

O-272-03

DECISION OF THE TRADE MARKS REGISTRY

TRADE MARKS ACT 1994

APPLICANT: ROBERT MCBRIDE LIMITED

OPPOSITION N^{os}. 51973, 51974, 51975 AND 51976

AND

**OPPONENTS: HENKEL KOMMANDITGESELLSCHAFT AUF AKTIEN AND
S A HENKEL BELGIUM NV**

APPLICATION N^{os}. 2234004, 2233932, 2234009 AND 2234005

CLASS 3

TRADE MARKS ACT 1994

BACKGROUND

1. The applications in the ANNEX were applied for on 25th May 2000 by Robert McBride Ltd of Middleton Way, Middleton, Manchester, M24 4DP United Kingdom for:

Class 3: Cleaning preparations; bleaching preparations; dish washing powders; textile washing powders; rinsing agents; all in tablet form.

2. Registration of the marks is opposed by Henkel Kommanditgesellschaft auf Aktien and S A Henkel Belgium NV under s. 5(2)(b) on the basis of the proprietorship of earlier marks. These are depicted, with the marks in suit, in the Annex to this decision. They are:

UK designation of International registration number	Priority Date	Goods
738273	03.02.2000	<p>Class 1: Chemical products for use in industry; anti-liming agents.</p> <p>Class 3: Soaps, laundry bleaching and washing agents; rinsing agents for dishwashing and laundry washing machines; cleaning and polishing agents; chemicals for cleaning wood, metal, glass, synthetic materials, stones, porcelain and textiles.</p>
729844	03.02. 2000	<p>Class 1: Chemical products for industrial purposes; descaling preparations other than for household purposes.</p> <p>Class 3: Soaps, detergents and bleaching preparations, rinsing preparations for laundry and washing-up purposes, stain removers, polishing and scouring preparations; chemical products for cleaning wood, metal, glass, stone, ceramics, china and textiles.</p>

The first is owned by Henkel Kommanditgesellschaft auf Aktien and the second by S A Henkel Belgium NV.

3. A Counterstatement was provided by the applicant denying the ground asserted. Both parties ask for costs to be awarded in their favour.
4. These oppositions have not been consolidated, but they are very similar: I have therefore decided to report them all in the same decision. It was pointed out at the hearing that application No. 2233932 had been refused following an unrelated opposition (No. 52032), on absolute grounds. No appeal was made and thus this application was not considered further.

HEARING

5. A hearing was held on 23rd July 2003, where the applicant was represented by Mr. K. Hodkinson of Messrs. Marks & Clerk and the opponents by Mr. D. McCall of Messrs. W. P. Thompson & Co.

EVIDENCE

6. The opponents enclose two Witness Statements, from Henkel Kommanditgesellschaft auf Aktien's head of marketing, Automatic Dishwashing Department, a Mr. Eckhard Von Eysmond. Both contain submission and are devoid of fact. At the hearing Mr. McCall was dismissive of the value of this material:

“I think the first point I want to make is that having read the evidence on both sides I do not think it is particularly helpful to either of us. My own view is that the case will almost certainly have to be decided without the assistance of the evidence.”

7. This is certainly the case with the material his clients have submitted: and despite the submission of Mr. Hodkinson on certain aspects of his own evidence, I think the same is true of that as well. I return to this point below, but choose to make no formal summary of either parties' evidence here.

LAW

8. The relevant section of the Act is:

“5(2) A trade mark shall not be registered if because -
(a) ... , or
(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

DECISION

9. The following decisions of the European Court of Justice (ECJ) on this provision (equivalent to Article 4(1)(b) of Directive 89/104/EEC) were brought to my attention by the parties, that is: *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v*

Metro-Goldwyn-Mayer Inc [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV*, paragraph 23, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd*, paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV*, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and *vice versa*; *Canon*, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it; *Sabel*, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel*, paragraph 26;
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon*, paragraph 29.

Earlier marks

10. The earlier mark No. 729844 is subject to an outstanding opposition: any decision made based upon the latter would be provisional in nature only. This was recognised at the hearing.

