

TRADE MARKS ACT

**IN THE MATTER OF APPLICATION NO. 2231098A
BY RECKITT BENCKISER N.V.
TO REGISTER A TRADE MARK IN CLASSES 1 AND 3**

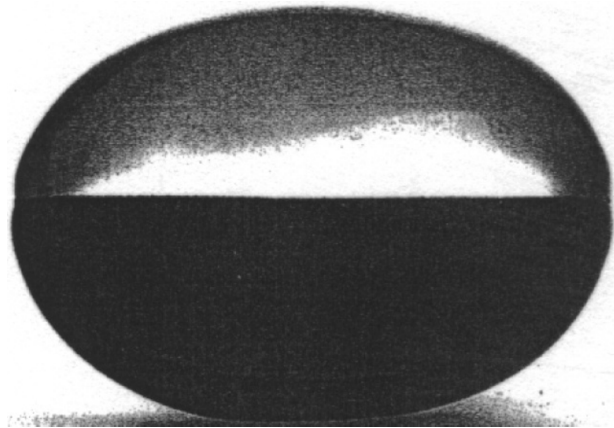
TRADE MARKS ACT

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DECISION AND GROUNDS OF DECISION

1. On 27 April 2000, Reckitt Benckiser N.V. of World Trade Center AA, 229 Schiphol Boulevard, NI-1118 BH Schiphol, The Netherlands, applied to register a series of two trade marks in classes 1 and 3. The series was later divided into two separate applications. This application relates to the black and white version of the mark.

2. The mark of this application is as follows:



3. The goods and services claimed are as follows:

- | | |
|---------|--|
| Class 1 | Chemical products for industrial purposes; descaling agents; all aforementioned goods with or without disinfective components. |
| Class 3 | Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; detergents; decalcifying and descaling preparations for household goods with or without disinfective components. |

4. The mark is a 2-dimensional logo, although its visual appearance is 3-dimensional in that it bears shading and looks to me like a photograph of an oval shaped capsule.

5. Objection was taken under Sections 3(1)(b) & (c) of the Act because the mark consists of the device of the goods, being devoid of distinctive character and which may serve in trade to designate the kind of goods.

6. At a hearing at which the applicants were represented by Ms Hutchinson of Grant Spencer Caisley and Porteous LLP, their Trade Mark Attorneys, the objections were maintained and the application was subsequently refused in accordance with Section 37(4) of the Act.

7. Following refusal of the application I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Marks Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

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

9. Section 3(1)(b) & (c) of the Act reads as follows:

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

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

(c) trade marks which consists 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 of services, or other characteristics of goods or services, "

10. 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?"

11. This application is for a sign which appears to be the representation of a capsule, with the top half of the capsule being light in colour, and the bottom half dark. The shape of the capsule in the representation is a basic geometric shape with no embellishment. When applied to the packaging of the goods claimed in classes 1 and 3, I am of the opinion that the average consumer of such products would make the connection that the oval shaped device is meant to represent the type of goods inside the packet i.e. chemical products and cleaning preparations sold as an oval shaped capsule or capsules. I do not consider that the mark applied for would communicate the message that the capsules emanate from any particular source. I say this, not least, because I am aware from my own knowledge that such products are now commonly sold either as tablets which dissolve in water or capsules that may be broken to release the contents inside. To my own knowledge, these tablets and capsules usually comprise an ordinary geometric shape such as round or rectangular, and it is only those sold with other memorable

features such as multicolour combinations or additional embellishment to the shape that are likely to be perceived as trade marks by themselves.

12. At the hearing Ms Hutchinson submitted that many geometric shaped devices have rightly been accepted by the Registrar in the prima facie, and that this one should be no exception. She asserted that the mark applied for is a logo and not a 3-dimensional shape, and that the whole device is "funky and eye-catching". I rejected these arguments and said at the hearing that the device will merely indicate on outer packaging what the consumer would expect to find inside i.e. a capsule, or number of capsules, of this appearance, containing a chemical or cleaning fluid. I do not see that there is anything in the sign which would serve to distinguish the goods in classes 1 and 3 from those of other traders.

13. In the Yakult Honsha KK's Trade Mark Application [2001] RPC 39, Mr Justice Laddie gives his view of the test for inherent distinctiveness in the case of a three dimensional trade mark at paragraph 10:

"The relevant question is not whether the container would be recognised on being seen a second time, that is to say, whether it is of memorable appearance, but whether *by itself* its appearance would convey trade mark significance to the average customer. For the purpose of this appeal, I am prepared to accept that the bottle shape which is the subject of these applications is both new and visually distinctive, meaning that it would be recognised as different to other bottles on the market. That does not mean that it is inherently distinctive in a trade mark sense."

14. Even though this application is for a two dimensional trade mark, as I have said before, it gives the visual appearance of being three dimensional in that it looks like a photograph of an oval shaped capsule.

15. I am also mindful of the Procter & Gamble Limited's application [1999] RPC 673, where Walker LJ said :

"Despite the fairly strong language of Section 3(1)(b), "devoid of any distinctive character" - and Mr Morcom emphasised the word "any" - that provision must in my judgement 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."

16. Finally, I would refer to Procter and Gamble's application to register a Community Trade Mark for a three dimensional shape of a dishwasher tablet where the European Court of First Instance in Case T-117/00 of 19 September 2001, paragraphs 54 and 55 state:

"Article 7(1)(b) of Regulation No 40/94 does not distinguish between different categories of trade marks. The criteria for assessing the distinctive character of three-dimensional trade marks consisting of the shape of the product itself are therefore no

different from those applicable to other categories of trade marks.

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 three-dimensional mark consisting of the shape and the colours of the product itself as it is in relation to a word mark, a figurative mark or a three-dimensional mark not consisting of the shape of 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."

17. 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 because it is no different from the type of sign commonly used by other traders in the market to indicate the kind of products on offer. It follows that this application is debarred from prima facie acceptance by Sections 3(1)(b) &(c) of the Act.

18. In this decision I have considered all the documents filed by the applicant and all the arguments submitted to me in relation to the 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 Sections 3(1)(b)&(c) of the Act.

Dated this 25th day of February 2002.

Janet Folwell
for the Registrar
the Comptroller General