

O-099-05

TRADE MARKS ACT 1994

**IN THE MATTER OF AN APPLICATION NO 2180238
BY THE PROCTER & GAMBLE COMPANY
TO REGISTER A TRADE MARK
IN CLASS 3**

DECISION AND GROUNDS OF DECISION

Background

1. On 23 October 1998 The Procter & Gamble Company of One Procter & Gamble Plaza, Cincinnati, Ohio 45201, U.S.A. applied under the Trade Marks Act 1994 to register the following trade mark in Class 3:



2. The following wording appeared with the mark on the form of application:

“The mark consists of a rectangular three-dimensional shape incorporating two layers of colour, white with green speckles and pale green.”

3. The specification of goods for which registration is sought is :

Class 3 Washing and bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; preparations for the washing, cleaning and care of dishes; soaps.

4. Objection was taken against the application under Section 3(1)(a) because the mark consists of a representation of the goods. Section 3(1)(a) refers to signs which do not satisfy the requirements of Section 1(1) i.e. that signs should be capable of distinguishing goods or services of one undertaking from those of other undertakings.

5. Objection was also taken under Section 3(1)(b) of the Act because the mark consists exclusively of the three-dimensional form of a tablet, coloured green and white. The mark is devoid of distinctive character for e.g. bleaching or cleaning preparations sold in tablet form.

6. Further objection was taken under Section 3(2)(a) of the Act because the mark consists exclusively of the three-dimensional form of a tablet, coloured green and white, being a shape which results from the nature of the goods themselves.

7. Objection was also taken under Section 3(6) of the Act because there is some doubt about the accuracy of the statement on the application form that the applicant is using, or intends to use, the mark on all the goods applied for.

8. Further objection was taken under Section 5(2) of the Act because there is a likelihood of confusion with earlier trade marks. However, all of these earlier trade marks have now been withdrawn and no longer form the basis of an objection under Section 5(2) of the Act.

9. A hearing was held on 24 November 2004 at which the applicant was represented by Ms Nicholls of D. Young & Co, their trade mark attorneys. At the hearing the objections under 3(1)(a), 3(2)(a) and 3(6) of the Act were waived and I need make no further reference to them in this decision. However, the objection under Section 3(1)(b) of the Act was maintained and Notice of Refusal was subsequently issued.

10. 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.

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

The Law

12. 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 Case for Registration

13. Prior to the hearing Ms Nicholls provided me with skeleton arguments in relation to all of the objections which were outstanding at that time. Insofar as the objection under Section 3(1)(b) of the Act is concerned the skeleton argument contained the following submissions:

“Section 3(1)(b) Objections

In all cases, this objection has been taken on the basis that the applicant’s mark is devoid of distinctive character for, in particular, bleaching or cleaning preparations sold in tablet form.

The further arguments below are based on the assumption that the applicant intends to sell their products in this form; nevertheless, the applicant also reserves their position with regard to a possible amendment to the specification wording, by the addition of the qualifying phrase “none sold in tablet form”, following discussion at the forthcoming Hearing.

Registrar’s “policy” on 3D coloured tablet shapes

At the outset, when considering each application, the Registrar obviously has a duty to consider each case individually on its merits and not to adopt arbitrary guidelines or principles of assessment which deny the applicant a full and fair Hearing on the particular case.

In this respect, we consider that the policy outlined in the official letter of 2 June 2000 regarding these applications is unsustainable and contrary to the principles of administrative law, in that it suggests that the Registry has a pre-set acceptance guideline for marks such as those of the applicant, described in the letter as “accepting them if they are in three or more colours and objecting to them if they are in two or less colours”. This policy is clearly contrary to the principles enunciated by the European Court of Justice in their judgment of 29 October 2004 in joined cases C-468/01P – C-472/01P (involving three dimensional tablets for washing machines or dishwashers), in particular at paragraph 45 of the Court’s judgment, which requires the competent authority to make an individual assessment of the features of the mark applied for before reaching a final conclusion on distinctive character.