Similarity of goods

11. These were considered identical by both parties. It is clear that the applicant's goods in Class 3 are subsumed by the opponents' goods in Class 3.

The Average Consumer

12. Mr. McCall stated that:

“... average consumer is your normal householder going round doing the weekly shopping and perhaps distracted by all sorts of other things and passing the shelves and reaching for something that they believe is the product they want. It is not a case where I believe there is a tremendous amount of attention paid during the purchasing process.”

I understand the point that Mr. McCall is trying to make here, but I feel it is something of an overstatement. Dishwasher/washing machine tablets are not ‘bags of sweets’ and the wide variety of these products that are available, and the appliances they can be used in, does connote some small care, at least, in their purchase.

The similarity of the marks

13. All are three dimensional representations of ‘washing tablets’, of three coloured layers and unremarkable shape. I do not believe that either party regarded them as anything other than similar, and I did not disagree.

Likelihood of confusion

14. In terms of a more detailed individual comparison of the marks, I stated at the meeting that I would base this on their graphical presentations as presented to the Registrar (shown in the Annex), not on the various, ambiguous verbal descriptions (blue, red etc.) or the pantone references (which not all used). I also note the following exchange at the meeting:

“MR. HODKINSON: Looking at these in turn, Mr. McCall’s strongest case I think you would say is probably against my application 004. He has a red top, thin blue middle and a white bottom layer.

THE HEARING OFFICER: Did you suggest that was your best case?

MR. McCALL: I think it has to be. I am not sure I put it that way, but I take that as being the best of the three cases.

THE HEARING OFFICER: If you cannot win on that, you cannot win on the other two?

MR. McCALL: If I cannot win on that, I stand very little chance on the other two.”

On the basis of this exchange, I will focus my attention on the application 2234004.

15. Mr. McCall emphasised the importance of viewing the marks – both applicant’s and opponents’ – as a whole. He also highlighted the complete identity of the goods at issue, referring me to *Canon* paragraph 17, cited above. He then stated:

“17 The next point again is *Sabel*. There is a greater likelihood of confusion where the earlier mark has a highly distinctive character. We do not actually have any evidence of that, but I would again draw attention to the *Raleigh* case where Geoffrey Hobbs QC, acting as the appointed person, says that in all proceedings relating to a registered trade mark, the registration of a person as proprietor of a trade mark shall be *prima facie* evidence of the validity of the original registration and then he goes on to say: ‘I understand this to imply that the earlier trade mark should be taken *prima facie* to have

possessed a distinctive character when it was registered.’ We have no evidence to the contrary in this case. ... Any argument along the lines that my mark is not distinctive I do not think is an argument you can take note of.”

16. That all registered marks are distinctive enough for registration cannot be anything but obvious, but that some are more distinctive than others must equally be obvious: a race can be won ‘by a mile’ and by hundredths of a second. This seems to me to be one of the ‘relevant factors’ to admit into the ‘multi-factorial’ analysis counseled by the case law, and I think it is fair for me to come to a view on the issue, from my own experience, and from the material I have before me. First, there is the general point that has been made by the ECJ about the public perception of three-dimensional ‘shape of product’ marks – that though no stricter criteria than those used for other categories of trade mark ought to be applied when assessing the distinctiveness of these marks, it may in practice be more difficult to establish their capacity to distinguish as compared to a word or figurative trade mark – largely because of consumer expectation (e.g. see *Linde AG’s Trade Mark Application* (C53/01) EU: Case C-53/01 Times, April 24, 2003).
17. Next, Mr. Hodkinson pointed out the following from a decision of the Court of First Instance (*Henkel KGaA v. Office for Harmonisation In the Internal Market (Trade Marks and Designs)* T30/00 [2002] E.T.M.R. 25, paragraph 53):

“...The shape represented by the image for which registration has been sought, namely a rectangular tablet, is one of the basic geometrical shapes and is an obvious one for a product intended for use in washing machines or dishwashers.”

And I do not believe one needs evidence to come to such a conclusion about the goods at issue in this case: it is common experience. To summarise, the general point that is being made, here, is that these marks have low inherent capacity to distinguish, even where they have just enough to qualify for registration. As a result, they attract protection that is limited to the whole of the mark and its features, including ‘... the combination of the shape and the arrangement of the colours...’ (T30/00, paragraph 52): in effect, the trade mark ‘footprint’ for which registration provides protection is small.

