

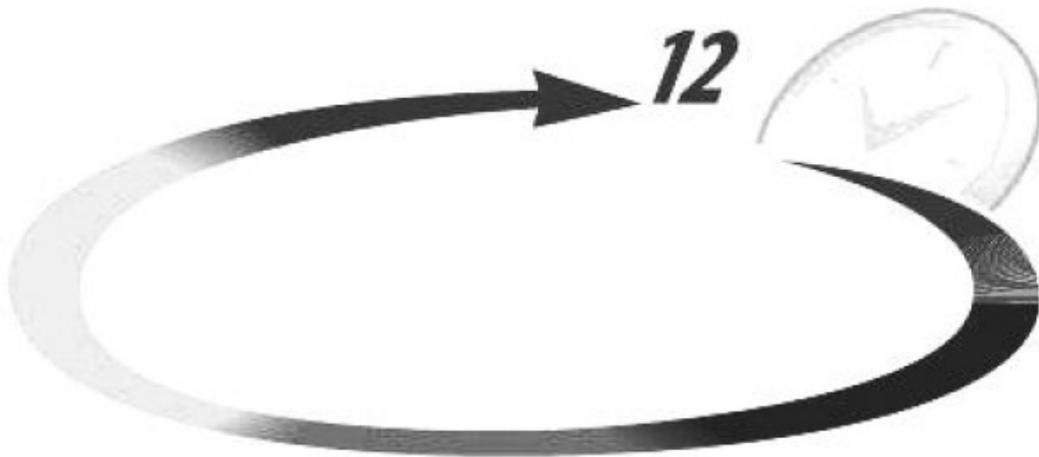
TRADE MARKS ACT 1994

AND

**THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996
IN THE MATTER OF INTERNATIONAL REGISTRATION No 854857
AND THE REQUEST BY COLGATE-PALMOLIVE COMPANY
TO PROTECT A TRADE MARK IN CLASS 3**

Background

1. On 1 February 2005 Colgate-Palmolive Company of 300 Park Avenue, New York NY 10022, United States of America, on the basis of International Registration 854857, requested protection in the United Kingdom under the provisions of the Madrid Protocol of the following mark:



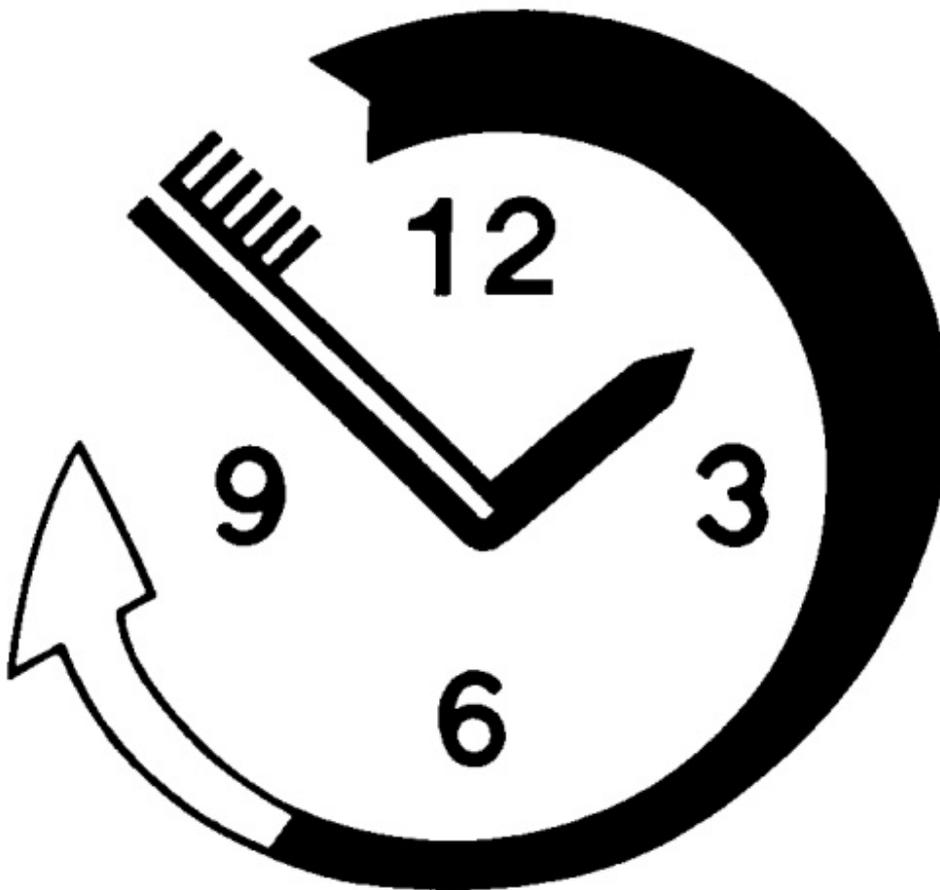
2. Protection is sought in Class 3 in respect of:

Toothpaste and mouthwash.

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 an elliptical arrow, a clock device and the numeral 12; the combination would not be seen as a trade mark as it is devoid of distinctive character because it sends a descriptive message (e.g. of how long the goods are effective). It is considered that the mark would not function as a badge of trade origin in the eyes of the average consumer.

4. Prior to requesting the hearing written submissions were filed which, in summary, suggested that the designation was free from an objection on absolute grounds because the message being sent by the mark is neither overt nor specific. Reference was made to paragraph 8.1 of Chapter 6 of the Trade Marks Work Manual, which indicates that a mark which strongly *alludes* to characteristics of goods/services is not a proper basis for a Section 3(1)(b) objection. The examiner was not persuaded by the submissions to waive the objection.

5. At the hearing the holder's trade mark attorney, Mr Ashmead of Kilburn & Strode, restated the view expressed in written communication which was that the mark was allusive. He informed me that the mark had been accepted for registration in New Zealand and also that the holder has an existing UK registration [2006267] which acts as a precedent. The prior registration is shown below:



6. I was not persuaded by the submissions to waive the objection under Section 3(1)(b) of the Act.

7. 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.

8. No evidence that the mark has acquired a distinctive character through the use made of it has been put before me. My decision is therefore based on the prima facie case for registration.

The Law

9. 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,”

Decision

10. It is appropriate to mention at the outset that in my view it is debatable whether the objection to this mark ought to have been raised under both Section 3(1)(b) and (c) of the Act. I say this because the basis of the objection is that the mark would serve as no more than an indication that the goods provide 12 hour protection. That being the case the grounds of objection extend to Section 3(1)(c) of the Act. However, as it is established that marks which are descriptive of characteristics of goods or services for the purposes of Article 3(1)(c) of the Directive are, on that account, necessarily devoid of any distinctive character with regard to the same goods or services within the meaning of Article 3(1)(b) of the Directive, nothing turns on this point. [see *Koninklijke KPN Nederland NV v Benelux Merkenbureau* Case C-363/99 [2004] ETMR 57 (para 86)].

11. In *Henkel KGaA v Deutsches Patent – und Markenamt* C-218/01 the ECJ identified the essential purpose of a trade mark

“30 As in the case of every other mark, the sign of which registration is applied for must fulfil the mark's essential function, which is to guarantee the identity of the origin of the marked product or service to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin. For a trade mark to be able to fulfil its essential role in the system of undistorted competition which the Treaty seeks to establish, it must offer a guarantee that all the goods or services bearing it have originated under the control of a single undertaking which is responsible for their quality (see, in particular, Case C-349/95 *Loendersloot* [1997] ECR I-6227, paragraphs 22 and 24, Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 28, and *Philips*, cited above, paragraph 30).”

