

O-226-03

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATIONS
Nos. 708434 AND 721688 AND REQUESTS BY
HENKEL KGAA TO PROTECT TRADE MARKS
IN CLASSES 1 AND 3**

AND

**IN THE MATTER OF OPPOSITIONS THERETO UNDER
Nos. 70325 AND 70356 BY ROBERT McBRIDE LTD**

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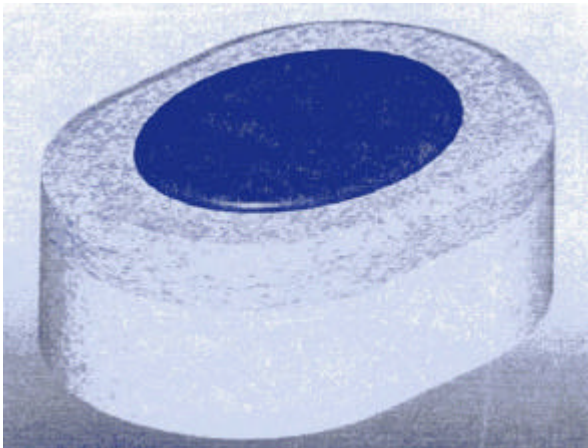
**IN THE MATTER OF International Registrations
Nos. 708434 and 721688 and requests by Henkel KGaA
to protect trade marks in Classes 1 and 3**

and

**IN THE MATTER OF Oppositions thereto under
Nos. 70325 and 70356 by Robert McBride Ltd**

Background

1. On 15 January 1999 (but claiming a priority date of 14 October 1998) Henkel KGaA, on the basis of a German registration, requested protection in the United Kingdom for the following trade mark:



in relation to the following goods:

Class 01

Chemical products for industrial purposes; softening agents for water, crust preventing and crust solving agents for use in tubes and apparatuses; scale removing preparations.

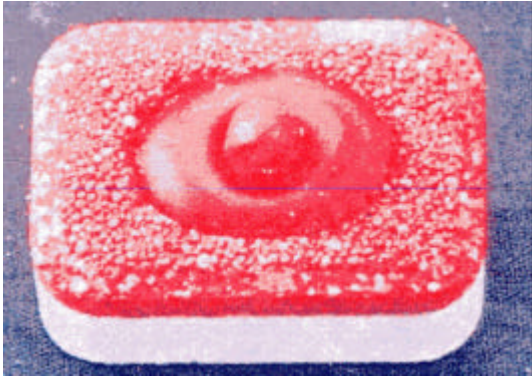
Class 03

Soaps; washing and bleaching agents; rinsing agents for dishwashing and laundry; cleaning and polishing agents; chemical preparations for cleaning wood, metal, glass, synthetics, stone, porcelain and textiles.

The international registration records that it is a three-dimensional mark and that the colours blue and white are claimed as an element of the mark.

The case is numbered 708434.

2. On 1 September 1999 (but claiming a priority date of 12 May 1999) the same party, also on the basis of a German registration, requested protection for the following trade mark:



in relation to the following goods:

Class 01

Chemical products for industrial purpose; softening agents for water; decalcifying agents.

Class 03

Soaps; washing and bleaching agents for laundry; rinsing agents for dishwashing and laundry; cleaning and polishing agents; chemical preparations for cleaning wood, metal, glass, synthetics, stone, porcelain and textiles.

The international registration records that this too is a three dimensional mark. The colours claimed in this case are red and white.

This case is numbered 721688.

3. The United Kingdom Trade Mark Registry considered that the requests satisfied the requirements for protection in accordance with Article 3 of the Trade Marks (International Registration) Order 1996 and particulars of the international registrations were published in accordance with Article 10.

4. On 3 July 2000 Robert McBride Ltd filed notice of opposition to the conferring of protection on No. 708434 and on 17 August 2000 the same company filed notice of opposition to the conferring of protection on No. 721688. The grounds are in substance the same in each case.

5. Under Section 3(1)(b) they say that the marks are devoid of distinctive character in that they consist exclusively of three dimensional tablet shapes commonly used in the trade along with colours which have also been commonly used in relation to soaps, detergents and other washing products. As a consequence it is said that the public would not in the absence of further information or education interpret these colours as an indication of source as opposed to decoration or indication of function. In further support of this ground reference is made to a decision of OHIM's First Board of Appeal (No. R0064/1999-1) where a three dimensional tablet having two layers of colour was refused registration as being devoid of distinctive character.

6. Under Section 3(1)(c) in that the marks applied for consist exclusively of shapes and colours which may serve in trade to designate the kind, quality, intended purpose or other characteristics of the goods for which protection is sought. In particular it is said that the use of colours is to indicate technical functions of the products.

