

TRADE MARKS

IN THE MATTER OF APPLICATION 2209937

BY G D SEARLE

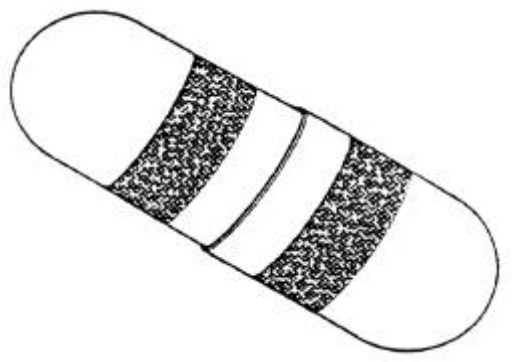
TO REGISTER A TRADE MARK IN CLASS 5

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IN THE MATTER OF APPLICATION 2209937 BY G D SEARLE TO REGISTER A TRADE MARK IN CLASS 5

DECISION AND GROUNDS OF DECISION

On 28 September 1999 G D Searle and Company of 5200 Old Orchard Road, Skokie, Illinois 60777, USA, applied to register the trade mark shown below in class 5.



The mark consists of a three dimensional shape and the following colour claim was entered on the form of application:

"The applicant claims the colour yellow as an element of the mark".

The goods for which registration is sought are as follows:

Class 5 Pharmaceuticals in the nature of anti-inflammatory analgesics.

Objection was taken under Section 3(1)(b) of the Act because the shape was devoid of distinctive character for the goods claimed and the addition of colour did little to add to the overall distinctiveness of the mark.

At the hearing, at which the applicants were represented by Mr Farrington of Ladas and Parry, their trade mark attorneys, the objection was maintained and the application was subsequently refused in accordance with Section 37(4) of the Act.

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

No evidence has been put before me. I have, therefore, only the prima facie case to consider.

Section 3(1)(b) of the Act reads as follows:

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

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

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

"What does *devoid of distinctive character* mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark?"

The application is for a mark which is a 3-dimensional shape of a capsule the base colour of which is white. Around the capsule are two bands coloured yellow.

The holders representative submitted in correspondence with the examiner and by way of argument at the Hearing that the shape of a capsule, as opposed to a tablet, caplet or other shape or design coupled with other fanciful elements such as colour, striping (bands) created a mark which was not devoid of any distinctive character and capable of identifying the applicant's goods.

The shape in question is, in my view, nothing more than an accurate representation of a capsule which is widely used for pharmaceutical goods. In my view members of the purchasing public encountering such a shape would see it as being typical of the goods.

However, the mark is more than a 3-dimensional shape. It includes two yellow coloured bands applied to the shape. I see nothing unusual in the presence of a single contrasting colour and do not consider that this feature makes the capsule recognisable as a trade mark in the sense that a typical consumer of the product would deduce that the capsules emanate from a particular source.

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 shape of the capsule with the two blue bands that would serve to distinguish the goods of the applicant from those of other traders.

In 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 judgement 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 Proctor and Gamble's application to register a Community Trade Mark for a three dimensional shape of a dishwasher tablet the European Court of First Instance in Case T-117/00 of 19 September 2001, paragraphs 54 and 55 said:-

"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.

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."

The public are well used to seeing this capsule shape for pharmaceutical goods and I do not see that there is anything memorable in this shape and single colour combination that would serve to distinguish the goods of the 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 30th day of January 2002.

IAN PEGGIE
For the Registrar
The Comptroller General