

**IN THE MATTER OF TRADE MARK  
APPLICATION No. 2242117 BY  
HENKEL LOCTITE ADHESIVES  
LIMITED**

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**DECISION**

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1. This is an Appeal to the Appointed Person from a Decision of Mr. Ian Peggie, the Officer acting for the Registrar, given on 4<sup>th</sup> April 2003. In that Decision, Mr. Peggie refused to register a series of three marks in respect of a number of goods in classes 1, 16, 17, 19 and 27.

2. The marks each relate to proposed packaging for goods particularly for adhesive tape. The marks are shown in Annex A to Mr. Peggie's Decision. It was common ground on this appeal that the validity of the first and second marks in the series could be determined together. Dr. Brand of W.P. Thompson & Co, the agents for the Applicant, who appeared before me on the appeal, contended however that even if I were to find that the first and second marks were unregistrable, nonetheless the third mark, which consists of packaging of the same shape as is shown in the first and second marks but with contrasting colours of green and grey, was nonetheless registrable because of this added subject matter.

3. Mr. Peggie refused to register the marks on the basis that they were excluded from registration by virtue of the provisions of section 3(1)(b) of the Trade Marks Act 1994. There has been no use of any of the marks and thus Mr. Peggie only had to consider the prima facie case.

4. At the hearing Dr. Brand produced a number of samples of packaging for adhesive tape and contended that the packaging shown in the representation of the trade mark was different from all of those. He drew attention to the trapezoidal shape which he contrasted with the rectangular or circular shapes which were customarily used in the trade. He contended before me, as he had before Mr. Peggie, that the substantially trapezoidal shape of the mark sought to be registered was not only different but was also memorable.

5. The crux of the reasoning behind Mr. Peggie's rejection of the applications can be found in paragraph 13 of his Decision where he stated:

*“Clearly the shape has some differences from the examples of competitor’s products referred to by the agent. However, I have no evidence that any trade mark significance attached to the overall shape of the packaging. To my mind the elements which make up the packaging are not striking or memorable and in my mind it will be seen only as a means of holding a roll of tape”.*

6. In paragraph 15 he concluded that nothing rested on the colour combination of the third mark in the series and that the purchasing public would not consider any of the marks to denote trade origin.

7. It is against this Decision that the Applicant appeals. Dr. Brand accepted that there was no evidence of use nor was there any expert evidence as to how packaging of this sort is regarded in the trade. He invited me to put myself in the position of a notional consumer and drew my attention to what he contended was the noticeably different shape of the marks from other shapes on the market. He contended that not only did the shape of the mark appeal to the eye of the consumer but also that it was a shape which would catch the eye and remain in the mind of the relevant consumer seeking to purchase a further product.

8. He drew my attention to a number of decided cases. I believe it is necessary only to refer to two. First, in *Henkel KGaA v. OHIM* (Case T-30/00), a Judgment of the Court of First Instance of 19<sup>th</sup> September 2001, the court had to consider the question of registrability of a three-dimensional mark, in that case a dishwasher tablet. He drew my attention to paragraph 48 of the Judgment which states

*“Article 7(1)(b) of Regulation No. 40/94 (which equates to section 3(1)(b)) does not distinguish between different categories of trade marks. The criteria for assessing the distinctive character of figurative marks consisting of the representation of the product itself are therefore no different from those applicable to other categories of trade mark”.*

Dr. Brand therefore submitted that the approach to registration in the case of a packaging mark should be no different to the approach to registration of any other trade marks.

9. Mr. Alan James, who appeared on behalf of the Registrar, did not dissent from this but drew my attention to paragraph 49 of the Judgment which states:

*“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 figurative mark consisting of a faithful representation of the product itself as it is in relation to a word mark or a figurative or three-dimensional mark not faithfully representing 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. It follows that an assessment of distinctive character cannot result in different outcomes for a three-dimensional mark consisting of the design of the product itself and for a figurative mark consisting of a faithful representation of the same product”.*

10. Mr. James contended that similar considerations should apply to packaging marks and that it was correct to enquire whether the relevant purchasing public was used to recognising the shape of packaging as indicating origin, absent from the usual word or device trade marks.

