

1 MR. HOBBS: I have before me three applications for the
2 protection of international registrations in the United
3 Kingdom under section 54 of the Trade Marks Act 1994 and the
4 provisions of the Trade Marks (International Registration)
5 Order 1996. Each of the applications calls for consideration
6 of the question whether the trade origin of the goods of
7 interest to the applicant is liable to be distinguished from
8 that of other such goods on the strength of the features of
9 appearance and presentation graphically represented in the
10 application for protection. No claims to distinctiveness
11 acquired through use are made in relation to any of the marks
12 put forward for protection.

13 In each case, the applicant has sought to rely on
14 submissions without evidence in support of its claim that the
15 mark it wishes to register is intrinsically distinctive. I am
16 thus left to draw upon my own general knowledge and experience
17 of the manner and circumstances in which goods of the kind
18 specified in the applications for registration are normally
19 bought and sold in order to determine whether the application
20 should be accepted.

21 It is common ground that registrability falls to be
22 determined in accordance with the approach indicated in
23 paragraphs 7 to 9 of the decision of Mr. Simon Thorley, Q.C.,
24 sitting as the Appointed Person, in the matter of
25 International Registration No. 708442, 15th March 2001.

26 The first of the applications before me was filed on

1 22nd July 1999 by Henkel France in respect of International
2 Registration No. 715087. In the request for protection, the
3 relevant mark was described as "a bottle with a dark blue cap,
4 the upper part of the bottle being fluorescent green and the
5 lower part yellow." The colours dark blue, fluorescent green
6 and yellow were claimed as elements of the mark. The mark was
7 graphically represented in the form shown in Annex 1 to this
8 decision. The representation in the form of the application
9 does not quite agree with the verbal description of the mark.
10 The representation appears to show a clear bottle with two
11 colours applied to immiscible liquids visible through the
12 bottle. The right course would nevertheless seem to be to
13 impose the wording of the application on the image of the
14 application and treat it as a claim for a bottle coloured as
15 specified.

16 Protection was requested in respect of, "laundrying,
17 cleaning and rinsing products in liquid, gel or paste form" in
18 Class 3. The Registrar gave notice of refusal of protection
19 under Articles 3 and 9 of the 1996 Order on the basis that the
20 mark was excluded from registration by section 3(1)(b) of the
21 Trade Marks Act 1994. Notice of final refusal was issued on
22 14th August 2000.

23 Written reasons for the refusal of protection were
24 issued by Ms. Janet Folwell on behalf of the Registrar of
25 Trade Marks on 24th November 2000. Her assessment of the
26 relevant mark, which was not said to possess a distinctive

1 shape, was as follows: "From my own knowledge and experience
2 of household cleaning products such as these, I do not see
3 anything novel in the combination of the colours. The dark
4 blue cap in my view is typical and offers very little, if
5 anything, in the way of a distinctive character either on its
6 own or in combination with the claim as a whole, and therefore
7 my view is that this is essentially a claim of two colours
8 applied to immiscible liquids which are visible through a
9 clear bottle with a dark blue cap (or the appearance thereof).
10 I know from my own experience that such products appear in
11 this way at the point of sale, either by the liquid itself
12 consisting of two colours, or by the container being filled
13 only in part so that the clear section at the top of the
14 container appears to be a contrasting colour.

15 "I also know from my own experience that green and
16 yellow are colours that are traditionally associated with
17 cleaning preparations such as these. For example, green often
18 represents the essence of pine, and yellow the essence of
19 lemon. The mark applied for appears, to me, to depict two
20 separate substances in a bottle which are not meant to mix
21 together. Consequently the two colours are the natural
22 colours of the product, and presenting the two constituent
23 substances in contrasting colours is an effective way, in my
24 view, of informing the consumer that the product has two
25 ingredients.

26 Whilst I accept that a combination of non-distinctive

1 elements can create a distinctive whole I do not accept that
2 this is the case in this application. The shape of the bottle
3 is typical with a narrower middle section to enable an easy
4 grip. Whether it is evident from the colours of the liquids
5 within or as applied to the bottle itself so as to give the
6 same effect, the two colours of the bottle are insufficient to
7 imbue the mark with a distinctive character in the prima facie
8 case. The dark blue cap, even when considered as part of the
9 whole mark, offers very little, if anything, in the way of
10 distinctiveness."

