

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATIONS Nos. 2187801A, 2187801F, 2187801D, 2187801G BY COLGATE-PALMOLIVE COMPANY TO REGISTER SERIES OF TRADE MARKS IN CLASS 3

DECISION

Background

1. By an application dated 3 February 1999 Colgate-Palmolive Company of 300 Park Avenue, New York, NY 10022-7499, USA, applied to register a series of 20 marks under Application No. 2187801 in Class 3 for “Toothpaste”.
2. Following objections taken by the registry under sections 3(1)(b) and (c) and 41(2) of the Trade Marks Act 1994 (TMA), the application was divided into seven parts, A to G.
3. This appeal concerns the registrability of four of the divisional applications 2187801A, 2187801F, 2187801D and 2187801G.
4. Mr Allan James, Principal Hearing Officer, appearing on behalf of the registrar confirmed that some or all of the other divisional applications are pending, waiting the outcome of A, F, D and G.

The Applications

5. The divisional applications can conveniently be grouped into two:
 - (a) Applications Nos. 2187801A and 2187801F;
 - (b) Applications Nos. 2187801D and 2187801G.
6. Copies of the marks in the applications are attached sequentially in the above order to this decision.
7. **Applications Nos. 2187801A and 218701F**
Each of the applications is for a series of five marks (10 marks in all). The marks in 2187801A are three-dimensional. The marks in 2187801F are two-dimensional representations of the same marks. Each mark comprises a slug of toothpaste longitudinally divided into two stripes. The bottom stripes of the first, second and fourth marks are white with the top stripes in light green, light blue and pink respectively. The top stripes contain speckles in a darker

version of the colours of the top stripes and in the case of the fourth marks, red. The third and fifth marks have bottom stripes in blue and red respectively and top stripes in white. The white stripes bear speckles in the colour of the bottom stripe. The hearing officer noted that the colour claims relating to the third marks in 2187801A and 2187801F do not fit the colour representations of the marks (it is difficult to attribute the claimed light and dark blues). However nothing turns on that point in this appeal.

Applications Nos. 2187801D and 2187801G

8. 2187801D and 2187801G are for two series of three marks (six marks in all) - again toothpaste slugs. As before one series (D) is three-dimensional and the other (G) two-dimensional but otherwise the same. Mr Silverleaf QC, representing the applicant, described these marks as having a "sandwich appearance" in that each has a central white stripe bordered on either side by light coloured paste or gel with darker speckles. The outer stripes in the first marks are light green with dark green speckles; in the second marks, light blue with dark blue speckles; and in the third marks, pink with red speckles.

Limitations

9. Each mark in the original series and on division was accompanied by a colour claim. Messrs. Kilburn & Strode, trade mark agents for the applicant, confirmed by letter dated 4 August 2000 that each of the colour claims was amended to a colour limitation.

Refusal of the Applications

10. By a written decisions dated 15 January 2001 Mr A. J. Pike, acting for the registrar, refused the applications under section 37(4) of the TMA. In each case the grounds for refusal were that:
- (a) the marks are devoid of any distinctive character for the purposes of section 3(1)(b) of the TMA. The applicant tendered no evidence of acquired distinctiveness through use;
- (b) the marks in each application do not form a series within the meaning of section 41(2) of the TMA, which provides:

A series of trade marks means a number of trade marks which resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the mark.

11. Mr Pike waived the objection under section 3(1)(c) at the hearing attended by Mr R. Ashmead of Kilburn & Strode. In view of his primary findings under section 3(1)(b), Mr Pike did not detail his grounds for deciding that the applications were debarred from acceptance by section 41(2).
12. On the question of distinctive character Mr Pike held:

The [shape/device] 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 ... In my view members of the purchasing public encountering such a mark would see it as being the goods in use.

However, these marks are more than simple [3-dimensional shapes/devices]. Although all [five/three] marks constitute the same fundamental [shape/device] they are all represented in different combinations of colour.

The application is for [five/three] marks which vary in their colour limitations ... At the hearing Mr Ashmead argued that although such marks may not be so distinctive as marks incorporating three separate base colours they are, nevertheless, more distinctive than marks where two separate base colours are the only colours present within the marks. Whilst I agree that, as a matter of principle, this may be true, I remain of the view that this does not necessarily bring distinctive character to these marks. Clearly the devices of dots bring an additional feature to the marks but I do not regard this additional feature as being particularly memorable or distinctive. When they appear in a background of the same colour (albeit of lighter tone) they are likely to be lost or virtually lost in use. The impact is likely to be de minimis.

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 these marks. I do not see that there is anything in these [shapes/devices], in these colours, which would serve to distinguish the goods of the applicant from those of other traders.