7. Under Section 3(1)(d) on the basis that the practices and functional indications referred to were established at the relevant date such that they could be said to have become customary in the trade.

8. Under Section 3(6) the opponents claim that the applicants have filed applications to register three dimensional tablets using many different combinations of colours including many which are not currently capable of being produced using technology known to the industry and which make use of colours traditionally associated with the industry. The opponents say that this gives rise to the inference that the applicants have no bona fide intention to use the marks in issue. Alternatively it is said that the applicants are seeking to monopolise all or nearly all conventional colour combinations that are capable of being manufactured and that this constitutes an abuse of the registration process contrary to Section 3(6). In relation to No. 721688 there are further observations bearing on the 'third textured element' within the upper layer of the tablet. It is said that this is also an indication of function namely the addition of, for example a rinse and/or water softener to the pre-wash and wash functions. In essence this is a further expression of the objection as framed above.

9. The applicants (I will, for convenience, refer to the international registration holders as such) filed counterstatements denying the above grounds.

10. Both sides ask for an award of costs in their favour.

11. Both sides filed evidence. The matter came to be heard on 10 July 2003 when the applicants were represented by Mr D McCall of W.P. Thompson & Co and the opponents by Mr J Mellor of Counsel instructed by Marks & Clerk. A separate batch of eleven consolidated cases was heard at the same time.

Opponents' Evidence

12. This consists of witness statements, dated 16 January 2001 and 29 January 2001, together with five exhibits, from Julia Bradley (the witness statements are in substantially the same terms). Ms Bradley explains that she is an employee of the opponents, being the head of marketing of Robert McBride Ltd, a position she has held since 1999. Ms Bradley has been actively engaged in the textile and dishwashing detergent business since 1988. Ms Bradley further explains that her evidence is addressed in general terms to all the applications opposed by the opponents, but makes specific reference to the colours used in the individual cases.

13. Ms Bradley says that the shape of the tablets adopted in the various applications is commonplace and used by many producers. Initially the tablets took the form of simple white tablets of either round or rectangular shape. They then began to be found with speckled designs, the darker speckles containing coloured beads which may or may not perform an additional

function in much the same way as loose washing powders have for some years comprised powders with more than one colour element to produce the effect of a speckled powder.

14. Several suppliers have adopted coloured tablets of this type in the United Kingdom to indicate the multifunctional aspect of these tablets which now operate as a substitute for separate dosing of machines with pre-wash chemicals, cleaning preparations, softening agents, bleaches and rinsing agents. Exhibit JBA is said to show examples of companies which produce such tablets, including Unilever Group companies, Reckitt-Benckiser Group companies, Henkel Group companies, Proctor & Gamble Group companies and retailers such as Asda, Tesco and Sainsbury's. (In fact the exhibit only appears to show Safeway and Morrison products in relation to retailers- but Exhibit JBB shows Sainsbury's and Tesco's products). The colours chosen are said to be commonplace in the industry in question and detergent products used in this field have for many years commonly included green, white, red, yellow, pink and blue.

15. Ms Bradley says that not only are the combinations sought to be registered made up of commonplace, non-distinctive features, but the products have been marketed in such a way that members of the public will perceive the colour combinations as indicative of function not source. As the tablets have become more complicated, they have begun to include, e.g. pre-wash and rinsing or finishing agents. In order to promote the tablets these functions came to be expressed in advertising as consumer benefits and the promotion of these benefits to consumers has been reflected in the appearance of the tablets by colouring differently the different ingredients so as to emphasise their presence in the product.

16. For many years the colours blue, white and green have been standard colours used in detergents for textile and for dishwashing purposes, to indicate functions- blue for high performance, white to indicate cleanliness, green to indicate strength. Yellow has been used to indicate the presence of a softener or lemon fragrance, pink to represent products used in delicate colour washes or softener, red to indicate strong anti-grease action and so on. The consumer is accustomed to seeing these colour codes in all domestic cleaning products of this type.

17. Ms Bradley claims that the colours used perform the function of instructing the public of the various functions performed by the tablets in the machine. These are commonly referred to in the case of two colour/two layer tablets as "two phase" or "dual action" tablets. Exhibit JBB shows advertising material explaining to members of the public the different functions reflected by the colours used. The products in question have gradually become more sophisticated. To begin with the products were produced in homogenous form even if the ingredients were introduced as speckles. It then became apparent that there was a marketing advantage to be gained by selling to consumers the technical functionality of the products and this led to a desire to stress this function by presenting the ingredients in clear colour codes.

