

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2235217E
BY HENKEL KOMMANDITGESELLSCHAFT AUG AKTIEN
TO REGISTER A TRADE MARK IN CLASS 3**

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On 6 June 2000 Henkel Kommanditgesellschaft Aut Aktien of Henkelstrasse 67, D-40191 Dusseldorf, Germany applied to register a series of ten marks in respect of the following goods:

Class 3 Soaps; washing and bleaching preparations for laundry; rinsing agents for laundry and tableware; chemical products for the cleaning of textiles; cleaning preparations for sanitary, laundry and dry cleaning use.

Class 18 Bags for clothing made from synthetic/materials.

Class 21 Bags for use in automatic dryers, bags for use in dry cleaning, protective bags for holding laundry.

The mark for which registration is sought is as follows:

1. FRESH & GENTLE DRY CLEANING
2. Fresh & Gentle Dry Cleaning
3. SVIT FRESH & GENTLE DRY CLEANING
4. Svit Fresh & Gentle Dry Cleaning
5. FRESH AND GENTLE DRY CLEANING
6. Fresh and Gentle Dry Cleaning
7. SVIT FRESH AND GENTLE DRY CLEANING
8. Svit Fresh and Gentle Dry Cleaning



Objection was taken under Section 3(1)(b) and (c) of the Act to the first, second, fifth and sixth mark of the application in classes 3 and 18 because the mark consists of the term Fresh and Gentle Dry Cleaning, the whole being a sign which may serve in trade to designate the type of the goods claimed (e.g.) goods for use in dry cleaning.

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Objection was also taken under Section 41(2) of the Act in that the marks differ in their material particulars, substantially affecting the identity of the marks. The first, second, fifth and sixth marks were considered acceptable as a series and the third, fourth, seventh, eighth and tenth marks considered acceptable as a series.

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The objection under Section 41(2) of the Act was overcome on 13 September 2000 by the filing of two divisional applications and the application divided into three parts. Details of these marks are set out below:

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2235217A FRESH & GENTLE DRY CLEANING
Fresh & Gentle Dry Cleaning
FRESH AND GENTLE DRY CLEANING
Fresh and Gentle Dry Cleaning

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2235217B SVIT FRESH & GENTLE DRY CLEANING
Svit Fresh & Gentle Dry Cleaning
SVIT FRESH AND GENTLE DRY CLEANING
Svit Fresh and Gentle Dry Cleaning

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2235217C



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Applications 2235217B and 2235217C have both proceeded to registration and I will make no further mention of them.

5 At a hearing, at which the applicants were represented by Mr J D McCall of W P Thompson & Co the objection under Section 3(1)(b)(c) of the Act against classes 3 and 18 of application 2235217A was maintained against class 3 and waived against class 18.

10 Following the hearing the application was further divided as follows:

2235217D classes 18 and 21
2235217E class 3

15 Following the refusal of application 2235217E under Section 37(4) of the Act 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.

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

20 Sections 3(1)(b) and (c) of the Act read as follows:-

"The following shall not be registered:-

- 25 (b) trade marks which are devoid of any 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, geographical origin, the time of production of goods or of rendering or services, or other characteristics of goods or services,

30 The mark consists of ordinary dictionary words which are so well known that I believe I do not need to set out any dictionary references for all the individual components of the mark. I am, in any case, bound to accept or reject the mark in its totality.

35 Turning to Section 3(1)(c) first, the goods specified are soaps; washing and bleaching preparations for laundry; rinsing agents for laundry and tableware; chemical products for the cleaning of textiles; cleaning preparations for sanitary, laundry and dry cleaning use. As such I considered that the words indicate two characteristics and desired qualities of goods which have been dry cleaned. <Fresh' indicating fresh smelling and <gentle' indicating that the products would be suitable for use with certain delicate fabrics.

40 It is for the above reasons that I also considered the mark is devoid of any distinctive character and not acceptable, prima facie, for registration under Section 3(1)(b) of the Act. In this regard I was guided by the comments of Mr Justice Jacob in the British Sugar Plc and James Robertson and Sons Ltd case (the TREAT case), 1996 RPC 281, comments which also go to Section 3(1)(c) of the Act when he said:

5 "Next, is "Treat" within Section 3(1)(b)? What does devoid of any 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? A meaningless
10 word or a word inappropriate for the goods concerned ("North Pole" for bananas) can
clearly do. But a common laudatory word such as "Treat" is, absent use and
recognition as a trade mark, in itself (I hesitate to borrow the word from the old Act
"inherently" but the idea is much the same) devoid of distinctive character. I also think
"Treat" falls within Section 3(1)(c) because it is a trade mark which consists
15 exclusively of a sign or indication which may serve in trade to perform a number of the
purposes there specified, particularly to designate the kind, quality and intended
purpose of the product".

20 I therefore concluded that the mark applied for was devoid of any distinctive character and
consists exclusively of a sign that may serve, in the trade, to designate the kind and intended
purpose of the goods and is thus excluded from protection in the United Kingdom under
Sections 3(1)(b) and (c) of the Act.

25 Since I made the decision to refuse the application, the European Court of Justice has given
further guidance on the scope and purpose of Article 7(1)(c) of the Community Trade Mark
Regulation (equivalent to Section 3(1)(c) of the Act).

30 The guidance indicates that the purpose of Section 3(1)(c) of the Act is not to prevent
unjustified monopolies in descriptive terms but to exclude from registration those signs which
may serve, from a consumers viewpoint, to designate directly the essential characteristics of
the goods.

35 Although this guidance was not available at the time of my decision, it would not have caused
me to have come to a different conclusion. For the reasons already given, I believe that 'Fresh'
and 'Gentle' are essential characteristics of dry cleaning preparations, and combine naturally to
form a sign with an exclusively descriptive meaning.

I believe that would be the consumers view of the mark in use in relation to the goods at issue.

40 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 this reason give, it is refused
under the terms of Section 37(4) of the Act because it fails to qualify under Sections 3(1)(b)
and (c) of the Act.

45 Dated this 17TH day of October 2001

Ian Peggie
For the Registrar
The Comptroller General