Moreover, in the instant case, the official letter of 13 November 1998 does not contain any reasoned justification or detailed reasoning behind the conclusion that the marks are devoid of distinctive character for bleaching or cleaning preparations sold in tablet form.

We submit further that the principles of natural justice, as set out in general administrative law (applicable to the operations of the Trade Marks Registry and its officials) require full reasoning to support such conclusions, in order to

give the applicant the opportunity to properly / fairly contest the basis on which such conclusion has been reached and to appeal therefrom if necessary.

On the substance of the objection under Section 3(1)(b), we submit the following arguments:

1) Meaning of “devoid of any distinctive character”

It is now well established in case law that this criterion must not be interpreted too strictly (see statements in “BABY DRY”); any feature of the applicant’s mark which would allow the consumer to recognise the sign or symbol as having trade mark characteristics should be sufficient to permit registration.

Clearly, marks featuring colours and combinations of colours are inherently capable of performing this function; this is apparent, not only from an examination of the numerous trade marks which contain colours and have been accepted for registration across all categories, but also by an examination of the commercial marketplace, where use of colour is one of the central methods wherein a proprietor distinguishes his brand, creating a striking visual effect likely to fix itself in the consumer’s recollection.

In the case of the applicant’s mark, it is submitted that at the time when these were filed, there was no established practice in the trade in the field of washing and cleaning preparations of producing goods in tablet form, combining coloured layers. Accordingly, this feature was sufficiently unusual to have a capacity to distinguish the applicant’s goods from those of their competitors.

Indeed, the uniqueness of this particular product presentation makes it more than usually likely to strike the consumer as having distinctive character, thus leading to a clear association between the producer and the product. This is despite the fact that the products in question are everyday consumer products and that the sign applied for does not contain any graphic or word element.

In circumstances where a new product is introduced with a different format, such as that in issue here (i.e. compressed tablets for washing preparations, rather than loose powder or liquid), it is submitted that the average consumer is likely to pay closer attention to the product and to rely on the visual appearance of the goods in order to correctly select the goods when making repeat purchases, for example. The applicants customarily use representations of these signs on their packaging in order to assist the consumer in so doing.

2) Date of assessment of distinctive character

It is settled law in the UK that this assessment relates to the time when the application is filed; it should also be noted that the European Court

of Justice, in case C-468/01P – C-472/01P specifically declined to adjudicate on the relevant date for the assessment of distinctive character (see paragraph 58 of their judgment) and it is therefore submitted that the current Registry practice and interpretation under UK law is applicable to these cases.

Generally therefore, it is submitted that the marks, when applied for, were sufficiently unusual insofar as the combination of the shape and arrangement of colours in each case is concerned, to be capable of being perceived by members of the public as an indication of origin. We therefore request that the objections under Section 3(1)(b) be waived.”

14. At the hearing the submissions made by Ms Nicholls were in line with those set out in the skeleton argument and no additional submissions were put before me.

Decision

15. The approach to be adopted when considering the issue of distinctiveness under Section 3(1)(b) of the Act has recently been summarised by the European Court of Justice in paragraphs 37, 39 to 41 and 47 of its Judgment in *Joined Cases C-53/01 to C-55/01 Linde AG, Windward Industries Inc and Rado Uhren AG* (8th April 2003) in the following terms:

“37. It must first of all be observed that Article 2 of the Directive provides that any sign may constitute a trade mark provided that it is, first, capable of being represented graphically and, second, capable of distinguishing the goods and services of one undertaking from those of other undertakings.

.....

39. Next, pursuant to the rule 1 Article 3(1)(b) of the Directive, trade marks which are devoid of distinctive character are not to be registered or if registered are liable to be declared invalid.

40. For a mark to possess distinctive character within the meaning of that provision it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from products of other undertakings (see Philips, paragraph 35).

