

TRADE MARKS ACT

IN THE MATTER OF APPLICATIONS NO. 2185286F AND NO. 2185286I BY
COLGATE-PALMOLIVE COMPANY TO REGISTER TRADE MARKS IN
CLASS 3

DECISION

Introduction

1. These are appeals from decisions of Mr. Craig Redmore, the Hearing Officer for the Registrar, dated 11th January 2002, whereby he refused each of these applications.
2. Objections were taken under section 3(1)(b) and (c) of the Trade Marks Act 1994 (“the Act”). The Hearing Officer considered that the objection under section 3(1)(c) of the Act could not be sustained, and he therefore waived it. He concluded, however, that each of the applications was unregistrable by virtue of section 3(1)(b) of the Act.
3. On the 8th February 2002 Colgate-Palmolive Company (“the Applicant”) gave notice of appeal to an Appointed Person against each of the decisions. I heard the appeals together. The Applicant was represented by Heather Lawrence, instructed by Kilburn & Strode. Mr. Allan James appeared on behalf of the Registrar.

The Trade Marks

4. Application No. 2185286F is for a series of six marks, all of which are three-dimensional shapes of what the Applicant described as circular, cylindrical slugs of toothpaste of uniform cross-section throughout their length. Representations of the marks the subject of the application are set out in Annex A to this decision. Colour claims were entered in respect of all six marks. In the case of each of the marks, the slug of toothpaste is longitudinally divided into two stripes. The first four marks contain speckles in the lower stripes, and the fifth and sixth marks contain spherical bubbles in the lower stripes. The Applicant summarised the combination of colour and pattern of each of the marks as follows:
 - (i) red upper, pink lower with red speckles;
 - (ii) blue upper, light blue lower with blue speckles;
 - (iii) turquoise upper, light turquoise lower with turquoise speckles;
 - (iv) light blue upper, light green lower with blue speckles;
 - (v) pink upper, light pink lower with red bubbles;
 - (vi) white upper, light blue lower with blue bubbles.

5. Application No. 2185286I is for a series of five two dimensional marks which are identical in appearance to those of application No. 2185286F, save that the fifth mark (pink upper, light pink lower with red bubbles) is absent from the series.

The Decision of the Hearing Officer

6. The Hearing Officer considered that the shape in question was nothing more than a reasonably accurate representation of a slug of toothpaste. In his view members of the purchasing public encountering any of the marks in issue would see them as being representations of the goods in use. He noted that, although all the marks comprised the same fundamental shape, they were all represented in different combinations of colours, speckles or bubbles. In his judgment the combinations of colours, dots and spherical bubbles brought an additional feature to each of the marks, but not one which was particularly memorable or distinctive. He also observed that the dots and spherical bubbles were likely to be lost in use.

7. The Hearing Officer recited the test of distinctiveness formulated by Jacob J. in *British Sugar v. James Robertson* [1996] RPC 281 at 306:

“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?”

He also cited the well known passage from the judgment of Robert Walker

L.J. in *Procter & Gamble Ltd's Applications* [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.”

The Hearing Officer also referred to the decision of Mr. Geoffrey Hobbs Q.C given on the 7th September 2000 in the case of *Reemtsma Cigarettenfabriken GmbH*. In that case Mr. Hobbs QC considered whether or not a trade mark application comprising a get up for cigarette packaging was “sufficiently arresting” to be likely to be taken as having trade mark significance.

8. The Hearing Officer considered that while it was clear that combinations of non-distinctive elements could create distinctive wholes, he did not accept that this was the position with the marks in issue. He concluded that there was nothing in the marks which would serve to distinguish the goods of the Applicant from those of other traders.
9. Later in his decision the Hearing Officer observed that the colours red, pink, blue and green were all colours which were amongst the usual range of colours used in the manufacture of toothpaste. In his judgment the straightforward shape of toothpaste slugs in well known colours, even when combined with dots or spherical bubbles, would not be taken by members of the public as having any trade mark significance. He therefore maintained the objection under section 3(1)(b) of the Act.

Section 3(1)(b) – The Appeals

10. On the appeals, the Applicant submitted that the Hearing Officer fell into error in identifying and applying the wrong test in assessing the distinctiveness of

the marks. It was further submitted that the Hearing Officer wrongly assumed certain facts which were unsupported by evidence and which were disputed.