18. Originally there were only two layers in such tablets, which were rejected as trade mark applications by the UK Trade Marks Registry. Exhibit JBC shows examples of trade mark applications made by the applicants, which were rejected on this basis. Exhibit JBD shows examples of trade mark applications made by the applicants before the Office for Harmonisation of the Internal Market (OHIM), which were rejected on this basis.

19. Ms Bradley says that three layer or three colour tablets are no more distinctive or less descriptive than the old two layer tablets, given the introduction of a third functional element to the tablet. Thus she says it will be seen that the addition of a third colour or of a “powerball” pre-wash element into the tablet merely reflects the marketing of a third functional element. Exhibit JBB shows examples of this type of marketing. Ms Bradley goes on to argue that the public has been educated that it is not a trade mark but an indication of function.

20. In relation to the allegation of bad faith, Ms Bradley refers to Exhibit JBE which shows a list of current trade mark applications filed by the applicants or its associated group of companies in the UK and before OHIM for three dimensional tablets with colour layers or colour combinations of a similar type to the present application. Between 1998 and 2000 the applicants had made over 100 applications extending to the UK for registration of three dimensional tablet designs of this type for various combinations of shape and colour for the same product range; and over 40 applications before OHIM. Of the applications opposed, Ms Bradley claims that she has not been able to identify any tablet designs of the applicants actually in use in the UK. She is only aware of two layer green and white tablets actually in use by the applicants. The only three layer tablets of which Ms Bradley is aware on the market in the UK are those sold by Wm Morrison Supermarkets plc and J Sainsbury plc, each of which market a so called “triple layer tablet” comprising three layers, white, green and orange.

21. Furthermore, to the best of Ms Bradley’s knowledge, the applicants only sell two types of tablet product, one for a textile wash product and one for a dishwashing product. There have been no announcements on the part of the applicants of any intention to expand the range offered to any significant degree. Ms Bradley adds that many of the combinations of colours applied for by the applicants are not currently capable of being manufactured by machinery known to be in existence. The economics of the business suggest that such manufacture is not feasible in the foreseeable future in many of these cases. Therefore there cannot be any realistic intention to make use of all of these designs.

Applicants’ evidence

22. This consists of a witness statement by Eckhard Von Eysmond. Mr Von Eysmond explains that he is head of marketing for Henkel, the applicants in respect of their Automatic Dishwashing Department. Mr Eysmond has been actively involved in the textile and dishwashing product business for 10 years.

23. Mr Von Eysmond says that in his view the colour, shape and other features of the tablets do have a distinctive character which enables a shopper to distinguish the goods of one particular manufacturer from those of another and does not consist exclusively of shapes or colours which may serve in trade to designate the kind, quality or intended purpose of the goods and does not consist exclusively of indications which have become customary in the bona fide and established practices of the trade.

24. Commenting on Ms Bradley’s evidence Mr Von Eysmond agrees that the shape of the tablet is “in itself commonplace and used by many producers”, but he argues that it is the mark

as a whole which should be considered and should not be broken down into separate small elements each of which is independently analysed.

25. In relation to exhibit JBA of Ms Bradley's witness statement, Mr Von Eysmondts states that he cannot find any examples from a Henkel Group company nor any examples of Asda, Tesco or Sainsbury products as claimed. Furthermore the examples given seem to be primarily of one and two colour tablets. Also, in relation to this exhibit, he says none of the items support Ms Bradley's conclusion that the colours green, white, red, yellow, pink and blue have been used in this field "for many years". The colours red and pink have not been shown to have been applied to the layers of a tablet at all.

26. Mr Von Eysmondts refutes the suggestion that coloured layers indicate a specific function of the product as different colours are used in respect of products stated to have the same function. Exhibit EVEa shows photographs of sample packaging of tablets on sale in the UK illustrating the variety of colours used. Mr Von Eysmondts also refers to Ms Bradley's exhibit JBA which shows the Safeway product in two shades of blue and is stated to have a lemon fragrance, a Morrisons product in green, white and yellow referred to as "lemon tablets" which have a fresh lemon smell and exhibit JBB, which shows a Finish lemon product which is white and two shades of blue, the Tesco citrus product which is blue and white and the Safeway lemon product which is green, white and yellow. The submission by Julie Bradley that this type of product is marketed in such a way that members of the public will receive colour combinations as indicative of function and not source is contradicted, Mr Von Eysmondts argues, by what the situation actually is in practice.