11 Her conclusion was as follows: "I do not believe that
12 the purchasing public, bearing in mind that these are ordinary
13 consumer items which are offered for sale in all supermarkets
14 and household stores nationwide, would consider the mark the
15 subject of this application to denote trade origin. The
16 public are well used to seeing bottles of this shape depicting
17 two or three colours whether the colours are applied to the
18 bottle itself or to the liquid within which is visible through
19 the clear container. I do not see anything in the shape or
20 colour combination as a whole to persuade me that this would
21 serve to distinguish the goods of this applicant from those of
22 other traders."

23 On 20th December 2000, the applicant gave notice of
24 appeal to an Appointed Person under section 76 of the 1994
25 Act. In the statement of case in support of the appeal and
26 orally in argument at the hearing before me, it was contended

1 that the hearing officer had fallen into error by dismembering
2 the mark into its constituent elements and imbuing the mark as
3 a whole with the non-distinctive significance she had
4 separately attributed to each of the dismembered elements. It
5 was submitted that the mark as a whole possessed enough of a
6 distinctive character to stand alone as an indication of trade
7 origin. The overall get-up in terms of the shape and colours
8 of the bottle put forward for registration was said to be so
9 striking as to set it apart from other containers in a way
10 that was both memorable and distinctive in a trade mark sense.

11 I have asked myself whether the get-up put forward for
12 registration could be regarded as aberrational or arresting.
13 I have asked myself whether it possesses a specific
14 individuality which could be said to render it not merely
15 distinguishable from other such bottles, but also distinctive
16 of the trade origin of the goods it contains. In doing so I
17 have paid attention to the presence of the three different
18 colours in the get-up in question. However, bearing in mind
19 that colourful packaging is very much the norm nowadays, I
20 find that I cannot treat the fact that the get-up put forward
21 by the applicant has three different colours as conclusive of
22 the question whether it is distinctive or not.

23 In my view, the presentation of the bottle put forward
24 for registration is really rather ordinary in modern day
25 terms. I find myself in agreement with the hearing officer in
26 thinking that the mark is, for the reasons she gave, excluded

1 from registration by section 3(1)(b) of the Act. I agree with
2 the submission made on behalf of the applicant that it is
3 necessary to consider the impact of the mark as a whole.
4 However, I do not think that the hearing officer actually fell
5 into the error of doing otherwise in her decision in the
6 present case.

7 The second of the applications before me is an
8 application filed on 18th November 1999, again by Henkel
9 France, this time in respect of International Registration No.
10 721512. In the request for protection, the relevant mark was
11 described as a three-dimensional mark. It was graphically
12 represented in the form shown in Annex 2 to this decision.
13 The graphic representation showed loose particles arranged in
14 a circle on a flat surface. They had been poured from a
15 container and arranged in a circle for the purpose of the
16 photograph in the application for protection. The majority of
17 the particles are white; the remainder are coloured red.
18 There is, however, no claim to colour as an element of the
19 so-called three-dimensional mark put forward for protection.
20 Nevertheless, on the basis that it may be possible for the
21 applicant to introduce a colour claim even at this stage, I
22 think it is expedient to treat the mark for which protection
23 is claimed as an accumulation of particles, relatively few of
24 which are red and the bulk of which are white.

25 Protection was requested in respect of, "Chemical
26 products for industrial use; water softening agents; chemicals

1 to prevent or dissolve deposits in pipes and appliances;
2 antiliming agents" in Class 1 and, "Soaps, laundry bleaching
3 and washing agents; rinsing agents for dish washing and
4 laundry washing machines; cleaning and polishing agents;
5 chemical preparations for cleaning wood, metal, glass,
6 synthetic materials, stone, porcelain and textiles" in
7 Class 3. Notice of refusal of protection was given on the
8 basis that the mark was excluded from registration by section
9 3(1)(b). The notice of final refusal was issued on 3rd
10 November 2000.

