

BENELUX OFFICE FOR INTELLECTUAL PROPERTY
CANCELLATION DECISION
N° 3000624
of 12 July 2024

Claimant: **Henkel AG & Co. KGaA**
Henkelstrasse 67
40589 Düsseldorf
Germany

Representative: **Novagraaf Nederland B.V.**
Hoogoorddreef 5
1101 BA Amsterdam
The Netherlands

against

Defendant: **Reckitt Benckiser Finish B.V.**
Siriusdreef 14
2132 WT Hoofddorp
The Netherlands

Representative: **Merkenbureau Knijff & Partners B.V.**
Leeuwendeldseweg 12
1382 LX Weesp
The Netherlands

Contested trademark: **Benelux registration 1482557**



I. FACTS AND PROCEEDINGS

A. Facts

1. On 16 October 2023 the claimant filed an application for a declaration of invalidity with the Benelux Office for Intellectual Property (hereinafter: "the Office") in accordance with Article 2.30bis (1)(a), invoking several grounds. In its arguments claimant limited the cancellation action to the absolute grounds stated under Article 2.2bis (1)(b) and (c) of the Benelux Convention on Intellectual Property (hereinafter: "BCIP"), namely that the contested trademark is devoid of any distinctive character and is descriptive.

2. The cancellation application is directed against Benelux trademark registration 1482557 of the



figurative mark , which was filed by the defendant on 18 April 2023 and was registered on 30 June 2023 for goods in class 3.

3. The cancellation application is directed against all goods of the contested trademark, namely:

Cl 3 Dishwashing preparations; combination cleaner, freshener and deodorizer for machine dishwashers; rinse agents for machine dishwashers; detergents for dishwashing in solid, fluid or gel form; polishing preparations for kitchen and glassware; cleaning, polishing, scouring and abrasive preparations for dishwashing; decalcifying and descaling preparations for domestic use; stain removing preparations, all aforementioned goods with or without a disinfective component.

4. The language of the proceedings is English.

B. Course of the proceedings

5. The cancellation request is admissible and was notified by the Office to the parties on 26 October 2023. During the administrative phase of the proceedings both parties filed arguments. The course of the proceedings meets the requirements as stated in the BCIP and the Implementing Regulations (hereinafter: "IR"). The administrative phase was completed on 15 January 2024.

II. ARGUMENTS

A. Claimant's arguments

6. Claimant argues that according to European and Benelux case law trademarks consisting of simple geometric shapes are generally devoid of any inherent distinctive character. Consumers are not accustomed to inferring the origin of goods from a simple geometric figure without additional distinctive graphic or word elements, since a simple geometric shape as such is not generally used as a means of commercial identification; a simple geometric shape as such does not normally have the capacity to distinguish the goods of a particular undertaking from others.

7. The claimant highlights legal proceedings between parties in Germany, where similar attempts by the defendant to trademark a red round element were rejected. These legal disputes extend to other jurisdictions including Poland and Italy, involving claims under trademark and unfair competition laws. Several attempts to obtain trademark protection for the shape of a red round element and a red dot, respectively, were also explicitly denied by several trademark offices within the European Union, according to the claimant. The most recent attempt made by the defendant to obtain trademark protection for a simple red dot must – once again – be denied.

8. The claimant emphasizes that both parties are manufacturers of dishwasher detergents in tab form. The dishwasher detergents are marketed under the trademarks "Somat" (claimant) and "Finish" (defendant). The denominations "Somat" and "Finish" are each protected as trademarks and used prominently – alongside and in combination with multiple other descriptive and decorative elements – on the respective product packagings:



Somat Excellence 4in1 Caps (2021)



finish Powerball All in 1 (2021)

9. The claimant provides an overview of the legal criteria for assessing trademark distinctiveness, stressing the importance of consumer perception and the overall impression conveyed by the mark. He argues that the contested trademark does not meet these criteria and therefore should be invalidated under Benelux trademark law.

10. In the present case, the claimant argues that the features of the contested registration are neither distinctive in themselves nor in combination. The graphic element consists of a round red element, i.e., a simple geometric shape, but with no other additional or fanciful (distinctive) elements. Even the slightly implied shades do not lead to a different result, as they do not significantly influence the consumer's perception. It thus can be excluded that, at the relevant date, the contested trademark would be easily and instantly memorized by the relevant public. Therefore, the contested trademark is only perceived as a decoration for the relevant goods, without giving any specific information or precise message as to their commercial origin. The claimant supports this finding by providing a list of several EU trademarks or trademark applications consisting of geometric shapes that were declared invalid or were rejected due to lack of distinctiveness. Claimant also cites from several decisions and stresses that the distinctive character required under trademark law could not be justified on the basis of any three-dimensionality of the red element, even if any three-dimensionality could be discerned in the contested trademark, which seems more than doubtful.