27. With reference to paragraph 18 of Ms Bradley's witness statement, Mr Von Eysmondts says that three functions of the tablet are not necessarily represented by three layers, e.g. the applicants' SOMAT 3-in-1 product has three functions and is made up of only two layers (blue and red). Exhibit EVEb shows a sample of this product.

28. Mr Von Eysmondts accepts that the UK Trade Mark Registry and OHIM have rejected applications for registration of trade marks which consist of tablets of two different colours. He argues that the rejection of two colour tablets has no bearing on the present case which relates to three colour tablets.

29. Mr Von Eysmondts says that he is confused by exhibits JBC and JBD of Julia Bradley's witness statement, which are said to be "examples of trade mark applications before the UK Trade Marks Registry rejected on this basis"- which Mr Von Eysmondts presumes to be the two colour basis. Mr Von Eysmondts says that exhibit JBC appears to be a series of printouts relating to Community Trade Mark Applications which do not all refer to colour and which are all stated to be pending. Exhibit JBD is stated by Ms Bradley to be "examples of trade mark applications before the Office made by the applicants and rejected". The exhibit appears however to be a series of UK applications not all of which are for tablets, not all of which are two coloured products and all of which are listed as "abandoned".

30. In relation to Ms Bradley's comments on the bad faith allegation, Mr Von Eysmondts replies that it was at the time of application, and still is, the applicants' intention to use the mark in each

case in the United Kingdom. With reference to Ms Bradley's assertion that some of the combinations applied for are not capable of being manufactured, Mr Von Eysmond asks the opponents to identify which combinations these might be.

Opponents' further evidence

31. This consists of witness statements, dated 7 September 2001 from Keith Leonard Hodkinson. Mr Hodkinson is a partner in the firm of Marks & Clerk who act as agents for the opponent in relation to these and related proceedings. Mr Hodkinson adopts into these proceedings evidence filed in another opposition case (No. 70532) between the parties involving dishwashing etc. tablets.

32. Exhibit KHB1 is a witness statement, dated 31 July 2001, from Julia Bradley. This includes what is essentially a chronology of events in the dishwashing and textile washing detergents market in tablet form. These can be summarised as follows:

- Although such tablets have been in existence for many years, the current generation of such tablets were first introduced in 1994 for dishwashing tablets and 1998 for laundry washing tablets.
- In 1998, Benckiser NV of Holland, introduced a marketing campaign in the UK focussing on the different functions performed by its dishwashing tablets and distinguishing between those functions in a graphical manner by presenting tablets with two colour differentiated layers.
- May 1998- Finish branded dual layer blue and white tablets became available in the market place, provided by Benckiser. For about a year, these were the only tablets on the UK marketplace making use of the dual layer colour coding and Benckiser went to great lengths to publicise the dual function of such tablets.
- June 1999- Proctor & Gamble launched a competing green and white product under the brand Ariel.
- July 1999- Reckitt Benckiser launched the Finish Powerball product which comprises a dual layer tablet with blue and white layers and a red ball inserted in the top of the tablet – the “powerball”. The purpose of the “powerball” was to provide a “pre-soaking” agent.
- August 1999- Lever Brothers introduced a Persil dual layer product with blue and white layers.
- June 2000- J.Sainsbury Plc introduced a triple layer tablet comprising the colours green, white and yellow and at the same time Wm Morrison Supermarkets plc introduced their own triple layer tablet again having the colour combination green, white and yellow.

- September 2000- Reckitt Benckiser introduced a further variant of their powerball called Finish Powerball 2 in1 having the colour layers blue and white with a silver ball; the purpose of this “powerball” was to provide a rinsing agent.
- December 2000 – Proctor & Gamble introduced Fairy Tab in Tab comprising a tablet of white speckled material with a blue centre and a white “frame” around the outside of the tablet, the blue centre acting as and promoted as a pre-soaking agent.
- April 2001- J. Sainsbury Plc introduced a new triple layer tablet product comprising the colours blue, white and yellow.
- May 2001- Reckitt Benckiser introduced a further variation on their powerball theme called Finish Powerball 3 in 1 comprising the colours blue, white and green with a silver ball, differentiating the previous offer with the introduction of salt into the detergent and rinsing agent mixture.

Exhibit JBB1 shows an example of the Finish Powerball 3 in 1 packaging with the explanation of the functionality of the different layers and powerball on the back of the package. Ms Bradley also sets out a table in relation to the volume of sales by the respective manufacturers and retailers of the products previously mentioned:

Brand	Colours	Volume (unit) No. of Packs
Finish Dual Layer	Blue/White	*Between May 98 and Jan 2000 *2,153,032
Ariel	Green & White	30,648,810
Finish Powerball	Blue/White + Red Ball	10,970,809
Persil Dual Layer	Blue & White	55,843,040
Finish Powerball 2 in 1	Blue/White + Silver Ball	2,375,780
Fairy Tab in Tab	Speckles + Silver Ball/blue centre/white outside	162,705
Finish Powerball 3 in 1	Blue/White/Green	113,795

33. Finally at Exhibit JBB2 Ms Bradley shows a further example of the promotion of the functionality of the different colour elements. This is a video of a television advertisement broadcast during April/May 2001 and entitled “Finish 3 in 1 TV”.