The Appeal

13. In February 2001, the applicant gave notice of an appeal to an Appointed Person under section 76 of the TMA. In its statement of grounds the applicant contests the hearing officer's findings under sections 41(2) and 3(1)(b) of the TMA.

Section 41(2) TMA

14. In his skeleton argument and before me on appeal, Mr Silverleaf QC for the applicant conceded that there may be substance in the series objections. If, or to the extent that the appeal was successful under section 3(1)(b) the applicant would divide the series colour by colour into individual applications. Under rule 21(2) of the Trade Marks Rules 2000 that was a course of action open to the applicant at any time before preparation for publication of the application. Mr James on behalf of the registrar agreed with this approach.

Nature of the Marks

15. The parties also agreed that the applications concerned get-up marks comprising the get-up of toothpaste. Further, on the authority of *Philips Electronics NV v. Remington Consumer Products Ltd* [1999] RPC 809 (CA), [1998] RPC 283 no distinction was to be drawn between the three-dimensional and two-dimensional groups of trade marks.

16. In *Philips v. Remington*, Jacob J., referring to Philips' two-dimensional registration for the three-headed faceplate of their electric rotary shaver, said (at page 288):

Even though it is only a picture which is formally the subject of the registration, both sides, in my judgment rightly, treated it as a registration covering also a three-dimensional shape. It would be quite artificial to regard a straight picture of a thing, and the thing itself, as significantly different under a law of trade marks which permits shapes to be registered.

The Court of Appeal implicitly accepted the judge's view.

17. Mr Silverleaf stated his belief that the applicant's case on distinctiveness was more powerful in relation to the sandwich marks, that is, Applications Nos. 2187801D and 2187801G.

Section 3(1)(b) TMA

18. Section 3(1)(b) of the TMA (art. 3(1)(b) Council Directive 89/104/EEC) provides that registration must refused to:

trade marks which are devoid of any distinctive character.

19. The proviso to section 3(1) (art. 3(2)) makes clear that section 3(1)(b) does not bar registration of a trade mark:

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.

20. No evidence of use was put forward in support of the applications. The hearing officer therefore had only the prima facie case to consider.

Test for Distinctive Character

21. There exists a substantial body of authority on the determination of distinctive character, which was summarised recently by Mr Simon Thorley QC sitting as the Appointed Person in *Henkel's Application*, SRIS O/152/01 at paras. 7 – 8.

22. Mr Silverleaf argued that distinctive character lay in the unique combinations of colour, stripes and speckles especially in the sandwich marks. Mr James took me to paras. 8 to 11 of the judgment in *Yakult Honsha KK's Trade Mark Application* [2001] RPC 756 where Laddie J. said:

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 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 memorable

appearance, but whether *by itself* its appearance would convey trade mark significance to the average customer. For the purpose of this appeal, I am prepared to accept that the bottle shape 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.

23. The *Yakult* case concerned the shape of a container for bottled milk. In *Henkel's Application*, *supra.*, which was about a white and blue dishwasher tablet, Mr Thorley applied the same reasoning to shape and colour marks in general (at para. 9):

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.

24. Indeed, I did not understand Mr Silverleaf to dissent from that approach. Both in his skeleton argument and at the hearing of the appeal, he submitted that the correct approach in this case was to ask the following questions:

- (a) Is the get-up applied for sufficiently different from the get-up of other toothpastes on the market?
- (b) Would the get-up applied for be regarded by the average consumer as an indication of origin?

25. However, Mr Silverleaf also suggested that the appropriate test was that the get-up is at least capable of distinguishing the applicant's toothpaste from toothpastes of other manufacturers.

26. The relationship between on the one hand "capable of distinguishing" and on the other hand "devoid of any distinctive character" respectively in arts. 2 and 3(1)(b) of the Directive (sections 1(1) and 3(1)(b) TMA) is the subject of several references to the European Court of Justice including by the Court of Appeal in *Philips Electronics NV v. Remington Consumer Products Ltd*, Case C-299/99.

27. There has been no suggestion with the present applications that the get-up of toothpaste is incapable of forming the subject matter of a trade mark within the meaning of section 1(1) of the TMA, so as to attract objection under section 3(1)(a).

28. Instead the objection is under section 3(1)(b) where enquiry is directed at the inherent distinctiveness of a mark or, if the proviso to section 3(1) is invoked, any distinctiveness acquired through use of it. Although there may well be overlap between the absolute grounds for refusal of registration in the Directive/TMA, each ground must be applied independently of the others (*Philips Electronics NV v. Remington Consumer Products Ltd* [1999] RPC

809 at 817, *Procter & Gamble v. OHIM (BABY-DRY)*, Case C-383/99P [2001] ETMR 75, Opinion of A.G. Jacobs at para. 67). Moreover, it appears from decisions of the Court of First Instance on equivalent provisions in the Community Trade Mark Regulation 40/94/EC (art. 7(1)) that it is sufficient for one of the absolute grounds for refusal to apply for a sign to be ineligible for registration as a trade mark (see, for example, *TRUSTEDLINK*, Case T-345/99, OHIM OJ 2/2001, p. 449. The point was confirmed by A.G. Jacobs in his Opinion in *BABY-DRY*, supra., at para. 71).

