablets put forward for registration is not sufficiently arresting to perform the essential function of a trade mark. In the absence of distinctiveness acquired through use, the mark put forward for registration was, in my view, devoid, by which I mean unpossessed, of a distinctive character, and therefore excluded from registration by section 3(1)(b) of the Act at the relevant date.

In the unreported decision on the applications by Reemtsma Cigarettenfabriken GmbH to register a 3-Dimensional shape of a cigarette packet (Applications Nos 2031898 and 2031899 dated 25 August 1995) Geoffrey Hobbs QC, in his role as the Appointed Person, said:

“On the basis of my general awareness of cigarette packaging acquired through exposure to it as a (non-smoking) member of the public, I think that the features I have mentioned render the Applicant's packaging distinguishable from the general run of cigarette packaging in relatively small details which provide it with a low, but not negligible, degree of individuality. The question is whether the degree of individuality imparted by those features is sufficient to render the packaging not merely distinguishable, but distinctive of the trade origin of the goods it contains. I have not found it easy to answer that question on the basis of the materials before me. Giving the matter the best consideration I can, I think that the get-up (in terms of the shape and colour) of the packaging put forward for registration is aesthetically pleasing without also being sufficiently arresting per se to perform the “essential function” of a

trade mark (as identified in Canon paragraph 28). In the absence of distinctiveness acquired through use it was, in my view, devoid (by which I mean unpossessed) of “*a distinctive character*” and therefore excluded from registration by Section 3(1)(b) of the Act (Article 3(1)(b) of the Directive) at the relevant date.”

In my view the sign 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 applicant 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 in that it fails to qualify under Sections 3(1)(b) of the Act.

Dated this 21 day of June 2001

A J PIKE

**For the Registrar
The Comptroller General**