

TRADE MARKS ACT

IN THE MATTER OF APPLICATION 2185286H BY COLGATE-PALMOLIVE COMPANY TO REGISTER A TRADE MARK IN CLASS 3

DECISION AND GROUNDS OF DECISION

On 24th of December 1998 Colgate -Palmolive Company of 300 Park Avenue, New York, N.Y.10022-7499, USA, applied to register a series of 22 marks, then as application number 2185286.

The application was made in respect of the following goods:

Class 03 Toothpaste.

Objections were taken to the marks under Section 41(2) of the Act in that the marks differ in their material particulars, substantially affecting the identity of the marks. During correspondence this objection was waived as the application was divided with the 20th mark forming Part H. Details of this mark is set out at Annex A. I need therefore make no further reference to this objection.

The following colour claim was entered on the original form of application:

“The applicant claims the colours red and pink as an element of the mark.”

On 17 November 1999 objections were also taken under Sections 3(1)(b) and (c) of the Act because the mark consists exclusively of the device of a portion of toothpaste being a sign which may serve in trade to designate the kind and intended purpose of the goods.

Following refusal of the revised application bearing the suffix “H”, I am now asked under Section 76 of the Act and Rule 56(2) of the Trade Mark Rules 1994 to state in writing the grounds of my decision and the materials used in arriving at it.

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

Sections 3(1)(b) and (c) of the Act reads as follows:

3.-(1) The following shall not be registered.

(b) trade marks which are devoid of distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographic origin, the time of production of goods or rendering of services, or other characteristics of the goods or services,

On reflection I do not consider that the objection under Section 3(1)(c) of the Act can be

sustained. I therefore waive that objection. This leaves the objection under Section 3(1)(b) of the Act.

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

“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?”

This application is for a mark which is a device of what has been described as a “slug of toothpaste.” The device in question is, in my view, nothing more than a reasonably accurate representation of a slug of toothpaste that one encounters on squeezing an ordinary tube of toothpaste. It is a simple representation of the toothpaste which is squeezed from the toothpaste tube and deposited onto a toothbrush. In my view members of the purchasing public encountering such a mark would see it as being the goods in use.

However, the mark is more than a simple device as it is represented by spherical red/pink bubbles dispersed on a red/pink background. Clearly these spherical bubbles bring an additional feature to the mark but I do not regard this additional feature as being particularly memorable or distinctive. When they appear dispersed on a red/pink background the impact is likely to be de minimis.

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 mark which would serve to distinguish the goods of the applicant from those of other traders.

In the Proctor & Gamble Limited’s application (1996 RPC 281), Walker L J said:

“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”

In the unreported decision on the applications by Reemtsma Cigarettenfabriken GmbH to register a 3-Dimensional shape of a cigarette packet (Applications Nos 2031898 and 2031899 dated 25 August 1995) Geoffrey Hobbs QC, in his role as the appointed person, said:

“On the basis of my general awareness of cigarette packaging acquired through exposure to it as a (non-smoking) member of the public, I think that the features I have mentioned render the Applicant’s packaging distinguishable from the general run of cigarette packaging in relatively small details which provide it with a low, but not negligible, degree of individuality. The question is whether the degree of individuality

imparted by those features is sufficient to render the packaging not merely distinguishable, but distinctive of the trade origin of the goods it contains. I have not found it easy to answer that question on the basis of the materials before me. Giving the matter the best consideration I can, I think that the get-up (in terms of the shape and colour) of the packaging put forward for registration is aesthetically pleasing without also being sufficiently arresting per se to perform the “essential function” of a trade mark (as identified in Canon paragraph 28. In the absence of distinctiveness acquired through use it was, in my view, devoid (by which I mean unpossessed) of “*a distinctive character*” and therefore excluded from registration by Section 3(1)(b) of the Act (Article 3(1)(b) of the Directive) at the relevant date.”

I am also guided by the unreported decision on an application by the Colgate-Palmolive Company to register a series of three and two dimensional toothpaste slugs. Professor Ruth Annand in her role as the Appointed Person said:

“I am prepared to accept for the purposes of this appeal that the individual colours used by the applicant form part of each of the overall get-ups that the applicant is seeking to register. However, Mr James made the point (not, as I understand it, rebutted by Mr Silverleaf) that pink, green, blue and red are amongst the usual range of colours used by toothpaste manufactures in connection with their products.”

Going on to say:

After lengthy consideration, I have arrived at the view that none of the combinations of stripes, speckles and colours in the applicant’s get-ups is *in itself* “sufficiently arresting” (to borrow that phrase from Mr Hobbs) to be likely to be taken as having trade mark significance by the relevant consumer. Instead, I believe that those features are likely to be seen as the arrangement of the product itself, mere decoration or perhaps even as indicating the active ingredients in the toothpaste.”

The colours pink and red are claimed as an element of the mark. However, these colours are I believe amongst those considered usual in toothpaste manufacture. The straightforward representation of a toothpaste slug containing spherical bubbles common in toothpaste manufacture will not in my view be taken as having a trade mark significance by the relevant consumer.

In my view 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 applicant 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 in that it fails to qualify under Section 3(1)(b) of the Act.

Dated this 18th day of December 2001

CRAIG REDMORE

For the Registrar

The Comptroller General

ANNEXE ONLY AVAILABLE AS A PAPER COPY