

TRADE MARKS ACT 1994

AND

**THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996
IN THE MATTER OF INTERNATIONAL REGISTRATION No 854426
AND THE REQUEST BY HENKEL KGaA
TO PROTECT A TRADE MARK IN CLASS 16**

Background

1. On 18 May 2005 Henkel KGaA of Henkelstrasse 67, 40191 Dusseldorf, Germany, on the basis of International Registration 854426, requested protection in the United Kingdom under the provisions of the Madrid Protocol of the following mark:



2. Protection is sought in Class 16 in respect of:

Adhesive tapes and self-adhesive tapes for stationery or household purposes; adhesives for do-it-yourself and household purposes; office articles, namely adhesive tape dispensers, as far as included in this class.

3. It was considered that the request failed to satisfy the requirements for registration in accordance with Article 3 of the Trade Marks (International Registration) Order

1996 and notice of refusal under Article 9(3) was given because the mark is excluded from Registration by Section 3(1)(b) of the Trade Marks Act 1994. This is because the mark consists of a device which is a depiction of fingers pulling tape from a tape dispenser. This device will not be seen as a trade mark as it is devoid of any distinctive character because it would be seen as demonstrating a tape dispenser in use and not as an indication of the origin of the goods.

4. Following a hearing, at which the applicant was represented by Mr McCall of W. P. Thompson & Co., their trade mark attorneys, the objection under Section 3(1)(b) of the Act was maintained.

5. Notice of refusal was issued under Article 9(3) and 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.

The Law

6. 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

7. At the hearing Mr McCall advised me that he will forward me a copy of the mark as originally filed which is a clearer representation of this mark. These were sent to the registry under cover of letter dated 28 February 2006. These documents consisted of a copy of the original Certificate of International Registration (which does contain a clearer representation of the mark applied for) and papers demonstrating the mark in actual use. Copies of these are attached at Annex A.

8. In further correspondence dated 21 March 2006 Mr McCall argued that the mark is more than a representation of the goods. He states:

“The mark in fact illustrates in a fanciful manner the goods, a device of part of a hand and a somewhat unusually shaped container. In this connection it is to be noted that the container represented in the mark, somewhat unusually, is rounded at both ends but the curvature differs at the two ends. The mark includes a dark band towards the top and another dark band across the bottom. The overall impression is of a device of a container which is of unusual and fanciful shape.”

Additionally, Mr McCall directed my attention to International Registrations M828646 and M828644. Copies of these two registrations are attached at Annex B.

Decision

9. The approach to be adopted when considering the issue of distinctiveness under Section 3(1)(b) of the Act has 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 is to be observed at the outset 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 or services of one undertaking from those of other undertakings.
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39. Next, pursuant to the rule in 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).
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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.”

10. Section 3(1)(b) of the Act prohibits (prima facie) the registration of trade marks which are devoid of any distinctive character. Its purpose is to prohibit registration of marks which do not fall foul of the clear parameters set by Sections 3(1)(c) and (d) of the Act but, nevertheless, still do not fulfil the function of a trade mark because they do not identify goods and services from one undertaking from those of other undertakings.

11. It is now well established that the matter must be determined by reference to the likely reaction of an average consumer of the goods in question, who is deemed to be reasonably well informed, reasonably observant and circumspect. In relation to these goods I consider the average consumer to be the general public and organisations of varying sizes. The purchasers, and potential purchasers, of the goods in question purchase them because they satisfy their own personal requirements regarding the practical benefits they offer.

12. In relation to all of the goods applied for the mark appears to provide an indication as to the ease with which tape may be dispensed from this particular dispenser.

13. In his letter dated 21 March 2006 Mr McCall referred to this mark as a “container”. However, I do not accept that this two dimensional device is necessarily a representation of a container as it could equally be perceived as a label affixed to a container. Unfortunately the papers attached at Annex A which demonstrate the mark in use do not clarify this as they contain very poor representations of the mark applied for. In any event, it is the representation of the mark as it appears on the International Register which must be considered. Regardless of whether this mark is a representation of a container or a label it is, essentially, a representation as described by Mr McCall in his letter of 21 March 2006 (see paragraph 7 of this decision). I see nothing distinctive about the outline shape of the device. Neither do I detect any distinctive character in the banding to which Mr McCall refers. I do however, perceive the device of two fingers apparently pulling tape, possibly adhesive tape, from a circular reel to be the dominant feature of the mark as a whole. From my own experience I am aware that regardless of size tape, including adhesive tape, is usually stored and dispensed from circular reels. The message that this part of the mark sends is that this particular tape, is easy to use. I consider this to be the central message of the mark and when the mark is considered as a whole, comprising as it does of the numerous components to which Mr McCall refers, the remaining components do nothing to turn this mark from a device sending a promotional message into a distinctive trade mark.

14. The relevant consumer of the goods would therefore, in my view, perceive this mark as no more than an indication that the goods for which registration are sought are easy and practical to use. The fact that the device has curved edges with bands in both halves of the device is not a significant departure from the customs and norms of the sector and does not persuade me that this by itself bestows distinctive character on the mark to the extent that it becomes capable of performing the function of a trade mark. In order to do that the sign must guarantee that the goods originate from a single undertaking.

15. Assuming that the mark may be regarded as a representation of a container, it would stand to be assessed in the same way as a three dimensional container for the goods. I find nothing particularly unusual or striking about this shape and regard it to be similar to many other shapes used for such goods.

16. In relation to this I refer to a decision by the European Court of Justice in case C-218/01 *Henkel KGaA v. Deutsches Patent-und Markenamt* at paragraph 49 where the court said:

“49. It follows that a simple departure from the norm or customs of the sector is not sufficient to render inapplicable the ground for refusal given in Article 3(1)(b) of the Directive.”

17. Attached to this decision at Annex B are details of two registered trade marks. I note that both of these marks are registered *inter alia* in respect of “adhesives tapes” in Class 16. However, both of these marks appear to be quite different from the mark applied for. In any case, I am not aware of any of the circumstances surrounding either of these acceptances and I do not accept that they are influential in deciding the issues of this application.

18. I am not persuaded that the trade mark applied for is distinctive in that it would serve in trade to distinguish the goods of the applicant from those of other traders. In reaching this conclusion I have considered the mark in its totality placing due weight on all of the components incorporated within the mark as a whole. In my view the mark applied for will not be identified as a trade mark without first educating the public that it is a trade mark. I therefore conclude that the mark applied for is devoid of any distinctive character and is thus excluded from *prima facie* acceptance under Section 3(1)(b) of the Act.

Conclusion

19. In this decision I have considered all the documents filed by the applicants 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 because it fails to qualify under Sections 3(1)(b) of the Act.

Dated this 14th day of July 2006

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

Annexes Not Attached