11. Claimant furthermore argues that in the relevant market sector of dishwasher detergents, red round elements generally serve a purely descriptive function, indicating the presence of an ingredient or a function

of the product. Claimant explains that it is common knowledge that dishwashers generally require several additives to function properly (in particular salt, detergent, and rinse aid). Manufacturers of dishwasher tablets and pouches highlight different layers or sections within these products to emphasize multifunctionality. As such, each layer/section is associated with a particular ingredient and function. This marketing approach is evident on product packaging and in commercial communications with various partners. The claimant provides an example of the defendant's product description. In the product description of the Finish Powerball Quantum, it is for instance said that the liquid Powerball is filled with power actions that dry and deliver a finishing boost of shine. In other words, it has a function of drying and making the product shine. Therefore, the claimant is of the opinion that consumers interpret the different elements and colours of dishwasher detergents not as an indication of commercial origin, but as an indication that the product contains certain ingredients and has specific characteristics and provide certain functions, respectively. The red element, including a red round element, does not escape this logic either as it indicates the presence of a certain ingredient/function, e.g. a rinse aid, in the products. No trademark protection can be claimed for such a descriptive indication. The claimant supports this finding with the EUIPO's decision in case R 979/2002-2 (October 19, 2004) regarding EUTMA no. 1156595 in which it has been concluded that the small rudimentary circle on top of the tablet, representing a protrusion, does not add any distinctiveness and merely highlights the presence of an active ingredient and/or effect of the tablet.

12. In addition, claimant stresses that the use of a red round element is purely decorative in the market sector of dishwasher detergents, both on packaging and on the products themselves. According to claimant it has to be taken into consideration that there exists a long-standing labelling custom in the sector in which, in particular, the decorative use of simple geometric red shapes and the colour red in general (in various kinds) is of importance. The shape of a simple red round geometric shape like the contested trademark as well as geometric dot-like shapes in red colour are not only on the parties' products but also in numerous third-party products in the product sector. In this respect claimant provides several examples from the Benelux:





Due to the multiple and varied use of red dots in the field of dishwasher detergents and dishwashing/washing agents in more general, the public is therefore accustomed to being confronted with simple geometric shapes in the form of dots in red colour when purchasing products and will not attribute any function to identify the commercial origin of the products to such an element.

13. Taking all abovementioned factors into account, claimant concludes that the contested trademark lacked (and still lacks) the necessary distinctive character and conveyed/conveys a descriptive meaning within the Benelux at the time of application.

14. Consequently, the claimant respectfully requests the Office to declare the contested trademark invalid for all goods. In addition, the claimant seeks an award of costs as defined in Article 2.30ter (5) BCIP.

B. Arguments of defendant

15. According to defendant, claimant wrongfully claims that the subject figurative mark must be invalidated. As regard to the rulings claimant relies on, defendant indicates it is settled case law that the competent authorities in one Member State are not bound by the decisions handed down by the authorities in other Member States, since the distinctive character of a trademark depends, in each individual case, on specific criteria that are applicable in particular circumstances. Each individual case has to be examined on its own merits and the rulings of national courts of other EU Member States or of the EUIPO, as referred to by claimant, are therefore irrelevant.

16. Defendant argues that the contested trademark has the required (minimum) degree of distinctiveness in relation to the goods for which the mark is registered. This mark therefore can fulfil the essential function

of a trademark. The contested mark is not a very simple sign consisting only of a basic geometric figure. Due to various colour shades and hues, the figurative mark as a whole exhibits a significant degree of complexity and possesses at the very least a minimum degree of distinctiveness. The examples mentioned by claimant fall in the category of extremely simple signs. In contrast, the various colour shades and hues, present in the contested trademark give the mark at the very least the required minimum degree of distinctiveness. Furthermore, most examples mentioned by claimant relate to very different goods or services in different classes. Defendant includes a list of figurative marks which are very similar to the contested trademark and which are generally found to be distinctive by the Office or the EUIPO.

17. Defendant furthermore disputes that red round elements have a function in the product. Only the ingredients of a dishwashing product may have a function, for instance a cleaning function or a drying and shining function. The shape and colour, however, do not determine the function at all. The ingredients can be put in any form and any colour to perform the necessary function of it. In this respect defendant refers to decisions of the General Court and the Court of Justice. Defendant also argues that the contested mark differs significantly from the actual product.

18. Defendant concludes that the contested mark, when perceived as a whole, is distinctive. The objections of the claimant should be waived. Defendant requests the Office to reject the invalidity application in its entirety.

III. GROUNDS FOR THE DECISION

A.1 Legal framework - general

19. Pursuant to Article 2.30bis (1)(a) BCIP, an application for invalidation of the registration of a trademark may be filed with the Office based on the absolute grounds for invalidity referred to in Article 2.2bis BCIP.

20. It follows from case law that in the context of an application for a declaration of invalidity based on Article 2.30bis (1)(a) BCIP, the relevant date for the purposes of examining the conformity of the trademark with Article 2.2bis BCIP is that of the filing of the application for registration.¹ In this case the relevant date is 18 April 2023.