41. In addition, a trade mark’s distinctiveness must be assessed by reference to, first, the goods or services in respect of which registration is sought and, second, the perception of the relevant persons, namely the consumers of the goods or services. According to the Court’s case-law, that means the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and *circumspect* (see Case C-210/96 Gut Springenheide and Tusky [1998] ECR I-4657, paragraph 31, and Philips, paragraph 63).

.....

47. As paragraph 40 of this judgment makes clear, distinctive character means, for all trade marks, that the mark must be capable of identifying the product as originating from a particular undertaking, and thus distinguishing it from those of other undertakings.”

16. The first point made in Ms Nicholls’ submissions relates to the Registrar’s policy on three dimensional coloured tablet shapes. The role and significances of the Registrar’s practice was considered in the case of Henkel KGaA’s appeal to the Appointed Person against the refusal of the Registrar to grant protection in respect of International Registration No 708422. In his decision Simon Thorley QC provided the following guidance:

“...I must mention the Registry Practice which was drawn to my attention by Mr McCall and subsequently clarified by Mr Knight. Mr McCall submitted that the Registry Practice consisted of allowing registration of a shape/colour mark without evidence of use, on a prima facie basis, where there was a three colour combination. Mr Knight amplified upon this stating that the Registry Practice was indeed that, as a guideline, the combination of three colours was the minimum necessary to qualify for registration but that each case had to be considered separately and that three colours by themselves might not be sufficient. In each case the Registry had to be satisfied that the combination of colours and shape was distinctive.

It must always be remembered that the Registry Practice is a guideline and nothing more. It is helpful both to the Registry and to practitioners, but it cannot absolve the Registrar’s hearing officers, or me on appeal, from approaching each case on its own facts. The fact that a mark consists of three colours will not necessarily qualify it for registration and the fact that it consists of only two cannot be an absolute bar to registration. In each case it is necessary to have regard to the combination of colours and shape in reaching a conclusion as to whether or not the overall combination is distinctive in a trade mark sense.”

17. It is clear that Registry Practice does not make a mark registrable or unregistrable. Each case must be decided on its merits having regard as to whether the overall combination of colours and/or shape is distinctive in a trade mark sense.

18. When considering the meaning of “devoid of any distinctive character” Ms Nicholls states that marks featuring colours are inherently capable of possessing sufficient distinctive character to permit registration. She points out that in the commercial marketplace colour is used in order to create a striking visual effect likely to fix itself in the eye of the consumer’s recollection. She goes on to state that where a new product is launched in a different format then the average consumer is likely to pay close attention to it and rely on the visual appearance of the goods in the process of making repeat purchases.

19. In some circumstances colour may be recognised and accepted by consumers as an indication that the goods in question come from a single undertaking. However, I

must judge this in respect of the mark applied for in relation to the goods contained within the specification.

20. I note that Ms Nicholls makes reference to the goods in question as being washing and cleaning preparations in tablet form. However, the specification of goods applied for has not been amended in any way and remains as filed on the form of application. I should perhaps record that I do not see that any limitation to the goods being in tablet form would result in a different conclusion as far as this application is concerned.

21. The second point made by Ms Nicholls relates to the date of assessment of distinctive character. In her submissions Ms Nicholls reminded me that this application was made on 22 October 1998. The thrust of this submission is that I must consider whether, at the date of application, this combination of shape and arrangement of colours is capable of being perceived by members of the public as an indication of origin.