34. I should add that Mr Von Eysmond has supplied his own chronology of the development of the tablet market which may differ in minor respects from Ms Bradley’s. I am not aware that any differences in the parties’ accounts of the development of this trade are such as to have a material bearing on the outcome of these cases.

The law

35. Section 3(1) of the Act reads:

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

- (a) signs which do not satisfy the requirements of section 1(1),
- (b) trade marks which are devoid of any distinctive character,
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above 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.”

36. This action has been brought under paragraphs 3(1)(b)(c) and (d). By common consent my decision in relation to (b) is likely to be determinative of the matter. I refer below to various decisions and judgments that have been issued in relation to washing tablet marks. So far as I can see all have been decided under Section 3(1)(b) of the UK Act or Article 7(1)(b) of the Community Trade Mark Regulation (40/94). Mr Mellor accepted at the hearing that it was difficult to envisage circumstances where the opponents could fail under Section 3(1)(b) but nevertheless succeed under either paragraph (c) or (d). Although I understand Mr McCall, who appeared for the applicants, considered that it would be useful to deal with those other grounds of objection, in the circumstances of these cases I do not think it will serve any worthwhile purpose. My consideration of the matter is, therefore restricted to the question of whether the marks proposed for registration are devoid of any distinctive character.

Authorities

37. The following authorities provide guidance on the general principles to be followed in applying the Section –

CYCLING IS.... Trade Mark Applications [2002] RPC 37 and the ECJ cases of *Libertel Group BV v Benelux Markenbureau*, Case C-104/01, and *Linde AG (and others) v Deutsches Patent-und Markenamt*, Joined Cases C-53/01 to C-55/01. The principles I draw from these decisions can be summarised as follows:

- an objection under Section 3(1)(b) operates independently of objections under Section 3(1)(c) (*Cycling IS* paragraphs 43-45 and *Linde* paragraphs 67-68);
- for a mark to possess a distinctive character it must identify the product (or service) in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product (or service) from the products (or services) of other undertakings (*Linde* paragraphs 40-41 and 47);
- it is legitimate, when assessing whether a sign is sufficiently distinctive to qualify for registration, to consider whether it can be presumed that independent use of the same sign by different suppliers of goods or services of the kind specified in the application for registration would be likely to cause the relevant class of persons or at least a significant proportion thereof, to believe that the goods or services on offer to them come from the same undertaking or economically-linked undertakings (*Cycling IS* paragraph 53);
- a trade mark's distinctiveness is not to be considered in the abstract but rather by reference to the goods or services in respect of which registration is sought and by reference to the relevant public's perception of that mark (*Libertel* paragraphs 72-77 and *Cycling IS* paragraphs 54-61);
- in this respect the relevant public must be deemed to be composed of the average consumer who is reasonably well-informed and reasonably observant and circumspect (*Libertel* paragraph 46 referring to Case C-342/97 *Lloyd Schuhfabrik Meyer*);
- when assessing the distinctiveness of a three-dimensional shape of goods trade mark, a stricter test must not be applied but it may in practice be more difficult to establish distinctiveness in relation to a shape of goods mark than a word or figurative mark (*Linde* paragraphs 48 and 49);
- similarly, in relation to colour, consumers are not in the habit of making assumptions about the origins of goods based on their colour or the colour of their packaging in the absence of any graphic or word element because as a rule colour per se is not, in current commercial practice, used as a means of identification (*Libertel* paragraph 65).

38. In addition to these general principles, I was referred to various decisions of Registry Hearing Officers, the Appointed Persons and the Court of First Instance that have dealt with washing/dishwasher tablet marks. It is not necessary to review them all. Guidance on the relevant considerations and the approach to be adopted can be taken from the following.

39. In a case, O/482/00 involving the present applicants' request for protection of a mark consisting of "the shape of a tablet consisting of the combination of two layers in the colours green and white" the Appointed Person (Mr G Hobbs QC) concluded that:

"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 perceptions and recollections 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 Class 3 goods in the United Kingdom at the relevant date and what effect that might have upon the perceptions and recollections of the average consumer of such goods."

and

"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."

