

In The Matter Of A Trade Mark Application No T94/00542A By Colgate-Palmolive Company

And

**Opposition Thereto By
The Procter & Gamble Company**

*Before Principal Assistant Registrar of Trade Marks Mr Wong Sheng Kwai
31 October 2007*

Trade Marks – Opposition to registration – Distinctiveness – whether the Application mark satisfies the definition of a trade mark under section 2(1) and the requirements under Sections 7(1) of the Trade Marks Act 1998 [Cap. 332]

Trade Marks – Opposition to registration – Distinctiveness – whether the Application mark consists exclusively of the shape which results from the nature of the goods and should not be registered under Section 7(3) (a) of the Trade Marks Act 1998 [Cap. 332]

The Applicant, Colgate-Palmolive Company applied for registration of a mark in 1994, which comprised a “slug” device (with limitation to the colours green, white and blue as reproduced below), for use or intended use on “Dentrifices” in class 3. On 12 July 1999, the Applicant applied to have the registrability of the mark determined in accordance with the provisions of the Trade Marks Act 1998.



The Opponent, the Procter & Gamble Company raised objections under sections 2 (1), 7(1) (a), (b), (c) and 7(3) (a) the Trade Marks Act 1998 (hereinafter referred to as “TMA”). The Opponent contended that the mark is not a trade mark because it is a device of a slug of toothpaste that is descriptive for “dentrifices”. It is also devoid of any distinctive character and not capable of distinguishing the goods of the Applicant as a badge of origin.

The Opponent further contended, in the alternative, that the mark consists exclusively of the shape that result from the nature of the goods, that is toothpaste and should not be allowed registration by virtue of Section 7(3)(a) of the TMA.

The Applicant contended that the mark is a highly stylized and unique representation of a “slug” device and clearly falls within the meaning of a sign that is capable of being represented graphically. Being limited to colours green, white and blue, it is very different from the other toothpaste designs that the Opponent claimed are common place. Its distinctiveness lies in its stylistic and unique representation which has not been used by any other trader and is sufficiently memorable for acceptance by the consumers as a badge of origin.

The Applicant also contended that the mark does not have a “shape” that is a result of the nature of the goods. “Dentrifices” include paste, gel or powder for use in oral hygiene. They do not have a definite shape and do not naturally occur in the shape of the mark.

Held, allowing the application mark to proceed to registration

1. Sections 7(1) (a) incorporates the requirement for the mark to be a trade mark and “capable of distinguishing” under section 2(1) appears to be a general statement of the positive requirement for distinctiveness regardless of whether the same is inherent or acquired. The section is then followed by a series of negative prohibitions in section 7(1) (b), (c) and (d). The positive statement and the negative prohibitions that follow are two sides of the same coin, requiring the same test of distinctiveness but assessed from different perspectives
2. For Sections 2(1) and 7(1) (a) considerations -

- a. The mark qualifies as a “sign” being a “device” with a limitation to specific colours. It is capable of being represented graphically and there is no difficulty or incapability of the two-dimensional mark being used on packaging or be otherwise visible as a “sign” to a purchaser;
 - b. Its stylistic rendering and limitation to specific colours does not immediately invoke an association that it is a representation of a slug of toothpaste. The context of use is not intended for toothpaste alone but on “dentrifices” which include paste, gel or powder for use in oral hygiene. It is therefore not inherently incapable of distinguishing the Applicant’s goods from those of others. Many traders use common descriptive devices in their trade but adapted with distinctive elements in order to act as a badge of origin.
3. For Sections 7(1) (b) and (c) as there is a common practice for traders in goods in class 3 of using devices like toothpaste and toothbrushes with limitation to distinctive colours to distinguish their products from those of other traders., consumers who buy these goods on a daily basis are exposed to this practice. They would not need to be educated that these devices are trade marks. The mark is also not exclusively descriptive of the nature and quality of the goods. The stylistic and unique rendering with limitation to a particular combination of colours does not convey any specific meaning. The device alone does not necessarily bring to mind the function of toothpaste.
 4. On the face of the application, there was no intention on the part of the Applicant to apply for the registration of a three dimensional shape mark. The application is for a two dimensional device mark. If the Applicant had wanted to apply for registration as a shape mark, a separate application will have to be made under the TMA. Section 7(3) (a) has no application on the facts.

Provisions of Legislation discussed:

- Trade Marks Act 1998 (Cap. 332, 2006 Rev. Ed.), Sections 2(1) 7(1)(a), 7(1)(b), 7(1)(c), and 7(3)(a).

Cases referred to:

- Dualit Ltd’s Trade Mark Application [1999] RPC 890.
- British Sugar PLC v James Robertson & Sons Ltd [1996] RPC 281,
- AD2000 [1997] RPC 168
- Philips v Remington [2002] All ER (EC) 634).
- In the matter of an opposition by Proctor & Gamble Inc to application no. 760,655 for the trade mark Striped Toothpaste Design – Green/White/Blue Stripes filed by Colgate-Palmolive Canada Inc) [Canadian case - unreported]
- Nation Fittings (M) Sdn Bhd v Oystertec Plc and Another Suit [2005] SGHC 225

Representation:

- Mr Tan Bok Hoay with Ms Gooi Chi Duan (M/s Donaldson & Burkinshaw) for the Applicant.
- Mrs Mugiana Haq (M/s Haq & Selvam) for the Opponent.