22. In *Procter and Gamble v. OHIM*, Joined Cases, 468/01/482/01 the Court said at paragraphs 36 and 37:

“36 The Court of First Instance was also correct in stating that the criteria for assessing the distinctive character of three-dimensional shape-of-product marks are no different from those applicable to other categories of trade mark. It none the less observed that, for the purpose of applying those criteria, the relevant public’s perception is not necessarily the same in relation to a three-dimensional mark consisting of the shape and colours of the product itself as it is in relation to a word or figurative mark consisting of a sign which is independent from the appearance of the product it denotes. Average consumers are not in the habit of making assumptions about the origin of products on the basis of their shape or the shape of their packaging in the absence of any graphic or word element and it could therefore prove more difficult to establish distinctiveness in relation to such a three-dimensional mark than in relation to a word or figurative mark (see, to that effect, *Linde*, paragraph 48, and Case C-218/01 *Henkel* [ECR I-000, paragraph 52).

37 In those circumstances, the more closely the shape for which registration is sought resembles the shape most likely to be taken by the product in question, the greater the likelihood of the shape being devoid of any distinctive character for the purposes of Article 7(1)(b) of Regulation No 40/94. Only a trade mark which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin, is not devoid of any distinctive character for the purposes of that provision (see, in relation to the identical provision in Article 3(1)(b) of First Directive 89/104, *Henkel*, paragraph 49).”

23. The trade mark applied for is a three-dimensional representation of a tablet form. The mark is described on the form of application as “*a rectangular three-dimensional shape incorporating two layers of colour, white with green speckles and pale green*”.

24. In my view the tablet shape in question is a basic geometric shape. Even at the date of application this particular shape, being a basic geometric shape, is one which would have been an obvious shape to choose for such products. In my view the shape for which registration is sought is the shape which, at the date of application, is the shape most likely to be taken by the product in question or closely resembles the shape most likely to be taken by the product in question. The colours may have some visual impact but I do not regard them as being particularly striking. Basic colours such as white and pale green are commonly used in relation to products in the detergent sector. The presentation of the colours in this mark do no more than to indicate the presence of a number of active ingredients contained within the tablet. This combination would do no more than to indicate to the relevant consumer who, I consider to be the general public, that the tablet contains active ingredients.

25. In order to achieve registration I acknowledge that there is no requirement for a trade mark to possess a specific level of artistic creativity or imaginativeness. I must determine whether the trade mark applied for is capable of enabling the relevant consumer of the services in question to identify the origin of the services and thereby to distinguish them from other undertakings. In *OHIM v SAT.1* (Case C-329/02) the European Court of Justice provided the following guidance at paragraph 41:

“41 Registration of a sign as a trade mark is not subject to a finding of a specific level of linguistic or artistic creativity or imaginativeness on the part of the proprietor of the trade mark. It suffices that the trade mark should enable the relevant public to identify the origin of the goods or services protected thereby and to distinguish them from those of other undertakings.”

26. I should also mention that I am aware that what appears to be an identical mark was the subject of an application as a Community Trade Mark (No 000954404). That application was made in the same name as the applicant for this application and was refused by the Community Trade Mark office because it lacked any distinctive character. The matter was appealed to the Court of First Instance (Case T-118/00) who, on 19 September 2001, dismissed the appeal. The matter was finally decided by the European Court of Justice on 29 April 2004 in Joined Cases C-473/01P and C-474/01P where the applicant’s appeal was again dismissed.

27. For the reasons set out earlier in this decision I have concluded that the relevant consumer of the goods in question, who I have found to be the general public, would not place any trade mark significance upon this combination of shape and colour. They would, in my view, perceive the mark as a representation of the goods. The shape is not at all unusual and the colours are those frequently used in the detergent sector. The speckles do no more than indicate some form of active ingredient. I must, of course, consider the effect of the mark in its entirety and not isolate elements of the mark. Having done so I have concluded that the trade mark applied for is devoid of any distinctive character and is incapable of guaranteeing that the goods upon which it appears emanate from a single undertaking. It follows that this application is debarred from prima facie acceptance by Section 3(1)(b) of the Trade Marks Act 1994.

28. In this decision I have considered all of the documents filed by the holder and for the reasons given the notice of refusal is upheld.

Dated this 15th day of April 2005

**A J PIKE
For the Registrar
The Comptroller-General.**