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 caselaw, 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. At the hearing the focus of Mr Ashmead’s submissions was based on the allusive nature of the mark. He contended that marks which are skilful and covert allusions were acceptable under the old law and given that the 1994 Act is a more permissive Act this mark ought to be accepted. He submitted that if a trader wished to inform a consumer that the goods offered 12 hour protection then they would use words such as ‘[gives/offers] 12 hour protection.

14. Mr Ashmead’s submissions at the hearing did nothing to persuade me that the mark has the requisite distinctive character to be prima facie acceptable. I concur with Mr Ashmead that allusive marks are prima facie acceptable, however, I could not agree the

mark in suit is an example of such a mark. The mark consists of a number of constituent parts, each of which are non-distinctive; a clock face, the numeral 12 and an elliptical arrow which emphasises the progression of time over a 12 hour period. I am of course mindful that the mere fact that each of those elements, considered separately, is devoid of distinctive character does not mean that their combination cannot present a distinctive totality. Distinctiveness must depend on the appraisal of the mark as a whole [SAT.1 SatellitenFernsehen GmbH vOffice for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-329/02 P the ECJ].

15. I therefore asked myself the question whether, notwithstanding the fact that individually each of the elements are devoid of distinctive character, there is anything distinctive in the way the individual elements are brought together and arranged. The mark has not been filed in colour, but there is a degree of shading present in the mark which I have also taken into account in reaching my decision. It is my view that there is nothing distinctive in the arrangement of the constituent parts. It seems to me that the mark consists of elements that combine to inform the consumer that the goods offer 12 hour protection. Both word marks and figurative marks can be subject to an objection on absolute grounds and I do not agree with Mr Ashmead's submission that traders would use words rather than figurative arrangements to inform the consumer that the goods offer 12 hour protection.

16. It is established that the assessment 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. I take into account the fact that the goods in question are likely to be bought with a degree of care, but not the highest degree of care.

17. Assessed as a whole and through the eyes of the average consumer I consider that the mark does no more than inform the relevant consumer, by visual means, that the goods offer 12 hour protection. I do not consider that prima facie the sign is capable of guaranteeing the identity of the origin of the product to the consumer.

18. At the hearing I referred Mr Ashmead to a decision of Mr Hobbs Q.C., sitting as the Appointed Person, which concerned the mark shown over the page and was applied for in relation to washing tablets [BL 0-205-04]



19. I observed that in my view this mark has similarities to that mark. Mr Hobbs Q.C. concluded in that case that the mark is a well-executed, artistically pleasing origin neutral device.

20. Although in that case the mark consisted of both words and figurative elements, and in the present case the mark is purely figurative, I consider that the net result is the same; a mark which is a well-executed, artistically pleasing origin neutral device.

The Registration in New Zealand

21. Mr Ashmead informed me that the same mark had been registered in New Zealand and suggested that this should influence my decision to accept the mark in the UK. While decisions from other national tribunals/courts within the EU *may* be of persuasive value [affirmed by the ECJ in *Henkel KGaA v Deutsches Patent Und Markenamt* (C-218/010)] I do not consider that a decision from outside the EU can be determined as anything other than a matter of interest. This is because the factual position surrounding such acceptances is unknown and moreover the law governing acceptance in Countries outside the EU may be materially different.

The prior UK Registration

22. In my view there are considerable and obvious differences between the mark in suit and the prior registration and it is self evident why the earlier mark was not subject to an objection on absolute grounds. In any event it is established that precedents cannot be decisive [see comments made in the *MADAME* case (1966) RPC page 545 which were re-stated by Mr Justice Jacob in the *TREAT* trade mark case (1996) RPC page 25.]

Conclusion

23. I have taken into account all the written and oral submissions which have been made to support the protection of this designation but, for the reasons given, I have not been

persuaded that the mark is prima facie distinctive. The designation is therefore refused protection in the UK under the terms of Section 37(4) of the Act because it fails to qualify for registration under Section 3(1)(b) of the Act.

Dated this 13th day of September 2006

**Lynda Adams
For the Registrar
The Comptroller-General**