40. In a further case involving the current applicants, O-165-02, the Appointed Person (Mr S Thorley QC) dealt with a three dimensional mark in the form of a cylindrical tablet consisting of two layers in the colours green and white. He came to the view that:

"The two colours are likely to indicate to the relevant public the presence of two active ingredients. Only by education could the public come to regard the colour combination as being distinctive of goods coming from one undertaking. As at the date of application this mark was unused and thus the public had not had that education."

41. A number of cases have come before the Court of First Instance (CFI) on appeal from decisions of the OHIM Boards of Appeal. In case T-117/00 involving an application for a three dimensional tablet shape including two colour layers the CFI said:

"59. The three-dimensional shape for which registration has been sought, namely a square tablet, is one of the basic geometrical shapes and is an obvious one for a product intended for use in washing machines or dishwashers. The slightly rounded corners of the tablet are dictated by practical considerations and are not likely to be perceived by the average consumer as a distinctive feature of the shape claimed, capable of distinguishing it from other washing machine or dishwasher tablets.

60. As to the tablet's two layers, one of which is white and the other green, 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. As the applicant itself explained at the hearing, powder 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, on its own, 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."

42. Similar conclusions were reached in Case T-194/01 in relation to a variant shape which is described as consisting of "an irregular oval with flattened edges and large dark speckles, which resembles a pebble".

"That shape is not, as such, one of the basic geometric shapes but it combines a number of features of various roundish shapes and also appears to draw on certain quadrangular shapes. It is thus closely related to certain tablet shapes commonly used for detergent products, in particular round and oval tablets and, to a lesser extent, rectangular tablets.

As the Office has correctly pointed out, the differences between the shape for which registration is sought and those other shapes are not easily perceptible. The shape applied for is a variation on the basic commonly-used shapes and is not sufficiently different from them to enable the relevant public, on the occasion of a subsequent acquisition, to recognise it and make a further purchase, if the experience proves to be positive, or to avoid a further purchase, if it proves to be negative.

The speckles on the tablet are not such as to confer distinctive character on the mark applied for. The addition of speckles is one of the most obvious solutions where various ingredients are to be combined in a detergent product (see, in particular, *Rectangular tablet with inlay*, cited at paragraph 36 above, paragraph 58). In addition, speckles are a commonplace feature of detergent solids..."

43. Since then there has been a decision in Case O-089-03 in relation to a three dimensional/three colour tablet where the Registry Hearing Officer concluded as follows:

“35. It may well be that particular combinations of colour and/or shape impart a degree of individuality to a tablet that enables the consumer to tell it apart from other tablets, but as Mr Mellor said in quoting Mr Hobbs (in Henkel’s appeal in relation to international registration number 700785) that is not the question. The issue is whether the individuality is sufficient to render the tablet distinctive in terms of trade origin.

36. In my view there is nothing sufficiently arresting about the combination of these three colours, nor anything in the individual and collective features of the mark applied for that persuades me that it should be regarded as being capable of distinguishing or denoting trade origin. Consequently, the opposition in respect of Section 3(1)(b) succeeds.”

44. There is one further case to which I was referred which I should briefly mention, *Yakult Honsha KK’s Trade Mark Application*, [2001] RPC 756. It is relied upon by Mr Mellor in dealing with the applicants’ claim that the marks now before me are different to what has gone before. The Yakult case involved an application for a container shape. Mr Justice Laddie said:

“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 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.”

Submissions

45. The principal submissions were as follows. Mr Mellor said that the marks applied for are, or are indistinguishable from, the products; it does not in itself assist the applicants to say that these marks are different from what has gone before; the evidence does not suggest that traders were using shape/colour combinations as indicators of origin; on the contrary distinctive word marks are used for the latter purpose; the evidence suggests that traders have employed colour/layers of colour to indicate functional aspects of the goods; and that there is no evidence to support a claim of acquired distinctiveness at the material date.

46. Mr McCall, in support of the applications, said that the marks were more than simply colours; the whole effect of the marks must be borne in mind; the exhibited trade material did not in a number of cases carry explanatory matter pointing to the functional aspects of colours or coloured elements; the presence of housemarks or such like did not mean the marks applied for could not also function as second tier marks; the marks enjoy a high degree of individuality and have additional features compared to what has gone before; and that consumers have been or are being educated to perceive the tablet get-up as an origin indicator.

47. I have referred in my evidence summary to Ms Bradley’s chronology of the development of dishwasher and laundry washing tablets. It will be apparent from this that as time has passed additional shapes, layers of colour and features (such as the Finish Powerball) have been added.

