

O-088-03

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2242117
BY HENKEL LOCTITE ADHESIVES LIMITED
TO REGISTER A TRADE MARK
IN CLASSES 1, 16, 17, 19 AND 27**

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DECISION AND GROUNDS OF DECISION

BACKGROUND

1 .On 9 August 2000 Henkel Loctite Adhesives Limited of Apollo Court, 2 Bishop Square Business Park, Hatfield, Hertfordshire AL10 9EY applied for registration of a series of three three dimensional trade marks in respect of the following goods and services:-

Class 01

All goods in class 1; chemicals used in industry; unprocessed artificial resins, unprocessed plastics; tempering and soldering preparations; adhesives used in industry.

Class 16

All goods in class 16; paper, cardboard and goods made from these materials, not included in other classes; printed matter; stationery; adhesives for stationery or household purposes; artists materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); adhesives for stationery and household purposes; tape dispensers for household and stationery use; paper masking tape; paper carton sealing tape; adhesive carpet tape, paper picture mounts; cardboard boxes, paper containers, cushions or padding for packing purposes, packing paper; desk pads; office organizing products, file folders, drawers; wrapping paper, tissue paper, paper labels, and adhesive tape for household use; arts and crafts kits for children containing paints, glue and decorative items; envelopes, paper identification tags, address labels, blank and partially printed labels, shipping labels, paper name badges, note pads; plastic film for wrapping not for commercial or industrial purposes; correction pigment applicators; adhesive applicators, applicators including adhesive; printed newsletters in the area of entrepreneurship marketing, business relations and management, self-adhesive plastic sheets for lining shelves.

Class 17

All goods in class 17; packing, stopping and insulating materials; sheets, strips or squares of foam or solid plastic or rubber and/or cloth having a pressure sensitive adhesive on one or both sides for electric, air, heat or moisture sealing or insulation; masking and strapping tape; sheets, strips or squares of paper having a pressure sensitive adhesive on one or both sides for

electric, air, heat or moisture sealing; adhesive tape for sealing cartons for personal, industrial and commercial use; elongated tape having a pressure sensitive adhesive on one or both sides; weather-stripping for home use, pre-tapes plastic drop cloths; drywall joint tape.

Class 19

All goods in class 19; building materials (non-metallic); non-metallic rigid pipes for building; asphalt, pitch and bitumen; excluding roofing felt; window insulating kits comprising plastic sheeting with adhesive along one edge and double faced adhesive tape.

Class 27

All goods in class 27; plastic sheets, matting, underlaying, cushioning and decorative coverings; rubber or plastic mats, for household and domestic use.

2. The marks for which registration is sought are represented at Annex A.
3. The third mark in the series is limited to the colours grey and green as shown on the form of application.
4. Objection was taken under Sections 3(1)(a) and (b) and Section 3(2) of the Act as the mark consists of a sign used in trade to designate the intended use of the goods, e.g. adhesive dispensers.
5. By letter of 15 September the applicants' representative submitted a sample of the mark applied to adhesive tapes on a product sold in France and plan drawings for equivalent application of the mark to a product to be sold to the United Kingdom.
6. This sample is represented as Annex B.
7. At a hearing at which the applicants were represented by Dr T L Brand of W P Thompson & Co, their trade mark attorneys I maintained the objection under Section 3(1)(b) only and the application was subsequently refused on 23 January 2003 in accordance with Section 37(4). The objections under Sections 3(1)(a) and 3(2) of the Act were waived and I need say no more about them.
8. Following the refusal of the application 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 arriving at it.
9. No evidence that the mark has acquired a distinctive character as a result of use has been put before me and therefore I have only to consider whether the mark is inherently distinctive.

THE LAW

10. Section 3(1)(b) of the Act reads as follows:

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

THE DECISION

11. At the hearing Dr Brand argued that the shape was unusual and visually distinctive and that the applicants had deliberately created packaging which was different from their competitors so that it would be memorable and therefore perform the function of a trade mark. To demonstrate this point Dr Brand referred to several examples of packaging from competitors which he had brought to the hearing.

12. The marks consist of two representations, the first being at an angle presented from the top, the second presented from the bottom. It is clear they are intended to show the three dimensional shape of packaging for tape. The packaging is flat at the top and bottom, curved at the sides and indented near the bottom.

13. Clearly the shape had some differences from the examples of competitors products referred to by the agent. However, I have no evidence that any trade mark significance attaches to the overall shape of the packaging. To my mind the elements which make up the packaging are not striking or memorable and in my mind it will be seen only as a means of holding a roll of tape. Even if the overall appearance was considered to be different from other packaging for tape this would not, in my view, be sufficient to indicate trade mark significance. I bear in mind the comments by Laddie J in Yakult Honsha KK's Trade Mark Application [2001] RPC 39 (Page 756) at paragraphs 10 and 11:

"10. Where inherent distinctiveness is concerned, the Registry has to find that the mark performs the function of identifying origin even before the public is educated that it is so used for that purpose. Where invented, non-descriptive word marks are concerned, it may be easy to come to such a finding. But where a container is in issue it may well be much more difficult. As Mr Thorley rightly conceded, the fact that a container is unusual or attractive does not, per se, mean that it will be taken by the public as an indication of origin. The relevant question is not whether the container would be recognised on being seen a second time, that it 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.

11. Mr James came to the conclusion that the average consumer was likely to conclude that the design in the applications was nothing more than a bottle of pretty ordinary shape. I agree. Like Mr James, I can see nothing which would convey to someone who was not a trade mark specialist that this bottle was intended to be an indication of origin or that it performed that function. Even were it to be recognised as of different shape to other bottles on the market, there is nothing inherent in it which proclaims it as having trade mark significance."

In addition in the Proctor and Gamble Limited case [1999] RPC 673, Walker L J 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 traders products - 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."

14. The third mark in the series is limited to the colours grey and green.

15. I do not consider anything rests on the colour combination in the prima facie case as packaging for goods is normally coloured, so the presence of colour per se cannot be distinctive. Packaging comes in all colours and I see nothing unusual about seeing packaging coloured grey and green. In addition the arrangement of colours applied to this application is not distinctive. The grey rectangle is simply a box within which a word mark will appear. Also as the applicants have applied for the marks as a series they do not appear to place particular weight on the distinguishing effect of the colours.

16. I do not believe that the purchasing public, bearing in mind that these are ordinary consumer items, would consider the mark to denote trade origin. I do not see anything in the shape and colour combination as a whole to persuade me that this would serve to distinguish the goods of the applicant from those of other traders. In my view the mark applied for will not be taken as a trade mark without first educating the public that it is. The overall impression is not sufficiently different from other such packaging as to convey trade mark significance. I therefore conclude that the mark applied for is devoid of any distinctive character and is thus excluded from prima facie acceptance under Section 3(1)(b) of the Act.

CONCLUSION

17. In this decision I have considered all documents filed by the agent, and for the reasons given the application is refused under the terms of Section 37(4) of the Act because the mark fails to qualify under Section 3(1)(b) of the Act.

Dated this 4TH day of April 2003.

Ian Peggie
For the Registrar
The Comptroller General

Annex in paper copy only