18. As his final point, Mr. McCall referred to association and economically linked undertakings as per *Canon*, paragraph 29. I believe that this point can be dismissed as consequence of what I have just been discussing: it is hard to see how consumers will make the required trade source connection between various of these marks in view of the low inherent capacity to distinguish that they possess. They are too unremarkable.
19. Turning, now, to Mr. Hodkinson’s submissions, he first cited his client’s evidence, which is appended to a Witness Statement sworn by himself, and refers to Exhibit KHA, containing the details of a large number of UK and CTM applications and registrations. He states that these are:

“...in the form of three dimensional representations of detergent tablets in the ownership of a variety of proprietors, but many of which are in the proprietorship of the opponent.

3. Exhibit KHA clearly demonstrates the wide variety of colours and shapes in which detergent tablets are capable of being produced, or presumably intended to be produced by the same manufacturer, whom it is reasonable to assume feels that they are distinguishable, one from the other, commercially by customers. These are in many cases much closer in appearance than the opposed mark is to the marks relied upon by the opponent.

4. I believe that it is reasonable for the Registrar to conclude on the basis of these marks that the relevant consumer, who is deemed to be reasonably well-informed and reasonably observant and circumspect, would clearly be able to differentiate between two detergent tablets of three colours, which possess only the colours white and blue in common and would not be confused as to the origin of the tablets.”

20. At the hearing, Mr. Hodgkinson resiled from this position somewhat:

“...the real point I would like to draw from the evidence is that the fact that a number of applicants feel the need to file so many very similar marks, even the same applicant ... with minor variations between them, must be taken as an indication that the trade itself regards very small differences between this type of mark as sufficient to distinguish different products.”

Mr. Hodgkinson agreed with me that the ‘state of the register’ evidence indicated a desire by traders to register such marks, but this point is rather different: Mr. Hodgkinson is saying that this material shows that very small differences between these marks are regarded as satisfactory alternatives by the applicants themselves, even within their own product range. The finding that follows is similar to that I have already established above: that these marks are of low inherent capacity to distinguish.

21. As I have already come to this conclusion, even if I accepted the premise put by Mr. Hodgkinson it does not take me any further. But I believe it to be wrong, anyhow. That the applicants for these marks believe that very small differences between them is enough to distinguish them, does not mean that the Registrar believes this as well, or the law suggests it. And the clamour to register these marks could be because of a number of reasons: to gain rights in a particular representation, to protect one’s position in the marketplace, to ‘make things difficult’ for competitors. Even the registration of these marks does not naturally lead to the conclusion Mr. Hodgkinson wishes to draw: many of them could have been registered on the basis of use, under the proviso to s. 3(1) of the Act.

Likelihood of confusion

22. With this background in mind I now wish to compare the marks at issue, starting with application 2234004 and the registered 738273 (this was the mark that Mr. McCall concentrated on). In my view, having accepted the small ‘footprint’ of protection these marks possess, I need to compare their overall visual effect, whilst minding their differences and similarities.

23. Mr. McCall emphasised the similarity in shape of the marks – all of which are based on that of a rectangular prism. He noted the ‘chamfered’ edges of 738273, and the of

2234004, and that they both consisted of three coloured layers, which he called white, blue and pink. He, again, referred to the fact that these are low attention purchases, and stated that ‘..as far as 2234004 is concerned, the case is clear and the opposition should succeed.’