I do not understand there to be any significant dispute about this chronology. Mr Mellor's skeleton argument helpfully included as an Annex a tabulated version of the chronology which incorporated the dates of designation of the cases being dealt with here. Strictly it would also be necessary to take into account international priority dates but nothing appears to turn on this point.

48. It is apparent that these applications (and the related cases) were the subject of requests for protection over a period of time and, therefore, that different material dates apply. However, submissions at the hearing did not seek to distinguish particular cases on the basis of dates. It is not, therefore, suggested that some may succeed because they enjoy earlier designation/priority dates. I think that must be right. Either the opponents' or the applicants' case will prevail. The outcome will read across to all of the cases. I should also say that Nos. 708434 and 721688 have been separately consolidated because the registration details supplied when protection was requested in the UK indicate that only two colours are claimed (the other eleven cases relate to three colour combinations). In fact No. 708434 in particular is akin to a three colour mark having two contrasting shades of the colour blue. In practice a composite set of submissions was made concerning all the marks.

Decision

49. Firstly I should say that I accept Mr McCall's submission that it is not permissible to pick out elements of marks, decide that they are not distinctive and thereby dismiss the marks as wholes. Nevertheless it is sometimes inescapable that individual elements call for comment. Providing the final appraisal is made on the basis of the whole of the mark including the interaction of the component elements, that is a necessary part of explaining the basis for a decision.

50. The elements of the marks in issue here are their shapes, the colours employed and the manner in which those coloured elements are configured in the marks. Submissions at the hearing concentrated primarily on the colour components but I should first of all comment briefly on the shapes of the tablets. I do not understand the applicants to place much reliance on the character of the tablet shapes even within the context of appreciation of the marks as wholes. Ms Bradley suggests that the shapes are "commonplace and used by many producers". Mr Von Eysmond says "I agree that this may well be so, and is likely to be so in view of the receptacle of the appliance in which the tablet is in some cases to be inserted...". The shapes themselves are indeed commonplace ones and, judging by the material in Exhibits JBA and JBB are within the normal range of such shapes that consumers would expect to see.

51. Turning to the colours employed and the arrangement of these colours, it does not follow that, because two colour tablet marks have been found to be devoid of distinctive character under Section 3(1)(b) (or the equivalent provision in the Community regulation) that three colour tablets will also be open to objection on this account. If the combination of features results in the high degree of individuality argued for by Mr McCall then that is likely to point towards registrability rather than away from it. I accept too that it is not fatal to the applicants' case that the marks might be seen as second or third tier marks rather than primary indicators of origin (which tend to be word marks in the context of these goods). Equally, as Mr Mellor pointed out

by reference to the *Yakult* case, it is not enough that the marks proposed for registration are simply different to what has gone before. The test is whether the features of shape and colour may have broken new ground in the presentation of the goods at issue and what effect that might have on the perceptions and recollections of the average consumer (per Mr Hobbs in O/482/00).

52. The collective force of the opponents' evidence including the chronology of the development of the tablet market establishes that the use of colour tablets in a variety of basic geometric shapes (round, oval, rectangular etc) has been well established in the trade since at least 1998. Not surprisingly the product packaging exhibited at JBA and JBB show representations of the goods. As Mr Mellor submitted that is the start of the applicants' problems in that the sign is indistinguishable from the product. Consumers are unlikely to regard representations of the products themselves as also serving as badges of origin (though they may be educated to that position).

53. The difference between the parties' positions in relation to the use of coloured layers or elements in the marks resides in the question as to whether colour is indicative of a particular function. Mr Von Eysmond says:

"I do not agree that the colours are used to perform the function of instructing the public as to the functions performed by the tablets. Julia Bradley in introducing Exhibit JBB indicates that this shows advertising material explaining to members of the public the different functions reflected by the different colours used. I do not agree that this is the case. I accept that the advertising material produced does show that the different layers have different functions and that each layer of a different colour has a different function. This does not mean however that all manufacturers use a particular colour to identify the same function."

54. He goes on to give examples showing that different colours may mean different things. In other words there is no consistent use by different manufacturers of particular colours to indicate the same type of function.

55. Mr Von Eysmond's concession that different (colour) layers have different functions was in my view a necessary one on the evidence. That functionality is explained with varying degrees of directness in the advertising/packaging material that has been exhibited. Thus the FINISH Powerball packaging shows an exploded view of a three colour tablet with explanatory text indicating that the red powerball contains stain soakers, the blue layer breaks down food residues and the white layer produces a brilliant finish; others refer to dual or triple action with visual representations of the tablets dissolving (such as the Sainsbury tablets); yet others, such as the Fairy 'Tab in Tab', employ a combination of such features. There can be little doubt that the average consumer would understand that the different colour layers/elements represent different functions.