11 Written reasons for refusal were, as in the previous
12 case, issued by Ms. Janet Folwell on behalf of the Registrar.
13 Her decision was issued on 31st January 2001. She approached
14 the question of registrability on the basis that the mark in
15 question consisted of a mixture of red particles within white
16 particles regardless of the shape or colour of the packaging
17 in which they were presented for sale. She considered the
18 mark to be excluded from registration by section 3(1)(b) on
19 the following basis: "From my own knowledge and experience of
20 household products which form the majority of the claim in
21 this application, I know that these goods often come in
22 particle form. I do not see anything novel in the combination
23 of these two colours. I also know from my own experience that
24 the colour white often forms a base colour for cleaning
25 tablets and powders and the introduction of another colour
26 usually means that the cleaning process has a dual purpose,

1 firstly basically cleaning and secondly, for example, stain
2 removal or to produce a particular fresh smell.

3 "Whilst I accept that a combination of non-distinctive
4 elements can create a distinctive whole, I do not accept that
5 this is the case in this application. We have a three
6 dimensional sign comprising numerous white particles with a
7 fewer number of red particles mixed in. But as these
8 particles are not either bound together or housed within a
9 transparent container, the rights claimed extend to any
10 presentation. And I do not believe that the combination of
11 red particles mixed with white particles is sufficient to
12 imbue the mark with a distinctive character without first
13 educating the public that it is a trade mark."

14 I should mention that although she had previously
15 indicated at a hearing which had taken place on 19th April
16 2000 that she was minded to raise an objection to registration
17 under section 3(1)(a) of the Act on the basis that the
18 application failed to define a sign susceptible of
19 identification as a sign capable of distinguishing, she did
20 not finally reject the application on that ground.

21 The applicant gave notice of appeal to an Appointed
22 Person on 26th February 2001. In essence, it was contended
23 that although the sign consisted of an amorphous mixture of
24 loose particles, the choice and proportions of colour, the
25 size of the particles and their distribution through the
26 mixture rendered the mark as a whole distinctive.

1 On any view of the matter, this is an ambitious claim
2 for protection. The distinctiveness or otherwise of the mark
3 is a matter of impression. The point is not really
4 susceptible of any great elaboration. I can only say that
5 having considered the matter and having considered the
6 submissions addressed to me on behalf of the applicant, I find
7 myself once again in agreement with the hearing officer in
8 thinking that the mark lacks distinctiveness for the reasons
9 that she gave. On that basis, the mark is ineligible for
10 registration having regard to the provisions of section
11 3(1)(b) of the Act.

12 The third of the applications before me is an
13 application for protection filed on 20th January 2000 by S.A.
14 Henkel Belgium N.V. in respect of International Registration
15 No. 728481. In the request for protection, the relevant mark
16 was graphically represented in the form shown in Annex 3. The
17 representation shows a rectangular sealed packet. There is an
18 area of the packet which is in the shape of a trapezium, the
19 contents of which appear to be predominantly white with red
20 speckles. In a separate corner of the packet, there is an
21 oval or circular article which is blue in colour. The colours
22 red, white and blue were claimed as elements of the mark.
23 Protection was requested in respect of, "Chemical products for
24 industrial purposes; descaling preparations, other than for
25 household purposes" in Class 1 and, "Soaps, washing and
26 bleaching preparations for washing-up and laundry use; stain

1 removers; cleaning preparations and polishing preparations;
2 chemical preparations for cleaning wood, metal, glass,
3 plastic, stone, ceramics, china and textiles" in Class 3.
4 Notice of final refusal was issued on 18th October 2000 on the
5 basis that the mark was excluded from registration by section
6 3(1)(b) and section 3(1)(c) of the 1994 Act.