11. I was referred to the decision of the European Court of Justice in *BABY DRY* [2002] RPC 17. At paragraphs 39 and 40 of the decision the court said:

“The signs and indications referred to in Article 7(1)(c) of Regulation 40/94 are thus only those which may serve in normal usage from a consumer’s point of view to designate, either directly or by reference to one of their essential characteristics, goods or services such as those in respect of which registration is sought. Furthermore, a mark composed of signs or indications satisfying that definition should not be refused registration unless it comprises no other signs or indications and, in addition, the purely descriptive signs or indications of which it is composed are not presented or configured in a manner that distinguishes the resultant whole from the usual way of designating the goods or services concerned or their essential characteristics.

As regards trade marks composed of words, such as the mark at issue here, descriptiveness must be determined not only in relation to each word taken separately but also in relation to the whole which they form. Any perceptible difference between the combination of words submitted for registration and the terms used in common parlance of the relevant class of consumers to designate the goods or services or their essential characteristics is apt to confer distinctive character on the word combination enabling it to be registered as a trade mark.”

So, it was submitted, the relevant question is whether there is any “perceptible difference” between the mark as a whole and those aspects of the mark which are descriptive of the goods or services in question. Any such difference, it was submitted, is apt, as a matter of law, to confer distinctive character on the mark enabling it to be registered as a trade mark. Accordingly, it was submitted, a device mark which is free of objection under section 3(1)(c) of the Act must also be free of objection under section 3(1)(b).

12. Applying these principles to the present case, the Applicant relied upon the finding of the Hearing Officer that the combination of colours, dots and spherical bubbles of the marks in issue brought an additional feature to them. It was submitted that this constituted a perceptible difference between the marks and any normal or common representation of toothpaste. It was also submitted that a device mark consisting purely of decoration built into the goods could not be descriptive of them and accordingly such a mark was different from a word mark which inherently described the goods. In all these circumstances it was submitted that it was not open to the Hearing Officer to find that the marks in issue could not distinguish the goods of the Applicant from those of other traders.
13. I do not accept the submission that a device mark which is free of objection under section 3(1)(c) of the Act is necessarily also free of objection under section 3(1)(b). First of all it is clear that each ground of objection must be assessed independently.
14. Secondly, and more fundamentally, a device mark may, in my judgment, be novel and not descriptive, but nevertheless not distinctive of the trade origin of the goods to which it is to be applied. I believe the fundamental question is whether or not the elements of a device mark confer a distinctive character upon it, such that the mark will be seen as an indication of origin. This approach was explained by the Court of First Instance of the European Communities (the CFI) in Case T337/99, *Henkel's Application*, dated 19th

September 2001. This case concerned an application to register a three dimensional trade mark in the form of a round tablet, comprising two layers, coloured white and red. Registration was sought in respect of washing or dish washing preparations in tablet form. The court reasoned:

“40. The distinctive character of a trade mark must be assessed in relation to the goods or services in respect of which registration of the mark is sought.

...

44. It is clear from the wording of Article 7(1)(b) of Regulation No. 40/94 that a minimum degree of distinctive character is sufficient to render the ground for refusal set out in that article inapplicable. It is therefore appropriate to ascertain – in an a priori examination not involving any consideration of the use made of the sign within the meaning of Article 7(3) of Regulation No. 40/94 – whether the mark applied for will enable the members of the public targeted to distinguish the products concerned from those having a different trade origin when they come to select a product for purchase.

45. Article 7(1)(b) of Regulation No. 40/94 does not distinguish between different categories of trade marks. The criteria for assessing the distinctive character of three-dimensional trade marks consisting of the shape of the product itself are therefore no different from those applicable to other categories of trade marks.

46. Nevertheless, when those criteria are applied, account must be taken of the fact that the perception of the relevant section of the public is not necessarily the same in relation to a three-dimensional mark consisting of the shape and the colours of the product itself as it is in relation to a word mark, a figurative mark or a three-dimensional mark not consisting of the shape of the product. Whilst the public is used to recognising the latter marks instantly as signs identifying the product, this is not necessarily so where the sign is indistinguishable from the appearance of the product itself.

...