24. For his part, Mr. Hodkinson stated that the opponents’ mark was not pink, but red with white speckles. I think that I am inclined to agree: the coloured elements of 738273 are mottled in this way, and the red is much more intense than that of the applicant’s mark. Further, as was also pointed out, the colours are in a different order, the blue layer in the opponents’ mark is thin compared to that in 2234004 and the chamfers are smaller. Perhaps these are fine details that might be lost on a consumer who, as the case law states, ‘rarely has the chance to make direct comparisons between marks’. Nevertheless, they can be added to other differences that sum up, in my view, to a totality that distinguishes between the marks. In coming to this result, I am considering, the influence of the entire visual effect of the two marks: the applicant’s seems smoother and flatter than the opponents’, and the latter also seeming more ‘chunky’ in form. Taking this together with the low footprint of protection that I have decided these species of marks possess, I do not believe that confusion is likely.
25. Turning to the opponents’ 729844, I do not believe that the situation is any better for them: the speckled appearance has gone, but the effect of this is to enhance the intensity of the red colour, and other differences remain: the order of the colours, and thin blue layer: the overall effect is further from 2234004 than 738273.
26. This result means that the opponents have lost all three remaining oppositions, as I believe Mr. McCall was correct in considering his strongest was against 2234004, that is, opposition number 51973. Opposition number 5175, concerning mark number 2234009, depicts a mark identical in shape to 2234004, but the colours, from the bottom up, are white, yellow and blue. As for the last opposition, number 51976, application number 2234005, this, in my view, is even further away again: the colours are white, orange and lilac. My final comment on the likelihood of confusion issue, is that, apart from the commonplace shape of the opponents’ tablet marks, and the unremarkable white stripe on the bottom layer, they have nothing in common with the applicant’s latter two applications (2234009 and 2234005). As for 2234004, this is clearly closer because of the common use of the colour blue. The following, however, appears in Mr. Hodkinson’s evidence:

“I note the decision of the Court of First Instance of the European Communities in cases: T-129/00, T-128/00, T-121/00, T-120/00, T-119/00, T-118/00, T-117/00, T0337/99 and T-30/00 where it was stated that:

‘The use of basic colours, such as blue or green, is commonplace and is even typical of detergents. The use of other basic colours, such as red or yellow, is one of the most obvious variations on the typical design of these products.’ ”

27. All in all, I do not consider that confusion is likely between these marks.

Conclusion

28. The opposition has failed on the ground pleaded.

COSTS

29. I do not see any reason to depart from the usual scale. Mr. McCall argued for a costs award in his client's favour, whatever the outcome in these proceedings, because:

“Mr. Hodkinson has for his client been arguing at great length that this kind of mark is not registrable. Even in cases where he has had a registration or an application and that has been opposed, he has argued that he more or less agrees with the opponent and it is not really a mark he thinks should be granted. On that basis it seems to me that he has put us all to a considerable amount of trouble on cases he does not really believe and, perhaps regardless of the outcome, costs should be awarded in my favour.”

30. In response, Mr. Hodkinson responded:

“It has certainly been the position of McBride that they believe section 3 objections are quite legitimate in relation to all tablets of this type. However, the opponent Henkel has appealed the CFI decisions to the ECJ. If it should turn out that the ECJ finds tablet marks of this kind are indeed registrable as a matter of law, it is obviously incumbent on McBride to defend its own position and have registrations of this type which it may use. Henkel has previously threatened infringement proceedings against McBride in relation to three-layer tablets. It is therefore a perfectly legitimate stance for McBride to take to defend its position under section 5 in relation to applications of this type while hoping in the long run that all tablets of this type disappear off the face of the earth as soon as possible.”

31. Mr. Hodkinson's admission, here, might be taken as one against interest. Nevertheless, I do not believe that this is a matter I can deal with fairly on the basis of two scant submissions at the end of a hearing, on the basis of costs. It seems to me that the issue rather goes to bad faith, which the opponents have not pleaded. Nevertheless, whatever the applicant's views on the law in respect of the registrability of these marks, the possibility remains that they might be wrong. Their subsequent applications, intended to protect their position, do not appear, in my view, to constitute unreasonable commercial practice.

32. I order the opponents to acknowledge the applicant's success by paying them £2300. This is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful. I have combined the costs for three oppositions i.e. for 51973, 51975 and 51976. However, I do not see any need to 'treble' up the award of costs: the pleadings and evidence are identical in each case, and the matter turned on 51973 only. I have awarded relatively little for preparing and filing evidence and considering evidence as the utility of each was low.

Dated this 3rd Day of September 2003.

**Dr W J Trott
Principal Hearing Officer
For the Registrar**

ANNEX

(Representations of the marks available on request).