11. In this respect Mr. James also drew my attention to a recent Judgment of the full court of the ECJ in *Libertel Groep BV v. Benelux-Merkenbureau* (C-104/01, 6<sup>th</sup> May 2003). In this case the trade mark consisted of an orange rectangle and the debate was over registration of the colour orange. In paragraphs 64 and 65 of its Judgment, the ECJ stated as follows:

*“64. Account should be taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect picture of them that he has kept in his mind....*

*65. The perception of the relevant public is not necessarily the same in the case of a sign consisting of a colour per se as it is in the case of a word or figurative mark consisting of a sign that bears no relation to the appearance of the goods it denotes. While the public is accustomed to perceiving word or figurative marks instantly as signs identifying the commercial origin of the goods, the same is not necessarily true where the sign forms part of the look of the goods in respect of which registration of the sign as a trade mark is sought. Customers are not in the habit of making assumptions about the origin of goods based on their colour or the colour of their packaging, in the absence of any graphic or word element, because as a rule a colour per se is not, in current commercial practice, used as a means of identification. A colour per se*

*is not normally inherently capable of distinguishing the words of a particular undertaking”.*

12. Mr. James submitted that it was implicit from that reasoning that the same should apply to the shape of packaging and that it would therefore be right to have regard to current commercial practice in relation to packaging in the relevant fields in order to determine whether the purchasing public had come to make assumptions about the origin of goods based upon the shape of packaging.

13. I accept the force of this argument and did not understand Dr. Brand to disagree.

14. The second case that Dr. Brand referred to me to was *Daimler-Chrysler Corporation v. OHIM*, another Judgment of the Court of First Instance in case T-128/01 of 6<sup>th</sup> March 2003. This was an appeal concerned with a figurative mark being the representation of a vehicle grille. In this case there was expert evidence from a Mr. Hoadley which made clear that grilles no longer had a purely technical function and that this had been the case for some considerable time before the mark was applied for. The evidence was that, unlike other parts of motor cars, grille shapes tend to be retained and were used in other models made by the same manufacturer. As a result the CFI held in paragraph 42

*“Grilles have become an essential part of the look of vehicles and a means of differentiating between existing models on the market made by the various manufacturers. They are therefore one of the features that are inherently helpful in visually identifying a model or range, or even all vehicles made by the same vehicle manufacturer, as compared to other models”.*

15. In the light of this finding, the CFI concluded in paragraph 48

*“In those circumstances the sign in question must be considered to be capable of leaving an impression on the memory of the target public as an indication of commercial origin and thus of distinguishing and setting apart motor vehicles bearing that grille from those of other undertakings”.*

16. Both Dr. Brand and Mr. James relied on this judgment, claiming, by analogy, that the facts in this case either were the same or different to the facts in that case.

17. The above analysis of the law satisfies me that although packaging marks are to be considered no differently to other types of mark, nonetheless one must be satisfied, when dealing with a proposed packaging mark which is different to other packaging used in that trade, that it is not only different but also that it is sufficiently distinctive to be capable of performing the function of a trade mark. It must be such as to be taken by the public as an indication of origin (see e.g. Laddie J. in Yakult Honsha KK's Trade Mark Application (2001) RPC 39 (page 576) at paragraph 10).

18. In reaching a conclusion as to whether or not the packaging mark might have trade marks significance, it is necessary to have regard to the nature of the trade in question and to enquire whether or not the public have been educated into considering packaging marks of this sort to indicate origin. In the Libertel case, the perception of the relevant public was not to perceive colours as a means of identification of origin in the then current commercial practice in the relevant industry. In the Daimler Chrysler case the evidence in relation to radiator grilles in motor cases was different.

19. With that analysis of the law, I turn to the facts of the present case. There is no expert evidence and there has been no use. I am therefore left to place myself, as best I can, in the shoes of the relevant consumer. I am helped in doing this by the samples which were produced by Dr. Brand. These all show adhesive tape packaged in a variety of packages, some simple, some more complex. Many are packaged in cardboard outers which are rectangular in shape or circular with some form of flat portion on which to rest the package on the shelf. All have word trade marks or device trade marks in addition to the packaging. The packaging does not speak for itself as to the origin of the product.

20. There is no material before me which suggests that the purchasing public for adhesive tape have in any way been educated to regard the packaging as anything other than packaging. Use of word trade marks runs counter to a suggestion that the packaging itself has come to indicate origin.

21. I am therefore satisfied that, without use, the packaging the subject of the first and second marks so far as they relate to adhesive tape does not possess any capacity inherently to distinguish goods in that packaging from the goods of other traders and thus cannot function in a trade mark sense. It was not suggested that the position was any different in relation to any of the other goods in respect of which registration was sought.

22. In my judgment therefore the reasoning of the hearing officer was wholly correct and the appeal against his Decision in respect of the first two marks must be dismissed.

23. I turn then to consider the third mark, the colour mark. The colours are green and grey. There is no evidence before me that these colours have come to be recognised in this field as being indicative of the products of any particular trader. There is no evidence that the precise positioning of the grey trapezium on the green background has come to be recognised as indicating origin.

24. In these circumstances the colour configuration adds nothing by way of relevant distinctiveness to the basic mark. Accordingly the appeal in relation to the third mark of the series must also be dismissed.

25. In accordance with the usual practice there will be no order as to costs.

Simon Thorley Q.C.  
1<sup>st</sup> October 2003