29. The applicant has not used any of the marks in the present applications. I can therefore only have regard to the inherent distinctiveness of the get-ups of the toothpastes in question to determine whether the hearing officer correctly refused the marks registration.
30. Before doing this I shall deal with two criticisms made by Mr Silverleaf of the legal reasoning in the hearing officer's decision.
31. First, Mr Silverleaf says that the hearing officer fell into error by considering two authorities dealing with cases where the differences between the appearances of the products sought to be registered and competing products were slight.
32. Mr Pike referred to the now well-known statement by Robert Walker L.J. in *Procter & Gamble Ltd's Trade Mark Application* [1999] RPC 673 at 680:

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 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 (unless, of course, one constitutes an unlawful infringement of some existing mark).
33. In referring to Robert Walker L.J.'s statement I believe that Mr Pike was doing no more than paying proper regard to the generally accepted test for determining the distinctive character of get-up marks. The same is true of Mr Pike's reference to the decision in *Reemtsma's Application*, SRIS O/334/00. There Mr Geoffrey Hobbs QC sitting as the Appointed Person was addressing the issue whether differences in the get-up of the applicant's cigarette packaging were "sufficient to render the packaging not merely distinguishable, but distinctive of the trade origin of the goods it contains".
34. Second, Mr Silverleaf says that Mr Pike should not have relied on the decision of Mr Geoffrey Hobbs QC sitting as the Appointed Person in *Henkel's Application*, SRIS O/482/00. The reason is that Mr Hobbs thought that the colours of the washing tablet in question were likely to be taken by the average consumer as indicative of the ingredients of the tablet.

35. Again, I believe that Mr Silverleaf's criticisms are unfounded. True, Mr Pike might have had functionality issues in mind when making his decision, although he did not expressly say so. But his reference to *Henkel* may equally well have been prompted by the wish to provide further authority on the correct approach to get-up cases. Moreover, in response to a point put by Mr James on appeal (see para. 43 below), Mr Silverleaf objected that functionality played no part in Mr Pike's decision. Mr Silverleaf cannot have it both ways.

Decision on section 3(1)(b)

36. It is common ground that toothpaste get-ups in the past have made individual use of both stripes and speckles. Here distinctive character is said to lie in the unique combinations of stripes, speckles and colours in each of the applicant's toothpaste get-ups. I have to consider the extent to which those features may have broken new ground in relation to toothpastes in the UK at the filing date of the applications (3 February 1999) and what effect that might have on the perceptions and recollections of the average consumer.
37. I should mention a disagreement between the parties on appeal as to the relevance of the individual colour combinations. Mr James pointed to the history of the applications and argued that since they (and others) were originally applied for as part of series and subsequently divided into further series the applicant cannot now say that the individual colour combinations contribute to the distinctive character of the individual marks. Mr Silverleaf counters that by saying that the applicant has acknowledged that there may be substance in the series objections and is prepared to split its divisional applications colour by colour into individual applications.
38. I am prepared to accept for the purposes of this appeal that the individual colours used by the applicant form part of each the overall get-ups that the applicant is seeking to register. However, Mr James made the point (not, as I understand it, rebutted by Mr Silverleaf) that pink, green, blue and red are amongst the usual range of colours used by toothpaste manufacturers in connection with their products.
39. Part of the difficulty in this case is that the applicant has relied on submissions without evidence as to how its toothpaste get-ups differ from those of other manufacturers in the market and what the likely reactions of the average consumer would be. Mr Silverleaf suggested I might take "judicial notice of what is on the shelves in supermarkets" - then I should not find anything like the applicant's toothpaste get-ups. I note that in *Reemtsma's Application*, supra., Mr Geoffrey Hobbs QC cautioned against any such private research and investigation by the person charged with the task of making the determination especially in the context of an appeal which must be determined on the basis of information and materials before the hearing officer. Like Mr Hobbs in *Reemtsma*, I have therefore not acted on Mr Silverleaf's suggestion.
40. Nevertheless, I do not understand the hearing officer or Mr James to dispute the applicant's assertion that the get-ups applied for are novel in the market. The contentious issue is whether the average consumer is likely to take the get-ups as indicating the origin of the applicant's toothpastes.

41. The hearing officer was of the view that the speckles would contribute little to the distinctive character of the marks:

When they appear in a background of the same colour (albeit of a lighter tone) they are likely to be lost or virtually lost in use.

