

## **TRADE MARKS ACT**

### **IN THE MATTER OF APPLICATION 2185286E BY COLGATE-PALMOLIVE COMPANY TO REGISTER A TRADE MARK IN CLASS 3**

#### **DECISION AND GROUNDS OF DECISION**

On 24<sup>th</sup> of December 1998 Colgate-Palmolive Company of 300 Park Avenue, New York, N.Y.10022-7499, USA applied to register a series of 22 marks, then as application number 2185286.

The application was made in respect of the following goods:

Class 03      Toothpaste.

Objections were taken under Sections 3(1)(a)(b) and (d) of the Act because the 3-dimensional marks were not graphically represented and they consist of non-distinctive devices of toothpaste being customary in the trade,

Objections were 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. During correspondence this objection was waived as the application was divided with the 8<sup>th</sup> mark forming Part E. Details of this mark is set out at Annex A. In need therefore make no further reference to this objection.

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

“The applicant claims the colour blue against a transparent background.

Following the decision of Geoffrey Hobbs QC in the Ty Nant Spring Water Ltd’s trade mark application (2000) RPC 55, on the 3 September 1999 the agents for the applicants were informed that the application did not meet the requirements of Section 32(2)(d) of the Act as the sign had not been clearly and unambiguously recorded. Subsequently in correspondence this objection was waived with the insertion of the following clause:

“The mark is a perspective view of a circular, cylindrical, slug of toothpaste uniform in cross-section throughout its length”.

Again I need make no further reference to this objection.

On 17 November 1999 the objections outstanding against the application were reviewed. Those raised under Sections 3(1)(a) and (d) were waived but an additional objection under Section 3(1)(c) was raised because the mark consists exclusively of the device of a portion of toothpaste being a sign which may serve in trade to designate the kind and intended purpose of the goods.

Following refusal of the revised application bearing the suffix “E”, I am now asked under Section 76 of the Act and Rule 56(2) of the Trade Mark Rules 1994 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.

Sections 3(1) (b) and (c) of the Act reads as follows:

- 3 (1) The following shall not be registered.
  - (b) trade marks which are devoid of distinctive character.
  - (c) trade marks which consists exclusively of signs or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographic origin, the time of production of goods or rendering of services, or other characteristics of the goods or services.

On reflection I do not consider that the objection under Section 3(1) (c) of the Act can be sustained. I therefore waive that objection. This leaves the objection under Section 3(1)(b) of the Act.

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 education the public that it is a trade mark”.

This application is for a mark which is a 3-dimensional shape of what has been described as a slug of toothpaste, the base colour of which is transparent. Through the slug are circles of blue shaded to represent spheres, some singly some in groups of two or three.

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 the goods in use.

However, the mark is more than a simple 3-dimensional shape as it is represented by spherical blue bubbles dispersed in a transparent background. Clearly these spherical blue bubbles bring an additional feature to the mark but I do not regard this additional feature as being particularly memorable or distinctive. When they appear dispersed in a transparent background 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 this mark. I do not see that there is anything in the mark 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 borne 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”.

Although the base colour for toothpaste is white I am aware from my own knowledge and experience that there are a considerable number of variations available in the market place. I am also aware that a number of products such as these are described as “gels” rather than “pastes”. The lack of colour or transparency of the base colour of this application would in my view be typical of a product of this nature. The dispersion of coloured bubbles through the product offers a small degree of individuality but this is insufficient to persuade me that the combination would serve to distinguish the goods of this applicant from those of other traders.

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 Section 3(1)(b) of the Act.

**Dated this 4<sup>th</sup> day of December 2001**

**CRAIG REDMORE**  
**For the Registrar**  
**The Comptroller General**

*ANNEXE ONLY AVAILABLE AS A PAPER COPY*