7 Written reasons for refusal of protection were issued by
8 Mr. R.A. Jones on behalf of the Registrar of Trade Marks on
9 7th February 2001. His assessment of the relevant mark was as
10 follows: "The mark consisted of a two-dimensional
11 representation of the goods, which appear to be contained in a
12 transparent sachet or pack divided into two segments. The
13 first segment appears to contain a white powder with pale red
14 specks, the second contains a round, or possibly oval, blue
15 tablet. As such I consider it conveys to the purchasing
16 public a representation of a ready-portioned sachet or pack
17 containing two separate active ingredients for use in e.g. a
18 dishwasher or washing machine. From my own knowledge of such
19 everyday household products the packaging does not appear to
20 be unusual and merely serves as an alternative to the large
21 containers or packs of compressed powder tablets which are
22 also available. Indeed 'sachet' is described in the Concise
23 Oxford Dictionary, 10th Edition as 'a small sealed bag or
24 packet containing a small quantity of something', and in
25 Collins English Dictionary, 2nd Edition as '1. A small sealed
26 envelope, usually made of plastic or waxed paper, for

1 containing cream, shampoo etc.' I consider this demonstrates
2 the packaging concept shown has been around for some time and
3 do not see anything novel or original in the way the sachet
4 is presented or that the goods can be seen through it."

5 He went on to say: "I believe the purchasing public are
6 used to seeing such packaging for household goods or for goods
7 used in industrial cleaning and are unlikely to consider the
8 mark, the subject of this application, as denoting trade
9 origin. The powder shown is, predominantly, white which is a
10 very common base colour for the goods. Indeed, from my own
11 experience of such everyday products I believe it could be
12 said that white powder, with or without specks of another
13 colour, is common to the trade. Furthermore, the specks of
14 red are almost de minimis in the mark and would create little
15 impact on the consumer in its overall impression of the
16 mark. The blue tablet simply indicates another element of
17 the pack which contains an item with a complementary purpose.
18 Therefore, the representation of the pack, taken as a whole,
19 will simply indicate to the prospective customer that it
20 contains goods with different functions to achieve an overall
21 purpose e.g. cleaning clothes or dishes."

22 These considerations led him to conclude that the mark
23 was objectionable under sections 3(1)(b) and 3(1)(c). The
24 applicant gave notice of appeal to an Appointed Person on 8th
25 March 2001. It was contended that the shape and transparent
26 nature of the packet, the shape of the compartments, the

1 positions, proportions and colours of the elements all
2 combined to render the overall appearance of the packaged
3 product distinctive of trade origin.

4 I do not find it necessary to consider whether the mark
5 in question could be said to have consisted exclusively of
6 signs or indications which may serve in trade to designate any
7 of the attributes specified in section 3(1)(c) of the Trade
8 Marks Act 1994. In my view, the mark defined in the
9 application for protection projects the kind of appearance to
10 the eye of the observer which in and of itself is unlikely to
11 be perceived as an indication of trade origin in the absence
12 of use sufficient to impress upon people the fact that that is
13 what it can rightly be taken to be. Again, I find myself in
14 agreement with the hearing officer in thinking that the mark
15 put forward for protection is excluded from registration by
16 the provisions of section 3(1)(b) of the Trade Marks Act 1994.

17 For these reasons shortly stated, I consider that the
18 appeals in all three of the cases before me should be
19 dismissed.

20 We do not normally make an order for costs in a
21 proceeding of this kind at this stage and I do not suppose
22 that anyone wants to deviate from that.

23 MR. McCALL: No.

24 MR. MORGAN: No.

25 MR. HOBBS: Thank you very much indeed.

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PATENT OFFICE

Harmsworth House,
Bouverie Street,
London, EC4

Wednesday, 6th June, 2001

Before:

THE APPOINTED PERSON
MR. G. HOBBS Q.C.

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In the Matter of the
TRADE MARKS ACT 1994

and

THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996

and

In the Matter of International Registration Nos. 715087,
751512 and 728481 in the name of
HENKEL FRANCE and SA HENKEL
BELGIUM NV to protect Trade

Marks

in Classes 1 and 3.

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Appeals to the Appointed Person from the
Decisions of Ms. J. Folwell on 24th November 2000 and
31st January 2001 and the Decision of
Mr. R.A. Jones on 7th February 2001

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(Transcript of the Shorthand Notes of Marten Walsh Cherer
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MR. J. McCALL, of Messrs. W.P. Thompson & Co., appeared for
the Appellant.

MR. D. MORGAN appeared as the Registrar's Representative.

D E C I S I O N
(As approved)