21. In invalidity proceedings on absolute grounds, the contested trademark enjoys a presumption of validity, and it is up to the claimant to raise before the Office the concrete elements which call into question its validity. The Office will therefore limit its examination to the grounds, arguments and evidence submitted by the parties.²

¹ See by analogy: CJEU 23 April 2010, C-332/09 P, ECLI:EU:C:2010:225 (Flugbörse).

² See by analogy: General Court EU 19 October 2022, T-486/20, ECLI:EU:T:2022:642 (Swisse).

A.2 Regarding the ground set out in Article 2.2bis (1)(b) – Trademark devoid of distinctive character

22. The trademarks referred to in Article 2.2bis (1)(b) BCIP are those that are regarded as incapable of performing the essential function of a trademark, namely that of identifying the commercial origin of the goods or services in question, thus enabling the consumer to distinguish the goods or services from others which have another origin.³

23. According to case law of the General Court of the European Union (hereinafter: General Court EU), extremely simple signs, composed of a basic geometric figure, such as a circles, lines, rectangles or common pentagons, are not capable, as such, of conveying a message that consumers can remember, with the result that they will not consider it as a trademark.⁴ Also a simple geometric sign in a specific colour will, according to the General Court EU, not be perceived and remembered as an indicator of the commercial origin of goods or services.⁵

24. The distinctive character of a sign must be assessed, first, by reference to the goods and services concerned and, second, in relation to the perception of the relevant public, which consists of average consumers of those goods and services in question who are reasonably well informed and reasonably observant and circumspect.⁶ The overall impression of the sign is decisive.

25. In the present case the relevant goods are dishwasher detergents. The relevant public for these goods is the general public. The level of attention of this public is considered to be average.

26. The contested trademark is a simple figurative sign, composed of a basic geometric figure, namely a circle, in the colour red. The colour contains some shade effects.

27. According to the Office the relevant public will not perceive this simple geometric figure in the colour red as an indicator of commercial origin (see paragraph 23). Instead, the public will perceive the sign as a decorative element for advertising and marketing the goods.⁷ As substantiated by claimant (see paragraphs 12 and 8), circles in the colour red are widely used in advertising and marketing dishwasher detergents.

28. The shade effects do not change the overall impression of the sign. In this respect the Office notes that the public is used to shade effects being used (on packaging) to make a product more attractive. The shade effects thus do not give the sign distinctive character, but underline the decorative character of the sign.

29. In the opinion of the Office the shade effects do not make the relevant public see the sign as a three-dimensional sign and/or as a representation of the goods itself (see paragraphs 10 and 17).

³ CJEU 21 October 2004, C-64/02 P, ECLI:EU:C:2004:645, point 33 (DAS PRINZIP DER BEQUEMLICHKEIT); CJEU 15 September 2005, C-37/03 P, ECLI:EU:C:2005:547, point 60 (BioID); CJEU 8 May 2008, C-304/06 P, ECLI:EU:C:2008:261, point 56 (EUROHYPO).

⁴ General Court EU 12 September 2007, T-304/05, ECLI:EU:T:2012:271, point 22 (Pentagon). See also: CJEU 15 September 2005, C-37/03 P, ECLI:EU:C:2005:547, points 72 and 74 (BioID).

⁵ General Court EU 9 December 2010, T-282/09, ECLI:EU:T:2010:508, points 28-30 (Carré convexe vert).

⁶ CJEU 12 February 2004, C-363/99, ECLI:EU:C:2004:86, point 34 and case law mentioned there (Postkantoor).

⁷ See also General Court EU 9 December 2010, T-282/09, ECLI:EU:T:2010:508, point 29 (Carré convexe vert).

30. The Office concludes that the contested trademark is a simple figurative sign composed of a circle in the colour red with shade effects. This sign does not enable the relevant public to distinguish dishwasher detergents from others which have another origin.

Other factors

31. The parties have quoted various cases which they consider to be very similar to the present case (see paragraphs 7, 10 and 16). In this respect the Office notes that it is not bound by previous decisions. Each case must be assessed individually and on its own merits. This principle is established case law in the Benelux and the European Union.⁸

B. Conclusion

32. The claim for cancellation of the contested trademark is justified.

33. Since the claim is upheld on the basis of Article 2.2bis (1)(b) BCIP, the Office will not examine the case on the other ground invoked, namely Article 2.2bis (1)(c) BCIP (descriptiveness).

IV. DECISION

34. The cancellation application with number 3000624 is justified.

35. Benelux trademark registration 1482557 is invalidated.

36. The defendant shall pay the claimant 1,420 euros in accordance with Article 2.30ter (5) BCIP in conjunction with rule 1.44 (2) IR, as the cancellation application is upheld in its entirety. This decision constitutes an enforceable order pursuant to Article 2.30ter (5) BCIP.

The Hague, 12 July 2024



Marjolein Bronneman
(*rapporteur*)

Pieter Veeze

Flavie Rougier

Administrative officer: Rudolf Wiersinga

⁸ See for instance: CJEU 10 March 2011, C-51/10 P, ECLI:EU:2011:139, point 77 (1000).