The hearing officer put forward no justification for that view and I agree with Mr Silverleaf that it should be discounted. Mr James accepted that it could have no relevance to the two-dimensional applications.

42. On the other hand I think that the hearing officer was perfectly entitled to comment on the fact that one of the colours claimed by the applicant – white – is the generic colour for toothpaste. Mr Silverleaf acknowledges as much in his grounds for appeal and his skeleton argument.
43. Mr James took me to the case of *Unilever Ltd's (Striped Toothpaste No. 2) Trade Marks* [1987] RPC 13, a decision of Hoffmann J. under the 1938 Act. Mr James in no way suggested that the decision was binding on me. He merely used it illustrate the finding of fact that in the mid-1980's a red stripe in Unilever's toothpaste was likely to be taken by the average consumer as indicating the presence of an active ingredient. However, it is fair to mention that Unilever's own advertising may have contributed to that perception.
44. I have not found this appeal easy to determine and I am grateful for the very full arguments put to me by Mr Silverleaf and Mr James.
45. After lengthy consideration, I have arrived at the view that none of the combinations of stripes, speckles and colours in the applicant's get-ups is *in itself* "sufficiently arresting" (to borrow that phrase from Mr Hobbs) to be likely to be taken as having trade mark significance by the relevant consumer. Instead, I believe that those features are likely to be seen as the arrangement of the product itself, mere decoration or perhaps even as indicating the active ingredients in the toothpaste.
46. To put it another way, on what little evidence is available in this case I am not satisfied using Mr Silverleaf's own questions that:
- (a) The applicant's toothpaste get-ups are sufficiently different from the get-ups of other toothpastes on the market.
- (b) The get-ups applied for are likely to be regarded by the average consumer as indicating the origin of the applicant's toothpaste.

Conclusion

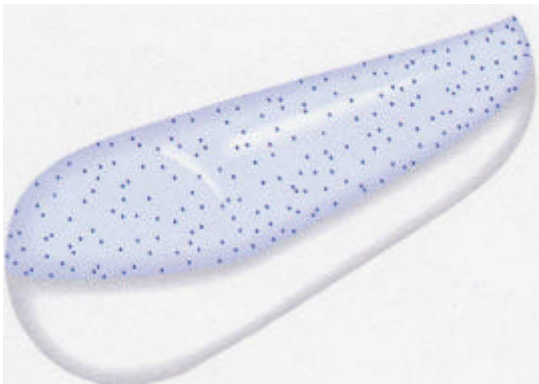
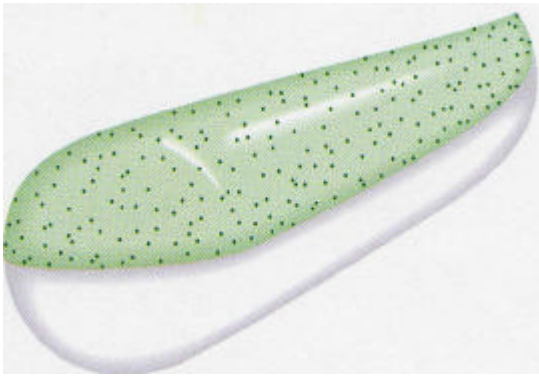
47. I have differed from the hearing officer's findings in certain respects but I believe that his overall assessment of the applicant's get-ups was essentially correct. In the absence of distinctiveness acquired through use, each and every one of the marks put forward by the applicant is devoid of any distinctive character and is therefore debarred from registration by section 3(1)(b) of the TMA. As is customary in *ex parte* appeals there will be no order for costs.

Mr Michael Silverleaf QC, instructed by Messrs. Kilburn & Strode, appeared on behalf of the applicant.

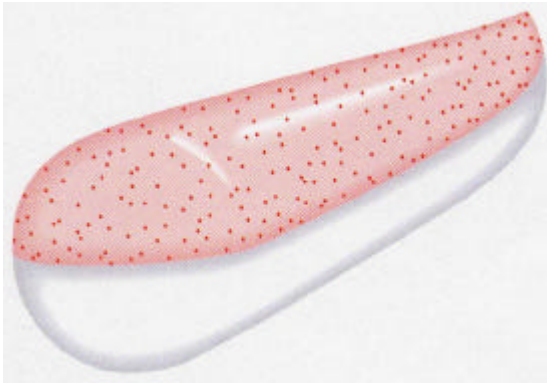
Mr Allan James, Principal Hearing Officer, appeared as the registrar's representative

Professor Ruth Annand, 8 October 2001

Applications Nos. 2187801A and 2187801F



Applications Nos. 2187801A and 2187801F



Applications Nos. 2187801D and 2187801G