56. Ms Bradley goes further than this in her evidence and suggests that the colours themselves say something to the consumer about the manner in which the product performs its job. She gives examples such as yellow to indicate the presence of a softener or lemon fragrance, blue for high performances, white to illustrate cleanliness, green to indicate strength etc. Mr Von

Eysmondts disputes that there is any industry-wide colour coding system in operation and cites various examples from the evidence which suggest that individual manufacturers have adopted their own practices. Thus yellow, for instance, may or may not indicate the presence of a softener or lemon fragrance.

57. Does it matter that, whilst colour layers/elements indicate function, they may not always be reliable indicators of a specific function when the products of various manufacturers are being considered? In my view it clearly does not. The fact of the matter is that consumers have been educated to see colour combinations as being indicative of different functional characteristics of the component parts of the products. Once that point has been established I would suggest that it is likely to become that much more difficult for a trader to establish that any particular colour combination also serves in its own right as an indicator of trade origin.

58. It may well be that the inconsistent use of colour may put consumers on notice to check the precise functionality of the products under consideration but it does not elevate colour or colour combinations to the point where they act as guarantees of trade origin in their own right. The most that can be said is that particular colour combinations may be recognised as being different to other such products on the market.

59. Returning to the specific marks under consideration the question is whether the combination of colours and shapes and the way the elements are disposed within the marks can be said to endow them with a sufficient degree of distinctive character to avoid failing the Section 3(1)(b) test.

60. There appear to be a number of basic tablet shapes. I am not entirely clear when individual shapes made their appearance or whether the shapes in question here (an oval and a rectangle with rounded corners) were in common use at the material dates. Nevertheless they are not in themselves complex shapes. The colours too appear to be typical of what was available or coming onto the market at the relevant times. The earliest Finish tablets are said to have been blue and white (May 1998) and red and white were colours employed in the Finish powerball that was introduced to the market in July 1999. No. 708434 contains two shades of blue, the outer segment being in a lighter shade and with a somewhat speckled appearance (speckles are also a common feature of these goods). No. 721688 has the appearance of what was described at the hearing as a tablet with a 'blob' at its centre. The top surface of the tablet also has a slightly textured or pebbled appearance.

61. Given the nature of the goods, the range of shapes and colours in which they are produced, the manner in which the colour features have been promoted to the public as indicators of function I have little hesitation in concluding that these particular three dimensional tablets would fail to convey to consumers the message that they were intended to serve as badges of origin. They are devoid of distinctive character and, hence, objectionable under Section 3(1)(b).

62. There remains the opponents' further ground under Section 3(6) based on whether the applicants had a genuine intention to use the various combinations of three dimensional coloured tablets applied for. The opponents point to the many applications filed by Henkel (over and above the two sets of consolidated cases heard on 10 July 2003). The applicants on the other

hand say I need only consider the position in relation to the specific applications before me. The latter may not strictly be true as the opponents have filed evidence bearing on the applicants' pattern of behaviour (Exhibits JBC and JBD). Against that, it is clear that a large number of colours and shapes of washing tablets have been shown to have been brought into use. It is not a matter I consider I need to resolve. The Section 3(6) ground is peripheral to these cases. The position under Section 3(1)(b) seems to me to be clear. That is sufficient to decide the matter in the opponents' favour.

Costs

63. The opponents are entitled to a contribution towards their costs. A further eleven cases involving three colour tablets were separately consolidated and are the subject of my related decision of the same date. These two applications are technically for two colour labels. Both sets of consolidated proceedings were dealt with by means of a single set of submissions. I have issued separate decisions in case any point is taken on the differences if either matter goes to appeal.

64. So far as costs are concerned I have reviewed the position across both sets of consolidated proceedings taking account of the fact that separate oppositions and counterstatements needed to be filed; that the opponents filed separate evidence but of a substantially similar nature in each case (save for amendments to headings etc); that the small amount of additional evidence filed in two of the cases does not materially affect the position; that the applicants filed consolidated evidence; and that composite submissions were made at the hearing. It is also my understanding that the consolidation process was initiated by the Registry rather than the parties.

65. Taking all these factors into account I have decided to base my award of costs on the position and economies of scale achieved across both sets of consolidated proceedings but allowing also for the fact that the opponents, of necessity, had to file individual actions. I order the applicants to pay the opponents the sum of £6,500 of which £1,000 relates to these particular cases.

66. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 11TH day of August 2003

M REYNOLDS
For the Registrar
the Comptroller General