48. The way in which the public concerned perceives a trade mark is influenced by the average consumer's level of attention, which is likely to vary according to the category of goods or services in question (see Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26). In that regard, the Board of Appeal rightly held that the level of attention given by the average consumer to the shape and colours of washing machine and dishwasher tablets, being everyday goods, is not high.
49. In order to ascertain whether the combination of the tablet's shape and the arrangement of its colours may be perceived by members of the public as an indication of origin, the overall impression produced by that combination must be analysed (see, by analogy, Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 23). That is not incompatible with an examination of each of the product's individual features in turn.
- ...
51. As to the tablet's two layers, one of which is white and the other red, the public concerned is used to seeing different colour features in detergent preparations. Powder, the form in which such products are traditionally presented, is usually very light grey or beige and appears almost white. It often contains particles of one or more different colours. The advertising carried out by the applicant and other manufacturers of detergents tends to highlight the fact that those particles indicate the presence of various active ingredients. The coloured particles thus suggest certain qualities, although that does not mean that they can be regarded as a descriptive indication in terms of Article 7(1)(c) of Regulation No. 40/94. However, it does not follow from the fact that that ground for refusal is inapplicable that the coloured elements necessarily confer a distinctive character on the mark applied for. Where, as in the present case, the target sector of the public sees the presence of coloured elements as a suggestion that the product has certain qualities, and not as an indication of its origin, there is no distinctive character. The fact that consumers may nevertheless get into the habit of recognising the product from its colours is not enough, in itself, to preclude the ground for refusal based on Article 7(1)(b) of Regulation No. 40/94. Such a development in the public's perception of the

sign, if proved, may be taken into account only for the purposes of Article 7(3) of Regulation No. 40/94.”

In my judgment it is clear that the CFI considered that the elements of a device mark might not be regarded as descriptive in terms of Article 7(1)(c) of Regulation No. 40/94. However it did not necessarily follow that the elements of the mark would confer a distinctive character on the mark as a whole. The tribunal must consider whether the overall impression produced by the combination of elements of the mark is such that the mark will be perceived by members of the public as an indication of origin. In my judgment there is no inconsistency between the approach of the CFI and that adopted by the courts in this country in *British Sugar* and *Procter & Gamble*. Accordingly I reject the first submission made on behalf of the Applicant. In believe the Hearing Officer directed himself correctly as to the law.

15. It was then said that the Hearing Officer wrongly assumed certain facts which were unsupported by evidence and which were disputed. Moreover, it was submitted, the Hearing Officer gave the Applicant no opportunity to rebut those assumptions. A number of specific criticisms were advanced on behalf of the Applicant. First, criticism was made of the following passage in the decision:

“Clearly the combinations of colours, dots and spherical bubbles bring an additional feature to the marks but I do not regard these additional features as being particularly memorable or distinctive. When the dots and the spherical bubbles appear in a background they are likely to be lost in use.”

The Applicant submitted that the Hearing Officer had no evidence upon which to reach the conclusion either that the additional features to which he there referred were particularly memorable or distinctive or that when the dots and the spherical bubbles appeared in a background they were likely to be lost in use. Moreover, it was submitted, the Hearing Officer erred in law in finding that the dots and bubbles were likely to be lost in use. He ought to have been considering a notional use of the mark as registered which would include the dots and spherical bubbles as depicted in the applications.

16. I believe that the last of these criticisms is justified. It seems to me that the Hearing Officer ought to have considered the marks as depicted in the applications. The dots and the bubbles are visible and, in my judgment, reasonably clearly so. I do not think it was appropriate to consider circumstances in which they might come to be lost in practice. Nevertheless, in my judgment the Hearing Officer came to the correct conclusion with regard to the distinctive nature of the marks. The Hearing Officer had no evidence to support the applications and accordingly he had to consider them for himself. To my mind this was primarily a matter of impression. Nor do I accept the criticism that the Hearing Officer ought not to have arrived at a conclusion without giving the Applicant an opportunity to put in evidence. Once the objection was taken by the Registry, it was open to the Applicant to file any evidence in support of the application which it thought fit. Moreover, and after the hearing before the Hearing Officer, the Applicant had further opportunity to seek to file evidence before the hearing of this appeal. In my

judgment the Hearing Officer was bound to reach a decision on the materials before him and he rightly did so.

17. It was also submitted that the features comprising the marks in issue could in fact serve no purpose other than to attract custom by virtue of their appearance and by making the products to which they are applied stand out in the crowd and from those of other traders. It was submitted that decorative stripes and patterns of the kind the subject of these applications would be assumed by consumers to be unique to and characteristic of particular products and hence distinctive.

