

**TRADE MARKS ACT 1994**

**AND**

**THE TRADEMARKS (INTERNATIONAL REGISTRATION) ORDER 1996**

**IN THE MATTER OF  
INTERNATIONAL REGISTRATION NO. 708442  
AND THE REQUEST BY HENKEL KGaA  
TO PROTECT A TRADE MARK IN CLASSES 1 AND 3**

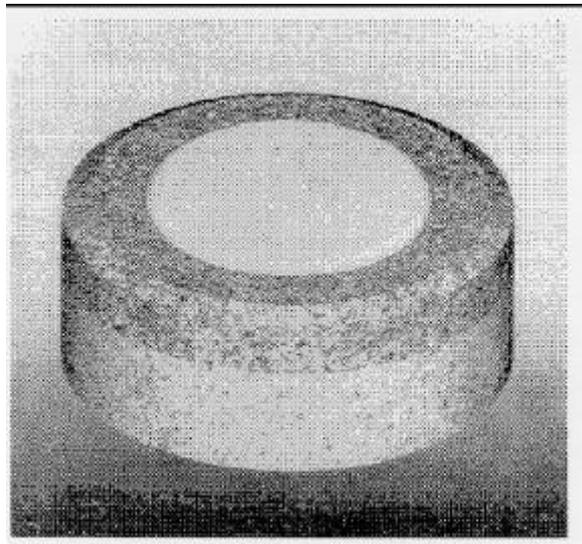
**TRADE MARKS ACT 1994**

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AND THE REQUEST BY HENKEL KGaA  
TO PROTECT A TRADE MARK IN CLASSES 1 AND 3**

15 On 15 January 1999, HENKEL KGaA of 67 Henkelstrasse, D-40191 Düsseldorf, Germany,  
on the basis of international registration no. 708442, requested protection in the United  
Kingdom, under the provisions of the Madrid Protocol, of the mark:



The following words appear beneath the mark on the form of notification:

35 *Colors claimed:* Black, white.

By a notification dated 07.10.1999 the colour claim was corrected to read:

40 *Colors claimed are as follows:* Blue, white.

45 The International Registration is numbered 708442 and protection is sought in Class 1 in respect  
of

Chemical products for industrial purposes; softening agents for water; crust preventing  
and crust solving agents for use in tubes and apparatuses; scale removing preparations.

and in Class 3 in respect of

5 Soaps; washing and bleaching agents; rinsing agents for dishwashing and laundry; cleaning and polishing agents; chemical preparations for cleaning wood, metal, glass, synthetics, stone, porcelain and textiles.

10 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(5) 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 picture of the goods in tablet form, being devoid of any distinctive character, the blue element also lacking in distinctive character for laundry whiteners. The designation was also refused under Section 5(2) of the Act because there was considered to be a likelihood of confusion with Community Trade Mark no 949651, but this ground of refusal was subsequently waived and I need say no more about it.

15 Through Mr J D McCall of W P Thompson & Co, their representatives, the holder requested a hearing. A hearing was appointed for 24 September 1999 but no substantive hearing took place. Further correspondence ensued between the holder's representative and the registry, in which the holder's representative submitted (in summary) that although only two colours are claimed, the net effect is that of a three coloured tablet. He also noted that the central core has a smooth surface whereas the upper and lower layers have a coarse grained appearance.

20 After consideration of these submissions the objection under Section 3(1)(b) was maintained and notice of final refusal under Article 9(6) was issued on 20 June 2000. I am now asked by the holders representatives W P Thompson & Co under Section 76 of the Act and Rule 62(2) of the Trade Marks Rules 2000 to state in writing the grounds of decision and the materials used in arriving at it.

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

30 Section 3(1)(b) of the Act reads as follows:-

35 3(1) The following shall not be registered -  
(b) trade marks which are devoid of any distinctive character.

The test of distinctiveness was laid down by Mr Justice Jacob in the TREAT case [1996] RPC 281 page 306 lines 2-5 when he said:

40 "What does *devoid of distinctive character* mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark?"

45 The mark consists entirely of a picture of a round tablet with a bevelled edge consisting of the combination of two layers in the colours blue and white, with a circle of plain white on the top of the blue layer. From my own knowledge and experience of such everyday products I do not

see anything novel in these elements of the mark.

5 The tablet is of a basic geometrical shape and there is nothing fanciful about selecting a round tablet shape for the manufacture of solid detergents. White is a natural colour for cleaning agents and I see nothing unusual in the presence of a single contrasting colour which may, in addition to being decorative, indicate the presence of different ingredients such as laundry whiteners or scents. These features do not make the shape of the tablet recognisable as a trade mark in the sense that a typical consumer of the product would deduce that the tablets emanate from a particular source.

10 In his submissions in correspondence Mr McCall referred to a "central core" which I take to be indicated by the circle of plain white on the top of the tablet. I do not see anything in this additional feature which would make the shape of the tablet recognisable as a trade mark. In my view the typical customer is likely to see it as an indication of an additional ingredient or feature of these tablets which is not present in tablets consisting only of two colours.

15 Whilst it is clear that a combination of non-distinctive elements can create a distinctive whole I do not accept that this is the position with this mark. I do not see that there is anything in the shape of this tablet in the colours blue and white that would serve to distinguish the goods of the applicant from those of other traders.

20 In the Proctor & Gamble Limited's [1996] RPC 281, Walker L J said:

25 "Despite the fairly strong language of s. 3(1)(b), "devoid of any distinctive character" - and Mr Morcom emphasised the word "any" - that provision must in my judgment be directed to a visible sign or combination of signs which can by itself readily distinguish one trader's product - in this case an ordinary, inexpensive household product - from that of another competing trader. Product A and Product B may be different in their outward appearance and packaging, but if the differences become apparent only on close examination and comparison, neither can be said to be distinctive"

30 I have also borne in mind the comments made by Aldous L J in the case of Phillips Electronics N.V. v. Remington Consumer Products before the Court of Appeal when he said:

35 "In fact I am unable to point to any feature or features of the trade mark which could be other than descriptive of a particular design of head for an electric shaver and which would enable the trade mark to acquire a distinctive character. The trade mark contains no feature which has trade mark significance which could become a distinctive character. In my view the judge was right to conclude that the trade mark was not registrable because of section (Article) 3(1)(b) in that it was devoid of distinctive character."

40 The public are well used to seeing coloured tablets of this sort of shape. At best it may be a slight variant on other such tablets but to my mind there is nothing memorable or distinctive about it. I do not see that there is anything in the shape and colour combination of this tablet that would serve to distinguish the goods of the holder from those of other traders.

45 It is my view that the sign applied for will not be taken as a trade mark without first educating the public that it is a trade mark. It follows that this application is debarred from prima facie acceptance by Section 3(1)(b) of the Act.

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

Dated this 29 day of August 2000.

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Anne Pritchard  
For the Registrar  
The Comptroller General

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