

TRADE MARKS ACT 1994

AND

**THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996
IN THE MATTER OF INTERNATIONAL REGISTRATION No 854919
AND THE REQUEST BY HENKEL KGaA
TO PROTECT A TRADE MARK IN CLASS 16**

Background

1. On 17 August 2004 Henkel KGaA of Henkelstrasse 67, 40589 Dusseldorf, Germany, on the basis of International Registration 854919, requested protection in the United Kingdom under the provisions of the Madrid Protocol of the following mark:



The following words appear beneath the mark on the application form:

Indication relating to the nature or kind of mark: Three dimensional mark.

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

Stationery, namely Indian ink; correction materials and instruments for writing, drawing, painting, signing and marking; self-stick notes, self-adhesive labels and pads, adhesive corners for photographs, adhesives tapes for stationery or household purposes; adhesives for do-it-yourself and household purposes; instructional and teaching materials (except apparatus) in the form of printed matter and games; preparations and instruments for the deletion of writing made with ink, ball-point pens, pencils and felt pens; rubber erasers; stamps and stamping ink.

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 is devoid of any distinctive character because the shape is not considered to stand out from the usual variety of shapes used for the goods at issue and is therefore not considered to be distinctive and is unlikely to be perceived by the average consumer as a sign which indicates trade origin.

4. Subsequently an objection was raised under Section 3(1)(a) of the Act on the grounds that the mark is not graphically represented but for the purposes of this decision I have accepted that the mark is graphically represented. A further objection was raised under Section 3(2)(b) of the Act but this issue has not yet been determined. Subject to the outcome of this appeal and preliminary ruling of the European Court of Justice in the appeal by Dyson Limited against a decision by the Registrar which was upheld on appeal to the High Court of Justice [2003] EWHC 1062 (Ch) it may be necessary to revisit this objection.

5. 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.

6. 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.

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

The Law

8. 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

9. 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 further representation of the mark which appears to be a print taken from the Patent Office’s web site and a sample of the actual item in question. Unfortunately this sample was damaged in transit but has now been repaired in the office. This sample is now attached at Annex A. Of course, the definitive representation of the mark is that in the International Register.

10. Additionally, Mr McCall provided a certified copy of the mark as applied for with the World Intellectual Property Organization.

11. In further correspondence dated 9 May 2006 Mr McCall argued that the mark is more than a representation of the goods. He states:

“The mark consists of an elongated, rounded, lozenge shaped object, formed from translucent material enabling the inner of the product to be visible to the user. It is submitted that as such the mark is more than merely a representation of the goods, being a somewhat unusually shaped product, with respect to the goods concerned. In light of this it is respectfully submitted that the average consumer would recognise the shape of the goods as a badge of origin of our client.”

Decision

12. 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.

.....

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).

.....

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.”

13. 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.

14. 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.

15. Although barely discernible from the representation of the mark on the International Register, it is clear from the sample provided that this mark consists of a three dimensional representation of a product used for the dispensing of correction tape. However, it is the representation of the mark as it appears on the International Register which must be considered. Turning to the goods in Class 16 for which protection is sought I consider the objection to be relevant only for the following goods:

“correction materials and instruments for writing, drawing, painting, signing and marking; preparations and instruments for the deletion of writing made with ink, ball-point pens, pencils and felt-pens.”

16. In respect of the remaining goods I do not consider the objection under Section 3(1)(b) of the Act to be relevant. However, the very nature of the goods represented by this mark appear to render it unlikely that this mark will be used as a three-dimensional mark in relation to these remaining goods. In these circumstances there does not appear to be a bona fide intention to use the mark on all of the goods applied for. I raise this point as an issue which may need to be considered further in the event of a successful appeal against my decision.

17. Mr McCall has suggested that the mark is an unusually shaped product in respect of the goods applied for. In my view there is nothing distinctive about this shape. In use it appears to settle comfortably into one hand in much the same position as one would hold a writing or marking instrument. The fact that it is translucent merely enables the user to observe the functional mechanism inside it and be aware of how much correcting tape remains available for use. The message that this mark sends is that this particular item is one that dispenses correcting tape, is translucent for ease of use and is of a convenient shape to make it easy and comfortable to use. I consider this to be the only messages 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, these

components do nothing to turn this mark from a representation of the goods into a distinctive trade mark.

18. The relevant consumer of the goods would therefore, in my view, perceive this mark as no more than the goods themselves. The “elongated, rounded, lozenge shaped object”, as Mr McCall describes it, is not a significant departure from the customs and norms of the sector and does not persuade me that this 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.

19. I must say that I find nothing particularly unusual or striking about this shape and regard it to be similar to many other shapes used for such goods.

20. 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.”

21. 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 insofar as these are discernible from the entry in the International Register. 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 in relation to the following goods:

“correction materials and instruments for writing, drawing, painting, signing and marking; preparations and instruments for the deletion of writing made with ink, ball-point pens, pencils and felt pens”

and, in respect of these goods, is thus excluded from prima facie acceptance under Section 3(1)(b) of the Act.

Conclusion

22. 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 partially 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**

ANNEX A

ANNEXE NOT ATTACHED TO THIS COPY