

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 2148672**

**TO REGISTER A TRADEMARK IN CLASS 3**

**IN THE NAME OF COLGATE-PALMOLIVE COMPANY**

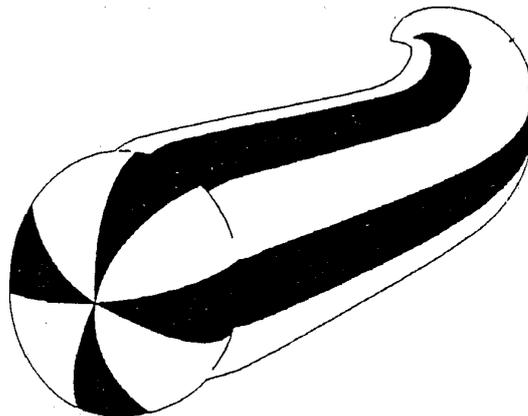
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**DECISION**

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Introduction

1. This is an appeal to the Appointed Person from a decision of Mr. Pike, the Hearing Officer acting for the Registrar, dated the 21<sup>st</sup> June 2001 in which he refused a request by Colgate-Palmolive Company (“the Applicant”) to register a trade mark in Class 3.
2. The mark in issue is a two dimensional pictorial mark and is in the colours dark blue and light blue. A reproduction appears below:



3. At the hearing the specification of goods was revised to “toothpaste” only. There was no evidence of use before the Hearing Officer and he therefore had only the prima facie case to consider.

#### Refusal of the Application

4. The application was refused by the Hearing Officer under section 3(1)(b) of the Trade Marks Act 1994 (“the Act”). The Hearing Officer assessed the mark as follows:

"This application is for a mark which is a device of what could be described as ‘a slug of toothpaste’. The mark has two colours which are divided diametrically. A colour claim has been entered on the form of application. The two colours are light blue and dark blue. The two colours are evenly spaced diametrically and gradually narrow to a point in the centre of one end of the device. The other end of the device is curved and tapers to a point.

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 a representation of the goods in use.

However, this mark is more than a simple device. There is the colour combination to consider. The mark is represented in two shades of blue i.e dark blue and light blue. The colours are in an alternating pattern which gives the effect of stripes. From my own knowledge and experience of the market for these goods I am aware that the use of contrasting colours in the form of stripes is not distinctive per se.

While 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 this device, in these colours, which would serve to distinguish the goods of the applicant from those of other traders."

5. After citing from a number of authorities, the Hearing Officer concluded:

"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."

The Hearing Officer accordingly found that the trade mark failed to qualify under section 3(1)(b) of the Act.

### The Appeal

6. In July 2001, the Applicant gave notice of an appeal to an Appointed Person. At the hearing of the appeal the Applicant was represented by Mr. Silverleaf QC, instructed by Kilburn & Strode and Mr. Morgan appeared on behalf of the Registrar.

7. Mr. Silverleaf drew my attention to Case T337/99, *Henkel's application*, a decision of the Court of First Instance of the European Communities, dated 19<sup>th</sup> September 2001. He referred me to the following paragraphs in particular:

"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...."

....

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."

8. Basing himself upon the *Henkel* case, Mr. Silverleaf accepted that the Hearing Officer had asked himself the correct question, namely whether the mark in issue had a sufficiently distinctive character to perform the essential function of a trade mark, but submitted that the Hearing Officer fell into error in seeking to answer that question. Mr Silverleaf contended that in the paragraphs from the decision cited above, the Hearing Officer wrongly sought to isolate the individual conceptual features of the mark and wrongly decided the issue on the basis of his own view as to whether or not the mark was a trade mark when he should have considered the matter from the perspective of

members of the purchasing public. Overall, it was submitted, the Hearing Officer failed to take adequate account of the nature of the mark as a whole, the goods in issue and the perceptions of the purchasing public.

9. I do not accept the criticisms levelled by Mr. Silverleaf at the decision of the Hearing Officer. I believe that the Hearing Officer accurately described the mark as a reasonably accurate representation of a slug of toothpaste that anyone encounters on squeezing an ordinary tube of toothpaste. He also pointed out that the device has a colour combination and pattern which gives the effect of stripes.
10. The Hearing Officer then went on to consider whether or not these elements of the mark were either themselves distinctive or could create a distinctive whole. He concluded that they did not. In my judgment the Hearing Officer did not fall into error in this approach. Indeed in the *Henkel* case, the Court of First Instance expressly pointed out that while the overall impression produced by the mark must be analysed, that was not incompatible with an examination of each of the product's individual features in turn.
11. As to the criticism that the Hearing Officer substituted his own view for an objective assessment of that of the purchasing public, I do not believe that this is justified. The Hearing Officer was clearly looking at the mark from the perspective of the purchasing public, and this is apparent from his approach to the shape of the mark. He observed that in his view, members of the

purchasing public encountering such a mark would see it as being a representation of the goods in use.

12. I have to determine whether or not the degree of individuality of the mark as a whole is sufficient to render it distinctive of the trade origin of the goods to which it is applied. There is no evidence of use and accordingly it is helpful to consider the question as a matter of first impression. Indeed the parties before me agreed that that was an appropriate approach.
  
13. I accept that the mark may be novel, but to my mind it lacks that distinctive character necessary for the mark to be perceived as an indication of origin. I believe that the purchasing public would see it as a representation of a slug of toothpaste bearing stripes of shades of a colour within the normal range which the public expects to see applied to such goods. I believe they would be likely to perceive the coloured elements of the mark as a suggestion that the product has certain qualities or as decoration. Looking at the mark as a whole, it does not appear to me to possess the specific individuality which would render it distinctive of the trade origin of the goods to which it is applied.
  
14. In my judgment the Hearing Officer was right to conclude that the mark failed to qualify under section 3(1)(b) of the Act. The appeal will accordingly be dismissed and, as agreed, there will be no order as to costs.

DAVID KITCHIN, Q.C

29th January, 2002