

TRADE MARKS ACT

IN THE MATTER OF APPLICATION 2187801G BY COLGATE-PALMOLIVE COMPANY TO REGISTER A TRADE MARK IN CLASS 3

DECISION AND GROUNDS OF DECISION

On 3rd of February 1999 Colgate -Palmolive Company of 300 Park Avenue, New York, N.Y. 10022-7499, USA, applied to register a series of 20 marks, then as application number 2187801.

The application was made in respect of the following goods:

Class 03 Toothpaste.

Objection was taken under Sections 3(1)(b) and (c) of the Act because the marks consist 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.

Objection was also 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.

At the hearing at which the applicants were represented by Mr Ashmead of Kilburn & Strode, their trade mark agents, the series objection was maintained. As a result the application was divided into seven parts with the 12th, 15th and 18th marks forming Part G. Details of these marks are set out at Annex A..

The following colour claims were entered on the original form of application:

First mark: “The applicant claims the colours light green, dark green and white as an element of the mark ”

Second mark: “The applicant claims the colours light blue, dark blue and white as an element of the mark”

Third mark: “The applicant claims the colours pink, red and white as an element of the mark”

In a letter dated 4 August 2000 the agent confirmed that each of these colour claims is amended to a limitation to the colours originally claimed.

The remaining marks are proceeding as separate applications and no further mention need be made of them. The objections were maintained against the marks forming application 2187801G.

Following refusal of the revised application bearing the suffix “G”, 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.

Firstly I turn to Sections 3(1)(b) and (c) of the Act which reads as follows:

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

(b) trade marks which are devoid of 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, 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 educating the public that it is a trade mark?”

This application is for a series of three marks, all of which are devices of what have been described as “toothpaste slugs”. All marks are for identical devices which have two base colours divided chordally with a third colour in the form of dots. Colour limitations have been entered in respect of all three marks. The two base colours of the first mark are light green and white with dark green dots appearing in the light green segments. The two base colours of the second mark are light blue and white with dark blue dots appearing in the light blue segments. Finally the base colours of the third mark are pink and white with red dots appearing in the pink segments.

The 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. 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, these marks are more than simple devices. Although all three marks constitute the same fundamental device they are all represented in different combinations of colour.

This application is for three marks which vary in their colour limitations. In my view the first

and second marks consist of two separate base colours with a darker shade of one of those colours being used to represent dots within the lighter base colour segments of the marks. The third mark is slightly different in that the colour red is used to represent dots on the pink segments of the mark. At the hearing Mr Ashmead argued that although such marks may not be as 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 a 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 devices, in these colours, 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 born 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.”

It is worth noting that white (one of the “base” colours in each of the marks) is a generic colour for toothpaste and therefore adds nothing to the distinctive character of the mark. From my own knowledge and experience of the market for these goods I am aware that the use of a contrasting colour to white in the form of a stripe or stripes is not distinctive per se.

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.

I now turn to the objection raised under Section 41(2) of the Act.

Section 41(2) of the Act reads as follows:

41.-(2) 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 trade mark.

I have already found that this application is debarred from *prima facie* acceptance by Section 3(1)(b) of the Act. Therefore, there is no requirement for me to set out, in detail, the grounds of my decision that this application is also debarred from acceptance by Section 41(2) 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 Sections 3(1)(b) and 41(2) of the Act.

Dated this 15 day of January 2001

A J PIKE

**For the Registrar
The Comptroller General**

ANNEXE ONLY AVAILABLE AS A PAPER COPY