18. I do not accept this submission. To my mind it does not follow that because the elements of the mark are not clearly descriptive, it necessarily means that they confer a distinctive character on the marks. I believe it is more likely that members of the public would see the presence and patterns of the coloured elements of the marks in issue as a suggestion that the products to which they are applied have certain qualities, such as comprising particular active ingredients, or indeed simply as decoration. I have considered all of the marks in issue and to my mind none of them possesses a distinctive character. Absent evidence of distinctiveness acquired through use, I do not believe that the trade marks in issue would function as an indication of the origin of the products to which they may be applied. In arriving at this conclusion I also have in mind that the products for which registration was sought, namely dentifrices, are widely used consumer goods and that the public concerned must be taken to comprise all consumers. I agree with the conclusion of the

Hearing Officer that the straightforward representation of toothpaste slugs in well known colours, even when combined with dots or bubbles, would not be taken as having any trade mark significance by those who purchase these goods.

Conclusion

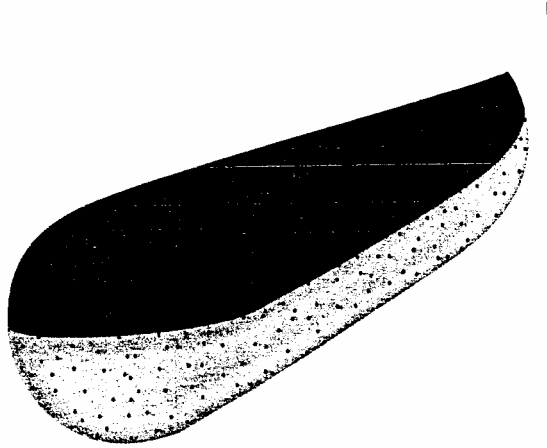
19. In all the circumstances these appeals must be dismissed. There will be no order as to costs.

DAVID KITCHIN, QC

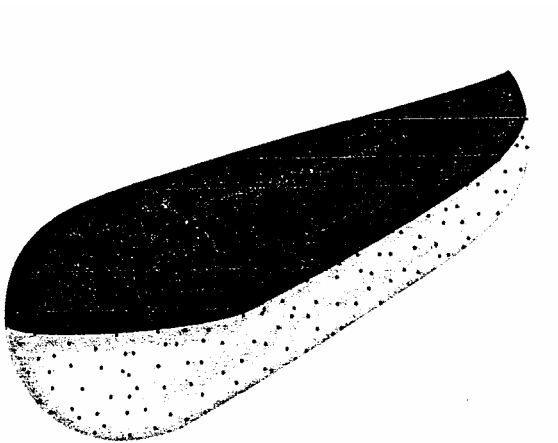
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Appendix A

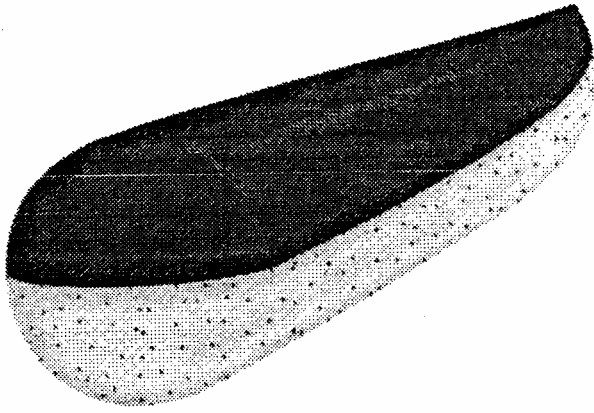
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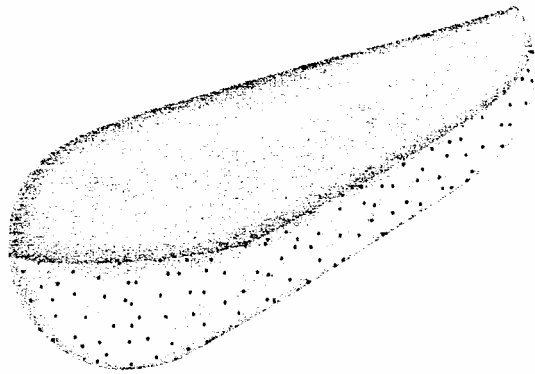
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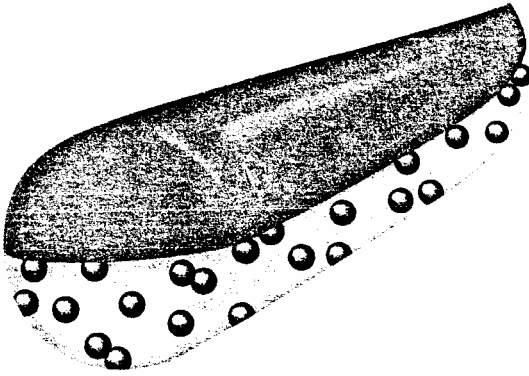
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(iv)



(v)



(vi)

